

O/467/11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2528078**

**BY  
ROHECARE LTD  
TO REGISTER THE TRADE MARK**

**RoheCare**

**IN CLASS 44**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 100449  
BY  
F. HOFFMANN-LA ROCHE AG**

## Trade Marks Act 1994

**In the matter of application No 2528078  
by RocheCare Ltd  
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## **RocheCare**

**in class 44**

**and the opposition thereto under no 100449  
by F. Hoffmann-La Roche AG**

1. On 6 October 2009, RocheCare Ltd (“the applicant”) applied to register the trade mark RocheCare for the following services in class 44:

*Provision of health care services for the elderly, mentally ill and the infirm in domestic homes; provision of nursing care services for the elderly, mentally ill and the infirm in domestic homes or residential nursing homes; residential nursing home services; care services for the elderly, mentally ill and the infirm provided in domestic homes or residential nursing homes; rehabilitation services relating to healthcare, mental and behavioural problems.*

2. Following publication of the application in the *Trade Marks Journal* on 29 January 2010, F. Hoffmann-La Roche AG (“the opponent”) opposed the registration of the mark under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”)<sup>1</sup>. In relation to the section 5(2)(b) ground of opposition, the opponent relies only upon some of the services of its earlier International registration 832631 and all of the goods and services of its earlier Community Trade Mark (“CTM”) registration 3927308. The relevant details of its two earlier marks are shown below:

(i) International Registration 832631



Class 44: *Medical and veterinary consulting; medical laboratory and health centre services; medical advice and support for customers purchasing diagnostic*

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<sup>1</sup> In its evidence, the opponent also raised an issue under section 3(1)(c) and referred to use of the application taking unfair advantage of and damaging the opponent’s reputation, which is the language of section 5(3). Neither of these grounds were pleaded and there has been no request to add them; consequently, they are not grounds of opposition.

*apparatus; provision of medical and veterinary information via Internet portals; all the aforesaid consultations and services also provided by means of a database.*

Protection in the United Kingdom was requested on 8 April 2004, claiming a priority date of 27 November 2003 from the Swiss Office of Origin. It was published for opposition purposes in the UK *Trade Marks Journal* on 1 April 2005. No opposition was received to the granting of protection of the IR; consequently, the IR was protected in the UK with effect from 2 July 2005, the day after the expiry of the opposition period. It had not therefore been protected in the UK for more than five years before the date of publication of the application which is opposed (29 January 2010). This means that the earlier mark is not subject to the proof of use provisions<sup>2</sup>.

(ii) CTM 3927308



*Class 1: Chemical, biochemical and biological products used in industry, science, photography, agriculture, horticulture, forestry and for research; chemical substances for preserving feed- and foodstuffs; in vitro diagnostic agents and reagents for use in industry, science, agriculture, horticulture and forestry; control solutions for accuracy control of test results; control solutions for the calibration and function control of apparatus; kits, mainly consisting of laboratory instruments, reagents, control- and calibration solutions (for non medical purposes).*

*Class 3: Soaps; perfumery; essential oils; cosmetics; non-medicated toilet preparations; skin care preparations; deodorants; cosmetic products for the treatment of the hair and nails.*

*Class 5: Pharmaceutical and veterinary preparations, sanitary preparations for medical purposes; dietetic substances adapted for medical use; vitamin and mineral preparations; food for babies; plasters, materials for dressings; disinfectants; preparations for destroying vermin; fungicides, herbicides; chemical, biochemical and biological products for medical and veterinary purposes; in vitro diagnostic agents and reagents for medical, veterinary and scientific purposes.*

*Class 9: Scientific apparatus and instruments; laboratory apparatus used in industry, science, agriculture, horticulture and forestry as well as accessories thereof in the form of dispensers and disposable articles; optical, measuring,*

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

*checking (supervision) and life-saving apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; data processing equipment and computers as well as accessories thereof; computer software; computer programs for error diagnosis, error recovery, remote control, registration and administration of medical, veterinary and scientific apparatus and instruments; electronic publications; recordings on videotape and electromagnetic bands, including recordings of reproduction or cinematographic in the field of medical education.*

