

BL O/608/22

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3489006

BY

BIOMED LABORATORIES LTD.

TO REGISTER THE TRADE MARK:



IN CLASS 3

-AND-

THE OPPOSITION THERETO UNDER No. 422638

BY

ELTA MD, Inc.

Background and pleadings

1. On 12 May 2020, BIOMED LABORATORIES LTD. (“**the Applicant**”) applied to register the trade mark shown below, in the UK (“**the Contested Mark**”):



It was accepted and published in the Trade Marks Journal on 2 October 2020 in respect of the following goods in Class 3:

Lotions for cosmetic purposes; Facial cleansers; Cosmetic preparations for skin care; Make-up removing preparations; Beauty masks; Sunscreen preparations; Cosmetics; Essences for skin care; Make-up preparations; Oils for cosmetic purposes.

2. ELTA MD, Inc. (“**the Opponent**”) opposes the Contested Mark under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The Opponent relies on its earlier International Trade Mark Registration designating the UK (IR), shown below (“**the Earlier Mark**”):



IR number: 1363479
Designation Date: 19 July 2017
Date of protection in UK: 7 December 2017

The Earlier Mark is registered in respect of the following goods in Classes 3 and

5, all of which are relied upon for the purposes of this opposition:

Class 3

Non-medicated skin care preparations.

Class 5

Medicated skin care preparations.

3. Given the respective filing dates, the Opponent's mark is an earlier trade mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon all of the goods for which the Earlier Mark is registered without having to show any use at all.
4. The Opponent claims that the Contested Mark is similar to the Earlier Mark and that the respective goods are identical or similar, giving rise to a likelihood of confusion.
5. The Opponent contends that the respective marks *"share the element MD, which forms a discrete element in each mark. The specific form of the stylised letters MD in the opposed mark closely resembles the stylisation of the letters MD in the earlier mark [...] Although the marks differ in respect of the additional elements, this is insufficient to avoid the marks being deemed similar as a result of the shared element"*.
6. The Applicant filed a counterstatement denying the claims made.
7. The Applicant states that 'MD' is the *"only element which is common in both marks"* however, it contends that 'MD' is a *"weakly distinctive component"* of the Earlier Mark by virtue of it being *"a well-known pronoun of medicine and products for skin care (Nice class 3 and 5 goods) and would be viewed, by the average consumer, as an indication of specific product type rather than an indicator of trade origin. Therefore, it should not be owned exclusively by someone."* It contends that the marks *"differ significantly in their visual impression"* and are aurally and conceptually dissimilar due to the additional elements in the respective marks,

ultimately concluding that “[i]n light of the significant distance between the signs and the weak distinctiveness of the earlier mark, the opposition is unfounded.”

8. Both sides filed written submissions which will not be summarised here but will be referred to as and where appropriate during this decision. No hearing was requested therefore this decision has been taken following a careful perusal of the papers.
9. In these proceedings the Opponent is represented by Kilburn & Strode LLP and the Applicant is represented by Arturs Zvirgzds of Agency Arnopatents.
10. Although the UK has left the EU, section 6(3)(a) of the European Union (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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Preliminary issue

11. The Applicant’s TM8 ‘Notice of defence and counterstatement’ of 2 March 2021, which was verified by a statement of truth, contained the following:
 - (i) 23 supporting appendices (“**the Appendices**”);
 - (ii) photographic images (incorporated within the main body of its counterstatement) of skincare and cosmetic products featuring the letters ‘MD’ in the product name/brand (hereinafter referred to as “**the Photographic Images**”);
 - (iii) a list of registered UK marks, comparable UK marks and international marks designating the UK, which contain the letters ‘MD’ and are registered in respect of class 3 and/or class 5 (hereinafter referred to as “**the List of Earlier MD Marks**”).
12. The Applicant’s submissions, filed on 21 October 2021, during the evidence rounds of these proceedings, largely reflect the Applicant’s counterstatement and were filed containing the same supporting material, that is, the Appendices, the

Photographic Images and the List of Earlier MD Marks (collectively “**the Supporting Material**”). Following the Applicant’s filing of its submissions, the Tribunal notified the Applicant that the Appendices could not be entered into evidence unless they were filed in the correct format (i.e. they would need to be submitted in the form of either a Witness Statement, Statutory Declaration or Affidavit), alternatively the Appendices could be removed. The Applicant elected to remove the Appendices, but the Photographic Images and the List of Earlier MD Marks remained incorporated within the main body of the Applicant’s written submissions.

