

O-0850-25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3910067

IN THE NAME OF

ECOLAB USA INC.

TO REGISTER THE FOLLOWING TRADE MARK:

ACTIGEL

IN CLASS 5

AND

OPPOSITION THERETO (UNDER NO. 443283)

BY

SOLAR MEDICAL AND CHEMICAL LIMITED

BACKGROUND

1) On 10 May 2023, Ecolab USA Inc. ('the applicant') applied to register the word ACTIGEL, as a trade mark in the UK. The application is made in respect of 'Disinfectants; sanitizing preparations; hand sanitizers; antiseptics' in class 5.

2) The application was published in the Trade Marks Journal on 07 July 2023 and notice of opposition was later filed by Solar Medical and Chemical Limited ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) In support of its grounds under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following two trade mark registrations:

- **UKTM 3486587 ('the word mark')**

Alcagel

Class 5: Hand-santizing preparations.

Filing date: 04 May 2020

Date of entry in register: 11 August 2020

- **UKTM 3716546 (series of 2) ('the stylised mark(s)')**



Class 5: Sanitary preparations and articles; hand sanitising preparations; hand sanitiser; sanitising wipes.

Filing date: 01 November 2021

Date of entry in register: 21 January 2022

4) It is claimed that the respective goods are either identical or highly similar and that the respective marks are similar, such that there exists a likelihood of confusion under section 5(2)(b) of the Act.

5) Under section 5(3) of the Act, it is claimed that the earlier marks have a reputation in the UK in relation to all the goods for which they are registered. It is also claimed that use of the contested mark will result in the relevant public believing that the respective marks are used by the same undertaking and that use of the contested mark will result in the applicant gaining an unfair advantage. It is also claimed that there will be detriment to the earlier marks' reputation and distinctive character.

6) The trade marks relied upon by the opponent are earlier marks, in accordance with section 6 of the Act. Neither of the earlier registrations completed its registration procedure more than five years prior to the application date of the contested mark; they are, therefore, not subject to the proof of use conditions, as per section 6A of the Act.

7) Under section 5(4)(a) of the Act, the opponent relies upon use of the word 'Alcagel' throughout the UK since 2005 in relation to 'Sanitary preparations and articles; hand sanitising preparations; hand sanitiser; sanitising wipes'. It is claimed that the opponent has generated goodwill, of which the word 'Alcagel' is distinctive, and that use of the contested mark will result in misrepresentation and damage to that goodwill.

8) The applicant filed a counterstatement denying the opponent's claims.

9) The opponent is represented by Lee & Thompson LLP. The applicant is represented by Stobbs. Both parties filed evidence. The opponent's evidence consists of a witness

statement from Russell Lewis Jack Powell, dated 16 February 2024, with Exhibits RLJP1 – RLJP12 thereto. The applicant’s evidence consists of a witness statement from Blake Robinson, dated 16 April 2024, with exhibits BR1 – BR3 thereto. Neither party requested a hearing; both filed written submissions in lieu.¹

DECISION

10) 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. Accordingly, I will refer, in this decision, to decisions of the EU courts which predate the UK’s withdrawal from the EU.

Section 5(2)(b)

11) This section of the Act states:

“5. - (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

¹ Both are dated 02 December 2024

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

12) The leading authorities which guide me are from the Court of Justice of the European Union ('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

13) The applicant accepts that its 'santizing preparations' and 'hand sanitizers' are identical to the opponent's 'hand-sanitising preparations' which is covered by both earlier marks. It also accepts that the same goods are identical to 'sanitary preparations and articles' and 'hand sanitiser', covered by the earlier stylised marks.²

² As per the applicant's submissions in lieu.

14) As regards its 'disinfectants' and 'antiseptics', the applicant concedes that there is 'a significant degree of overlap' between these goods and the opponent's 'sanitary preparations and articles' covered by the stylised marks. I take this to mean that it concedes those goods to be highly similar.³ I would go further than this. To my mind, the applicant's 'disinfectants' and 'antiseptics' are types of sanitary preparations. As such, I agree with the opponent that they fall within the opponent's 'sanitary preparations and articles' and the respective goods are therefore identical.

15) I also find the applicant's 'disinfectants' and 'antiseptics' are highly similar to the opponent's 'hand-sanitizing preparations', covered by the earlier word mark. I agree with the opponent⁴ that these goods clearly overlap in purpose, method of use, trade channels and users and may be in competition with each other.

Average consumer and the purchasing process

16) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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."