*Class 10: Apparatus and instruments for medical, surgical, dental and veterinary purposes and accessories thereof in the form of dispensers and disposable articles; implants; apparatus and instruments for medical and veterinary research and accessories thereof; kits, mainly consisting of medical and veterinary apparatus and instruments, in vitro diagnostic agents, reagents and control and calibration solutions, as well as accessories thereof in the form of dispensers and disposable articles.*

*Class 16: Printed matters; teaching and instructional material for research and in the field of scientific, medical, veterinary and technical laboratory matters; data files.*

*Class 35: Consulting in the fields of organisation, staff and business management.*

*Class 37: Repair and maintenance of laboratory apparatus.*

*Class 38: Transmission of medical and scientific information through a data base; provision of Internet portals; provision of information by means of Internet portals.*

*Class 41: Training; education and further education in the field of scientific, medical, veterinary, technical laboratory matters and for research; publishing of electronic publications, also in the Internet.*

*Class 42: Consultancy services and research and design relating thereto in the field of scientific, medical, veterinary, technological and technical laboratory matters for research and data processing purposes; design and development of computer hardware and software; services of laboratories.*

*Class 44: Medical, veterinary and scientific consultation; supply of information in the area of the medicine, veterinary and laboratory technology; health centers of medical care; medical care; advice and assistance for customers of diagnostic apparatus; all aforesaid consultancy and services also through a database.*

The date of application was 9 July 2004 and the CTM's date of completion of the registration procedure was 23 November 2005. Consequently, the CTM is not

subject to the proof of use regulations because it had not completed its registration procedure five years or more as of the date of publication of the opposed application.

3. Under section 5(4)(a), the opponent relies upon its use of a sign which corresponds to the earlier marks relied upon under section 5(2)(b) and for goods and services in classes 1, 3, 5, 9, 10, 16, 35, 37, 38, 41, 42 and 44. Rather than set out a lengthy list here, it is sufficient to note that they correspond largely to the goods and services in those classes of the CTM. I will refer to individual goods and services later, as necessary, if any difference becomes material to this decision.

4. The applicant filed a counterstatement in which it denied the opponent's grounds. It also put the opponent to proof of use. As can be seen above, the international registration was not, in fact, subject to the proof of use regulations but the opponent nevertheless said in its notice of opposition that the protection process for its international registration was completed five years or more before the date of publication of the opposed application; the opponent also made a statement of use in respect of the only services it relied upon in relation to the international registration. However, because the CTM is not subject to proof of use and is registered in class 44, essentially, for identical services to those relied upon under the international registration and, further, there are a number of other classes relied upon, this represents the opponent's strongest case. For the purposes of section 5(2)(b), I will confine my analysis to a comparison between the CTM and the application; it is therefore unnecessary to consider the implications of the statement of use in relation to the international registration. The CTM can be considered on a notional basis across the full range of its registered goods and services.

5. The applicant's counterstatement also said that it had been incorporated under the name Rochecare Ltd since 2 March 1999 and had, since that date, been providing domiciliary care and operating two care homes in the Oldham and Burnley areas. It states that it is unaware of any instances of confusion or misrepresentation, indicating, it claims, that the opponent's section 5(4)(a) ground is unfounded.

6. Both parties filed evidence and submissions, but neither wished to be heard, both being content for a decision to be made from the papers on file.

## **Evidence**

7. Rather than give a detailed evidence summary, since it is unnecessary to consider proof of use, I will provide here a summary of the facts which are relevant to the issues I have to determine. If particular facts are relevant, I will refer to them in greater detail as and when they become pertinent.

