

O-178-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3027265
BY ACTAVIS GROUP PTC EHF
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 3**

DERMALAB

AND

**OPPOSITION THERETO (NO. 402048) BY
DEBORAH GROUP S.P.A.**

Background and pleadings

1. This dispute concerns whether the trade mark **DERMALAB** should be registered for the following class 3 goods:

Soaps; preparations for the care of the hair, skin, scalp, face and nails; face and body soap; body washes; face and body lotion; skin balms (cosmetic); hair lotions; hair balms; lip balms; toners; moisturisers; shampoos; conditioners; creams and lotions for removing make-up; eye-masks filled with lavender or other herbs, flowers and plants; beauty masks; facial packs; perfumes; eau de cologne; toilet waters; perfume oils; aromatherapy oils and products; essential oils; massage oils; non-medicated massage preparations; breath freshening preparations; extracts of flowers; sun-tanning preparations; sun-screening preparations; deodorants and antiperspirants; body sprays; bath and shower products; foam bath, bath salts, bath and shower oils; shower gels; depilatory preparations; shaving preparations; aftershave preparations; cosmetics; non-medicated bath and toilet preparations; non-medicated toilet preparations; non-medicated toilet preparations produced from essential oils; tissues and wipes impregnated with non-medicated toilet preparations; cotton wool and cotton wool buds.

The mark was filed by Actavis Group Ptc ehf (“the applicant”) on 21 October 2013 and was published for opposition purposes on 24 January 2014.

2. Registration is opposed by Deborah Group S.P.A. (“the opponent”). It pleads a single ground of opposition under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying on the following trade mark:

UK registration 3016927 which was filed on 6 August 2013 and which completed its registration process on 8 November 2013. The mark and the class 3 goods for which it is registered are:



LABORATORI **DEBORAH** GROUP
DERMOLAB

Soaps; perfumery; essential oils; cosmetics; make-up preparations; face and body beauty care preparations; hair lotions; dentifrices.

In its statement of case the opponent states that:

“The dominant element of the earlier mark is the word DERMOLAB. Taking this into account, the marks are phonetically and visually similar. The marks share the elements 'DERM' and 'LAB'. The only difference is in the fifth letter of each mark; the fifth letter in the earlier mark is 'O' and the fifth letter in the contested application is 'A' and this does not materially affect the pronunciation of the marks. This is especially so as the vowels 'O' and 'A' are both soft sounding. In addition, the respective goods are identical and similar and consequently, there is a likelihood of confusion.”

3. The applicant filed a counterstatement denying the claims, specifically it:
- a) Denies that DERMOLAB is the dominant part of the earlier mark, highlighting the inclusion of the words LABORATORI DEBORAH GROUP which is says plays “an important and distinctive role” within the earlier mark and that this aspect of the mark refers to its commercial origin.
 - b) Denies that the marks are visually and aurally similar, highlighting the visual and aural distinction the additional words LABORATORI DEBORAH GROUP make. It notes that the opponent did not refer to conceptual similarity – it adds that there is conceptual dissimilarity due to the concept behind LABORATORI DEBORAH GROUP (referring to an Italian/European company) which is not present in the applicant’s mark.
 - c) Denies that the respective goods are identical or similar.
 - d) Denies that there is a likelihood of confusion.
4. The applicant is represented by Olswang LLP, the opponent by Cleveland LLP. Both sides filed evidence. Neither side requested a hearing, both opting to file written submissions instead.

The evidence

The opponent’s evidence

5. This comes from Ms Rebecca Silva, an associate trade mark attorney at Cleveland LLP. Exhibit RS1 of her evidence contains definitions taken from Collins English Dictionary (21st Century Edition) for the terms: beauty, dentifrice, cosmetic, essential oil, lotion, make-up, perfume and soap. I will bear the definitions in mind (and refer to them when necessary) but will not set them out here.
6. Exhibit RS2 contains webpage prints of the products of various manufactures/suppliers in order to show that they provide a range of cosmetic etc products. The uses include:
- Nivea body lotion, hand lotion, day cream, soap, sun lotion, after sun lotion, deodorants and body sprays.
 - Garnier make-up remover, scrubs, skin toner, gel wash, BB cream, shampoo, conditioner, sun lotion and after sun, moisturising lotion, bronzer, body mist, cleansing wipes and day cream.
 - Colgate toothpaste, mouthwash and inter-dental brushes.
 - Dove shampoo, hair treatments, body lotion, hand cream, self tan lotion, soap, body wash, bath lotion, hand wash, deodorants and anti perspirants, after shaving creams.
 - Shishedo face creams and lotions, serums, face masks, body cream, exfoliator, hair lotion, perfume, shower gel, sun tan preparations, moisturiser and self tanning preparations.