13. Whilst no formal evidence has been submitted by the Applicant, the Supporting Material has nonetheless entered into proceedings via Form TM8 which was verified by a statement of truth.
14. As such, I will not overlook the Appendices in the counterstatement (even though the Applicant elected to remove them from its later filed submissions) and am addressing them instead as a preliminary issue. I will also address the Photographic Images and the List of Earlier MD Marks contained within the Applicant’s counterstatement and replicated in the Applicant’s submissions of 21 October 2021.
15. I have carefully reviewed the Appendices but do not consider it necessary to fully summarise them here. It suffices to say that they broadly fall within three categories and I comment on them as follows:
 - (i) Screenshots of websites from which the Photographic Images were obtained - I will deal with these appendices when I deal with the Photographic Images and Supporting Material in my paragraphs 16 to 21 below;
 - (ii) Screenshots of the website from which the Applicant obtained the dictionary definitions of the words ‘skinny’ and ‘skin’ (referred to in the main body of its counterstatement and submissions) – these serve merely as a point of reference; and

- (iii) Trade mark application and/or registration details for the parties' respective marks in jurisdictions other than the UK. These are included insofar as the Applicant is attempting to support its submissions that the parties' respective marks co-exist in those same jurisdictions.

Co-existence (even if it were proved by the Applicant) in jurisdictions other than the UK is irrelevant. This argument put forward by the Applicant (and supporting appendices relating thereto) can be disregarded. As it stands, there is no evidence before me with regards to co-existence that relates to the UK.

16. The Applicant contends that 'MD' is "*weakly distinctive*". In its submissions it quotes section 3(1)(c) of the Act followed by this statement: "*[i]t should be noted that, there are many trade marks with [the] 'MD' logo on the market*". The Applicant then proceeds to provide the List of Earlier MD Marks and the Photographic Images by way of example, ultimately concluding that 'MD' is "*a well-known pronoun of medicine and products for skin care (Nice class 3 and 5 goods) and would be viewed, by the average consumer, as an indication of specific product type rather than an indicator of trade origin*".
17. Clearly the Applicant is not seeking to contest (on the absolute grounds under section 3) the validity of the Earlier Mark, however, by providing the List of Earlier MD Marks and the Photographic Images it is inviting me to conclude that 'MD' indicates a specific product type and that it has weak distinctive character. The purpose of which would be so that I discount its significance when comparing the marks and making an assessment as to the likelihood of confusion.
18. Firstly, whilst the Applicant states that 'MD' is "*a well-known pronoun of medicine and products for skin care*", the Supporting Material fails to establish this. The Supporting Material does not evidence what the letters 'MD' stand for and neither has the Applicant offered any such definition in its submissions. The Applicant has readily supplied dictionary definitions for the words 'skinny' and 'skin' and therefore I would have expected evidence and submissions establishing a clear definition of 'MD', demonstrating that it relates to the goods in classes 3 and 5. Something similar to, for example, the definition for the abbreviation 'SPF', which stands for

‘Sun Protection Factor’, and indicates the effectiveness of skin care preparations in protecting the skin from the sun’s rays which, when seen on skin care products, would indicate to the average consumer that the type of product is a sunscreen preparation. I find that no definition or indication can be deduced from the Applicant’s evidence about the letters ‘MD’.

19. Secondly, the Supporting Material does not establish that ‘MD’ indicates a specific product type i.e. there is nothing contained within the Supporting Material that establishes that ‘MD’ is used in the relevant trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or other characteristics of the goods. Following my review of the Supporting Material, I am unable to ascertain what type of skin care product ‘MD’ is or would be, and the Applicant has not presented me with any such indication.
20. Thirdly, there is nothing in the Supporting Material that establishes that ‘MD’ is “*weakly-distinctive*”. In reaching this conclusion I am mindful of the case law regarding state of the register evidence,¹ its limitations and impact upon the distinctive character of a mark. The mere presence of ‘MD’ trade marks or trade marks containing ‘MD’ in the UK register does not evidence use, and such state of the register evidence is insufficient to establish that the distinctive character of the letters ‘MD’ has been weakened because of its use in the UK market. Further, the Photographic Images alone without any additional information or context are also not sufficient to establish that the distinctive character of the letters ‘MD’ has been weakened in the UK. I note that the (removed) Appendices referred to in my paragraph 15(i) above do not provide any substantive detail that would establish this either. For example, they do not establish that any of these products are available on the UK market - the only currency referred to is Dollars as opposed to Pounds Sterling, they do not establish use in the UK, do not show number of sales etc.
21. In summary, nothing in the Applicant’s evidence enables me to conclude what the letters ‘MD’ stand for or that ‘MD’ is descriptive of the goods nor even that it is “*weakly distinctive*”. The Applicant has therefore failed to demonstrate that the