### The opponent's evidence

8. This comes from Dr Hans-Friedrich Czekay, who is the opponent's Vice-Director. The opponent has used the word mark ROCHE for over 110 years and has used the mark in the form of the word ROCHE within a hexagon border (as relied upon in this case) since 1964 in the UK and the EU. Dr Czekay states that the marks are used in relation to goods and services in the pharmaceutical, diagnostics, research and medical sectors. The hexagon mark is used alongside other trade marks on pharmaceuticals, such as Valium, Tamiflu and Herceptin. Exhibits attest to the use of ROCHE, with and without the hexagon border, throughout the 20<sup>th</sup> century and to the present day, mainly in relation to pharmaceuticals, but also in relation to medical apparatus such as diabetic and anti-coagulation checking devices. Dr Czekay gives turnover figures for pharmaceuticals bearing ROCHE (with or without the hexagon border) between 1997 and 2010; in 2009, turnover was £711,437,390. Figures for diagnostic and "other products" were on a similar scale.

### The applicant's evidence

9. Mr Athar Mahmood is the applicant's Director. He states that the applicant is a care home operator for the elderly which has been trading under the RocheCare name since 1999 in the Oldham area and since 2001 in the Burnley area. Mr Mahmood states that the selection of a care home is often the result of extensive research, personal recommendation and visits to the home itself. Further, Mr Mahmood says "care home services are not cheap. For these reasons, the purchase decision is the result of a lengthy and considered purchase." Mr Mahmood states that the ROCHE element of the applicant's mark was chosen as a reference to the ROCH in ROCHDALE, the area local to the applicant's care homes, and that ROCHE is the traditional spelling for the River Roche.

10. The remainder of the evidence (from both sides) is more in the way of submission, which I will bear in mind in making my decision.

## **Decision**

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

11. Section 5(2)(b) of the Act states:

"(2) A trade mark shall not be registered if because –  
....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

12. The leading authorities which guide me in this ground are from the Court of Justice of the European Union ('CJEU'): *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, *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 for 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) 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*

f) 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*.

(g) 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*,

(h) 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*,

(i) 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*,

(j) 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*,

(k) 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*,

(l) 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*.

### Comparison of goods

13. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*. where the CJEU stated at paragraph 23 of its judgment:

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

The criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 for assessing similarity between goods and services were:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;



- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

14. A further factor to bear in mind is that if goods or services fall within the ambit of terms within the competing specification, they are considered to be identical, as stated in *Gérard Meric v OHIM*, case T-133/05, where the General Court (“GC”) stated, at paragraph 29:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by 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).”

I also bear in mind that in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J<sup>3</sup> held that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

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<sup>3</sup> Jacob J also said, in *Treat*: “When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade”. Neither should specifications be given an unnaturally narrow meaning, as per *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000]. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, although in the context of a non-use issue, the court considered interpretation of specifications: “In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”.

activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

15. The opponent relies upon a lengthy list of goods and services in twelve classes, including class 44, which is the only class covered by the application. As this represent’s the opponent’s best case, I will only compare the class 44 services of the CTM and the class 44 services of the application. The applicant, in its written submissions dated 7 October 2011, provided a fall-back specification, which I will look at after assessing the services as applied for. These are:

<b>Earlier mark</b>	<b>Application</b>
<i>Medical, veterinary and scientific consultation; supply of information in the area of the medicine, veterinary and laboratory technology; health centers of medical care; medical care; advice and assistance for customers of diagnostic apparatus; all aforesaid consultancy and services also through a database.</i>	<i>Provision of health care services for the elderly, mentally ill and the infirm in domestic homes; provision of nursing care services for the elderly, mentally ill and the infirm in domestic homes or residential nursing homes; residential nursing home services; care services for the elderly, mentally ill and the infirm provided in domestic homes or residential nursing homes; rehabilitation services relating to healthcare, mental and behavioural problems.</i>

16. I will group the applicant’s terms into homogenous categories for the purposes of this assessment<sup>4</sup>. There appear to be two separate categories which are susceptible to collective comparison:

(i) *Provision of health care services for the elderly, mentally ill and the infirm in domestic homes; provision of nursing care services for the elderly, mentally ill and the infirm in domestic homes or residential nursing homes; residential nursing home services; care services for the elderly, mentally ill and the infirm provided in domestic homes or residential nursing homes;*

(ii) *rehabilitation services relating to healthcare, mental and behavioural problems.*

