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UK INTELLECTUAL PROPERTY OFFICE

Rolls Building,  
7 Rolls Buildings,  
Fetter Lane,  
London EC4A 1NL.

Monday, 17th September 2012.

Before:

MR. GEOFFREY HOBBS QC  
(Sitting as the Appointed Person)

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In the Matter of the TRADE MARKS ACT 1994

and

In the Matter of Application Number 2497564  
by Paras Pharmaceuticals Limited to register the Trade Mark  
MOOV in Class 5

and

In the Matter of Opposition thereto under No. 98728  
by LYNPHA VITALE SRL

and

An appeal to the Appointed Person from the decision of  
MS. AL SKILTON, acting on behalf of the Registrar of  
Trade Marks, dated 11th October 2011.

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(Transcript of the Shorthand Notes of:  
Marten Walsh Cherer Limited,  
1st Floor, Quality House, 6-9 Quality Court,  
Chancery Lane, London WC2A 1HP.  
Telephone: 020 7067 2900.  
Email: info@martenwalshcherer.com)

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The Parties were not represented and did not appear.

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DECISION  
(AS APPROVED BY THE APPOINTED PERSON)

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# O-419-12

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THE APPOINTED PERSON: On 12th September 2008 Paras

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Pharmaceuticals Limited applied to register the following sign

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as a trade mark for use in relation to: "Preparations of all

5

kinds for joint pains and inflammation, backache, sprains,

6

myositis, fibrositis, sciatica or pain relieving preparations

7

included in Class 5:

8



9

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The application for registration was opposed by Lynpha

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Vitale SRL on the basis of the earlier trade mark rights to

12

which it was entitled under sections 5(1) and 5(2) of the

13

Trade Marks Act 1994 as proprietor of Community Trade Mark No.

14

6080899, consisting of the word MOOV, registered on 12th March

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2009 with a filing date of 8th July 2008, for use in relation

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to various goods and services in Classes 3, 5 and 44.

17

The goods for which the earlier trade was protected in

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Class 5 were: "Pharmaceutical and medical preparations

19

containing essential oils for the treatment of inflammatory

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diseases, namely inflammatory bowel diseases, inflammatory

21

connective tissue diseases and arthritis disinfectants."

22

The Opposition succeeded in relation to all goods listed

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in the opposed application for registration for the reasons

24

given by Ms. Al Skilton in a written Decision issued on behalf

25

of the Registrar of Trade Marks, under reference BL O-346-11

1 on 11th October 2011.

2 The Hearing Officer concluded that the opposed  
3 application covered goods in Class 5 which were identical to  
4 those covered by the Opponent's earlier trade mark  
5 registration in Class 5. Her reasoning in that connection was  
6 set out in paragraphs 16 to 19 of her Decision in the  
7 following terms:

8 "16. In Gérard Meric v. OHIM, Case T-133/05, the GC held  
9 that:

10 '29. ...goods can be considered identical when the goods  
11 designated by the earlier mark are included in a more  
12 general category, designated by the trade mark  
13 application or when the goods designated by the trade  
14 mark application are included in a more general category  
15 designated by the earlier mark.'

16 17. PPL's goods are 'preparations of all kinds for joint  
17 pains and inflammation, backache, sprains, myositis,  
18 fibrositis, sciatica ...' I will begin by considering the  
19 nature of the conditions that PPL's preparations are intended  
20 to treat.

21 18. All of the aforementioned conditions are defined in the  
22 Oxford English Dictionary as follows:

23 \* A 'sprain' is defined in as 'to wrench the  
24 ligaments of (an ankle, wrists, or other joint)  
25 violently so as to cause pain and swelling but not  
dislocation.' As swelling and inflammation are  
synonymous, I am bound to conclude that a sprain  
is an inflammatory condition.

\* 'Myositis' is defined as 'inflammation and  
degeneration of muscle tissue.' This is also,  
self evidently, an inflammatory condition.

\* The definition of 'fibrositis' is 'inflammation of  
fibrous connective tissue, typically affecting the  
back and causing stiffness and pain.' This is  
also, clearly, an inflammatory condition.

\* 'Sciatica' is defined, as 'Severe pain in the back  
and radiating down one or other leg, along the

1 course of the sciatic nerve. It is usually caused  
2 by inflammation of the sciatic nerve or by  
3 pressure on the spinal nerve roots.' Therefore,  
4 this is also an inflammatory condition.

