o/1121/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003876664

BY ACT + ACRE IRELAND LIMITED

TO REGISTER THE TRADE MARK:

Act+Acre Skincare For Your Scalp

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 442192

BY HOTHOUSE BEAUTY LIMITED

BACKGROUND AND PLEADINGS

1. On 10 February 2023, Act + Acre Ireland Limited ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 28 April 2023. The applicant seeks registration for the following goods:

Class 3 Hair shampoos; Hair serums; Hair preparations and treatments; Cosmetic preparations for the hair and scalp; Scalp treatments (Non-medicated -).

2. The application was opposed by Hothouse Beauty Limited ("the opponent") on 28 July 2023. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade mark:

ACT+CARE

UK registration no. UK00002619696

Filing date 3 May 2012; Registration date 10 August 2012.

Relying upon some of the goods for which the earlier mark is registered, namely:[1]

Class 3 Cleaning preparations; soaps; toiletries; preparations for the skin; soap products; soaps for personal use; soaps for use on the skin; moisturisers; skin moisturisers; preparations for the skin; skin care preparations; skin care preparations for adults; skin care preparations for children; skin care preparations for persons with sensitive skin; hand care preparations.

3. The opponent claims there is a likelihood of confusion because the marks are highly similar and the goods are identical or highly similar.

[1] The opponent originally relied upon all of its goods, but requested that this be limited in its written submissions filed during the evidence rounds dated 20 November 2023.

4. The applicant filed a counterstatement putting the opponent to proof of use, stating that “we would request evidence of the use of this mark in commerce- as we can’t find any in the public domain”.

5. The opponent is represented by Appleyard Lees IP LLP and the applicant is unrepresented. The opponent filed evidence in chief and written submissions during the evidence rounds and the applicant filed submissions in response. The opponent also filed submissions in reply and evidence in reply. Neither party requested a hearing but the opponent filed submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

6. 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

7. The opponent’s evidence consists of the witness statement of Melanie Brownlow dated 20 November 2023. Ms Brownlow is the director of the opponent, a position she has held since April 2007. Ms Browlow’s statement is accompanied by 4 exhibits (MB1-MB4).

8. The opponent filed submissions on 20 November 2023, and the applicant filed submissions in response on 1 December 2023. In the applicant’s submissions, they state that there is a “clear distinction between these goods” and that there is a “clear and distinct separation” between the marks visually and verbally.

9. On 22 December 2023, the opponent stated that the applicant’s submissions gave rise to a right of reply, both in the form of evidence and submissions. This was granted

by the Tribunal. The opponent's evidence in reply consists of the witness statement of Graham Pierssene Johnson dated 7 February 2024. Mr Johnson is a Partner of Appleyard Lees IP LLP, and his statement is accompanied by 3 exhibits (GPJ1-GPJ3). The opponents submissions in reply are dated 8 February 2024. I note that the evidence and submissions address the similarity of the goods and the opponent also responds to the applicant's assertion on the similarity of the marks.

10. On 28 March 2024, the opponent filed submissions in lieu also in regard to the similarity of the goods and the marks.

11. I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

PRELIMINARY ISSUE

12. As noted in paragraph 4 above, the applicant did not address the identity or similarity between the parties' respective goods within their counterstatement. This would have arguably amounted to an acceptance of the opponent's pleaded case, as per SKYCLUB BL O/044/21. I also note that in SKYCLUB, Mr Phillip Johnson highlighted that the Hearing Officer has the power to request clarifications from a party to proceedings under Rule 62(1)(a) of the Trade Mark Rules 2008. It was therefore open to me to invite the applicant to amend its pleadings at this stage under the above Rule.

13. However, I note that this would have caused an unnecessary delay to the proceedings, especially when the applicant has made their position clear within its written submissions, to which the opponent replied to via a witness statement, written submissions and submissions in lieu of a hearing.

14. It is my view that no prejudice will be caused by taking the applicant's position to be that they deny the identity and similarity of the goods and the marks, without seeking a formal amendment to the pleadings at this stage, especially when, as noted above, it is clear both sides understand, have acknowledged and responded to each other's position.