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<sup>4</sup> As per the decision of Mr Geoffrey Hobbs Q.C. , sitting as the appointed person, in *Separode Trade Mark* BL O-399-10, with reference to BVBA Management, Training en Consultancy v. Benelux-Merkenbureau [2007] ECR I-1455 at paragraphs [30] to [38]: “The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

17. Taking the applicant's category (i) terms first, these services are all care services. Some of these are defined as being for the elderly, mentally ill or infirm, but there is also "residential nursing home services", which is not limited in this way. The closest of the opponent's class 44 terms to these services are *medical care*. This term covers all kinds of medical care, including medical care carried out in care homes and in domestic homes (i.e. people's own homes). It covers nurses who care for residents in care homes and in nursing homes and nurses who visit people in their own homes. Medical care covers the term 'health care' and 'nursing care'. Consequently, I find that the opponent's term 'medical care' is identical to *Provision of health care services for the elderly, mentally ill and the infirm in domestic homes; provision of nursing care services for the elderly, mentally ill and the infirm in domestic homes or residential nursing homes; residential nursing home services*. In relation to the applicant's term *care services for the elderly, mentally ill and the infirm provided in domestic homes or residential nursing homes*, the nature of these and of the opponent's *medical care* services is to provide care. There is an overlap in purpose in relation to care services for the elderly, mentally ill and infirm, and medical care: people who are in need of care and the administration of regular medication. Where care services are medical in nature, they will overlap with. Applying *Meric*, all of the applicant's category (i) terms are identical to the opponent's term *medical care*.

18. The applicant's category (ii) services are rehabilitation services. Although these are limited to rehabilitation services relating to healthcare, mental and behavioural problems, these are, themselves, wide in scope and are medical in nature. Rehabilitation involves services such as physiotherapy, occupational therapy and counselling, which are medical services. Rehabilitation would seem to fall within the ambit of medical care services and so these are also identical.

19. The applicant's fall-back specification is a reduced list of services: *provision of nursing care services for the elderly, mentally ill and the infirm in domestic homes or residential nursing homes; residential nursing home services; care services for the elderly, mentally ill and the infirm provided in domestic homes or residential nursing homes*. As is apparent from my assessment of these terms above, all of the applied-for and all of the fall-back specification services are identical to the opponent's term *medical care*.

#### Average consumer and the purchasing process

20. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. In assessing the level of attention of the average consumer in this case, I will confine this to the average consumer for the services I have compared above because these are the most relevant, rather than for the wide range of goods and services in the other classes, all of which the opponent relies upon.

21. The average consumer for the applicant's services is the general public. I agree with the applicant that those looking for these services will usually be doing so on behalf of a relative, perhaps one who is unable or unwilling to make the decision themselves. Choosing care is a considered purchase and although this will primarily involve the general public, it is also possible that a medical professional will be involved in the decision, for example, after hospitalisation of the person needing care. The level of attention, whether it is the public's or the medical professional's, is likely to be high. The purchasing process will involve both visual and aural aspects; such decisions will be discussed and will involve the perusal of brochures and website information, as well as visits to establishments providing the services.

22. The position in relation to the opponent's *medical services* is analogous to what the General Court ("GC") said about pharmaceutical goods in *Mundipharma AG v OHIM*, Case T-256/04:


"44 Second, it has not been disputed in the present case that the relevant public for the goods covered by the mark applied for, namely therapeutic preparations for respiratory illnesses, is made up of patients in their capacity as end consumers, on the one hand, and health care professionals, on the other.

45 As to the goods for which the earlier mark is deemed to have been registered, it is apparent from the parties' written submissions and from their answers to the questions put at the hearing that some therapeutic preparations for respiratory illnesses are available only on prescription whilst others are available over the counter. Since some of those goods may be purchased by patients without a medical prescription, the Court finds that the relevant public for those goods includes, in addition to health care professionals, the end consumers."

The average consumer for medical services is both the patient receiving the medical service and the professional delivering or prescribing the service. Both will play close attention to such services because of their importance for the patient concerned. The purchasing process will be aural in terms of discussion and referral, and visual in relation to printed information and written referrals.