- The Body Shop tee tree oil, skin reviver, bronzer, cleansing butter, moisturiser, hand cream, face wash, shampoo, conditioner, soap, exfoliator, moisture masks and wipes.
- Lush masks and deodorants; the prints are supposed to also show soap but this is not clearly depicted.
- Boots hand wash, skin cream, shampoo, make-up remover, face wash, deodorants and anti-perspirants, body sprays, sun tan lotion, wipes face masks, body butter and eye masks.
- Johnson's moisturiser (including cream), barrier cream, shampoo, soap, bath lotion, baby wipes, cotton wool buds and cotton wool.

7. Exhibit RS3 contains website prints of the opponent's use of its mark. It shows the mark in suit on various products such as day cream, cleansing milk, moisturising balm, make-up remover. There is a reference to "DERMOLAB - FROM THE DEBORAH GROUP LABORATORIES COMES DERMOLAB".

8. Exhibit RS4 contains further web prints which are meant to show house and secondary marks used together and on their own. The point being made is that sometimes the secondary mark is equally or more important than the house mark. I do not consider it necessary to summarise this material. I accept that it shows that some traders in the cosmetics/beauty field sometimes use house marks and sub-brands together, but sometimes they are split up.

The applicant's evidence

9. This comes from Kaisa Mattila, an associate at Olswang LLP. Much of her evidence relates to DERM- formative marks. Exhibit KM1 contains state of the register evidence of such marks which Ms Mattila states contains 522 results in class 3 (including 334 community trade marks). She states that this is indicative that such marks have a low degree of distinctiveness. Exhibits KM2-KM5 are various web prints and searches conducted on websites for names incorporating DERM. It is suffice to say that there are a reasonably large number, mainly in relation to products that are applied to, or used on, the skin. Exhibit KM6 contains similar results for the word DERMO-. It is stated by Mr Mattila that this shows that the suffixes derm/dermo have weak distinctive character. She also highlights that the uses typically have a house mark in conjunction with the DERM/DERMO formative sub-brand which acts as the primary indicator of origin.

10. In relation to the opponent's evidence of house and sub marks being used together and independently, Ms Mattila states that register searches have been conducted to show that in the majority of examples given by the opponent, the sub-brand was itself registered as a trade mark and that those standalone marks have stronger distinctive character.

11. In relation to the opponent's use, Ms Mattila states that the opponent's website makes use of the composite mark as per the registered form (or not materially different to it) which includes the words LABORATORI **DEBORAH** GROUP. She highlights the emphasis given to the word DEBORAH and that the word LAB in **DERMOLAB** (lab being in bolder print) creates a link to the earlier word laboratori. She adds that the words LABORATORI **DEBORAH** GROUP are not negligible in the

overall impression of the mark and highlights, again, the deliberate emphasis placed on the word DEBORAH.

Opponent's reply evidence

12. This is, again, from Ms Silva. It simply contains further web prints of cosmetic etc products using house marks and sub-marks together and on their own and that in some cases the sub-mark is more visually dominant. I do not consider it necessary to summarise this material in any greater detail.

Section 5(2)(b)

13. Section 5(2)(b) of the Act states that:

“5.-(2) A trade mark shall not be registered if because – ..

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

14. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Average consumer and the purchasing act

15. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

16. The goods of both parties are in the field of cosmetics and personal grooming. Although the cost of these goods can vary, they are not, generally speaking, highly expensive and they will be purchased fairly frequently. I consider the purchasing process to be a normal, reasonably considered one. The goods will most often be self-selected from a shelf (or the online equivalents) and the marks may be exposed visually in advertising and websites etc. I consider that the visual impact of the marks

will take on more importance, although I will not ignore the aural impact completely. It could be said that perfumes are purchased with greater care because they are generally more expensive than other types of personal grooming products. However, this should not be overplayed because whilst there may be some very expensive perfumes, there are also much cheaper products on the market and confusion must be considered from that perspective also. Therefore, I do not consider the position to be materially different from the perspective of perfumes than from the other goods covered by the various marks.

