

O-030-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2493382  
BY RHYTHM & BLUE INC LTD TO REGISTER THE TRADE MARK**

**SEBADERM**

**IN CLASSES 3 & 5**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 98368  
BY SEBAPHARMA GmbH & Co**

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by Sebapharma GmbH & Co**

## **BACKGROUND**

1. On 22<sup>nd</sup> July 2008, Rhythm & Blue Inc Ltd of 44 East Street, Chichester, West Sussex PO19 1HQ (hereafter "Rhythm") applied to register the mark, "SEBADERM", in Classes 3 and 5 for the following goods:


### **Class 03:**

Toiletries, foundations, concealers, face powders, blushers, lip liners, lip gloss, mascara, eye shadow, eye liner, nail polish remover, eye cleansers, face cleansers, skin toners, exfoliators, eye masks, face masks, moisturisers, facial cream, facial serum, eye make up remover, eye cream, eye gel, lip moisturisers, hand cream, body lotions, body washes, shower gels, foot balms, body scrubs, deodorants, talcum powder, soap, bath essences, shampoo, conditioner, hair styling preparations, hair dyes, sun tanning preparations, shaving preparations, dentifrices, facial packs, nail care preparations, emery boards, pumice stones, cotton sticks and wool for non-medical purposes, all for use on the body; but not including any such goods for the treatment of wounds.

### **Class 05:**

Dietary supplements for medicinal purposes; minerals, vitamins, mineral preparations, vitamin preparations; herbal remedies, medicated creams for application to the skin and face; but not including any such goods for the treatment of wounds.

2. The application was published on 5<sup>th</sup> September 2008 and on 3<sup>rd</sup> December 2008 Sebapharma GmbH & Co of Binger Str. 80, Boppard 56154 Germany (hereafter "Seba") lodged an opposition against the goods specified above.
3. Seba has an earlier Community mark, 108886, the details of which are as follows:

Mark. Filing and registration dates	Goods and services relied upon under section 5(2)(b)
 <p data-bbox="327 651 614 723">1<sup>st</sup> April 1996 and 6<sup>th</sup> October 1998</p>	<p data-bbox="751 394 890 427"><b>Class 03:</b></p> <p data-bbox="751 445 1289 1189">Cosmetics, shampoos, cosmetic preparations for cleaning and care of the skin, hair, lips; substances for the treatment of skin impurities for external use; baby care products, namely flannels for babies, foam baths for babies, baths for babies, skin creams for babies, oils for babies, cloths for applying oils, moist wipes and shampoos for children, powder for children; body care and cleansing products; face lotions, facial cleansing preparations and substances in liquid and solid form, being lotions, creams and gels, water or alcohol-based solutions; bath extracts based on medicinal plants and herbs for cosmetic purposes; foot care products; sun-tanning and skincare preparations in the form of lotions, creams and gels, aftersun skin balms, aftersun sprays.</p> <p data-bbox="751 1211 890 1245"><b>Class 05:</b></p> <p data-bbox="751 1263 1289 1827">Chemical, pharmaceutical and veterinary preparations for healthcare and hygiene purposes; pharmaceutical preparations for skin complaints, to combat swelling of the skin and being hand and nail balms, pharmaceutical preparations for skin complaints, namely skin cleansers, being pharmaceutical preparations for skin complaints in the form of a special substance for seborrheic conditions and microbial dermatitis (solid, liquid, lotion, cream, shampoo); bath extracts based on medicinal plants and herbs for skin complaints; medicinal creams for children.</p>

4. Seba has based its opposition solely upon section 5(2)(b) of the Trade Marks Act 1994 (hereafter “the Act”). They say the respective marks are visually, phonetically and conceptually similar; the most distinctive and dominant element of the earlier mark is SEBA and that same prefix is included in the later mark; the suffixes in both respective marks are non-distinctive; the goods claimed in the application are similar if not identical to the goods covered by the earlier trade mark and are marketed through the same trade channels. Overall, Seba say there is a clear likelihood of confusion.
5. Rhythm filed a counterstatement denying the ground of the opposition. They say there is no likelihood of confusion as the respective marks convey entirely different visual, phonetic and conceptual identities (taken as totalities, as opposed to being dissected into prefixes and suffixes). Thus they conclude that there is no likelihood of confusion. They also put Seba to proof of use of their Community mark.
6. Evidence has been filed by Seba only which, insofar as it is relevant, I shall summarise below. Both parties have filed submissions which I will take into account. Neither party has requested a hearing and instead, both parties are content for a decision to be issued based on the papers. Both parties request costs.

### **Opponent’s evidence**

7. This takes the form of a witness statement dated 15<sup>th</sup> October 2009 by Bodwin Nostitz who is the Managing Director International Marketing of Sales at Seba. He says Seba has been distributing products under the SEBAMED mark since 1983, and its UK distributor for the years 1999- 2009 is Ceuta Healthcare Ltd (“Ceuta”). All orders are sent to Ceuta which are forwarded to the wholesaler, Unidrug Distribution Group, for despatch.
8. Mr Nostitz says the mark is used on all the products claimed in the registration. Exhibit BN1 shows examples of packaging as well as leaflets for the following products:

face gel; cleansing bar; baby diaper rash cream; baby cleansing bar; baby skincare oil; clear face antibacterial cleansing foam; liquid face and body wash; baby bubble bath; sun soothing balm; sun cream; sun lotion and sun spray.
9. The packaging shows the mark in use as the two ‘elements’, “seba” and “med”, in lower case script, the seba element being slightly above the med; ‘seba’ is in dark green colouring and ‘med’ in red. Above the word, “sebamed”, there is a roundel device comprising the words “Ideal for healthy skin” and in the middle, “pH 5.5”.