¹ *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06; *British Sugar Plc v James Robertson & Sons Ltd* [1996], RPC 281

'MD' element should be disregarded when comparing the marks. My assessment of a likelihood of confusion will be made in respect of all aspects of the respective marks and in light of all relevant factors.

DECISION

Legislation and Case Law

22. Section 5(2)(b) of the Act reads 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”.

23. I am guided by the following principles which 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 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

24. The goods to be compared are:

Opponent's goods	Applicant's goods
<p><u>Class 3</u></p> <p><i>Non-medicated skin care preparations.</i></p>	<p><u>Class 3</u></p> <p><i>Lotions for cosmetic purposes; Facial cleansers; Cosmetic preparations for skin care; Make-up removing preparations; Beauty masks; Sunscreen preparations; Cosmetics; Essences for skin care; Make-up preparations; Oils for cosmetic purposes.</i></p>
<p><u>Class 5</u></p> <p><i>Medicated skin care preparations.</i></p>	

25. For the purposes of comparing the parties' goods, I take into consideration the case of *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05 ("**Meri**c") in which the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.
26. The Opponent submits that the Applicant's goods in Class 3 are identical to the Opponent's goods in Class 3 as they all fall within the more general category of "*non-medicated skin care preparations*". I agree. The respective goods in Class 3 are identical under the principle outlined in Meric.
27. I have found that the Applicant's Class 3 goods are identical to the Opponent's Class 3 goods. For reasons of procedural economy, I will not undertake any further

comparison between the Opponent's goods in Class 5 and the Applicant's goods in Class 3.

The average consumer and the nature of the purchasing act

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. Trade Mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. The word "average" merely denotes that the person is typical,² which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.³
29. It is therefore necessary to determine who the average consumer of the respective goods is, and how the consumer is likely to select those goods. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.⁴
30. I consider the average consumer of the goods at issue will be a member of the general public at large.
31. The goods are likely to be sold through a range of retail outlets (and their online equivalents) such as beauty and health stores, pharmacies, supermarkets and via catalogues. The goods are likely to be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply online and with catalogues where the consumer will select the goods having viewed an image displayed on a webpage/page.
32. The selection of the goods is therefore primarily visual, although I do not discount that aural considerations may play a part by way of word-of-mouth recommendations and advice from sales assistants or beauticians. However, it is my view that even where the goods are selected by making requests to staff, the selection process would primarily be visual in nature whereby the goods are

² *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), paragraph 60

³ *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

displayed on shelves behind a counter. Accordingly, visual considerations dominate.

33. The goods will range in price but are, for the most part, likely to be inexpensive. They will generally be purchased on a regular basis, although some of the goods may be purchased less frequently than others, and only as and when the need arises.
34. When purchasing the goods, the average consumer is likely to consider such things as ingredients, whether the products have been tested on animals, their durability, their properties and benefits and whether the goods meet their specific skin care needs. The average consumer may also base their considerations solely on the scent of the goods. These considerations will apply even where the goods are of low cost.
35. I consider the goods to be every day convenience goods because they are used as part of a daily skincare regime, relatively low priced, non-durable and can be purchased frequently with minimal effort. The purchasing process therefore is likely to be more casual than careful and will not require an overly considered thought process. The average consumer will tend to pay more attention because the goods are for use on the skin, however, they will not typically demonstrate more than a medium level of attention.

Comparison of marks



36. 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 Court of Justice of the European Union 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 dissect the trade marks artificially, 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.

38. The respective trade marks are shown below:

Earlier Mark	Contested Mark
	

39. The Opponent has submitted that ‘MD’ is an independent and distinctive element within the Earlier Mark, in particular because *“it is presented in a larger font than the other element (with the 2 letters taking up the same amount of space as the 4 letters in elta), making it particularly eye-catching. [...] Although the marks differ in respect of additional elements, this is insufficient to avoid the marks being deemed similar as a result of the shared distinctive element MD, presented in a strikingly similar font”*.