Comparison of goods

17. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

18. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

19. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use

of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

20. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as complementary and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

21. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

22. Even if goods are not worded identically, they can still be considered identical if one falls within the ambit of another, as per the judgment in *Gérard Meric v OHIM*, Case T-133/05.

23. The earlier mark is registered in respect of the following class 3 goods:

Soaps; perfumery; essential oils; cosmetics; make-up preparations; face and body beauty care preparations; hair lotions; dentifrices.

I will go through the applied for goods term by term, albeit grouping them when it is reasonable to do so:

Soaps; face and body soap; hair lotions; perfumes; essential oils; cosmetics

24. In its counterstatement, the applicant denied that any of the goods were identical or similar. However, it provided no submissions at all on this in its written submissions. There is clearly identity for the above goods. As the opponent pointed out in its written submissions, the above terms are identically worded (or amount to exactly the same thing) to terms in the earlier mark’s specification.

Preparations for the care of the hair, skin, scalp, face and nails; body washes; face and body lotion; skin balms (cosmetic); hair balms; lip balms; toners; moisturisers; shampoos; conditioners; bath and shower products; non-medicated bath and toilet preparations; non-medicated toilet preparations; non-medicated toilet preparations produced from essential oils; eye-masks filled with lavender or other herbs, flowers and plants; beauty masks; facial packs; depilatory preparations

25. In its evidence the opponent provides a dictionary definition of the term cosmetics (a term covered by its earlier mark) as “any preparation applied to the body”. It argues that virtually all of the applied for goods fall within this term with the consequence that they should be regarded as identical. Whilst I do not disagree that the term cosmetics is a fairly broad one, the key purpose of a cosmetic is, as the name suggests, to have some form of cosmetic impact upon ones appearance. Therefore, I do not go so far as the opponent has in its submissions with regards to the applied for terms which should be regarded as cosmetics, but I nevertheless consider the above goods to be identical to goods covered by the earlier mark on the basis that they are indeed “cosmetics”.

Eau de cologne; toilet waters; aftershave preparations

26. The earlier mark covers “perfumes”. I consider the above goods to fall within perfumes, and, so, are identical.

Deodorants and antiperspirants; body sprays

27. The above goods, whilst arguably not perfume per se, serve such a similar purpose to perfume that they ought to be regarded as highly similar.

Foam bath, bath salts, bath and shower oils; shower gels

28. The earlier mark is registered for “soaps” and I consider that the above goods serve such a similar purpose that they ought to be regarded as highly similar.

Creams and lotions for removing make-up; tissues and wipes impregnated with non-medicated toilet preparations; cotton wool and cotton wool buds

29. The above goods are used in conjunction with cosmetics as part of a person’s beauty regime. This creates some similarity in purpose, although I accept that they are not in competition and the methods of use differ. However, they are likely to be sold in close proximity to each other and I consider that they serve a clear complementary role and that the average consumer will very likely believe that the respective goods are offered by the same or economically connected undertakings. I consider the above goods to have a reasonably high degree of similarity in view of all this.

Extracts of flowers

30. The earlier mark covers “essential oils”. The above goods seem to me to be an equivalent term and ought to be considered identical; if not then they are highly similar.

Perfume oils; aromatherapy oils and products; massage oils; non-medicated massage preparations

31. Essential oils can be used for perfuming and massaging purposes and, thus, are highly similar to the above goods.

Breath freshening preparations

32. The earlier mark covers “dentifrices”. The applied for “breath freshening preparations” may not be a dentifrice per se, but it would appear to serve a similar purpose and performs a clear complementary role in that the average consumer will very likely believe that the respective goods are offered by the same or economically connected undertakings. The goods have a reasonably high degree of similarity in view of all this.

Sun-tanning preparations; sun-screening preparations

33. The applied for “sun-tanning preparations; sun-screening preparations” are not cosmetics per se given their primary function as a product to protect the skin as opposed to beautifying it. However, such products contain various moisturisers which help the skins appearance and, also, some cosmetics (such as foundation)

contain formulations to protect the skin from the sun. I consider the goods to be reasonably similar.