10. Exhibit BN2 comprises a large selection of invoices referring to sales for the following products:

cleansing bar; liquid cleanser; feminine intimate wash; fresh shower; shower oil; shampoo; conditioner; hair repair balm; deodorants; cleansing milk; day cream; lip defence stick; body lotion; anti-ageing cream for the face and body; hand and nail balms; face and body wash; anti-dandruff treatments; body milks; and aftersun lotion.

11. There are 489 invoices comprising this exhibit, but it seems that invoices numbered 61 - 489 are all addressed to wholesalers or distributors outside the UK, and for that reason I will just focus only on invoices 1-60. Invoices 1-23 are from Unidrug Distribution Group to various companies such as: AAH (PERRY BARR) of Cheshire, ENTERPRISE of Stoke on Trent, UNICHEM LTD of Derbyshire, SANGERS of Maidstone, NUMARK of Cheshire. The invoices are dated from 5<sup>th</sup> July 2004 through to 26<sup>th</sup> February 2009. The amounts involved vary, ranging from £9.35 to over £11,000. Items that do not bear the SEBAMED mark are however blanked out, and so it cannot be assumed that all products on the invoices bear the SEBAMED mark. Of the products that do bear that mark, there are cleansing bars, facial washes, shampoo, cleansers, shower oil, body gel, face and body wash, shower gel, clear face foam, baby diaper rash cream, and moist lotion.

12. Invoices 25 – 60 are all pro-forma invoices addressed to Ceuta and are dated from 20<sup>th</sup> January 2003 through to 10<sup>th</sup> September 2008. They are in EUROS and are for larger quantities of products including, in addition to the invoices 1-23, body lotion, bubble bath, hand and nail balm, baby soft cream, intimate wash emulsion and children's shampoo.

13. Mr Nostitz says Seba has been distributing products bearing the trade mark in Germany since 1967 and the UK since 1983. Approximate annual sales in the UK for the years 2003-2008 are given as follows:

<b>Year</b>	<b>£</b>
2003	179, 000.00
2004	186, 000.00
2005	193, 000.00
2006	187, 000.00
2007	186, 000.00
2008	188, 000.00

14. Advertising spend in the UK is then given as follows:

<b>Year</b>	<b>£</b>
2003	35, 800.00
2004	37, 200.00
2005	38, 600.00
2006	37, 400.00
2007	37, 200.00
2008	37, 600.00

15. Exhibit BN3 comprises a collection of advertising and promotions in the UK for the years 2003-2009. These show an advert in “HEALTHY TIMES”, a free health magazine for, and available from, pharmacists. The advert bears the words “Scientifically proven to protect your skin’s natural pH balance” and explains, “Most soaps are alkali (above the skin’s natural pH of 5.5) which can lead to irritation and dryness..... By matching the natural pH of your skin, seabamed soap-free products lock in moisture, naturally, leaving even the most sensitive skin soft and smooth.” “The seabamed range is suitable for all skin types: eczema, acne and spots, contact dermatitis, psoriasis, skin mycosis, seborrhoea, fungal and bacterial skin infections and burns.” “Find seabamed in your local pharmacy or online.”
16. There is a 2008 Marketing Overview which refers to this advert, which was placed in “HEALTHY TIMES” over Oct, Nov and Dec of 2008. This magazine is apparently available to pharmacy shoppers. The magazine has a circulation of 250,000 and the cost of the advert was £5,145. Other promotions are listed as 10% off the range of products through various wholesalers: AAH, ENTERPRISE, NUMARK and UNICHEM. This promotion cost £13,700. Goody Bags were also distributed at two running events – the BUPA Great Capital Run and the BUPA Great Yorkshire Run. Pharmacies were given incentives and samples and there was a special promotion involving SAINBURY’S of 25% off RRP. The overview concludes that sales of £187.8k between Jan and Dec 2008 has involved an advertising and promotion budget of £33.8k.
17. Other material in Exhibit shows similar incentives and bonus offers given over the period 2003-2009. Also, magazine insertions, press adverts, show and display cards, counter units and leaflets are all exhibited. The mark in use is consistently the same, and as described in para 9 above.
18. The trade mark has been awarded the accolade of “superbrand” in November 2005 and a copy of the certificate in German with an uncertified or unverified translation is provided at Exhibit BN4. The certificate explains that Seba’s mark has been elected by an independent jury to be one of Germany’s strongest trade marks. The evaluation criteria comprise “predominance and

acceptance of the mark, customer loyalty as well as longevity". It is worth recording that the mark given the award includes both the word "SEBAMED" in the form described in para 9 above, together with, and above it, the roundel device also mentioned in para 9 above, but in German.