17) The average consumer for the relevant goods is the general public and professionals in the medical/care sector. The purchasing act will be primarily visual;

³ *ibid*

⁴ As per the opponent's submissions in lieu, [11]

all the goods being sought out on the Internet or from bricks and mortar establishments. That is not to say, though, that the aural aspect should be ignored because the goods may sometimes be the subject of discussions with sales representatives, for example. The average consumer may take into account various factors such as scent, composition and suitability for skin type or other cleaning purposes. I would expect the level of attention paid during the purchase to be medium for both kinds of consumer.

Comparison of marks


18) 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.”

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

19) The opponent's stylised marks are identical save for the fact that one is in black and white and the other is in colour. As the opponent's coloured mark clearly offers it no stronger prospect of success than the black and white mark, I will use the latter for

the purposes of comparing the marks. The marks to be compared are, therefore, as follows:

Opponent's marks	Applicant's mark
<p data-bbox="204 456 432 488"><u>The word mark:</u></p> <p data-bbox="301 568 480 622">Alcagel</p> <p data-bbox="204 748 469 779"><u>The stylised mark:</u></p> 	<p data-bbox="983 533 1214 586">ACTIGEL</p>

Overall impressions

20) Both parties agree that, although their word marks consist of a single seven letter word, the average consumer will recognise the word 'gel' within them. As submitted by the opponent, although both the words 'Alcagel' and 'Actigel' appear to be invented, the 'gel' part of the marks 'will inform the average consumer of the nature of the respective products'.⁵ That being so, it seems to me that, if the average consumer will perceive the endings of the marks as merely indicating the nature of the goods, it will be the first part of the invented respective words, 'Alca' and 'Acti', which will have the greater degree of dominance in both marks over the ending, 'gel'. (For reasons given below in paragraph 25, I disagree with the applicant that the 'Alca' and 'Acti' parts of the marks have any immediately graspable concept. I note that the opponent also does not contend that the 'Alca' and 'Acti' parts of the marks have any conceptual meaning).

⁵ Submissions in lieu, paragraph [17]

21) The opponent's stylised mark is dominated by the word element. Further, within that word, and for the same reasons given above, it is the 'Alca' part that has greater dominance than the ending 'gel'. The arc shape above the word plays a lesser role than the word element and the small device at the end of the word, which is reminiscent of bubbles, plays the least role.

Similarity with the earlier word mark

22) Visually, both marks consist of seven letter words. The last three letters are identical; the first letter is also identical. A visual difference arises owing to the letters 'lca' in the earlier mark as opposed to the letters 'cti' in the later mark. Whilst both marks contain the letter 'c' within those three letters, the 'c' is in a different position in the marks. Despite the identity of the respective initial letters and last three letters of the marks, I find that the visual difference between 'lca' on the one hand and 'cti' on the other, near the beginning of the words, makes a striking impact upon the eye. Overall, I find no more than a medium degree of visual similarity between the marks.

23) Aurally, the earlier mark will be pronounced as 'AL-CA-GEL'. The later mark is likely to be pronounced as 'AC-TEE-GEL'. Both marks consist of three syllables, the last of which is identical. There is some similarity in the first syllable because they begin with the letter 'A'. The differences arise due to the 'L' sound versus the 'C' sound at the end of the first syllable and the second syllable of the marks is entirely different to the ear. I find a below-medium degree of aural similarity between the marks.

24) Conceptually, as noted above, the opponent submits that, although both marks are invented words, the consumer will recognise that they both consist of the word 'gel' which, it says, 'will inform the average consumer of the nature of the respective products'.⁶ Therefore, it says that this point of conceptual coincidence renders the marks conceptually similar to a low degree. The applicant agrees that the word 'gel' will be perceived in both marks. It further contends that the applicant's mark will be perceived as meaning 'active gel' or a 'gel with an active ingredient' and the opponent's mark will be perceived as meaning 'alcohol gel'.

⁶ Ibid

25) I am not persuaded that the average consumer will immediately perceive the 'alca' part of the opponent's mark as meaning 'alcohol'. There is no evidence before me to satisfy me that 'alca' is a common abbreviation of 'alcohol' or that the average consumer would recognise it as such. I also reject the applicant's contention that the 'acti' part of its mark will immediately be perceived as meaning 'active' or 'active ingredients' in the absence of evidence to satisfy me otherwise.