Shaving preparations

34. The above goods would include items such as shaving foam and gel. They would be used as part of a person's grooming regime. Although they are unlikely to be regarded as a cosmetic per se, they may nevertheless include ingredients which look after the skin whilst shaving. In comparison to goods such as soaps, moisturisers and the like (which would be covered by the goods of the earlier mark) there is some similarity in nature, although the exact purpose is not the same. They could be sold through similar trade channels. They may not be competitive, but there seems to me to be a complementary link in the sense that the average consumer will very likely believe that the respective goods are offered by the same or economically connected undertakings. I consider there to be a medium degree of similarity.

Distinctiveness character of the earlier mark

35. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

36. The opponent's evidence showing its mark in use contains no objective information such as sales figures etc to demonstrate what impact it has had on the average consumer. Consequently, the assessment of distinctive character must be based solely on its inherent qualities. The earlier mark consists of the following composite trade mark:

37. The mark has two distinct components LABORATORI **DEBORAH** GROUP and **DERMOLAB** separated by a line, the former being depicted above the latter. I accept that LABORATORI **DEBORAH** GROUP will likely be seen as a reference to the group (or company) that is the manufacturer of the product, a house mark if you like. The inclusion of the word **DEBORAH** (which is also emboldened) gives this component a reasonable level of inherent distinctive character. The other element **DERMOLAB** has a degree of allusiveness. The element **DERM-** or **DERMO-** is likely to be perceived and understood as some form of reference to dermatology. The evidence of the applicant relating to the vast number of marks both on the register (which in itself has little weight), but also on the market, demonstrates this. However, the component is **DERMOLAB** not **DERM** or **DERMO** alone. Whilst the word **LAB** may have its own meaning, its combination with **DERMO** seems somewhat unusual, albeit it gives the component some allusive, almost quasi scientific feel. However, there is no evidence that dermo labs, derma labs or even dermatology labs exist. I consider the allusiveness of this component to be quite mild and that it has, in my view, an average level of inherent distinctive character.

38. The combination of components may give the mark as a whole slightly more inherent distinctive character than **DERMOLAB** per se. However, this is not particularly relevant because it is the distinctiveness of the common element which is key. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis QC (sitting as the Appointed Person) pointed out that the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

Comparison of marks

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to

analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

40. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

41. The marks to be compared are:



and

DERMALAB

42. The overall impression of the applied for DERMALAB mark resides in its totality. Neither the word DERMA nor the word LAB is particularly distinctive and it is the combination as a whole in which its distinctive character resides with neither word dominating the other in the overall impression made.

43. The parties have made detailed submissions on the overall impression of the opponent's mark. The opponent focuses on the use in trade of house marks and secondary marks often in circumstances where the secondary mark is also used alone. The applicant focuses on what it considers the low distinctiveness of the common element and that the words LABORATORI **DEBORAH** GROUP is the part of the mark which primarily indicates trade origin. The applicant also complains that the opponent is attempting to make the comparison on the basis of the common element, ignoring the whole mark comparison that must be made. In terms of assessing the overall impression of the earlier mark, I did not find the opponent's evidence to be particularly helpful. I must consider the mark presented and the notional use of it as a whole. However, although some of the opponent's submissions referred to the common element as "the mark", I do not think it is attempting to make the comparison solely on the basis of the common element. Such an attempt would clearly be wrong. The words LABORATORI **DEBORAH** GROUP clearly play a role in the overall impression which is far from negligible. To attempt to assess the overall impression of the mark based upon the levels of

distinctiveness of the components is not, in this case, particularly helpful. Although, LABORATORI **DEBORAH** GROUP may have slightly more distinctiveness than DERMOLAB, the latter still has an average degree of inherent distinctive character. What is noticeable, in my view, is that the eye is drawn more directly to the DERMOLAB component given its size and impact. This component plays a greater relative role in the overall impression than LABORATORI **DEBORAH** GROUP, albeit the latter still plays an important role in the overall impression of the mark.

44. From a visual perspective, the marks coincide to a degree because the totality of the applied for mark is DERMALAB and the component of the earlier mark which plays the greatest relative role in its overall impression is DERMOLAB. Whilst these components are not identical, they nevertheless have a strong degree of similarity. However, as the applicant points out, a whole mark comparison must be made. The additional difference created by the words LABORATORI **DEBORAH** GROUP must therefore be taken into account, a difference which clearly reduces the degree of visual similarity. However, given the greater role DERMOLAB plays, I still consider there to be at least a medium degree of visual similarity.