19. It is perhaps also worthwhile recording the company's response to the award, "We are proud that the mark sebamed once again accomplished the leap into the first league. The success is due to the efficiency of the products in the field of physiological skin cleansing and care. Since the abolishment of the washing ban for skin diseases in 1968 because of sebamed soap free cleansing bars, the conception for sensitive and problematic skin could be convincingly developed for the customers by the consequent realization of the principle "quality by research" said Dr Heinz Maurer, Chairman of Sebapharma.
20. Exhibit BN5 is a selection of German poll results, EMNID 1994, BRIGITTE 1998, 2006 and 2008 showing the significant reputation of the mark.
21. Finally, Mr Nostitz draws my attention to a decision of the opposition division at OHIM, No B889 735, where Seba opposed the mark SEBACIN. The OHIM found in favour of Seba and a likelihood of confusion was found in relation to goods in Classes 3 and 5. Also Sebapharma was found to have a reputation in Germany which lead to victory also for Seba, with a finding also of unfair advantage or detrimental to distinctive character. Mr Nostitz explains his company owns a range of 'Seba' marks registered at OHIM, and these are listed in Exhibit BN7.

## **DECISION**

### **Proof of use**

22. The Trade Marks (Proof of Use, etc) Regulations 2004 apply in respect to the Section 5(2) (b) grounds of this case. The provision reads as follows:

#### **"6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

23. With a registration date of 6<sup>th</sup> October 1998, it is clear that under Section 6(1) of the Act, Seba’s mark is an earlier trade mark. Further, as it completed its registration procedure more than five years before the publication of the contested mark (being 5<sup>th</sup> September 2008), it is subject to the proof of use requirement set out in section 6A of the Act. The relevant 5 year period ends on 5<sup>th</sup> September 2008 and starts on 4<sup>th</sup> September 2003.

24. Consideration has to be taken, also, of section 100 of the Act which states:



“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequent upon section 100, the onus is upon the registered proprietor to prove that it has made use of the trade mark in suit, or that there are proper reasons for non-use.

25. The leading cases on genuine use are well known: *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] ETMR 85 (“*Ansul*”), *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38 and [2005] ETMR 114 (“*La Mer*”), *The Sunrider Corp v OHIM*, Case C-416/04P (“*Sunrider*”). A helpful synthesis of the ‘legal learning’ from these cases and several more recent ones has been provided in the appointed person case, *Sant Ambroeus* (BL O-371-09), as follows:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR 28 (*Silberquelle*) where relevant:

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

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

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

*The mark as used; Seba's own use and what the evidence shows*

26. The first point to note, and I do not understand Rhythm to take any issue on this, is whether the mark as used by Seba is an acceptable variant of the mark as registered. I have described the mark in use at para 9 above and there is no doubt in my mind that the usage described is of a variant which does not alter the distinctive character of the mark as registered. Such variation as there is, although it may be noticed by the average consumer, is of a purely descriptive or decorative nature. Accordingly, it is an acceptable variant.

27. Rhythm 's position is not that it denies genuine use on all goods covered by Seba's specification. At para 11 of their submissions filed in February 2010, Rhythm's attorneys say, in Class 3 they accept genuine use has been made

on the following: cleaning bar, facial wash, shampoo, liquid cleanser, face and body wash, shower gel, baby diaper rash cream, hand and nail balm, baby bubble bath and lotion and cream. They do not accept that any genuine use has been made on the remainder of the goods in Class 3, in particular they do not accept use on: cosmetics, essential oils (not in Seba's specification), dentrifices (also not in Seba's specification), extracts for the bath based on medicinal plants and herbs for cosmetic purposes or foot care preparations. In Class 5, they say Seba has not provided proof of use in respect of medicines, chemical, pharmaceutical and veterinary preparations for curative.... purposes or bath extracts based on medicinal plants and herbs for pharmaceutical purposes.

### **Class 3**

28. I need to remind myself of Seba's Class 3 specification which is as follows:

#### **Class 3:**

Cosmetics, shampoos, cosmetic preparations for cleaning and care of the skin, hair, lips; substances for the treatment of skin impurities for external use; baby care products, namely flannels for babies, foam baths for babies, baths for babies, skin creams for babies, oils for babies, cloths for applying oils, moist wipes and shampoos for children, powder for children; body care and cleansing products; face lotions, facial cleansing preparations and substances in liquid and solid form, being lotions, creams and gels, water or alcohol-based solutions; bath extracts based on medicinal plants and herbs for cosmetic purposes; foot care products; sun-tanning and skincare preparations in the form of lotions, creams and gels, aftersun skin balms, aftersun sprays.

29. As I understand Rhythm's position, it accepts genuine use in Class 3 for a variety of what may be called 'body care and cleansing products', but it does not accept that genuine use has been shown in respect of what may (albeit somewhat loosely) be called products which have a cosmetic purpose, such as, first and foremost, cosmetics or cosmetic preparations themselves. My understanding is that 'cosmetics' and 'cosmetic preparations' can be said, primarily, to adorn or beautify the body in some respect. Seba's products do not *primarily* set out to do that, but rather to cleanse, protect and soothe; in some cases, to improve, or to at least undertake their cleansing, protecting and soothing roles in a non-harmful manner, having regard in particular to certain skin complaints and conditions. Although the term 'cosmetics' or 'cosmetic preparations' could be understood in a broad way, I am not convinced that Seba's products would be understood by the average consumer to be 'cosmetics', or even 'cosmetic preparations', in the course of trade and the normal, more narrow, meaning of the word. Is it likely, I ask

myself, that a consumer or the trade in the UK would refer, eg to shampoo or body cream as being a 'cosmetic' or 'cosmetic preparation' ? In my opinion this would not be the case, at least not in the UK.