DECISION

Section 5(2)(b)

15. Section 5(2)(b) reads as follows:

> "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."

16. The opponent's mark qualifies as an earlier mark in accordance with section 6(1)(a) of the Act as its filing date is earlier than the filing date of the applicants' mark. As the opponent's mark has completed its registration process more than five years before the filing date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

17. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

18. Section 6A of the Act states:

> "(1) This section applies where
>
> (a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

19. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five years ending on the filing date of the applicants' mark, i.e. 11 February 2018 to 10 February 2023.

20. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

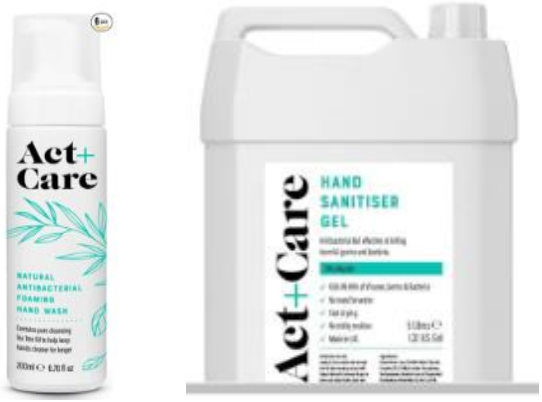
Evidence of use

21. I note the following from the opponent's evidence:

a) **Exhibit MB1** contains 2 undated amazon.co.uk screenshots of the opponent's ACT+CARE goods. The first shows "Act+Care" natural antibacterial foaming handwash, which is stated as being first available on 31 March 2020. The second shows "Act+Care" antibacterial hand sanitiser gel (5 litres) (with the

product stated as being currently unavailable), which was also first available on 31 March 2020.

b) The goods within **exhibit MB1** are shown as follows:



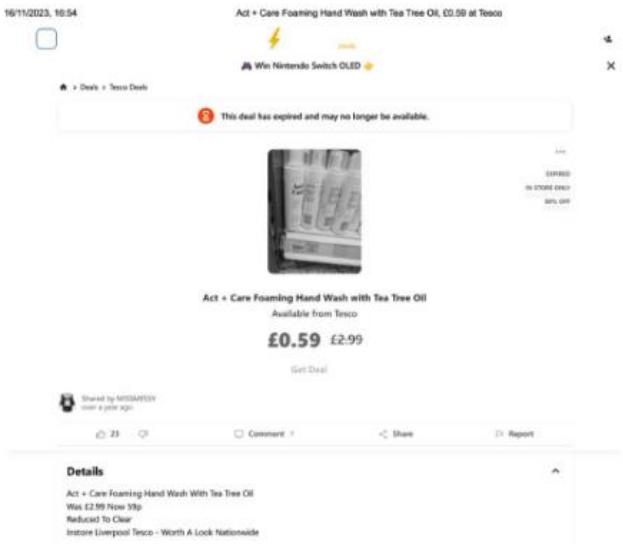
c) Ms Brownlow states that from 1 January 2020 to 31 December 2020, UK sales of ACT+CARE was in excess of £1.3 million.

d) I have not been provided with sales figures for 2021 to 2023, however, Ms Brownlow states that its ACT+CARE goods were on sale in the UK in a "number of retailers", although she does not specify where.

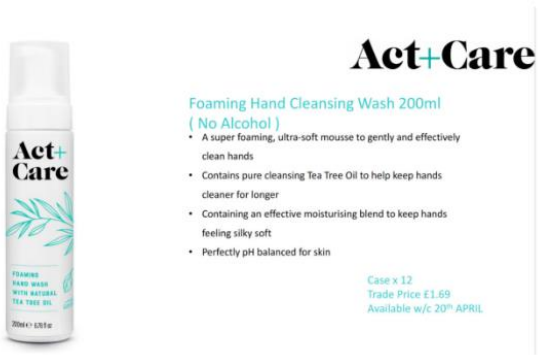
e) Ms Brownlow has provided 4 example invoices showing the sale of ACT+CARE goods in **exhibit MB4**. I note the following from them:

