o/0903/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. WO1754611

BY HONASA CONSUMER LIMITED

TO REGISTER THE TRADE MARK:

The Derma Co

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 446936

BY DERMACOL, A.S.,

Background and pleadings

1. International trade mark no.1754611 ('the contested mark') shown on the cover page of this decision was registered by Honasa Consumer Limited ('the holder'), with effect from 9 August 2023. The holder designated the UK as a territory in which it seeks to protect the contested mark under the terms of the Protocol to the Madrid Agreement on the same date. The holder seeks protection for the following goods:

Class 3: Cosmetics

2. The request to protect the contested mark was published on 12 January 2024. On 11 April 2024, Dermacol a.s., ('the opponent') opposed the protection of the contested mark in the UK based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act") against all of the goods.

3. The opponent relies on the following trade mark:

UK3478174

DERMACOL

Filing date: 30 March 2020
Registration date: 13 November 2020
Relying upon the following goods:

Class 3: Cosmetics; toiletries.

4. The opponent claims that the goods are identical. In relation to the marks, the opponent states that they are highly similar and that the minor differences between the marks will likely go unnoticed leading to a likelihood of confusion.

5. The holder filed a counterstatement in which it denied the similarity of the marks. It admits that the goods are identical but states that there is no likelihood of confusion between the marks.

6. The holder is represented by Robertson IP Limited and the opponent is represented by D Young & Co LLP.

7. Both parties filed evidence. Neither party requested a hearing but both filed submissions in lieu. This decision is therefore taken following careful consideration of the papers.

8. 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

9. The opponent's evidence consists of a witness statement dated 7 October 2024 by Rachel Pellatt who is a Chartered Trade Mark Attorney at D Young & Co LLP. This was accompanied by two exhibits and the main purpose of the evidence is to show other marks containing the elements 'DERMA' and CO' and also to discuss the significance of 'THE' in trade marks.

10. The holder's evidence consists of a witness statement dated 11 December 2024 by Christopher John Robertson, who is a director of Robertson IP Limited. This evidence contains rebuttals to the opponent's evidence.

Decision

11. Section 5(2)(b) is being relied upon and is as follows:

> "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."

12. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"6. (1) In this Act an "earlier trade mark" means –

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;"

13. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, which qualifies as an earlier trade mark under the above provisions. As the trade mark had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods they have identified.

Case law

14. The following principles are gleaned from the decisions 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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 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

15. In both the counterstatement and submissions, the holder has admitted that the class 3 goods are identical, therefore, there is nothing further for me to consider.

Average consumer and the purchasing act

16. 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.

17. 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. (as he then was) 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

18. In my view, the average consumer of cosmetics is a member of the general public (although I do not discount that it could include a professional user such as a beautician) who will consider factors such as cost, quality, ingredients and suitability for their skin. The frequency of purchase and the cost of purchase are both likely to vary. The level of attention paid during the purchasing process will be medium.

19. The goods are likely to be obtained by self-selection from the shelves of a beauty retail outlet, or online equivalent. Visual considerations are therefore likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word-of-mouth recommendations.

Comparison of the marks

20. 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."

21. 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.

22. The respective trade marks are shown below:

Contested mark	**Earlier mark**
The Derma Co	DERMACOL

23. The earlier mark is comprised of one word, being 'DERMACOL' and, therefore, that is where the overall impression lies.

24. Both parties have provided previous tribunal decisions within their evidence that discuss the presence of the article 'THE' within marks. I have read and noted these decisions however, I am not bound by previous tribunal decisions, and I must make my assessment on the marks as they are presented before me.

25. In relation to the contested mark, I note that 'Co' is likely to be understood by the average consumer to mean 'Company' and together with 'THE' they will be perceived as a company identifier. This means they lack any distinctiveness. I agree with the opponent's submissions that the average consumer will view 'DERMA' as referring to skin. Given the mark is registered for cosmetics which are applied to the skin and can have ingredients that benefit the skin, I consider that 'DERMA' is highly allusive, if not descriptive of the goods applied for. However, due to the non-distinctive nature of the other elements, I consider 'DERMA' to be the dominant and distinctive element of the

contested mark. The words are presented in a standard bold typeface and this therefore plays only a small role in the overall impression.

26. Visually, the contested mark contains three words and ten letters. The earlier mark contains eight letters, seven of which are shared (in the same order) with the contested mark. Although those letters are shared, they are separated by a space on the applied for mark whereas in the contested mark they form one word. 'THE' has no counterpart in the earlier mark and it also contains the letter 'L' at the end I therefore find the marks to be visually similar to a medium degree.

27. Turning next to the aural comparison, I consider all elements of the contested mark to be given their ordinary everyday pronunciations. I consider that the 'DERMA' part of the earlier mark will be pronounced identically to the same element from the contested mark. I consider the last elements of the marks to be COL and C/OH/ and therefore, they do differ slightly. Once again, 'THE' has no counterpart in the earlier mark. Therefore, I find the marks to be aurally similar to no more than a medium degree.