30. Moreover, there is no evidence on the part of Seba that genuine use on flannels for babies, cloths for applying oils and moist wipes or footcare products specifically has occurred. I will comment below at para 41 on the question of bath extracts.
31. From that, I need to assess what would be a 'fair specification' in Class 3, bearing in mind the terms used by Seba. This is a sometimes tricky 'value judgment', and I am aware there is some discussion that the various UK and European authorities on this point are wholly consistent (see, eg the appointed person's recent decision in BL O-217-10 *Extreme*, especially para 15). The potential difference is said to be that the English Courts approach is based upon the perception of the average consumer (and may therefore be more generous in outcome) and the General Court's approach provides no clear yardstick for determining when a 'sub-category' of products cannot be further divided.
32. Seba's specification in Class 3 comprises a mix of specific terms, such as "face lotions" for example, and much broader terms such as "body care and cleansing products". The question for me is whether I should divest Seba of these broader terms and allow only those specific items on which it has clearly demonstrated actual use. As is clear however from both the English and European authorities on this question<sup>1</sup>, the issue is arriving at a "fair specification", having regard to actual use. Any such "fair specification" takes account of consumer perception, the overall circumstances of the trade involved and, not least of all, the potential effect of reducing a proprietor's 'umbra' of protection to a narrower range of goods or services than may be "fair". What is meant by this latter point is that, for example, should I find that Seba has only shown use on 'shower gels', would it then be fair to reduce their specification that term only, and in so doing require them in any infringement action to demonstrate confusion in fact as far as 'shower creams' are concerned ? The answer is of course, no, it would not be fair. In essence, the trade and consumer would recognise both products as 'bath and shower products'; that is how they are collectively displayed and referred to in supermarkets.
33. In this case, it is beyond dispute that Seba has used its mark on a range of products, all of which may be fairly described and recognised by the consumer and trade alike as "body care and cleansing products". Such products are available in proximity to each other and in the same areas of larger supermarkets or together in pharmacies. Seba is thus entitled to the broad term "body care and cleansing products" as well as the more specific

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<sup>1</sup> Helpfully summarised and contrasted in *Extreme* BL O-217-10

items in relation to which it has shown use. I believe a fair description for the goods in Class 3 upon, or in relation to, which Seba has used its mark, is:

**Class 3**

Shampoos; substances for the treatment of skin impurities for external use; baby care products, namely foam baths for babies, baths for babies, skin creams for babies, oils for babies; powder for children; body care and cleansing products; face lotions, facial cleansing preparations and substances in liquid and solid form, being lotions, creams and gels, water or alcohol-based solutions; bath extracts based on medicinal plants and herbs for cosmetic purposes; sun-tanning and skincare preparations in the form of lotions, creams and gels, aftersun skin balms, aftersun sprays.

I should add that if I found to be wrong on this particular 'value judgment', this particular finding does not affect my overall conclusion on likelihood of confusion.

**Class 5**

34. Rhythm say that no genuine use has been shown in relation to Class 5 goods, or the "majority" of those goods (para 2 of their submissions of 27<sup>th</sup> August 2010). Once again, it is appropriate to remind myself of Seba's specification in Class 5, which reads:

**Class 5:**

Chemical, pharmaceutical and veterinary preparations for healthcare and hygiene purposes; pharmaceutical preparations for skin complaints, to combat swelling of the skin and being hand and nail balms, pharmaceutical preparations for skin complaints, namely skin cleansers, being pharmaceutical preparations for skin complaints in the form of a special substance for seborrheic conditions and microbial dermatitis (solid, liquid, lotion, cream, shampoo); bath extracts based on medicinal plants and herbs for skin complaints; medicinal creams for children.

35. It seems from their submissions, Rhythm are of the view that no genuine use has been shown, either, (a) on the basis that Seba's goods cannot properly be described as being pharmaceutical, chemical or veterinary products or preparations, or alternatively, (b) even if they could, the amount of sales can hardly be described as significant. As far as (b) is concerned, the case law referred to in para 25 says no de minimis rule applies, and provided the use involved is consistent with the essential function of a trade mark, and to maintain or create a commercial outlet for the goods then it is entirely possible, for example, that use by a single client can qualify as genuine use.

There is no question in this case that the use undertaken by Seba is, in any way, token or sham. Regular sales have been made, spanning the relevant 5 year period. I conclude that argument (b) has no basis (if indeed Rhythm were arguing that point), and that the use by Seba qualifies as genuine use.