40. In paragraph 13 of its submissions, the Opponent has invited me to consider the General Court’s decision in *Matratzen*⁵ to make a finding that *“two marks are similar when, from the point of view of the relevant public, they are at least partly identical as regards one or more relevant aspects”*. Firstly, I recognise that my assessment of the similarity between two composite marks is not confined to a situation where the common element is identical, but extends to a situation where

⁵ *Matratzen Concord AG v OHIM*, Case T-6/01

the common element is similar.⁶ Secondly, I note that this submission from the Opponent (which takes the wording from paragraph 30 of *Matratzen*) is far from the complete statement, and the Opponent's submission is, in my opinion, an over-simplistic interpretation of the Court's findings and of the assessment I am required to make. The Court goes on to say that:

“34. [...] that approach does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.”

41. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the judgment in *Bimbo*, on the Court's earlier judgment in *Medion v Thomson*. Making reference to the composite trade mark for which registration was sought, the judge said that *Bimbo* confirmed three points where a composite mark contains an element which is similar to an earlier mark:

“19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In Medion v Thomson and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite

⁶ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), paragraph 18

mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

Overall Impression

42. The Earlier Mark consists of the word ‘ELTA’ and the letters ‘MD’, presented in a stylised font, arranged vertically and separated by a straight horizontal line. Reading left to right and top to bottom the Earlier Mark is read as ‘ELTA MD’.

43. The Opponent has submitted that ‘MD’ is in a larger font than the word ‘ELTA’, however, I do not consider it is in a larger font per se, rather, the placement of ‘MD’ below the word ‘ELTA’ creates an optical illusion that the font size is larger. To illustrate my point, simply arranging the words vertically even in a plain font in the same font size produces this result:

elta

mD

44. Either way, the placement of ‘MD’ below the word ‘ELTA’ tends to make it appear larger. This placement is a conscious choice on the part of the Opponent which has the effect of giving a certain visual prominence to the letters ‘MD’ in the mark, without necessarily resulting in them dominating the overall impression created by the mark. In my view, both ‘MD’ and ‘ELTA’ play an approximately equal role in the overall impression created by the Earlier Mark. That said, ‘MD’ is not simply part of a unit and its meaning is not qualified by the presence of the word ‘ELTA’.

45. The average consumer, while perceiving the Earlier Mark will also perceive that it consists of two signs. The horizontal line creates a dividing line between the two verbal elements of the mark which conveys even more effectively that the mark is made up of two separate elements, than the words alone might have done. It has the effect of creating separation in the mark which would reinforce that perception of the average consumer that the mark consists of two signs.
46. Notwithstanding my finding that 'MD' does not dominate the overall impression created by the Earlier Mark, taking the above into account, I conclude that 'MD' has a distinctive significance which is independent of the significance of the whole. In reaching my conclusion I am reminded of the principle that an element may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark.
47. I now turn to the Contested Mark which consists of three elements arranged vertically. From top to bottom they are as follows:
- (i) firstly, a stylised monogram device ("**the MD Device**"). The Applicant has submitted that it could be perceived as the letters 'ND', 'NO' or 'MO' as opposed to 'MD', due to the stylisation of the lettering. I acknowledge in general terms that monograms can sometimes require deciphering of some kind on the part of the consumer, but the presence of the letters 'MD' elsewhere in the Contested Mark reinforces that the monogram consists of the letters 'MD'. In fact, the Applicant itself goes on to submit that the *"the figurative device [...] can be described as a dark circle containing highly stylised letters 'MD'."*
 - (ii) secondly, the letters 'MD' followed by the word 'Skinical', positioned below the MD Device; and
 - (iii) thirdly, the words 'SKIN CARE' in capital letters, in a smaller, much less pronounced font than 'MD Skinical' and positioned off-centre, to the right, below 'MD Skinical'. The average consumer would perceive the words 'SKIN CARE' as descriptive of the goods. The words carry no trade mark message and contribute little or nothing to the overall impression of the Contested Mark and may even be overlooked.