Date	**Customer address**	**Goods**	**Quantity**	**Price**
20/04/2020	Alliance healthcare, Chessington	Act+Care Foaming Hand Wash	2924	£57,895.20
23/04/2020	Alliance healthcare, Chessington	Act+Care Hand Sanitiser Gel	4749	£38,456.90
08/06/2020	Tesco, Cheshunt	Act+Care Foaming Hand Wash	3784	£72,198.72
16/07/2020	Tesco, Cheshunt	Act+Care Hand Sanitiser Gel	6858	£59,664.60

f) The above Tesco invoices are supported by **exhibit MB3** which shows the following screenshot dated 16 November 2023, from LatestDeals.co.uk, showing an offer from “over a year ago” on ACT+CARE hand wash in Tesco:



g) Lastly, Ms Brownlow states that **exhibit MB2** contains the following example of promotional material used in relation to ACT+CARE hand wash:



Assessment of genuine use and fair specification

22. As far as the form of the mark is concerned, I am satisfied that the mark has been used as registered on the invoices. For the sake of completeness, the evidence above shows the words “Act + Care” presented in a minimally stylised typeface, with the words presented in black and the plus sign presented in a mint green colour on the

goods. However, the stylisation is very minimal and does not alter the distinctive character of the mark.[2] Therefore it is acceptable variant use.

23. As I have found the variant mark used in the evidence to be acceptable, I will now consider whether the evidence shows that the earlier mark has been genuinely used. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[3] As indicated in the case law cited above, use does not need to be quantitively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark".

24. There are clearly some issues with the opponent's above evidence. For example, the promotional material contained in **exhibit MB2** is not supported by any narrative evidence stating how this material was used, or how many consumers would have been exposed to it. I also note that I have not been provided with any advertising figures or sales figures for 2021 to 2023. However, whilst the evidence only shows one year of use, use does not have to be shown for the entirety of the relevant five-year period. I note that UK sales figures for ACT+CARE products in 2020 was in excess of £1.3 million. This is supported by 4 example invoices which shows that 18,315 ACT+CARE hand wash and hand sanitiser goods were sold to Alliance Healthcare and Tesco Cheshunt in 2020, which amounted to £228,215.42. Therefore, taking the above into account, I consider that the opponent's earlier mark has been put to genuine use in the UK in relation to hand wash and hand sanitiser during the relevant period.

25. While I have concluded that there is genuine use, I do not consider that the use is sufficient to allow the opposition to continue in respect of all of the goods relied upon.[4]

[2] *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19
[3] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09
[4] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

26. The opponent relies upon a range of class 3 goods, including “hand care preparations”. I consider that caring for your hands would include cleaning them, and therefore this term would encompass the opponent’s hand wash and hand sanitiser. On this basis, I consider that the opponent has shown use of this term and I consider a fair specification for the opponent’s mark to be:

Class 3 Hand care preparations.

Section 5(2)(b) - case law

27. In making this decision, I bear in mind the following principles 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 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

28. The applicant's goods are listed in paragraph 1 and the opponent's goods are listed in paragraph 26 of this decision.

29. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "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."

30. Guidance on this issue has 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 uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

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

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

31. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM,* Case T-325/06, the GC stated that "complementary" means:

> "… there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."

32. Before I start my comparison, I note that the opponent has drawn my attention to two previous decisions of the Tribunal.

33. In BL O/498/13 the Hearing Officer found shampoos and soap to be identical, and in BL O/397/20, the Hearing Officer found that shampoos and hair care preparations were similar to "perfumed body, bath and shower gels, milks and soaps" to a medium degree.

34. I note that I am not bound by previous decisions of this Tribunal. Moreover, and for the sake of completeness, in BL O/498/13 the Hearing Officer did not provide any reasoning for their finding of identity between shampoos and soap, and therefore I am unable to determine why such a conclusion was reached. I also note that in BL O/397/20, the Hearing Officer did not provide detailed reasoning as to why they found the goods overlapped in nature and method of use. Therefore the conclusion I reach will be based on my own assessment of the similarity of the goods.

Hair shampoos.