45. A similar assessment runs through the aural comparison. DERMOLAB and DERMALAB will be pronounced in a very similar fashion, but a difference is created by the additional words in the earlier mark. I consider there to be a medium degree of aural similarity.

46. Conceptually, the applicant focuses on the concept underpinning the words LABORATORI **DEBORAH** GROUP, in terms of being a group or company characterised by the name DEBORAH. Such a concept is clearly not present in the applied for mark. However, I consider the words DERMOLAB/DERMALAB to both have at least an evocative concept³, both suggesting, albeit mildly, a lab that deals in dermatological matters. So, even though the additional wording of the earlier mark creates a difference, there is also a strong similarity.

Likelihood of confusion

47. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

48. I will consider the position firstly from the perspective of the following goods:

Soaps; face and body soap; hair lotions; perfumes; essential oils; cosmetics

49. These are the goods I found to be identically worded (or effectively so) in the respective marks. That the goods are identical means that a lower degree of similarity between the marks may potentially be off-set. I point out, though, that the

³ See, for example, *Usinor SA v OHIM* Case T- 189/05 where the General Court referred to a “suggestive connotation”. Also, in *Ontex NV v OHIM* Case T- 353/04 it referred to the “evocative effect”.

marks are, in any event, visually and aurally similar to a medium degree. Furthermore, whilst there may be a conceptual difference between the marks on account of the concept behind the additional wording, there is also conceptual similarity on account of the common (similar) element.

50. In its written submissions the opponent refers to a number of cases including *Matratzen Concord GmbH v OHIM*, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* and *Bimbo SA v OHIM*, Case C-591/12P; other cases referred to include *Sabatier* [2008] EWCH 881 (Ch), *Golden Eagle* Joined cases t 5/08 to t-7/08 and *Aveda* [2013] EWCH 589 (Ch). I do not consider it necessary to discuss in detail the case-law underpinning the treatment of complex marks beyond that already noted above in paragraph 14, particularly paragraphs d, e and f. It is, though, worth adding the point from *Aveda* that the common element in a composite mark need not be identical and a likelihood of confusion may arise on the basis of similarity in the common element. As I have already stated, **LABORATORI DEBORAH GROUP** is not negligible in the overall impression of earlier mark so a whole mark comparison has been made. However, I have found that **DERMOLAB** plays a greater relative role in its overall impression and that this element has at least an average level of inherent distinctive character. The question must, though, still be considered from the perspective of the average consumer and whether there is a likelihood of confusion on their part. In terms of informing that decision, I should say that two aspects of the opponent's evidence/submissions provide little help. Firstly, its evidence of house marks/secondary marks being used together and separately is not particularly informative. I must look at the marks before me. Secondly, whilst I accept that the notional and fair use of the applicant's mark would include use in a variety of fonts, the "mock-ups" provided in the opponent's evidence showing use of the applicant's mark on the product packaging (including get-up) of the opponent, and vice versa, takes notional use too far.

51. I consider that an average consumer for the goods at issue paying the degree of care and attention assessed earlier will believe that the identical goods sold under the respective marks are the responsibility of the same or an economically linked undertaking. Even if the presence/absence of **LABORATORI DEBORAH GROUP** were noticed, the common presence of **DERMALAB/DERMOLAB** in the respective marks, together with the role it plays in the earlier mark, coupled with the degree of distinctiveness as assessed, would indicate a same stable product. Whilst there is a difference between **DERMALAB/DERMOLAB**, **this** is a difference that could easily be lost due to imperfect recollection. There is a likelihood of confusion.

52. I have no hesitation, for obvious reasons, extending the above finding to the other goods I assessed as being identical. Neither do I have any real hesitation in extending the findings to the goods I assessed as being highly similar (or similar to a reasonably high degree) to the goods of the earlier mark. In terms of the remaining goods which I found to be similar to a medium (or reasonable) degree, I also find a likelihood of confusion. The relationship between the goods, bearing in mind the degree of similarity between the marks, will still lead to a same stable assumption.

Outcome

53. The opposition succeeds and the applicant's mark is to be refused registration in respect of all of the goods applied for.

Costs

54. The opponent has succeeded and is entitled to a contribution towards its costs. My assessment is as follows:

Preparing a statement and considering the other side's statement - £300

Official fee - £100

Filing and considering evidence - £500

Written submissions - £400

55. I therefore order Actavis Group Ptc ehf to pay Deborah Group S.P.A the sum of £1300. This should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15TH day of April 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**