26) I agree with the opponent that both marks will be perceived as invented words. I also agree with the opponent that, despite their invented nature, the average consumer will immediately recognise the presence of the well-known word 'gel' in the marks which will be perceived as a reference to the nature of the goods. On that basis, I accept the opponent's submission that there is a low degree of conceptual similarity between the marks.⁷ However, that is not a distinctive similarity for the precise reason which is given by the opponent i.e. it 'will inform the average consumer of the nature of the respective products'.

Similarity with the earlier stylised mark

27) Bearing in mind my findings above in relation to the word mark, it logically follows that the stylised mark is even less visually similar to the contested mark than the earlier word mark, owing to the presence of further points of visual difference (the arc shape and the device reminiscent of bubbles). The degree of visual similarity is below-medium. Aurally, the marks are similar to a medium degree for the same reasons given above in relation to the word mark given that the device elements will not be vocalised. Conceptually, I bear in mind my findings above as regards the respective word elements. The conceptual similarity arising out of the common 'gel' concept is not a distinctive one for reasons already given. I do not consider that the arc device in the opponent's mark will form part of the conceptual hook for the consumer. The device reminiscent of bubbles will be immediately perceived as such. However, that is not a distinctive conceptual difference between the marks because it merely indicates that when used, the relevant products may foam to produce bubbles.

⁷ Submissions in lieu, paragraph [17]

Distinctive character of the earlier marks

28) The distinctive character of each earlier mark must be considered. The more distinctive each of them is, either by inherent nature or by use, the greater the likelihood of confusion between each of them and the contested mark (*Sabel BV v Puma AG*). 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).”

29) I will first consider the inherent distinctiveness of the word mark, ‘Alcagel’. As I have already touched upon, I agree with the opponent that this word is most likely to be perceived as an invented word but one which will nevertheless be recognised as containing the word ‘gel’. The ‘Alca’ part of the mark is unlikely to create any immediately clear conceptual message for reasons already given earlier in this

decision. That being so, I find that the word mark, as a whole, has an above-medium degree of inherent distinctiveness. However, that degree of distinctiveness stems from the prefix 'Alca', not from the entirely descriptive 'gel' part of the mark. The same findings apply to the word in the stylised mark. I do not consider that the arc-shaped device or bubble device elevate the distinctiveness of that mark to any higher degree.

30) Turning to the question of whether the inherent distinctiveness of either of the opponent's marks has been enhanced through use, it is necessary to consider the evidence from Mr Powell. I summarise the most pertinent parts of his narrative evidence and exhibits below:

- Mr Powell states that products bearing the Alcagel mark have enjoyed commercial success since they were first introduced in 1995. First use was by a different company to that of the opponent. Mr Powell explains that the 'ownership of the ALCAGEL trade marks and the goodwill of the trade mark passed uninterrupted between the [list of companies in his witness statement and the opponent], with each new business taking over the assets and the business of the previous one'.⁸
- It is said that customers of Alcagel products have always been Nursing Homes and various distributors and, since the COVID-19 pandemic, the opponent has been supplying its ALCAGEL products throughout the UK, in particular, to local government, education, the NHS and larger care suppliers.⁹
- The opponent company was incorporated in March 2017 and its main line of business is supplying medical disposables, janitorial supplies, paper products and healthcare equipment to businesses and the general public throughout the UK. It is said that the opponent supplies over 4000 different products to nursing homes, domiciliary care, local government, hotels, veterinary practices, industry and many more. The opponent also produces and manufactures a range of household cleaning products to the public and businesses throughout the UK.¹⁰

⁸ Powell, paragraph [3]

⁹ Powell, paragraph [6]

¹⁰ Powell, paragraph [8]

- A print from the 'Wayback Machine' is provided from the opponent's website, www.solarmedchem.co.uk, dated 08 August 2020. The stylised mark is clearly visible on the website in use on, and relation to, hand sanitiser and hand and surface wipes.¹¹
- A print from www.vanguardchemicals.co.uk is provided from the Wayback Machine, dated 1 February 2011.¹² It is said that Vanguard Chemicals is the chemical manufacturing division of the opponent.¹³ I cannot see any use of the ALCAGEL mark on this page. A further print from the same website is provided which appears to be dated 8 February 2024 (which is after the relevant date) which does show ALCAGEL (stylised) in use on hand sanitiser and hand and surface wipes.¹⁴
- Various undated images of products are provided showing use of the stylised mark on the packaging of hand sanitising gels and hand and surface sanitising wipes.¹⁵
- Total turnover for products bearing the ALCAGEL mark in the UK between 2017 and 2023 are provided, as follows:¹⁶