36. Argument (a) needs more careful consideration. Whilst not expressly stated, the argument appears to say that, if use of certain goods in Class 3 is conceded, how can the self- same goods also, and at the same time, be classified to Class 5 ? The goods are either in one Class or the other. Class 3 concerns cleaning products, whilst Class 5 concerns medicinal and pharmaceutical goods, used to treat therapeutic conditions. The two Classes of goods are not the same. In practical, everyday terms however, the divide is not so clear or plain, particularly in the field of skin care products.
37. Sebamed's products are clearly formulated in a particular way, to provide alkali free products which, to use Sebamed's own words "are PH 5.5 balanced to support the development of the skin's protective hydrolipid layer and acid mantle" (leaflet on baby Sebamed products at Exhibit BN1). The wording on the pack containing the cleansing bar (also at Exhibit BN1) states, " If you have a skin disease or soap intolerance, consult your doctor to use this product as a *therapy supportive skin care*" [my emphasis].
38. The picture that emerges of Sebamed's products is that, whilst they may not be prescription based or, even specifically formulated with active ingredients to aggressively and directly address skin complaints, such as eczema or psoriasis, they are, at the very least, formulated by dermatologists to provide "therapy" support. In other words, their use by people having such skin complaints may well be tolerated, even beneficial and therapeutic. Beyond that, Sebamed's products present as having the necessary properties to maintain a healthy PH balance in the skin by avoiding alkali based ingredients.
39. In terms also of their respective trade channels and availability, they are marketed alongside and through the same channels as pharmaceuticals. So, for example, as the evidence shows, they are advertised and marketed in magazines available to pharmacy customers, such as 'HEALTHY TIMES'. As a consumer you would undoubtedly find them in pharmacies. For these reasons, I find it very difficult to deny Sebamed protection also in Class 5, but at the same time I am not convinced they are entitled to the full specification in this Class. In particular, I am not convinced that a fair specification would include, in this case, the broad term "chemical, pharmaceutical and veterinary preparations for healthcare and hygiene purposes". Sebamed are plainly not in the field of 'veterinary or chemical preparations'. Insofar as their products may be called 'pharmaceutical preparations'- and I agree they can, subject to the specification of a therapeutic condition- the qualifying term " for healthcare and hygiene purposes" is altogether too vague, unspecific and potentially

broad to provide a fair description of Sebamed's use. That leaves the following terms:

#### Class 5

“Pharmaceutical preparations for skin complaints, to combat swelling of the skin and being hand and nail balms, pharmaceutical preparations for skin complaints, namely skin cleansers, being pharmaceutical preparations for skin complaints in the form of a special substance for seborrheic conditions and microbial dermatitis (solid, liquid, lotion, cream, shampoo);bath extracts based on medicinal plants and herbs for skin complaints; medicinal creams for children.”

40. Sebamed are entitled to retain the above specification in Class 5 on the basis there is a clear indication as to the therapeutic condition(s) in respect of which the pharmaceutical preparations are designed to, in some way, address or alleviate. Such an indication appears to be something of a requirement as far as European case law on ‘fair specifications’ is concerned (see, eg Case T-256/04 *Mundipharma AG v Office for Harmonisation in the Internal Market* ).

41. The term ‘bath *extracts*....’ is perhaps an unusual one; I see extracts as nothing more than a synonym for ‘products’. Furthermore, as is clear from the leaflet to which I have referred in para 37, camomile is an ingredient in some, if not all, Sebamed's bath products and so the qualification ‘based on medicinal plants and herbs for skin complaints’ is also justified in the circumstances. Finally, the broad term ‘medicinal creams for children’; although it is a broad term and without any specific therapeutic indication, Sebamed has clearly demonstrated use on ‘multi use’ creams used to treat, eg nappy rash creams *and/or* general areas of contact and dryness, such as elbows and knees. On that basis, the broad term is justified in this case as a fair specification.

42. Now that I have determined what would be a fair specification in both Classes 3 and 5 I can now proceed to determine the opposition under section 5(2)(b).

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

43. The opposition is founded upon Section 5(2) (b) of the Act. This reads:

“(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.”

44. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,



(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

### ***The average consumer and nature of the purchase***


45. The average end consumer for both parties' products, in a notional sense, will be the general public, but along the way both parties' products are likely to be handled through wholesalers or intermediaries. There is no suggestion that either parties' products are available on prescription only, but as regards many of Seba's products in both Classes 3 and 5, and certain of Rhythm's products in Class 5, they are formulated with specific therapeutic conditions in mind, and to that extent the average consumer will be someone aware of such conditions and predisposed to select products on that basis.

46. As the consumer for both parties' goods will be drawn from the same 'pool', I must assume there is identity and commonality as far as the question as to who the respective average consumers are is concerned.

47. As far as the purchasing process is concerned, both parties' products are, if not everyday purchases, purchased on a regular basis. These are not expensive products and are generally available through self-selection. That said, consumers in this field will be nothing other than reasonably circumspect and observant in their selection, and in particular those who have skin conditions, or are purchasing on behalf of those (such as children) with such conditions, will exercise a degree of caution in their purchase. I will factor these observations into my overall assessment of likelihood of confusion.

***Comparison of marks***

48. The case law makes it clear that I must undertake a full comparison of both marks in their totalities, taking account of all differences and similarities. The comparison needs to focus on the visual, aural and conceptual identities of both marks. The respective marks to be compared are as follows:

Rhythm's mark	Seba's mark
SEBADERM	

49. Visually, Rhythm's mark presents as a single word mark comprising eight letters, SEBADERM. There are no breaks between the syllables or letters, and the word is in plain script. Seba's mark also presents visually as a single word of seven letters, all being in the same script. However, unlike Rhythm's mark, there is a break created in the word by the fact that the 'seba' element is slightly raised above the 'med' element'. Both marks share the same four letters at their beginnings, being S-E-B-A, but their endings are wholly different. Taking the similarities and dissimilarities of the respective marks into account, overall, I consider the marks to be visually similar to a moderately high degree.

50. Phonetically, Rhythm's mark will be pronounced 'SEE -BA- DERM', or 'SEB-A-DERM'. Seba's mark will be pronounced 'SEE-BA-MED', or 'SEB-A-MED'. The first syllables of both marks will accordingly be pronounced in the same way, whilst the final syllable is wholly dissimilar. Taking the similarities and dissimilarities into account, overall I consider the marks to be phonetically similar to a moderately high degree.