28. I agree with the opponent's submissions that 'DERMACOL' will likely be seen as an invented term but that the average consumer might identify that the beginning 'DERMA' is a reference to skin whilst 'COL' has no particular meaning.[1] Regarding the contested mark, I agree with the holder that the mark will be understood to mean 'The Derma Company' and therefore, will likely be viewed by consumers as being a company that deals with skin related products.[2] Whilst the marks do overlap in concept in so far as there is reference to 'DERMA' meaning skin, they differ in overall concept of one being an invented term and the other meaning a company related to skin.

---

[1] In *Usinor SA v OHIM*, Case T-189/05, the General Court found that: "62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T 356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II 3445, paragraph 51, and Case T 256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II 0000, paragraph 57)."

[2] The conceptual comparison is usually done without reference to the goods and services in question however, in this case I believe they do give context to the mark and reinforce the idea of 'DERMA' relating to skin. (As per Mr Philip Johnson, sitting as AP in *Viñedos Emiliana SA v Consorzio Tutela Vini Emilia, (2) Chiarli 1860- Pr.I.V.I Srl and (3) Medici Ermete E Figli Srl* O/054/22

Distinctive Character of the Earlier Mark

29. 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 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)."

30. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it however, I have not been provided with any evidence of use, so I only have the inherent position to consider.

31. As I have explained above, ‘DERMACOL’ will likely be seen as an invented term but that the average consumer might identify that the beginning ‘DERMA’ is a reference to skin and there is, therefore, a link to the cosmetic goods within the mark. As a result, I find the earlier mark to be distinctive to a medium degree.

Likelihood of confusion

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

33. The following factors must be considered to determine if a likelihood of confusion can be established:

- The contested mark comprises of the words ‘THE DERMA CO’ in bold standard typeface. I consider that the word ‘DERMA’ is the dominant and distinctive element of the mark with the other words and slight stylisation playing lesser roles.
- The earlier mark is a word mark comprising of one word and the overall impression lies in that word.
- I have found the marks being compared visually similar to a medium degree and aurally similar to no more than a medium degree. In relation to the

conceptual comparison, the marks do overlap in concept in so far as there is reference to 'DERMA' meaning skin, they differ in overall concept of one being an invented term and the other meaning a company related to skin.

- I have found the earlier mark to be inherently distinctive to a medium degree.
- I have identified the average consumer as being a member of the general public (although I do not discount that it could include a professional user such as a beautician). The purchasing process is likely to be predominantly visual.
- I have concluded that a medium level of attention will be paid during the purchasing process.
- The goods are identical.

34. Bearing in mind the guidance from Emma Himsworth K.C., as the Appointed Person in *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, whereby the common elements between the marks had no or low distinctiveness, I note that in this case both marks share the element 'DERMA' (which is likely to be understood as meaning skin) in respect of class 3 cosmetic goods and, as I have stated above, this is clearly allusive of those goods.[3] It therefore follows, as part of the approach set out by Ms Himsworth, that a coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion. I note that the marks also share the letters 'CO'. In the contested mark, as I have said above, this will be viewed by the average consumer as a shortening for the word 'Company' and the contested mark will be understood to be referring to 'The Derma Company'. In the opponent's mark, 'DERMACOL' there is no such association with the word 'Company' and the mark is likely to be viewed as an invented term (although consumers will likely be able to pick out the term 'DERMA' and its meaning). This difference in concept also points to a lack of likelihood of confusion.[4] This applies even though the goods at issue are identical. I therefore find there to be no likelihood of direct confusion.

35. I will therefore turn to look at indirect confusion. I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

[3] Paragraph 44
[4] *Picasso Estate v OHIM*, Case C-361/04 P, Para 20

"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)".

36. These examples are not exhaustive but provide helpful focus as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

"This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."[5]

37. Firstly, the common elements between the marks are 'DERMA' and 'CO' which are not so highly distinctive that no other party could be using it as a trade mark at all. Secondly, the change between the marks is an additional letter in the earlier mark which results in it being considered a made-up term versus the contested mark having

[5] Paragraph 12

a clearer concept and the additional word ‘THE’ at the beginning and therefore this is not likely to be a sub-brand nor a logical brand extension. I can see no other reason why the average consumer would view the marks as coming from the same undertaking or indicating the same or related brands. The difference in concepts- one having a clear meaning and one being seen as a made up term would prevent the average consumer from assuming they are from the same place, it may be that there average consumer calls to mind the other mark upon seeing the shared term ‘DERMA’ however, this is mere association and not indirect confusion especially as the word is allusive to the goods.[6] Therefore, I find there to be no likelihood of indirect confusion.

Conclusion

38. The opposition fails in its entirety, subject to any successful appeal.

Costs

39. The holder has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023 as these proceedings commenced after 1 February 2023. As the evidence provided by both parties was short and of little value to the decision itself, I have not made any award in relation to this. I award the opponent the sum of **£600**, calculated as follows:

Considering the Notice of opposition and preparing the counterstatement	£300
Preparation of submissions in lieu	£300
Total	**£600**

40. I therefore order Dermacol a.s. to pay Honasa Consumer Limited the sum of £600. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

[6] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

Dated this 29th day of September 2025

L Nicholas

For the Registrar