O/0732/24

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO. 3871091

IN THE NAME OF VOLTEN, INC.

TO REGISTER

VOLTEN

AS A TRADE MARK IN CLASSES 3, 8, 11, 26, 35

AND

OPPOSITION THERETO (UNDER NO. 440440)

BY

FOLTENE LABORATORIES S.R.L.

Background and pleadings

1. On 25 January 2023, VOLTEN, INC. ("***the Applicant***") applied to register in the UK the trade mark shown on the cover page of this decision, under number UK00003871091 ("***the Contested Mark***"). Details of the application were published for opposition purposes on 3 February 2023. Registration is sought for the following goods and services:

Class 3 Shampoos, conditioners, hair care products, skincare products.

Class 8 Electric hair straightener: Electric hair straightening irons.

Class 11 Hair dryer diffusers: Hair dryers; Hair dryers for beauty salon use; Hair dryers for household purposes; Electric hair dryers.

Class 26 Electric hair-curlers, other than hand implements: Hair curlers, electrically-heated, other than hand implements.

Class 35 On-line retail store services in relation to personal care products and clippers.

2. On 26 April 2023, Foltene Laboratories S.r.l. ("***the Opponent***") opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (***"the Act"***). The Opponent relies upon the prior trade mark registrations set out in the Annex to this decision ("***the Earlier Marks***"). The opposition is directed against class 3 of the application only.

3. For the purposes of the opposition, the Opponent relies upon some of the goods for which the Earlier Marks are registered as indicated in the Annex.

4. By virtue of their respective earlier filing dates (and priority date for Mark 1), the prior registrations set out in the Annex constitute earlier marks within the meaning of section 6 of the Act.

5. The Earlier Marks completed their registration process over five years prior to the filing date of the Applicant's mark. As such, they are, in principle, subject to the proof of use requirements specified within section 6A of the Act. However, in its counterstatement the Applicant did not request proof of use. The Opponent can, therefore, rely upon all of the goods it has identified without having to demonstrate use.

6. In its statement of grounds, the Opponent contends that the competing marks must be considered similar to a high degree, that the respective goods are identical or highly similar and that, as a result of the similarity in marks and similarity in goods, there exists a likelihood of confusion including a likelihood of association.

7. VOLTEN, INC. filed a counterstatement, denying the grounds of opposition and submitting that that there are visual and phonetic differences between the competing marks. Specifically, the Applicant argues that the respective marks have a different number of letters, begin with different letters (respectively "F" and "V"), and the overall pronunciation and emphasis differ due to the distinct vowel sounds in "FOLTENE" and "VOLTEN".

8. Subsequent to the filing of the counterstatement,[1] a preliminary indication was issued to the parties under the provision of Rule 19 of The Trade Marks Rules 2008.[2] That indication was that there exists a likelihood of direct confusion in respect of all the opposed goods. The Applicant gave notice that it wished to proceed to evidence rounds.[3] The preliminary indication, given by a different Hearing Officer, is not binding upon me and will have no bearing upon my decision.

Relevance of EU law

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

10. During the evidence rounds the Applicant filed written submissions.[4] The Opponent did not file evidence or written submissions. Neither party requested a hearing, but the Opponent filed submissions in lieu.[5] The submissions will not be summarised

[1] Dated 13 June 2023.
[2] Official letter dated 10 July 2023.
[3] As per form TM53, filed on 7 August 2023.
[4] Dated 23 January 2024.
[5] Dated 23 February 2024.

here but will be referred to as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

Approach

11. The Opponent relies upon two earlier registrations in the notice of opposition. Both earlier registrations are, respectively, identical to each other and the specification of Mark 1 covers that of Mark 2. Therefore, for the purposes of this opposition, if the Opponent cannot succeed on the basis of its Earlier Mark 1 (UK00800985193), it is clearly in no better position based upon the other Earlier Mark UK00001321667**.** I proceed accordingly.

Decision

The law

12. The relevant parts of section 5 of the Act are as follows:

> "5(1) […]
>
> (2) A trade mark shall not be registered if because—
>
> > (a) […]
> >
> > (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."
>
> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Case law

13. The leading authorities which guide me are from the CJEU: *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.

The Principles

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

14. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, 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".

15. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services;

c) The respective trade channels through which the goods or services reach the market;

d) 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;

e) 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.

16. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

17. The competing goods are as follows:

Opponent's goods	**Applicant's goods**
Class 3 (UK00800985193)	**Class 3**
Hair care products, hair lotions, cosmetic products for the hair; hair loss prevention products, hair regrowth products, hair strengthening products, restructuring hair masks, shampoos, hair conditioners, lotions for eyelashes and eyebrows, strengthening treatments for eyelashes and eyebrows.	Shampoos, conditioners, hair care products, skincare products.

18. The Applicant conceded[6] that the respective goods are either identical or similar. I agree with the Applicant. More specifically, for the purposes of this opposition and the global appreciation test, I find that the Applicant's "*Shampoos*", "*conditioners*",

[6] Applicant's written submissions dated 23 January 2024.

and "*hair care products*" in class 3 are reproduced identically in the Opponent's specification (i.e., "*shampoos*", "*hair conditioners*", "*Hair care products*").

19. With regard to the Applicant's "*skincare products*" I find this term to be highly similar to the Opponent's "*Hair care products*" as these goods have the same nature (beauty products), intended purpose (beautify), trade channels, and are aimed at the same users.

The average consumer and the nature of the purchasing act

20. It is necessary to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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".

21. The average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheideand Tusky* [1998] ECR I-4657, paragraph 31).

22. For the purposes 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 in question.[7]

23. The contested goods will be purchased by the general public as well as those working professionally, such as hairdressers or beauticians. Both the general

[7] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

public and the professionals will take various factors into consideration such as quality, ingredients, fragrance, price, and suitability for the user's needs (for example, in accordance with the purchaser's type of hair or skin). The cost of the purchase is likely to vary, although it is unlikely to be particularly high. The frequency of the purchase is also likely to vary, but they are likely to be bought fairly frequently. Accordingly, the level of attention paid will be average for everyday goods bought by members of the general public and above average for professional purchasers.[8] However, the likelihood of confusion must be assessed from the perspective of the former (the general public) since they are the group who will pay the lower degree of attention.[9]

24. The goods are likely to be obtained directly from the provider via websites, specialised retail outlets (e.g., chemists or hairdressers), or by self-selection from the shelves in supermarkets. As such, it is my view that the purchasing process will be predominantly visual in nature. However, aural considerations in the form of word-of-mouth recommendations or verbal discussions with the provider, for instance, cannot be excluded entirely.

Comparison of trade marks

25. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

26. 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

[8] Case T-356/14, [20].
[9] Ibid T -356/14 [25] – [26]

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion".

27. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

28. The trade marks to be compared are as follows:

Earlier trade mark	Contested trade mark
FOLTENE	VOLTEN

Overall impression

29. The overall impression of the Earlier Mark resides in the single word of which it is composed. The contested mark consists of the word VOLTEN with a stylised initial letter 'V' which appears to have had small part chipped away. The overall impression of that mark is dominated by the word VOLTEN, with the stylisation of the letter 'V' playing a much lesser role.

Visual similarity

30. The Earlier Mark is comprised of seven letters. The Contested Mark is comprised of six letters. The respective marks share the letter sequence "OLTEN" and differ in their first letter; the Earlier Mark also features an additional 'E' at the end. The Earlier Mark is represented in all capital standard characters, while the Contested Mark is a figurative mark which is composed of the word 'VOLTEN' in black and presented in uppercase, bold letters; part of the initial 'V' is incomplete as if a small part had been chipped away.

31. Whilst I take into account the general rule that the beginnings of words tend to have more visual and aural impact than the ends[10], this is no more than a general rule of thumb and does not apply in all cases. In the instant case, the fact that the first letters of the respective marks differ is tempered by the fact that the following five letters in the respective marks are identical. There is a point of visual difference arising due to the letter 'E' at the end of the Earlier Mark which is not present in the Contested Mark. I consider the marks to share an above medium degree of visual similarity.

Aural similarity

32. The Opponent submitted that:[11]

> "*The natural pronunciation of the Opponent's Mark is with a short vowel sound on the first letter 'E' and the second 'E' silent. Thus, both the Applicant's Mark and the Opponent's' Mark will be pronounced in essentially the same manner, i.e. 'fol-ten' and 'vol-ten'*."