51. When the authorities talk of conceptual similarity, it is meant semantic conceptual similarity. I must also remember that we are viewing matters from the perspective of the average consumer who is unlikely to be an expert linguist.
52. The suffixes (and I believe they will be recognised as suffixes) ‘derm’ and ‘med’ in the respective marks are apt, in the context of the goods upon or in relation to which they are used, to confer descriptive allusion or meaning. The suffix ‘derm’ will, in my opinion, convey that the product is something to do with the skin. The noun, ‘derm’, is in fact defined in the dictionary as follows:
- “derm**
- **n.**  
another term for **dermis**.”<sup>2</sup>
53. In other words, ‘derm’ is not simply an abbreviation but recognisable in its own right. I should just mention that the term ‘dermis’ in the definition above, relates to the skin, or more specifically, the thick layer of skin below the epidermis.
54. The suffix ‘med’ will, also remembering its context on the goods, convey that some form of medical treatment may be involved. This too, appears in the dictionary, this time as an abbreviation as follows:
- “med**
- **abbrev.**
- 1. (informal, chiefly N. Amer.) medical”**<sup>3</sup>
55. I may just mention that it is precisely because ‘derm’ is recognisable in Rhythm’s mark, I can confidently say that it will be seen by the average consumer as an ‘element’, or ‘suffix’ more properly, within the overall word, SEBADERM. The same applies in Seba’s mark, with ‘med’ being a recognisable ‘element’ or ‘suffix’, and this is amplified by the visual appearance in the mark, the MED element being at a lower level than SEBA.

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<sup>2</sup> "derm n." *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 26 January 2011 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e14922>>

<sup>3</sup> "med. abbrev." *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 26 January 2011 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e34717>>

56. Linguistic recognition by the average consumer of the shared prefix, 'SEBA', is more problematic. It could be that the average consumer will link that prefix to a shortened version of the word 'sebaceous', which is defined in the dictionary as follows:

**"sebaceous**

→ **adj.**

(*technical*) relating to oil or fat. • relating to a sebaceous gland or its secretion." <sup>4</sup>

57. In the above definition, 'sebaceous glands' are the small glands in the skin which secrete sebum into hair follicles and most of the body surface. Rhythm appear to argue that such a linguistic recognition on the part of the average consumer is highly probable. In their submissions, their attorneys say,

"Informally, users refer to a skin problem as 'seb derm'. A casual check on the Internet will reveal that the word SEB is generally used by a range of consumers in relation to matters to do with the skin. The opponent's contention that the mark SEBA has no known meaning seems to ignore the fact that 'seb' has been used generically in relation to matters to do with skin and contradicts the evidence."

58. I think this is asking me to accept far too much. They have provided no evidence at all that SEB is generally used by consumers in relation to matters to do with the skin or is otherwise used generically. In effect, they invite me to conduct my own research on the point. I do not intend to. Such a factual assertion needed to be proven; it has not. I may just add that if it had been proven, then, at best (and subject to an overall assessment of the respective marks) it may have simply served to render the respective marks conceptually closer, and thus not exactly helping Rhythm's case. I find no evidence to support the assertion that 'seb', or even 'seba', is in generic use in relation matters to do with skin.

59. That however leaves me with question as to whether any conceptual linkage between the respective marks will be made at all by the relevant consumer. Seba contend that the word 'Sebamed' is wholly invented, and would have no point of linguistic reference for the average consumer. I am not convinced either that absolutely *no* linguistic reference or derivation will exist, especially in relation to these goods. I have already said that the suffix 'med' will be recognised. Whilst expressly not in generic usage, I suspect there may be

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<sup>4</sup> "sebaceous *adj.*" *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 26 January 2011 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e50747>>

some 'loose linkage' and nexus made by the average consumer between the prefix, 'SEBA', and 'the skin'. In Rhythm's mark, this loose nexus becomes much stronger when the 'SEBA' prefix is followed by 'DERM'. In Seba's mark, the semantic concept invoked will be some form of medical treatment for the skin. Insofar then, as both marks will be viewed as 'relating to or treatments of the skin', there is some degree of semantic conceptual similarity, which I shall classify as moderately high. I may just say that in the event I am found to be wrong on this and that most consumers have no recognition at all of the prefix 'SEBA', whilst this may render conceptual similarity somewhat less, overall however it would only serve to render the SEBA 'prefix' as having a more dominant and distinctive capacity, bringing the marks closer in effect when an overall global impression is made of the marks. I need now to conduct that overall global impression assessment on behalf of the average consumer.

60. I have already said that the suffixes 'derm' and 'med' will, or are likely to, be recognised by the average consumer as having some descriptive allusion or meaning in connection with the goods. The prefix, SEBA, is less likely to confer the same degree of descriptive allusion or meaning; no more than, at best, a vague connection with skin will be conferred. In my opinion then it is the shared prefix 'SEBA' which will, in trade mark terms, operate as 'primary identifier', notwithstanding that both marks are, in effect, single words. If the consumer has no linguistic recognition of 'SEBA' at all, then its distinctive capacity thereby increases. I would also observe that, in my opinion, it will be visual selection that will predominate in the consumer's selection of these goods. So, taking the visual, aural and conceptual comparisons together, I find that the respective marks share an above average degree of similarity.