48. The word 'Skinical' is an invented word and is distinctive. 'MD Skinical' forms the widest part of the mark, this, together with the boldness and size of the font used for this element, and its central placement in the Contested Mark draws the eye. The stylisation of the MD Device is also visually impactful and distinctive. It is a bold, sizeable logo that forms a focal point within the mark by virtue of the prominence given to it within the mark by being placed centrally atop the other verbal elements. Both the 'MD Skinical' component and the MD Device component have prominence within the mark and share approximately equal dominance.
49. That said, the MD Device is not simply an integral part of a unitary whole; on the contrary, as it is a logo, it is likely to lead the average consumer to understand that it has a distinctive significance independent of the whole, not least because the average consumer is accustomed to perceiving logos as an indication of trade origin. Further, the fact that 'MD' is present twice in the mark - as a logo and to precede the word 'Skinical' - emphasises how the MD Device is being treated separately. Again, I am reminded of the principle with regards to elements of a composite mark being able to retain an independent distinctive role without necessarily constituting a dominant element of that mark.
50. I also find that the double presence of 'MD' within the mark would have a lasting impression in the mind of the average consumer to the point that the average consumer could perceive 'MD' as an indication of trade origin.

Visual comparison

51. The Earlier Mark is a figurative mark, as opposed to being a word-only mark. The word 'ELTA' is presented in lowercase. The 'M' appears to be a lowercase 'M' due to the stylisation of the font. The 'D' is uppercase, although it is the same height as the lowercase 'M'. The font is not especially elaborate, but nor is it entirely commonplace. In the vertical arrangement of the verbal elements, the eye is drawn at least as much to the 'MD' component.
52. Turning to the Contested Mark. I have found that the words 'SKIN CARE' play a lesser role in the overall impression of the mark, therefore my visual comparison focuses primarily on the assessment of the MD Device and the text 'MD Skinical'.

53. The MD Device consists of a white monogram of the conjoined letters 'MD' in a stylised font, contained within a black, solid circle. The two letters are conjoined where the third stem of the 'M' replaces the stem of the 'D'. The 'M' appears to be a lowercase 'M' and the 'D' is uppercase.
54. 'MD Skinical' is in an emboldened plain font and runs across the centre of the Contested Mark and is the widest part of the mark.
55. Visually, the respective marks coincide in their portrayal of the letters 'MD', which have at least an equal degree of visual prominence as the other elements in each mark. The font used for the MD Device is highly similar, if not identical to the font used for 'MD' in the Earlier Mark. It also shares the same stylistic choice with the Earlier Mark by combining a lowercase 'M' with an uppercase 'D'.
56. Although overall the portrayal of the shared element is not identical (in the Earlier Mark 'MD' is not conjoined and is not contained in a solid black circle), I allow for imperfect recollection and conclude that this shared element is a point of high similarity between the respective marks that would not go unnoticed by the average consumer despite the marks differing visually in all other elements.
57. Taking account of the differences arising from the elements 'ELTA' and 'Skinical', along with the marks' configuration differences, while factoring in the degree of similarity based on the 'MD' elements, I find the marks to be visually similar overall to a degree somewhere between low and medium.

Aural comparison

58. The word 'ELTA' has no counterpart in the Contested Mark and the word 'Skinical' has no counterpart in the Earlier Mark.
59. The ordinary words 'SKIN CARE' do not have any counterpart in the Earlier Mark, but it is likely they may not be articulated due to their descriptive nature and the lesser role that they play in the overall impression of the Contested Mark.
60. The letters 'MD' would be pronounced as though each letter is followed by a full stop, that is, 'EM-DEE'. The 'MD' element in the Earlier Mark would be pronounced identically to both 'MD' elements in the Contested Mark. However, the 'MD'

forming part of the MD Device is unlikely to be articulated. 'MD' would be articulated first in the Contested Mark and second in the Earlier Mark.

61. In my view, the average consumer is likely to just articulate 'MD Skinical' therefore the most likely aural comparison would be 'MD Skinical' (as opposed to 'MD MD SKINICAL SKIN CARE' or 'MD MD SKINICAL') versus 'ELTA MD'.
62. I bear in mind the importance of the first element of a mark insofar as the beginnings of words tend to have a more aural impact than the ends.⁷ Overall, when comparing the aural similarity between 'ELTA MD' and 'MD SKINICAL' they are similar to only a low degree although the average consumer will recognise that there is aural identity in relation to 'MD' which would not go unnoticed.
63. Finally, I note that the fact that the aural comparison for the 'MD' in the Contested Mark comes from the 'MD Skinical' element of the mark, as opposed to the MD Device is irrelevant, and it does not alter the finding I have made with regards to the aural comparison.