5 Backache is a broad term which can encompass many different  
6 medical conditions and can be a general description of some of  
7 the symptoms of some of the conditions listed in PPL's  
8 specification. There is no evidence before me which provides  
9 any further explanation in respect of any of the conditions  
10 named in either specification. As someone who does not  
11 possess expert knowledge in the medical field, I assume,  
12 reasonably to my mind, that a pharmaceutical product for use  
13 in treating inflammatory diseases could similarly be used to  
14 treat inflammatory conditions not caused by diseases such as  
15 those listed in PPL's specification. Therefore, whilst the  
16 respective medical conditions listed in both parties'  
17 specifications may not be identical, the respective goods  
18 share a common purpose in that they all treat inflammation.  
19 Insofar as LV's pharmaceutical preparations treat the symptoms  
20 of an inflammatory disease, as opposed to any underlying  
21 cause, the respective goods will have an identical effect and  
22 may in fact be identical products. Taking this into account  
23 there is a clear overlap between the respective pharmaceutical  
24 products.

25 19. Consequently, taking all of these factors into account, I  
conclude that terms in PPL's specification cover identical  
goods to those included in LV's class 5 specification."

For the reasons she gave in paragraphs 9 to 14 of her  
Decision, she was prepared to accept that the marks in issue  
could be regarded as identical in accordance with the case law  
of the CJEU on the basis that the differences between them  
were so insignificant that they were likely to go unnoticed by  
the relevant average consumer of the goods concerned.

Her determination rested upon the application being  
plainly objectionable under section 5(2)(b), even if it was  
not objectionable under section 5(1) of the 1994 Act as stated  
in paragraphs 20 and 21 of her Decision:

1 "Conclusion:

2 20. In view of my conclusions that the respective marks and  
3 the respective goods are identical, LV's opposition based upon  
4 section 5(1) of the Act succeeds, in its entirety. That  
5 effectively decides the matter, however, if I am found to be  
6 wrong in respect of the identical nature of the marks at  
7 issue, I will comment briefly upon the case based on section  
8 5(2)(b) of the Act.

9 "21. I have already identified that the only differences  
10 between the respective marks is the background rectangle  
11 present in PPL's marks and that the word element of its mark  
12 is presented in lower case whilst LV's mark is presented in  
13 upper case. These differences, even if noticed, are such as to  
14 only have a minor impact upon the perception of the consumer,  
15 and the marks must still be considered as being very highly  
16 similar. I factor this into the global assessment required by  
17 the relevant case law and also that marks are rarely recalled  
18 perfectly with the consumer relying instead on the imperfect  
19 picture of them he has kept in his mind (Lloyd Schuhfabrik  
20 Meyer & Co. GmbH v. Klijsen Handel B.V paragraph 27). Taking  
21 all of this into account, together with my earlier finding  
22 that identical goods are in play, it follows that there is a  
23 very high likelihood of confusion. Therefore, the opposition  
24 would clearly succeed under the grounds based on 5(2)(b) of  
25 the Act."

26 In a supplementary decision on costs, issued under  
27 reference BL 0-428-11 on 30th November 2011, the Hearing  
28 Officer ordered the Applicant to pay £1,600 as a contribution  
29 towards the Opponent's costs of the proceedings in the  
30 Registry.

31 The Applicant appealed to an Appointed Person under  
32 section 76 of the 1994 Act, contending, as stated in summary  
33 in paragraph 8 of its Statement of Grounds of Appeal, that:  
34 "... the Hearing Officer has failed to properly consider the  
35 clear differences between the respective trade marks and goods  
36 of the Opponent and PPL. Furthermore, she has interpreted the

1 case law erroneously. In the circumstances, PPL submit that  
2 the decision by the Hearing Officer in relation to sections  
3 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 is wrong  
4 in law and that the appeal should be allowed with costs."

5 The Opponent filed no respondent's notice or  
6 cross-appeal in relation to the Hearing Officer's Decision or  
7 supplementary Decision and thereby elected to support both  
8 decisions on the basis that her reasoning and conclusions were  
9 correct in all relevant respects.

10 Four days ago, that is to say on Thursday of last week,  
11 the Applicant indicated through its solicitors that it would  
12 not be attending the hearing of its appeal and proposed simply  
13 to rely on its previously filed Grounds of Appeal and written  
14 submissions. In reaction to that, the Opponent indicated  
15 through its solicitors that it, too, would not be attending  
16 the hearing of the appeal. No skeleton argument has been  
17 filed on behalf of the Opponent and I have no information as  
18 to whether or in what respect or amounts the Opponent may  
19 actually have incurred any costs in connection with the  
20 appeal.

21 On examining the Statement of Grounds of Appeal, I can  
22 find no reference to anything identifiable either as an error  
23 of principle or as a reason for saying that it was not open to  
24 the Hearing Officer to come to the decision that she did.  
25 There is inconsequential quibbling about possible differences