33. I agree with the Opponent. It is my view that a significant proportion of relevant consumers are likely to voice both marks as the two-syllable words 'vol-ten' and 'fol-ten'. Furthermore, I agree with the Opponent's submissions[12] that the initial letters 'V' and 'F' have similar pronunciations. Thus, overall, I find the marks to have a high degree of aural similarity.

34. I also find that a separate significant proportion of the relevant consumer is likely to voice the Earlier Mark as 'fol- teen'. In this case I find the marks to be aurally similar to a medium degree.

Conceptual similarity

35. The Applicant argued that the Contested Mark is composed of the combination of 'VOLT' (abbreviation for 'voltage' indicating the name of a unit of electric potential) and the number 'ten'. The Applicant submits that most consumers are familiar with

[10] *El Corte Ingles, S4 v OHIM*, Cases T-183/02
[11] Submissions in lieu dated 23 February 2024.
[12] Submissions in lieu dated 23 February 2024.

the term 'VOLT' since "*the general population possesses a basic knowledge of electricity*".[13]

36. It is settled case law[14] that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. I do not accept that the average UK consumer will dissect the Contested Mark to derive the meaning of 'voltage' and 'ten' in relation to the goods at hand (i.e., hair and skin care products) and there is no evidence before me to suggest that this is likely to occur. Rather, it is my view that the relevant consumer will perceive the Contested Mark as an invented word devoid of any clear meaning.

37. The Earlier Mark is not a dictionary word, and it does not seem to have any semantic correlation with the goods at hand.

38. Taking these factors into account I find the respective marks to be conceptually neutral.

Distinctive character of the Earlier Mark

39. 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 *WindsurfingChiemsee* 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

[13] Written submissions dated 23 January 2024.
[14] This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

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)."

40. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

41. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the Opponent has filed no evidence of use of its mark. Accordingly, I have only the inherent position to consider.

42. The Opponent submitted that the Earlier Mark does not have "*any meaning in English whether in relation to the goods in question or otherwise*".[15] Therefore, the Earlier Mark is an invented word that does not convey any meaning. I find the Earlier Mark to have a high degree of inherent distinctive character.

Likelihood of confusion

43. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

[15] Submissions in lieu dated 23 February 2024.

44. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion occurs where the average consumer recognises that the marks are different but puts the similarities between them down to the respective goods coming from the same or linked undertaking(s).

45. I have found the respective goods to be identical or highly similar. The level of attention paid by the relevant average consumer (the general public) is average.. The distinctiveness of the Earlier Mark is high. The marks are similar visually to an above-medium degree, aurally to a medium or high degree and the competing marks are conceptually neutral. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind. Weighing all of these factors, and bearing in mind the effects of imperfect recollection, I find that the average consumer is likely to mistake the Earlier Mark for the Contested Mark. Thus, there is a likelihood of direct confusion. I would have reached the same conclusion even if I had found that the distinctiveness of the Earlier Mark is of a medium level (rather than high).

Conclusion

46. The opposition under section 5(2)(b) succeeds and the application will be refused in respect of the goods in class 3. The application may proceed to registration for the other goods and services applied for in classes 8, 11, 26, 35.

Costs

47. The opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice ("TPN") 1/2023. Bearing that scale in mind, I award costs to the Opponent as follows:

Official fee	£100
Preparing the notice of opposition and considering the counterstatement	£250
Submissions in lieu	£350
Total:	**£700**

48. I order VOLTEN, INC. to pay Foltene Laboratories S.r.l. the sum of **£700**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of August 2024

Andrea Rossi

For the Registrar

ANNEX

The Opponent's Earlier Marks

1) UK00800985193

Mark 1: FOLTENE

Goods relied upon for the opposition:

Class 3: Hair care products, hair lotions, cosmetic products for the hair; hair loss prevention products, hair regrowth products, hair strengthening products, restructuring hair masks, shampoos, hair conditioners, lotions for eyelashes and eyebrows, strengthening treatments for eyelashes and eyebrows.

Filed: 24/09/2008

Date of entry in the register: 09/11/2009

Priority date: 17/09/2008 (Italy)

2) UK00001321667

Mark 2: FOLTENE

Goods relied upon for the opposition:

Class 3: Preparations for the care of the hair, shampoos; hair conditioners, all included in Class 3.

Filed: 17/09/1987

Date of entry in the register: 14/07/1989