¹¹ RLJP-3

¹² RLJP-4

¹³ Powell, paragraph [12]

¹⁴ RLJP-4

¹⁵ RLJP-5

¹⁶ RLJP-6

Alcagel Sales - all sales 2017-2023

<u>Stock Code/SKU</u>	<u>Description</u>	<u>Quantity Sold</u>	<u>Sales £</u>
H2309	ALCAGEL HAND & SURFACE WIPES 70% alc 200x280mm (50)	3,943	£ 8,601.64
H2310	ALCAGEL HAND & SURFACE WIPES 70% alc 180x200mm (250)	1,471	£ 8,532.77
H2311	ALCAGEL HAND & SURFACE WIPES 70% alc 180X200mm (1000)	351	£ 8,440.54
H6093	GEL DISPENSER 900ml - A3 SAFETY SIGN / FREE 5L ALCAGEL	105	£ 10,210.80
H6099	PLASTIC SOAP/ALCAGEL DISPENSER 1LTR MEVON WHITE	34	£ 799.96
H63033	ALCAGEL ALCOHOL 70% IBC 1000 Ltr READY TO USE	19	£ 27,629.64
H63035	ALCAGEL HAND SANITISER 70% (56x100ml) BS EN14476	148	£ 7,841.80
H63035A	ALCAGEL HAND SANITISER 70% alc (100ml) BS EN114776	16,514	£ 11,185.89
H63036	ALCAGEL HAND SANITISER 70% alc (6x1Ltr)BS EN14476	324	£ 17,260.10
H63037	ALCAGEL HAND SANITISER 70% alc (2L)BS EN14476	1,021	£ 13,173.32
H63038	ALCAGEL HAND SANITISER 70% alc (5L) BS EN14476	31,523	£ 588,949.98
H63162	ALCAGEL HAND SANITISER 70% alc (9X500ML)BS EN14476	34,445	£ 1,341,962.30
H631622	ALCAGEL HAND SANITISER 70% alc (500ML) BS EN14476	3,380	£ 27,551.77
H631623	ALCAGEL5 LTR HAND SANITISER STAND (each)	1	£ 154.80
H631624	ALCAGEL HAND SANITISER STAND (each)	51	£ 4,771.13
H631625	ALCAGEL BLACK WALL DISPENSER each	43	£ 258.00
H900	ALCAGEL HAND SANITISER 70% alc (9X500ml) SPECIAL	240	£ 1,944.00
		93,613	£ 2,079,268

- Total marketing expenditure for advertising and promoting ALCAGEL products in the UK between 2017 and 2023 is also provided, as shown in the table below.¹⁷ Mr Powell states that marketing activities happen predominantly via distributors and a dealer network via email, phone calls or in-person and are simply part of the role for staff members at Solar Medical. Therefore, he states that these activities cannot be specifically financially quantified.

<u>Service provider</u>	<u>Date/Date range</u>	<u>Amount</u>	<u>Description</u>
Hallmarketing Ltd	2020-2022	£ 17,717.00	Alcagel brand and marketing consultancy services
Go Local advertising	2019-2020	£ 820.00	Print advertising - local press
Jay Waugh	2020	£ 2,304.00	Graphic design for banners, promotions, website and digital media
Global Radio Service Advertising	May 2020	£ 1,872.00	Radio advertising
Newport & Valleys Bus Company Advertising	April 2021	£ 1,500.00	Outdoor advertising - local buses
Fat Film Frogs	16/09/2020	£ 294.00	Design and photography
Busnesa Office Support (Linos Price)	11/03/2022	£ 700.00	Support with tender writing to include Alcagel in public procurement platforms
Steve Kelly Design	26/11/2020	£ 500.00	Graphic design services
Steve Kelly Design	18/07/2022	£ 95.00	Graphic design services
Popin Van Wraps	2017-2022	£ 7,954.41	Outdoor advertising - own vehicle fleet
		£ 33,756.41	