Conceptual comparison

64. For a conceptual message to be relevant it must be capable of being immediately grasped by the average consumer.⁸
65. The word 'ELTA' has no conceptual message that would be capable of being immediately grasped by the average consumer.
66. The word 'Skinical' is an invented word that would strike the average consumer as a portmanteau coined from a combination of the words 'skin' and 'clinical', thus alluding to a concept that the goods are clinically developed for the skin. Where the average consumer does not make this connection, they will at least recognise that it contains the word 'skin' and therefore attribute a concept to 'Skinical', insofar as it alludes that the goods are intended for use on the skin (which would be reinforced by the fact that the Contested Mark also contains the words 'SKIN CARE'). Either way, the inclusion of the word 'Skinical' in the Contested Mark is a

⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, see paragraph 83

⁸ This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

point of conceptual difference between the respective marks. It is not an especially distinctive concept in relation to skin care (since these products can often be developed in a clinical setting) although the inventiveness of the coinage adds to distinctiveness.

67. Both parties have made submissions as to their interpretation of the letters 'MD'. The Applicant puts forward an argument that it is *"a well-known pronoun of medicine and products for skin care (Nice class 3 and 5 goods) and would be viewed, by the average consumer, as an indication of specific product type rather than an indicator of trade origin"*. I have already concluded that the Applicant's evidence does not substantiate this claim.
68. To counter the Applicant's argument, the Opponent has submitted that *"[w]hilst MD may be used to denote the professional graduate degree of "Doctor of Medicine", it has no meaning in relation to skincare preparations [...] the relevant public will generally use the term Dr. when referring to someone with a medical degree and is unlikely to be familiar with the term MD"*.
69. However, neither party has made any submissions with regards to what the concept of 'MD' is.
70. I accept that 'MD' may be used to denote the professional graduate degree of 'Doctor of Medicine'. In my experience it is customary for a graduate degree title to append a person's full name or at least append their title and surname. Neither mark adheres to this convention, not least because it is not apparent that 'ELTA' is a person's name and the 'MD' is placed below it rather than to the right of it; and 'Skinical' is a portmanteau as opposed to a name and the 'MD' precedes the word. I find that it is not at all clear that these letters in the marks refer to 'Doctor of Medicine' and even if it were, it does not follow that there is an immediately graspable concept in relation to the goods.
71. It is my opinion that 'MD' has no clear conceptual message that would be capable of immediate grasp by the average consumer. 'MD' does not have one commonly recognisable meaning and I am not convinced that the average consumer in the UK will know specifically what the letters 'MD' stand for. Whilst it can denote the professional graduate degree of 'Doctor of Medicine' (and on this point I tend to

agree with the Opponent insofar as the UK public, of which the average consumer comprises, is accustomed to referring to a 'Doctor of Medicine' as a 'Doctor', and that title is abbreviated to 'Dr') it can also stand for 'Managing Director' of a company/organisation and could conceivably be an abbreviation for all manner of things, including, amongst other things, the initials of a person's name for example. In each instance the concept is altered. I also do not discount that 'MD' may be completely meaningless for some.

Distinctive character of the earlier trade mark

72. The degree of distinctiveness of the Earlier Mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the Earlier Mark, the greater the likelihood of confusion may be, although it is the distinctive character of a component that is similar between the marks that is particularly relevant.
73. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
74. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that (my emphasis):

*“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).*

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

contain an element descriptive of the goods or services for which it has been registered [...]"

75. The Opponent makes no claim to enhanced distinctiveness through the use made of the Earlier Mark therefore I only have the inherent distinctiveness of the mark to consider.
76. The word 'ELTA' does not have any apparent meaning. It appears to be an invented word that has no allusive qualities in relation to the goods and enjoys a relatively high degree of inherent distinctiveness. I would have reached the same conclusion if it were not stylised.
77. The approach argued by the Applicant, is that 'ELTA' is the distinctive component in the Earlier Mark and that 'MD' is weakly distinctive and is an indication of specific product type. If this were indeed the case, then I would have expected evidence and submissions that supported this. However, there is nothing before me that establishes this and I therefore reject these contentions and note that a low level of distinctiveness does not preclude a finding of a likelihood of confusion per se.
78. 'MD' does not carry any clear allusive qualities when considered in respect of the goods and I have found that the average consumer would perceive no immediately graspable concept from the letters 'MD' in relation to the goods at issue. In general terms, trade marks consisting of abbreviations, acronyms or initials are acceptable for registration unless for example the letters represent descriptive words or are shown to be customary in the trade. The letters 'MD' do not indicate a specific product type – in contrast to my aforementioned example of the abbreviation 'SPF'. In the absence of any evidence before me to the contrary, I find that the letters 'MD' are inherently distinctive at least to between a low and medium degree.
79. Although the 'MD' element in this figurative mark is not heavily stylised there is some stylisation that creates visual interest which adds a degree of distinctive character beyond the plain letters.