### ***Comparison of the goods***

61. In assessing the similarity of the goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the 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 end users and their method of use and whether they are in competition with each other or are complementary.'

62. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

63. It is important to recognise that even though the factual evidence on similarity is sparse to say the least, I nevertheless have the statements of case, submissions and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the appointed person said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary. He also stated that the tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public.

64. I should also mention a further case in terms of the application of legal principle, and that is the European Court of First Instance (“CFI”) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (“Meric”)* Case T-133/05, where, at para 29, it is stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

65. The respective goods to be compared are as follows:

Seba’s goods, on which use has been shown	Rhythm’s goods
<p><i>Class 3</i></p> <p>Shampoos; substances for the treatment of skin impurities for external use; baby care products, namely foam baths for babies, baths for babies, skin creams for babies, oils for babies; powder for children; body care and cleansing products; face lotions, facial</p>	<p><i>Class 3</i></p> <p>Toiletries, foundations, concealers, face powders, blushers, lip liners, lip gloss, mascara, eye shadow, eye liner, nail polish remover, eye cleansers, face cleansers, skin toners, exfoliators, eye masks, face masks, moisturisers, facial cream, facial serum, eye make up remover, eye cream, eye gel, lip</p>

<p>cleansing preparations and substances in liquid and solid form, being lotions, creams and gels, water or alcohol-based solutions; bath extracts based on medicinal plants and herbs for cosmetic purposes; sun-tanning and skincare preparations in the form of lotions, creams and gels, aftersun skin balms, aftersun sprays.</p> <p><i>Class 5</i></p> <p>Pharmaceutical preparations for skin complaints, to combat swelling of the skin and being hand and nail balms, pharmaceutical preparations for skin complaints, namely skin cleansers, being pharmaceutical preparations for skin complaints in the form of a special substance for seborrheic conditions and microbial dermatitis (solid, liquid, lotion, cream, shampoo); bath extracts based on medicinal plants and herbs for skin complaints; medicinal creams for children.</p>	<p>moisturisers, hand cream, body lotions, body washes, shower gels, foot balms, body scrubs, deodorants, talcum powder, soap, bath essences, shampoo, conditioner, hair styling preparations, hair dyes, sun tanning preparations, shaving preparations, dentifrices, facial packs, nail care preparations, emery boards, pumice stones, cotton sticks and wool for non-medical purposes, all for use on the body; but not including any such goods for the treatment of wounds.</p> <p><i>Class 5</i></p> <p>Dietary supplements for medicinal purposes; minerals, vitamins, mineral preparations, vitamin preparations; herbal remedies, medicated creams for application to the skin and face; but not including any such goods for the treatment of wounds.</p>
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### **Class 3**

66. Applying the *Meric* case, it is clear that:- “toiletries, nail polish remover, eye cleansers, face cleansers, skin toners, exfoliators, eye masks, face masks, moisturisers, facial cream, facial serum, eye make up remover, eye cream, eye gel, lip moisturisers, hand cream, body lotions, body washes, shower gels, foot balms, body scrubs, deodorants, talcum powder, soap, bath essences, shampoo, conditioner, hair styling preparations, sun tanning preparations, shaving preparations, dentifrices, facial packs, nail care preparations, emery boards, pumice stones, cotton sticks and wool for non-medical purposes, all for use on the body; but not including any such goods for the treatment of wounds”, are all identical to “body care and cleansing

products”. That is to say, that although “toiletries” may be a broader portmanteau term, it nonetheless falls within the test of identity outlined in *Meric*. As far as the other products are concerned, these are all, by their nature and intended purposes, ‘body care and cleansing products’. Furthermore, as far as the other factors in the assessment are concerned, they will be found within the same proximity, if not the same shelves, in larger supermarkets and it is also likely that the same channels of trade will be used.

67. That leaves the following: “foundations, concealers, face powders, blushers, lip liners, lip gloss, mascara, eye shadow, eye liner, hair dyes”. Consistent with my findings above in para 29 above, on the face of it these can all be said to have a different nature and purpose, namely a purely ‘cosmetic’ one, concerned with outward adornment and beauty as opposed to body care and cleansing as such. That said, it is also the case that such products will nonetheless be in the same general area of a larger supermarket as body care and cleansing products, or all stocked together in a pharmacy. It is also more than possible that larger manufacturers (such as, eg L’Oreal) may be engaged in both areas and even sell kits containing what may be regarded as a body care product alongside a ‘cosmetic’. Whilst I found myself able, in the context of making a finding on ‘fair specification’, to distinguish between cosmetics and cosmetic preparations, and ‘body care and cleaning products’, I find it very much harder when making a finding on similarity of goods. I am also conscious that the trend within European case law (see eg, Case R 560/2009-2 of the OHIM Board of Appeal) is to conclude, for the reasons I have given, that ‘cosmetics’ and ‘cosmetic preparations’ are, at the very least, highly similar, if not identical, to what may be termed ‘body care and cleansing products’. Taking into account all the relevant factors, I find that these products share a very high level of similarity with body care and cleansing products.