¹⁷ RLJP-7

- Catalogues dated 2006/07 and 2009 are provided showing use of the word ALCAGEL on hand sanitiser.¹⁸ No indication is given about how many of these catalogues were circulated.
- A copy of a presentation is provided which is said to have been created in March 2016. This includes images of hand sanitiser bearing the stylised mark. Mr Powell states that this was ‘distributed as an external sales tool’ via email to existing and potential customers and was also presented in person to customers by sales representatives.¹⁹ There is no further information given about the scale of that distribution.
- A copy of an ‘NPS Award Statement’ is provided. It shows that the opponent had been awarded a place on the National Procurement Service (NPS) Provision of PPE & Workwear Dynamic Purchasing System (DPS). Mr Powell states that this shows ‘products bearing the ALCAGEL mark were provided to all Public Sector organisations across Wales as an approved supplier’ (my emphasis).²⁰ However, the exhibit actually states that ‘As an approved supplier [the opponent] is able to provide Alcagel Hand Sanitiser and Face Masks to all public sector organisations across Wales’ (my emphasis).²¹
- A copy of a press release is provided, dated June 2022. This states that the opponent has been awarded a place on the Scotland Excel Framework for ‘Supply and delivery of Personal protective Equipment (PPE) including Pandemic Recovery Items & Workwear’. The framework provides Scottish councils, Scotland Excel associate members and other participating public bodies with a mechanism to procure a range of PPE. Mr Powell also provides a copy of the schedule, which lists various Alcagel hand sanitisers, totalling a quantity of 12,000 packs. This is said to have been provided by Scotland Excel in relation to their Framework Reference 0621. The signature page of the Scotland Excel tender is dated 06 April 2022.²²

31) On the face of it, and despite the opponent being an approved supplier to public sector organisations across Wales and being awarded a place on the Scotland Excel

¹⁸ RLJP-9

¹⁹Powell, paragraph [17] & RLJP-10

²⁰ Powell, paragraph [18]

²¹ RLJP-11

²² RLJP-12

framework, the total sales figures and quantities of goods which have been sold over a period of six years (2017 – 2023) prior to the relevant date, appear to be modest. There is also no information about the opponent's share of the relevant market. Therefore, I cannot tell what share the opponent occupies in that market. Further, the marketing expenditure also appears to be quite small and there is nothing before me to suggest that there has, in fact, been wide-spread extensive promotion of the mark. In this connection, the catalogues and presentations do little to assist the opponent given that no further information is given about the scale of distribution of those advertising tools. Taking all the evidence into account, I find that neither earlier mark enjoyed enhanced distinctiveness at the relevant date of 10 May 2023.

Likelihood of confusion

32) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

33) I remind myself of my findings made earlier in this decision which were, as follows:

- In respect of the earlier word mark, there is no more than a medium degree of visual similarity, a medium degree of aural similarity and a low degree of conceptual similarity (although not a distinctive one) with the contested mark.
- In respect of the earlier stylised mark, the degree of visual similarity with the contested mark is below-medium, there is a medium degree of aural similarity and a low degree of conceptual similarity (although not a distinctive one) with the contested mark.

- All of the goods covered by the contested mark are identical to the goods covered by the earlier stylised mark. The contested goods are also either identical or highly similar to the goods covered by the earlier word mark.
- The average consumer includes both professionals in the care/medical sector and the general public. Both types of consumer are likely to pay a medium degree of attention during a mainly visual purchase, although the aural aspect is borne in mind.
- Both earlier marks have an above-medium degree of inherent distinctiveness. That degree of distinctiveness stems from the prefix 'Alca', not from the entirely descriptive 'gel' part of the earlier word mark. The same findings apply to the word element of the earlier stylised mark. The arc-shaped device and bubble device do not elevate the distinctiveness of that mark to any higher degree.

Weighing all these factors, I do not consider there to be a likelihood of direct confusion between either of the earlier marks and the contested mark. Notwithstanding the identity/highly similar goods at issue and the above-medium level distinctiveness of each earlier mark (as a whole), neither of the earlier marks is similar enough to the contested mark to be misremembered as being the same by an average consumer paying a medium degree of attention during a mainly visual purchase.

34) I will now consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar*), Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

35) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

36) I bear in mind that the categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

37) I can see no proper basis for concluding that the consumer is likely to believe that the goods covered by the contested mark come from the same/linked undertaking(s) as those covered by either earlier mark. The contested mark does not appear to be an entirely logical brand extension of either earlier mark. Nor does the contested mark simply add a non-distinctive element(s) to either earlier mark. Furthermore, this is not a case where the contested mark shares a common strikingly distinctive element with either earlier mark. I also cannot see any other basis for concluding that the average consumer is likely to be indirectly confused. **The opposition under section 5(2)(b) of the Act fails.**

38) For completeness, I add here that if I am wrong to have found that the 'alca' part of the earlier mark would not be perceived as a reference to 'alcohol' and this meaning was indeed immediately grasped, the likelihood of confusion between the marks would, of course, be even less likely. This is because, in such circumstances, the inherent distinctiveness of the earlier mark would be low (being highly allusive of the nature of the goods i.e. gel containing alcohol). Further, the presence of such a concept would also introduce a degree of conceptual difference between the marks. Bearing in mind those factors, and weighing all other relevant factors, there would be no likelihood of confusion in those circumstances either.