35. The applicant's above goods are all used to clean the user's hair, and the opponent's "hand care preparations" will include soaps and sanitisers which are used to clean the user's hands. Whilst the general purpose of the goods are to clean, I note that they are used on different parts of the user's body (hair vs hands). Therefore the method of use differs. It also means that the goods will be made from different ingredients, for example, soaps and sanitisers will include ingredients which kill harmful bacteria, whereas the applicant's shampoos will use ingredients which break

down and remove the buildup of sebum. The applicant's goods might also have other properties, such as to protect the scalp from dandruff, to facilitate hair growth, or to repair the bonds of damaged hair. I therefore consider that their overall purpose differs and that the goods are neither in competition nor complementary. However, the nature of the opponent's soaps and the applicant's goods may overlap as they are all types of liquids which can turn into a foam or lather.

36. The opponent has provided evidence at **exhibit GPJ1** to demonstrate that shampoo and soap are sold by the same undertakings. I note that the undated evidence shows the following:

a) A screenshot of a website dropdown from faithinnature.co.uk which lists shampoo, conditioner, soap and hand wash.
b) Screenshots showing "boots" branded coconut and almond shampoo and handwash being sold on boots.com.
c) Screenshots showing "Dove" branded handwash and shampoo being sold on amazon.co.uk.
d) Screenshots showing shampoo and handwash being sold on the body shop's website.
e) Screenshots showing shampoo and soap being sold on Lush's website.

37. **Exhibit GPJ2** contains undated screenshots of all-in-one products which are for both the hair and body. However, I note that these goods are not captured by either specification and therefore this evidence does not assist me.

38. Whilst I note that the above undated evidence shows that the same undertakings may create and sell all of the parties' goods, I also acknowledge that they can be made by separate undertakings, with the applicant's goods being created by hair care specialists and the opponent's goods being created by undertakings that specialise in either hand care or skin care in general. Moreover, I note that whilst all of the goods will be sold in beauty retail outlets and pharmacies, the goods will not be sold in the same aisle or in close proximity. I therefore consider that, taking all of the above into account, the goods are similar to only a low degree.

Hair preparations treatments; Hair serums; Hair […] treatments; Cosmetic preparations for the hair and scalp; Scalp treatments (Non-medicated -).

39. The applicant's above goods are all treatments for the users' hair and scalp. I note that these goods may exfoliate the user's scalp and target dandruff, they may help with hair growth, or they may facilitate the repair of damaged hair. These goods may also help hydrate or improve the moisture levels of dry and damaged hair. Whilst I note that "hand care preparations" would include hand creams and soaps that have moisturising properties, I note that the parties' goods are used on different parts of the user's body (hair vs hands), meaning that they will be made from different ingredients. This results in the method of use of the goods differing. Whilst I note that the nature of the applicant's treatments and serums (which are usually oil or water-based liquids) will not overlap in nature with the opponent's soaps, I appreciate that hand creams and hair mask treatments can both appear in thick-cream based forms. The goods will also overlap in user.

40. The opponent's above evidence does not show that the applicant's treatments and serums for the hair and scalp will be sold by the same undertakings which produce soaps. However, whilst I acknowledge that these goods could be sold by the same undertakings, I still consider that they can also be created by separate undertakings which either specialise in hair care, or specialise in hand care or skin care in general. Albeit the goods will all be distributed in beauty retail outlets and pharmacies, the goods will not be sold in the same aisle or located in close proximity. The goods are clearly neither in competition nor complementary in the way described by the case law cited above. I therefore consider that, taking all of the above into account, the goods are similar to only a low degree.

The average consumer and the nature of the purchasing act

41. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

42. The average consumer for the goods will be members of the general public, however, I do not discount that it could also include a professional user such as a hairdresser or beautician. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The goods will also be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, quality, ingredients, scent and the suitability for their specific needs. Therefore, the level of attention paid during the purchasing process for the goods will be medium.

43. The goods are likely to be obtained by self-selection from the shelves of a beauty retail outlet, pharmacy or online equivalent. Alternatively, the goods may be purchased following perusal of advertisements or inspection of a catalogue. 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 a sales assistant or representative.

Comparison of the trade marks

44. 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. 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."

45. 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.

46. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
ACT+CARE	**Act+Acre Skincare For Your Scalp**

47. The opponent's mark consists of the words "ACT + CARE". I consider that the overall impression lies in the combination of these elements.