Conclusions on Likelihood of Confusion

80. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.⁹ I must also keep in mind the average consumer of the goods, the nature of the purchasing process and have regard to 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.¹⁰
81. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether there is a potential that they might believe that the goods come from the same or an economically linked undertaking, and therefore are likely to be confused as to the origin of those goods. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public;¹¹ occasional confusion by a small minority is not sufficient to find a likelihood of confusion. The relative weight of the factors is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case.¹²
82. The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person; it involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade and, it is often very difficult to make such prediction with confidence.¹³ The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the Contested Mark with an imperfect recollection of the Earlier Mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.¹⁴

⁹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

¹⁰ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

¹¹ Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at paragraph 34

¹² See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O/049/17, (*Rochester Trade Mark*).

¹³ Again see comments of Iain Purvis as the Appointed Person, *ibid*

¹⁴ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

83. I am keenly aware from the case of *Whyte and Mackay*¹⁵ (particularly paragraph 44) that “*if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.*” However, it is important to remember in that case, the mark ORIGIN was being relied on in opposition to the trade mark JURA ORIGIN for alcoholic drinks. The Judge held that there was no likelihood of confusion, essentially because when used after the name of the island Jura, the name Origin became entirely descriptive and would simply be taken as indicating that the product in question came from the island, rather than having any independent trade mark significance.¹⁶
84. The facts in that case are distinguishable from *Whyte and Mackay* since contrary to the claims by the Applicant, ‘MD’ has no clear or established descriptiveness in relation to the goods at issue. It would not be perceived as part of a unit whereby its incorporation into a composite mark gives it a different meaning than the meaning it has as a separate component, nor is its meaning qualified by the other components within the mark.
85. I have found that ‘MD’ is distinctive to between a low and medium degree (at least) and I disagree with the Applicant’s submission that ‘MD’ is “*weakly distinctive*”. Even if I were to agree with the Applicant, I could not simply disregard the similarities between the marks because of this. Indeed, in *L’Oréal SA v OHIM*,¹⁷ the CJEU stated:

“42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

[...]

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character

¹⁵ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*

¹⁶ *Dominique Tillen v Design Go Limited and DG Capital Limited*, BL O/331/19, paragraph 16

¹⁷ Case C-235/05 P

of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

86. Bearing in mind that confusion can be direct – where there is a simple matter of the consumer mistaking one mark for another, or indirect – where the later mark and the earlier mark share common elements which would lead the consumer to conclude that it is another brand of the earlier mark,¹⁸ it is clear that there would be no likelihood of direct confusion between the two marks because the average consumer would not simply mistake one mark for another. The differences evident between the two marks, from their respective configurations to the presence of the elements of ‘ELTA’ and ‘Skinical’, preclude direct confusion.

87. Instead, my consideration as to whether there is a likelihood of confusion is based on whether there would be indirect confusion. I note 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”* therefore there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.¹⁹ In addition, it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

¹⁸ See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion

¹⁹ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 16

Therefore, a finding of indirect confusion should not be made merely because the two marks share a common element.²⁰