68. I need to recap my findings in this class:

Identical to Seba’s goods	Very high level of similarity to Seba’s goods
Toiletries, nail polish remover, eye cleansers, face cleansers, skin toners, exfoliators, eye masks, face masks, moisturisers, facial cream, facial serum, eye make up remover, eye cream, eye gel, lip moisturisers, hand cream, body lotions, body washes, shower gels, foot balms, body scrubs, deodorants, talcum powder, soap, bath essences, shampoo, conditioner, hair styling preparations, sun tanning	Foundations, concealers, face powders, blushers, lip liners, lip gloss, mascara, eye shadow, eye liner, hair dyes, all for use on the body; but not including any such goods for the treatment of wounds.



<p>preparations, shaving preparations, dentifrices, facial packs, nail care preparations, emery boards, pumice stones, cotton sticks and wool for non-medical purposes, all for use on the body; but not including any such goods for the treatment of wounds.</p>	
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### **Class 5**

69. “Medicated creams for application to the skin and face” are identical to the goods of Seba’s Class 5 specification. That leaves the following: “Dietary supplements for medicinal purposes; minerals, vitamins, mineral preparations, vitamin preparations; herbal remedies”. Whilst both Seba’s products and those of Rhythm may be said to, broadly speaking, promote well being, there are certain differences in nature and intended purpose. Dietary supplements are ingested rather than applied. Likewise, vitamin and minerals and preparations and herbal remedies may also be ingested, though they could also feasibly be applied to the body. Seba’s products are addressed to specific medical conditions, whereas Rhythm’s may claim broader benefit. It is likely that Rhythm’s products in a notional sense will be more readily available over the shelf and possibly through outlets, such as health stores, which would not normally be associated with Seba’s products.
70. Having said that, I recognise certain dietary supplements have a purpose of use comparable to that of both body care products contained in Seba’s Class 3, and even medicated and pharmaceutical products in Class 5. That is to say, they may be ‘complementary’ or replacement goods. Both may be said to ensure clear skin and can be used in addition to body care products. Certain vitamins can be absorbed via the skin or orally and so both products may contain the same ingredients. In larger supermarkets and pharmacies both parties respective goods may be found in reasonable proximity.
71. Taking all factors into account, I find that the respective goods share only at least a low level of similarity with Seba’s Class 3 and 5 goods. I would just add that this analysis is consistent with European case law, as can be found in, eg para 20 of Case R 875/2009-2 before the OHIM Board of Appeal.
72. I need to recap my findings in this Class:

Identical to Seba's goods	Low level of similarity to Seba's goods
Medicated creams for application to the skin and face, all for use on the body; but not including any such goods for the treatment of wounds	Dietary supplements for medicinal purposes; minerals, vitamins, mineral preparations, vitamin preparations; herbal remedies, all for use on the body; but not including any such goods for the treatment of wounds.

### Likelihood of confusion

73. Before proceeding to bring all my findings together in an overall global assessment I need to make an assessment of the distinctive character of the earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness. In terms of its inherent distinctiveness, I regard Seba's mark of at least a moderate degree of inherent distinctiveness. That is to say it could well be as I have said that the average consumer will see the 'elements' of the mark as having some derivation from known terms. 'Med', given the context of the goods upon or in relation to which it will be used, will certainly be seen as having some derivation and root in the word 'medical'; 'Seba' may or may not have the recognition discussed above in paras 56-58. For those that have no recognition at all of 'Seba', in its totality, the mark will be inherently very distinctive, but for others less so. I have already said that my view is that there will be some vague connection with the skin, given the usage on the respective products. At the very least then, the earlier mark is moderately distinctive.

74. I need to consider also whether this level of inherent distinctiveness can be said to be enhanced through use in the UK market. Plainly, use has been shown but it is hard from the evidence to assess what relative exposure to the UK market the mark has had. In other words, it is not clear what market share has been achieved, relative to other like products and exactly where it is sold. The predominant market for Seba's products still appears to be Germany and moreover, it has not relied upon possession of a 'reputation' in the UK. On that basis, I am not inclined to find that the degree of inherent distinctiveness I have found is enhanced through use.

75. I have found above that the respective marks share an above average degree of similarity, that the goods vary between being identical through to having a low level of similarity. I have also found the earlier mark to be at least moderately distinctive and the identity of the respective average consumers to have identity and commonality. I have also made observations on the nature of the purchase.

76. I must also bear in mind I need to consider marks as a whole of course, and factor in the notion of 'imperfect recollection'. That is to say, consumers may rarely see marks in use side by side but, in real life, retain an imperfect picture of them.

77. In this case, taking all factors into account, as well as imperfect recollection, I think likelihood of confusion is made out in respect of all goods, including those with a low level of similarity to Seba's. Even if the average consumer may not confuse the marks directly (direct confusion), they are likely to assume that products sold under these marks derive from the same economic undertaking (indirect confusion).

**78. The opposition therefore succeeds in relation to all the goods opposed.**

### **Costs**

79. Sebapharma GmbH & Co has been totally successful in its opposition. Accordingly, it is entitled to a contribution towards its costs. I take account of the fact that that the decision has been reached without a hearing. In the circumstances I award Seba the sum of £1200 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Filing fee for opposition - £200
2. Preparing a statement and considering counterstatement - £200
3. Preparing evidence and considering and commenting on other sides evidence - £500
4. Preparing submissions - £300

Total £1200

80. I order Rhythm & Blue Inc Ltd to pay Sebapharma GmbH & Co the sum of £1200. The sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 01 day of February 2011**

**Edward Smith  
For the Registrar,  
the Comptroller-General**