

**o/894/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL  
REGISTRATION NO. WO00001548047**

**IN THE NAME OF  
KERRIN PROFESSIONAL BEAUTY LTD**

**FOR THE TRADE MARK:**

**Qiqi**

**IN CLASSES 3 AND 35**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO. 503729 BY MEDODERM GmbH**

## **BACKGROUND & PLEADINGS**

1. A request for protection of the trade mark (IR) shown on the cover page of this decision was applied for on 27 April 2020 and entered in the UK register on 19 February 2021. It stands registered in the name of KERRIN PROFESSIONAL BEAUTY LTD (“the holder”) for the following goods and services:

Class 3: Hair care products including shampoo and hair conditioner; body care products; creams and lotions for hair and body; non-medicated ointments for hair and body; moisturizers for hair; moisturizer for hair and body care; hair care and restoration products; hair beauty masks; hair color; hair color remedies; hair mousse; hairspray; hair volume formulations; hair styling gel; hair styling preparations; all the aforesaid except for makeup and other cosmetics products.

Class 35: Online retail store services for hair and body care products; retail and wholesale services of hair and body care products; managing a business of hair and body care products; advertising and marketing of hair and body care products.

2. On 25 March 2021, Medoderm GmbH (“the applicant”) applied to have the contested mark declared invalid under section 47(2) of the Trade Marks Act 1994 (“the Act”). The application is based upon section 5(2)(b) of the Act and concerns all the goods and services the contested mark is registered for.

3. Under section 5(2)(b), the applicant relies upon the following UK trade Mark and International UK Trade Mark (“IR”):

No. 00917988272 for the trade mark “QiQu” which was applied for on 20 November 2018 and which was entered in the register on 27 March 2019.

**QiQu**

4. The applicant's marks are registered for the following goods in class 3:

**Class 3:** Cosmetics; toiletries; skin care preparations; hair preparations and treatments.

5. Under section 5(2)(b) the applicant contends that the competing marks are highly visually and aurally similar and that the respective goods and services are identical and/or similar to a varying degree. On this basis the applicant states that there is a likelihood of confusion.

6. The holder filed a counterstatement denying the grounds of invalidation. It denies that there is a sufficient similarity between the marks at issue on the grounds that they are phonetically, visually and conceptually not similar. Likewise, the holder denies that its goods and services are identical and/or highly similar to the applicant's goods. Accordingly, the holder states that a likelihood of confusion is extremely low or non-existent.

7. Furthermore, in its counterstatement the holder includes several Internet links relating to the applicant's company, the nature of its business and points out the different goods offered by the parties, including the different intended purpose of those goods. Additionally, the holder has also submitted details regarding the applicant's prior trade mark applications and registrations. Whilst comments concerning the meaning of the applicant's mark and its business activities are noted, such information is not relevant to my assessment and will have no bearing on the outcome of this application for invalidation. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. Once a trade mark has been registered for five years, the opponent or applicant for invalidation can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods and services for which it is registered.

8. Both parties have been professionally represented throughout these proceedings; the applicant is represented by Keltie LLP and the holder is represented by Harrison IP Limited. Neither party filed evidence. Both parties were given the option of an oral hearing but neither requested to be heard on this matter. This decision is taken following a careful review of the papers before me, keeping all submissions in mind.

9. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## **DECISION**

10. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to Section 47 of the Act.

Section 47 reads as follows:

“47(1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

11. As one of the earlier marks is a comparable mark, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9.— (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day –

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union”.

### **Section 5(2)(b)**

12. Section 5(2)(b) of the Act 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.”

13. 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 –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,



(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

14. The marks relied upon by the applicant qualify as earlier trade marks and given their registration dates, are not subject to the proof of use provisions contained in Section 47(2A) of the Act.

### **Section 5(2)(b) – Relevant case law**

15. The following principles are gleaned from the decisions of the courts of the European Union 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.

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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

## Comparison of goods and services

16. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

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

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

- (a) the respective 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.

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

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

19. 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/services. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

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

20. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language

unnaturally so as to produce a narrow meaning which does not cover the goods in question."

21. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

22. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux- Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

23. The competing goods and services are as follows:

The applicant's goods In Class 3	The holder's goods in Class 3
hair preparations and treatments;	hair care products including shampoo and hair conditioner; creams and lotions for hair; non-medicated ointments for hair; moisturizers for hair; moisturizer for hair care; hair care and restoration products; hair beauty masks; hair color; hair color remedies; hair mousse; hairspray; hair volume formulations; hair styling gel; hair styling preparations;

24. I find the applicant's *hair preparations and treatments* cover the above identified terms from the holder's registration and are therefore identical in line with the principle set out in *Gérard Meric*.

skin care preparations;	body care products; creams and lotions for body; non-medicated ointments for body; moisturizer for body care;
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25. The applicant's *skin care preparations* cover the above identified terms from the holder's registration and are therefore identical in line with the principle set out in *Gérard Meric*.

The applicant's goods In Class 3	The holder's services in Class 35
cosmetics; toiletries; skin care preparations; hair preparations and treatments.	online retail store services for hair and body care products; retail and wholesale services of hair and body care products;

26. The holder's services relate to the sale of goods covered by the applicant's specification. In *Oakley, Inc v OHIM*, Case T-116/06, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, making them similar to a degree.

27. Accordingly, although the respective goods and services have different natures, purposes and methods of use, it is considered that the holder's retail and wholesale services are complementary to the applicant's goods. The applicant's goods are important to the operation of the holder's services in such a way that consumers will

assume that the responsibility for them lies with the same undertaking. Moreover, the respective goods and services will be offered through shared trade channels. Consequently, I find that the respective goods and services are similar to a medium degree.

<p>cosmetics; toiletries; skin care preparations; hair preparations and treatments.</p>	<p>managing a business of hair and body care products; advertising and marketing of hair and body care products.</p>
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28. The holder's services appear to be Business to Business (B2B) services, the type provided to other businesses rather than to consumers. The holder's services, namely *managing a business of hair and body care products; advertising and marketing of hair and body care products* do not share nature, purpose, channels of trade or method of use. They are not in competition with one another and do not appear to be complementary in the sense of the caselaw. A user seeking business management services or advertising services will not go to the same undertaking as provides the goods. There is no evidence provided which shows any similarity; therefore, I decline to find any similarity between these services and the applicant's goods.

29. Similarity of goods/services is essential for a finding of a likelihood of confusion.<sup>1</sup> As a consequence, the application for invalidation fails with respect to *managing a business of hair and body care products; advertising and marketing of hair and body care products*.

### **Average consumer and the nature of the purchasing act**

30. The average consumer is deemed to be reasonably well informed and reasonably well observant and circumspect. For the purpose of assessing the likelihood of

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<sup>1</sup> *Waterford Wedgwood plc v OHIM*, Case C-398/07 P, CJEU

confusion, I must bear in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

31. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“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.”

32. I have explained, above, why the applicant's comments regarding the specific products offered by the parties are not relevant. No other submissions regarding the identity of the relevant average consumer have been made.

33. The applicant states that “the average consumer is the general public”. I agree. The goods and services at issue broadly consist of skin and hair care products, being everyday consumer products, and their associated retail services. The frequency with which the goods and services will be purchased will vary, though, overall, they are likely to be purchased relatively frequently. The purchasing act will not require an overly considered thought process as, overall, the goods and services are relatively inexpensive. The average consumer will, nevertheless, consider factors such as suitability, desired effect, colour and ingredients when purchasing the goods and factors such as the range of goods on offer and the quality of the service when purchasing the services. Taking the above factors into account, I find that the level of attention of the general public would be medium. The goods are typically sold in brick-and-mortar retail establishments or their online equivalents, where the goods are likely to be purchased after perusing the shelves or viewing information on the internet. In these circumstances, the purchasing process will be predominantly visual in nature, though I do not exclude aural considerations entirely as consumers may



receive word of mouth recommendations or discuss the products with a sales assistant.

34. The services are typically available from physical retail outlets and their online equivalents. The purchasing process for the services is likely to be dominated by visual considerations, as the average consumer will select the services following an inspection of the premises' frontage on the high street, after viewing information on websites, or viewing advertisements (such as flyers, posters, media campaigns or online adverts). Nevertheless, given that word of mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

### **Comparison of trade marks**

35. 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.

36. 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”.

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

**QiQu**

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

<b>The applicant's marks</b>	<b>The holder's mark</b>
QiQu	Qiqi

40. The applicant's mark comprises of the word "QiQu" presented in a standard typeface. The overall impression resides in this single element.