48. The applicant's mark consists of the words "Act + Acre Skincare For Your Scalp". I note that the "Skincare For Your Scalp" element is descriptive of their haircare products. However, I note that describing the goods as "skincare for the scalp" is slightly unusual. Regardless, whilst the phrase is descriptive, it is not negligible nor aurally invisible,[5] but it will be accorded less attention than the words "Act + Acre".

[5] *Purity Wellness Group Ltd v Stockroom (Kent) Ltd*, Case BL-O/115/22

49. Visually, the marks coincide in the word “ACT” followed by a plus sign at the beginning of both marks, a position to which the average consumer pays more attention to.[6] This acts as a visual point of similarity. The opponent states that the difference between the word “CARE” in the opponent’s mark and “Acre” in the applicant’s mark is the reversal of the letters C and A. I agree. However, I note that the words “Skincare For Your Scalp” at the end of the applicant’s mark also act as a visual point of difference. I therefore consider that the marks are visually similar to between a low and medium degree.

50. Aurally, I note that the plus sign in both marks will be read and understood as the word “and”. Therefore the opponent’s mark is likely to be pronounced as ACT-AND-CARE and the applicant’s mark is likely to be pronounced as ACT-AND-ACHE-ER SKIN-CARE FOR YOUR SCALP. Therefore the first two syllables are aurally identical. However, overall, I consider that the marks are aurally similar to between a low and medium degree.

51. Conceptually, the opponent states that the parties’ marks are “conceptually highly similar” on the basis that the “opposed mark contains ACT+ACRE as the dominant elements which differs simply by the reversal of “CA” which is readily overlooked”. However, in determining the conceptual similarity of the marks, I have to carry out a notional assessment of the marks before me. The opponent’s and applicant’s marks both begin with the ordinary dictionary word “ACT” (to do something) followed by a plus sign, which as noted above, will be pronounced and recognised as the word “and”. The plus element in the opponent’s mark is followed by the ordinary dictionary word “CARE”, which means to look after something. The plus element in the applicant’s mark is followed by the ordinary dictionary word “Acre”, which is a measurement of land. Therefore the reversal of the letters “CA” in these words clearly creates a conceptual point of difference between them.

52. The applicant’s mark also ends with the ordinary dictionary words “Skincare For Your Scalp”, which creates a conceptual point of difference. I also bear in mind, that when assessing the conceptual similarity of two marks this is usually done without

[6] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

reference to the goods in question.[7] Therefore, as the marks only share the concept conveyed by the "ACT+" elements, I consider that they are conceptually similar to between a low and medium degree.

Distinctive character of the earlier trade mark

53. 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 C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, 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 promotion of 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)."

54. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic

[7] Mr Philip Johnson, sitting as the 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.

of the goods and services, 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 that has been made of it.

55. I will begin with the inherent distinctiveness of the opponent's mark. I consider that the opponent's "ACT+CARE" mark, as a whole, is highly allusive of the opponent's "hand care preparations". This is on the basis that the average consumer will understand the mark as conveying that its goods "act" and "care" for their hands. As per *Formula One Licensing BV v OHIM*[8], the earlier mark must be considered to have at least some distinctive character. Therefore, I consider that the opponent's mark is inherently distinctive to a low degree.

56. Although the opponent has not specifically pleaded enhanced distinctiveness, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

57. I have been provided with sales figures for ACT+CARE hand wash and hand sanitiser sold in 2020 which was in excess of £1.3 million. This is supported by 4 example invoices which shows that 18,315 of these goods were sold to Alliance Healthcare and Tesco Cheshunt in 2020, amounting to £228,215.42.

58. However, I have not been provided with any other sales figures for any other year. Whilst I appreciate that the sales for 2020 are reasonably high, I bear in mind that every household in the UK will use soap every day, and therefore the market is likely to be significant in size. I have also not been provided with any evidence of the opponent's market share, nor have I been provided with any advertising figures. I have only been provided with one example of the opponent's promotional material; however, I have not been told how this material was distributed or how many UK consumers were exposed to it. Therefore, taking all of the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness of the opponent's mark.