88. In my view, the factors of primacy in this decision are that:

- (i) the respective goods are identical;
- (ii) the trade marks coincide in their MD elements and differ in all other elements;
- (iii) the MD Device and the 'MD' element in the Earlier Mark have an independent distinctive role in the marks (although that does not in itself automatically result in a likelihood of confusion);
- (iv) the 'MD' element in the Earlier Mark is inherently distinctive to between a low and medium degree (at least);
- (v) the MD Device and the 'MD' element in the Earlier Mark are highly similar on a visual basis, which is important given that the purchasing process is predominantly visual in nature. Due to imperfect recollection, the visual differences between those elements may be overlooked, while the visual similarities may be retained in the overall impression;
- (vi) factoring in the additional elements, the marks are visually similar overall to between a low and medium degree;
- (vii) there is aural identity between 'MD' in both marks. Factoring in the additional elements, the marks are aurally similar to a low degree;
- (viii) there is no immediately graspable concept for 'MD'. The presence of 'ELTA' and 'Skinical' in the respective marks are points of conceptual difference; and
- (ix) both marks treat 'MD' in a prominent way which would not go unnoticed by the average consumer and the double presence of 'MD' within the Contested Mark would have a lasting impression in the mind of the average

²⁰ Again see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

consumer to the point that the average consumer could perceive 'MD' as an indication of trade origin.

89. I again note the claims by the Applicant that (i) 'MD' is "*weakly distinctive*", but I have found that there is lack of any clear substantiation from the Applicant as to why 'MD' should be accorded such low distinctive character; and (ii) 'MD' would be "*viewed, by the average consumer, as an indication of specific product type rather than an indicator of trade origin*" – again a claim which I have rejected. I find that I am unable to reconcile these claims with the way the 'MD' is represented in the Contested Mark, this is because it is given particular prominence by appearing twice within the mark and it is elevated to logo status (i.e. the MD Device).
90. There appears to be no other logical explanation as to why MD has double presence in the Contested Mark other than an intention to highlight the origin significance of the letters 'MD' by the way the trade mark is configured by (i) choosing to incorporate 'MD' as part of a sizeable logo and (ii) placing 'MD' in plain font before the word 'Skinical', thus cumulatively emphasizing that the primary indicator of trade origin is 'MD' and indicating that 'Skinical' is a sub-brand of 'MD'.
91. The Applicant's choice of house mark/logo (the MD Device) also bears a strong similarity with the 'MD' element in the Earlier Mark. I note that there are many fonts in existence, the fact that the MD Device shares similarities in font and presentation with the 'MD' in the Earlier Mark would be noticed by the average consumer (who is paying a medium level of attention) and the average consumer is unlikely to just attribute it to a mere coincidence and instead might assume that the goods come from the same or economically linked undertakings.
92. The average consumer will see that the Contested Mark "*is different from the Earlier Mark, but also has something in common with it,*"²¹ and that that common element also has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the similarity of that sign to the Earlier Mark.

²¹ L.A. Sugar Limited v By Back Beat Inc, Case BL-O/375/10, paragraph 16

93. Indeed, the similarity between the MD Device in the Contested Mark, with the 'MD' element in the Earlier Mark is such that it would lead them to conclude that the Contested Mark is another brand of the owner of the Earlier Mark. Moreover, it would lead them to believe that the additional elements (which represent a point of difference between the two), reflect a variation in the nature of the products, a different product line or that the differences stemmed from brand expansion, brand evolution and/or marketing considerations, and not that the difference denotes goods from different traders.

94. I am keenly aware that a finding that the marks share a common element is not sufficient in and of itself to establish a likelihood of confusion. That said, my conclusion is not based solely on this finding. Taking all the above factors into account (including, amongst other things, the principle of interdependency; the shared similarities of 'MD'; the shared presentation of the 'MD' element; imperfect recollection; the independent distinctive trade mark significance of 'MD'; 'Skinical' being viewed as a sub-brand of 'MD'; the nature of the purchasing process; and the Applicant's failure in its evidential burden to show that the letters 'MD' have no or weak trade mark significance) I conclude that a significant proportion of the average consumer group, when seeing the Contested Mark on identical goods, will associate it with the Earlier Mark. Thus, leading to a risk that the average consumer might believe that the respective goods come from the same or economically linked undertakings, resulting in a likelihood of indirect confusion.

OUTCOME

95. The opposition succeeds under section 5(2)(b) of the Act.

COSTS

96. The Opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Opponent the sum of £600 as a

contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee ²²	£100
Preparing the Statement of Grounds and considering the Counterstatement	£200
Preparing written submissions	£300
TOTAL	£600

97. I therefore order BIOMED LABORATORIES LTD. to pay ELTA MD, Inc. the sum of £600. 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.

Dated this 18th day of July 2022

Daniela Ferrari
For the Registrar

²² Only £100 has been awarded as the opposition proceeded under s5(2)(b) only following the Opponent's withdrawal of its other ground