Comparison of trade marks

23. The marks to be compared are:

Opponent's mark	Applicant's mark
	<p style="text-align: center;">RocheCare</p>

24. The details of the CTM on the database of the Office for Harmonisation of the Internal Market includes a statement that the “indication of colour” is blue (pantone 300 U). The CTM regulations do not refer to colour claims, but the OHIM Trade Mark Examination Guidelines (2.7.1) explain that “Where a coloured representation is supplied the application is implicitly a colour claim and is therefore considered to be for registration of a coloured mark.” The CTM details on the UK trade marks register refer to Blue (pantone U300) as the description of the colour claimed. In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J stated:

“119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.”

The applicant’s mark makes no claim that it has colour as a feature; consequently, I should compare it as though it were also in the colour of the registered mark. Alternatively, if the indication of colour in the CTM on the OHIM database is not a claim to colour, then colour is irrelevant. Either way, colour is not an issue which affects the similarity of the trade marks. Even if I am wrong on this point, the issue of colour, in this case, will have a negligible impact upon my consideration of similarity of the marks.

25. The authorities direct that, in making a comparison between the marks, I must have regard to each mark’s visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. The opponent’s mark consists of a single word within a simple

hexagonal border. The word element is its distinctive and dominant component. The applicant's mark consists of a single word which appears as two conjoined words, Roche and Care, because of the capitalisation of the C in Care. Roche, as the first element of the conjoined word, is more distinctive than the second element, Care, on account of both its position at the front of the mark and because Care is descriptive in relation to the services at issue (I will come back to this below).

26. The first 'word' in the applicant's mark, ROCHE, is visually identical to the single word in the opponent's mark, and this is also, as I have said above, the beginning of the applicant's mark. The hexagon component of the opponent's mark is a border rather than a device; it has less visual impact, and will be given less visual significance, compared to the word ROCHE. Overall, there is a moderate level of similarity on a visual level.

27. What visual impact the hexagon has will be completely absent when the marks are used orally; the comparison is then between ROCHE and ROCHECARE. The ROCHE element is likely to be pronounced in the same way in both marks, with a silent 'e' ("rosh" or "roch") and CARE is an ordinary dictionary word, the pronunciation of which does not need explanation. There is a good deal of phonetic similarity between the marks: the identical sounding element ROCHE is the single verbal element of the opponent's mark and is the element with which the applicant's mark begins.

28. The applicant states that the ROCHE part of its mark is a reference both to the River Roche and to Rochdale, the area where it operates its services. Whether local residents perceive this conceptual connection is a moot point because a trade mark registration is a national right; it is highly unlikely that the rest of the population of the UK would see any meaning in the applicant's mark other than the meaning of the word CARE. Roche will be seen as an invented word, having a neutral conceptual effect on the CARE component of the applicant's mark. The overall concept of the applicant's mark is that of the word CARE preceded by an unknown word, ROCHE. It follows that the opponent's mark, ROCHE, also has no meaning (the border not adding or detracting from that). There is neither conceptual similarity nor dissimilarity between the parties' marks.

29. The marks are visually similar to a moderate degree, phonetically similar to a good degree and conceptually neither similar nor dissimilar. I will bring forward these points when I come to make a global assessment as to whether there is a likelihood of confusion.

#### Distinctiveness of the earlier mark

30. It is necessary to consider the distinctive character of the opponent's mark because the more distinctive it is, either by inherent nature or by use (nurture)

the greater the likelihood of confusion<sup>5</sup>. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public<sup>6</sup>. ROCHE has no immediately recognisable concept for the average UK consumer so is, effectively, an invented word, high in inherent distinctive character. The evidence filed by the opponent is almost wholly focussed upon pharmaceutical and diagnostic goods, with the pharmaceutical evidence being predominant. Although the opponent has not provided any evidence of use in relation to medical services, the mark is, of course, still inherently high in distinctive character for these services.