41. The holder's mark comprises of the word "Qiqi" depicted in standard typeface. The overall impression of the mark lies in this single element.

*Visual comparison*

42. Visually, the marks coincide in their first three letters 'QIQ-'. However, they differ in their fourth letters, namely 'i' in the applicant's mark versus 'u' in the holder's mark. Although the third letter "q" in the holder's mark is shown in lowercase (Qiqi), whereas in the applicant's mark the coinciding third 'letter "Q" is shown in uppercase (QiQu), this makes no difference to the comparison because a word-only trade mark registration protects the word(s) itself, written in any normal font and irrespective of

capitalisation.<sup>2</sup> Even if that were not the case, taking into account the coincidence of the first 75% of the mark in terms of letters, I am of the view that the marks are visually similar to a medium to high degree.

#### *Aural comparison*

43. Aurally, the marks coincide in the sound of the letters “QIQ” present identically in both marks. They are likely to be pronounced as kick-ee and kick-oo. The difference comes at the end of the marks: the first syllable is identical. Accordingly, I consider the marks aurally similar to a high degree.

#### *Conceptual comparison*

44. Both marks have no conceptual content and would be perceived by the average consumer as invented words. Accordingly, the marks are conceptually neutral.

### **Distinctive character of the applicant’s trade mark**

45. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“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).

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<sup>2</sup> *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, Professor Ruth Annand, sitting as the Appointed Person

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).”

46. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

47. The applicant has not filed evidence that it has used its mark. Consequently, I have only the inherent position to consider.

48. The earlier mark will be perceived as an invented word which does not describe or allude to the goods which are relied upon in the application for invalidation. I find the applicant’s mark to be inherently distinctive to a high degree.

### **Likelihood of confusion**

49. 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. One such factor 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. As I mentioned

above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

50. 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.

51. Earlier in the decision I concluded that all of the goods are identical and that some of the holder's services in class 35 are similar to the applicant's goods to a medium degree, while others are dissimilar. For those services in Class 35 that coincide with the applicant's goods in Class 3, I found that the average consumer of the goods and services are likely to be in the main, members of the general public, who would demonstrate a medium level of attention during the purchasing act; I am of the view that the purchasing process for the goods and services at issue would be predominantly visual in nature, though I have not discounted aural considerations.

52. I found that consumers would understand the applicant's mark to be an invented word, and consequently for them it would be highly distinctive. The competing trade marks are visually and aurally similar to a medium to high degree. The average consumer, perceiving the applicant's mark as an invented word has no concept to keep in their mind, and so could quite easily overlook or not notice that the last letter, a vowel, in the respective marks differ. Taking into account the identical goods and the similar goods and services (to a medium degree), and bearing in mind imperfect recollection, it is my view that the average consumer is likely to mistake the marks for one another and, therefore, to be directly confused.

## Outcome

53. The application for invalidity has been partially successful. Accordingly, under section 47(6), the protection in the UK of the holder's registration is deemed never to have been made in respect of the following goods and services:

Class 3: Hair care products including shampoo and hair conditioner; body care products; creams and lotions for hair and body; non-medicated ointments for hair and body; moisturizers for hair; moisturizer for hair and body care; hair care and restoration products; hair beauty masks; hair color; hair color remedies; hair mousse; hairspray; hair volume formulations; hair styling gel; hair styling preparations.

Class 35: Online retail store services for hair and body care products; retail and wholesale services of hair and body care products;

54. The application for invalidation fails with respect to the following services:

Class 35: Managing a business of hair and body care products; advertising and marketing of hair and body care products.

## Costs

55. Both parties have enjoyed a share of success, with the greater part going to the applicant, who is therefore entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. I have reduced what I would have awarded for total success by 20%, which is approximately the proportion of the specification retained by the holder, taking into account the repetitious terms in its class 3 list of goods. I award the opponent the sum of £720 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Statutory fee for the invalidation	£200
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Preparing a statement of grounds and considering the counterstatement	£300
Written submissions	£400
Less 20%	
Total	£720

56. I order Kerrin Professional Beauty Ltd to pay Medoderm GmbH the sum of £720. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings if any appeal is unsuccessful.

Dated this 10th day of December 2021

**SAM CONGREVE**  
For the Registrar