[8] Case C-196/11P, paragraphs 41 to 44

Likelihood of confusion

59. 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 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 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.

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

- I have found the marks to be visually, aurally and conceptually similar to between a low and medium degree.
- I have found the opponent's earlier mark to be inherently distinctive to a low degree.
- I have identified the average consumer as the general public, and professionals such as hairdressers and beauticians, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- The parties' goods are similar to only a low degree.

61. Whilst the beginning of the marks tend to make more of an impact than the ends, and the word "ACT" and the plus element at the beginning of the parties' marks are

identical, in *CureVac GmbH v OHIM*, T-80/08, it was determined that this was not always a decisive matter in the finding of a likelihood of confusion.

62. Therefore, taking all of the above into account, bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. The case law has made it clear that the average consumer normally perceives a mark as a whole and does not dissect the mark. Therefore, the average consumer will not pull out the "ACT+" elements and overlook the differences between the words "CARE" and "ACRE" in the parties' marks, which have a clear and distinct conceptual hook to assist in differentiating between them. Moreover, the "Skincare For Your Scalp" element at the end of the applicant's mark provides another conceptual hook to differentiate the marks. I also bear in mind the interdependency principle, and consider that the low degree of similarity between the goods offsets any visual, aural and conceptual similarity shared by the marks. Therefore, taking all of the above into account, I do not consider that there is a likelihood of direct confusion.

63. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., (as he was then) sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

> "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)".

64. 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.

65. Mr Purvis KC in *L.A Sugar Limited* above sets out that there are three main categories of indirect confusion and that indirect confusion 'tends' to fall in one of them. The opponent has not provided any submissions as to what category this case would fall within. However, for the sake of completeness, I will go through each category.

66. Firstly, where the common element is so strikingly distinctive that the average consumer would assume that no-one else, but the brand owner, would be using it. In

this case, the opponent's mark as a whole is inherently distinctive to a low degree. This is on the basis that the words "ACT" and "CARE" are highly allusive of their hand care goods, which will "act" and "care" for the user's hands. Therefore, I do not consider that the ordinary dictionary word "ACT" (which has a recognisable meaning to the average consumer) in conjunction with a plus sign (which will be recognised as the word "and") is so strikingly distinctive that the average consumer would think that no-one else but the opponent would use it. On this basis, the first category is not satisfied.

67. Secondly, where the later mark simply adds a non-distinctive element to the earlier mark. For this category to be satisfied, the opponent's mark as a whole, that being "ACT+CARE" would need to be reproduced, with an addition of a non-distinctive element. However, in this case, it is not. Nonetheless, for the sake of completeness, in its Notice of Opposition, the opponent indicates that imperfect recollection could lead the consumer to see "CARE" as "ACRE" and vice versa. I note that imperfect recollection can still occur in indirect confusion. However, as noted in paragraph 62 above, I do not consider that this would occur as the words "CARE" and "ACRE" have very different meanings, (to look after something vs a measurement of land) which provides a clear and distinct conceptual hook to assist in differentiating between them. Therefore, this category is also not satisfied.

68. Lastly, where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. As noted in paragraph 47 above, the overall impression of the opponent's mark lies in the combination of the words "ACT" and "CARE", with the plus sign connecting them. I therefore do not consider that changing the word "CARE" in the opponent's mark (which is low in distinctiveness due to its allusiveness), to the word "ACRE" in the applicant's mark (which is neither descriptive nor allusive of the parties' goods), or vice versa, is logical, nor consistent with a brand extension. I do not consider that the third category is satisfied.

69. I bear in mind that the examples above set out by Mr Purvis KC are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant's mark could be indirectly confused with the opponent's and the opponent

has not suggested any. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. As highlighted above, the marks are not natural variants or brand extensions of each other. I find there is no likelihood of indirect confusion.

CONCLUSION

70. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

71. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. The applicant has been successful and would normally be entitled to a contribution towards their costs. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited them to indicate whether they intended to make a request for an award of costs. The applicant was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that "if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded".

72. The applicant did not file a completed Pro Forma and paid no official fees. That being the case, I make no award of costs in this matter.

Dated this 25th day of November 2024

L FAYTER
For the Registrar