### Likelihood of confusion

31. The applicant has made reference in its evidence and submissions to its long use of the mark which has not resulted in confusion with the opponent's mark. It submits that "...even if the grounds of opposition are not dismissed then the application should be entitled to proceed to registration under the provisions of s7 ("Honest Concurrent Use")."

32. Section 7 of the Act was repealed upon implementation of the Trade Marks (Relative Grounds) Order 2007<sup>7</sup> and so has no bearing on this case. On the facts of this case, the applicant cannot avail itself of its absence of confusion/honest concurrent use argument. Absence of confusion has been the subject of judicial comment and a registry tribunal practice notice, TPN 4/2009. There must be evidence to suggest that the relevant public has shown that it distinguishes between the parties' services. The opponent's evidence is centred on the pharmaceutical and diagnostic apparatus sectors and the applicant's evidence shows use on residential care homes: this does not show concurrent use in a market where the public has become used to distinguishing between the undertakings. Although there may, hitherto, have been no overlap in the parties' target markets, peaceful coexistence appears to have depended upon a marketplace status quo which has now been disrupted by the applicant seeking a trade mark registration (which was notified to the opponent during *ex officio* examination), putting co-existence on an entirely different footing. There is no automatic entitlement to a registration simply because a mark has been used. Further, the applicant cannot speculate, on the basis of historical use, as to what services the opponent may choose to use its CTM upon in the five years it has to use it following completion of its registration procedure (or, if it assigned these services to another proprietor, what use that proprietor may make of the CTM). This is the principle of notional and fair use; my assessment under section

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<sup>5</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>6</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

<sup>7</sup> Statutory instrument 2007 No.1976 and section 7(5) of the Act refer.

5(2)(b) as to the likelihood of confusion must be in relation to the notional coverage of the parties' specifications, not their use to date<sup>8</sup>.

33. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison and the principle of interdependency, whereby a lesser degree of similarity between the services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found the coverage of the parties' services to be identical and I have found a moderate level of visual similarity and a good deal of phonetic similarity between the marks. They are neither similar nor dissimilar conceptually. Conceptual difference between marks (even where only one mark has a meaning) can offset visual and phonetic similarity<sup>9</sup>, but there is no concept here to operate upon the consumer's perception of the marks which would put a distance between them. The perception in relation to the applicant's mark will be of ROCHE plus a word descriptive of the services, CARE: care services supplied by an undertaking named ROCHE. In the market concerned, notwithstanding the high level of attention of the average consumer, the word CARE for care/medical services will be more likely to lead to this conclusion rather than putting a distance between the marks. Although I must guard against dissecting the marks, the dominance and high inherent distinctive character of ROCHE, balanced against the descriptive word CARE and the non-descript hexagonal border leads me to a conclusion that, in relation to identical services, there will be a likelihood of confusion.

34. The opposition is successful under section 5(2)(b) against all of the applicant's services.

#### **Section 5(4)(a)**

35. As the opponent has succeeded against all the services of the application under section 5(2)(b) there is no need to consider the section 5(4)(a) ground.

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<sup>8</sup> *Oakley, Inc v OHIM* Case T-116/06. "76 Consideration of the objective circumstances in which the goods and services covered by the marks in dispute are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is prospective. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors (*QUANTUM*, paragraph 75 above, paragraph 104, and *T.I.M.E. ART/Devinlec v OHIM*, paragraph 75 above, paragraph 59).

<sup>9</sup> *Ruiz-Picasso v OHIM*, case 361/04 P [2006] E.T.M.R. 29



## Costs

36. The opponent has been successful and is entitled to an award of costs on the following basis<sup>10</sup>:

Preparing a statement and considering the counterstatement	£200
Opposition fee	£200
Filing evidence and considering the applicant's evidence	£500
Written submissions	£300
<b>Total:</b>	<b>£1200</b>

37. I order RocheCare Ltd to pay F. Hoffmann-La Roche AG sum of £1200. This sum is to 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 22<sup>nd</sup> day of December 2011**

**Judi Pike  
For the Registrar,  
the Comptroller-General**

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<sup>10</sup> As per the scale in Tribunal Practice Notice 4/2007.