Section 5(3)

39) Section 5(3) of the Act provides, as follows:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

40) The relevant case law can be found in the following judgments of the Court of Justice of the European Union (CJEU): *General Motors Corporation v Yplon SA*, C-375/97, EU:C:1999:408, [1999] ETMR 950; *Intel Corporation, Inc. v CPM United Kingdom Limited*, 252/07, EU:C:2008:655, [2009] ETMR 13; *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.*, C-408/01, EU:C:2003:582, [2004] ETMR 10; and *L'Oréal & Ors v Bellure & Anor*, C-487/07, EU:C:2009:378, [2009] ETMR 55; *Interflora & Anor v Marks & Spencer & Anor*, C-323/09, EU:C:2011:604; and *Environmental Manufacturing LLP v OHIM*, C-383/12P, EU:C:2013:741. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public: *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind: *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness: *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future: *Intel*, paragraph

68; whether this is the case must also be assessed globally, taking account of all relevant factors: *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark: *L'Oréal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future: *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character: *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark: *L'Oréal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it: *L'Oréal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases

where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure*).

Reputation

41) The first hurdle that the opponent must overcome under section 5(3) of the Act is to show that the earlier marks had a reputation in the UK on the date that the applicant's mark was filed. The relevant date in these proceedings is, therefore, **10 May 2023**. If the evidence does not establish the existence of a reputation on the relevant date in respect of either earlier mark, the opponent's case must fail. This is because, without a qualifying reputation, there can be no link made in the consumer's mind between the contested mark and either earlier mark nor can there be any unfair advantage taken of, or damage to, the same.

42) In *General Motors*, the CJEU gave guidance on what is required to establish the necessary reputation:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence

of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

43) I have already summarised the most pertinent parts of Mr Powell’s evidence earlier in this decision when I considered whether the distinctiveness of either earlier mark had been enhanced through use. Bearing in mind my earlier comments in that regard, particularly as regards the modest sales figures, the lack of market share data, and the small levels of marketing expenditure, I find that the evidence does not establish that either earlier mark had the requisite reputation at the relevant date of 10 May 2023. As the opponent has failed to overcome the first hurdle of demonstrating a reputation, **the opposition under section 5(3) of the Act fails.**

Section 5(4)(a)

44) Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

45) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

46) This ground can be dealt with relatively briefly. The opponent relies upon use of the sign ‘Alcagel’ since 2005, throughout the UK, in relation to: ‘Sanitary preparations and articles; hand sanitising preparations; hand sanitiser; sanitising wipes’.

47) I recognise that the test for misrepresentation is different to that for likelihood of confusion because misrepresentation requires “*a substantial number of members of the public are deceived*” rather than considering whether the “*average consumer is confused*”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that to be the case here. I find that the opponent is in no stronger position under section 5(4)(a) than it was under section 5(2)(b). This is because, whilst I accept that: i) the opponent had the requisite goodwill at the relevant date in a business providing ‘hand sanitiser and sanitising wipes’, ii) the sign relied upon was distinctive of that goodwill and iii) the parties are clearly in the same field of activity, the earlier sign is simply not similar enough to the contested mark to result in a likelihood of a substantial number of the opponent’s customers being deceived into purchasing any of the applicant’s goods in the belief that they are the responsibility of the opponent. Misrepresentation is not made out. Without misrepresentation, there can be no damage. **The opposition under section 5(4)(a) of the Act fails.**

OVERALL OUTCOME

48) **The opposition fails.**

COSTS

49) The applicant has been successful and is entitled to an award of costs. Using the guidance in Tribunal Practice Notice 1/2023, I award the applicant costs on the following basis:

Preparing a statement and considering the other side's statement	£300
Preparing and filing evidence and considering the opponent's evidence	£600
Written submissions in lieu	£350
Total:	£1250

50) I order Solar Medical and Chemical Limited to pay Ecolab USA Inc. the sum of **£1250**. 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 17th day of September 2025

Beverley Hedley
For the Registrar