

O-216-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2617256
BY MEDREICH PLC TO REGISTER THE TRADE MARK**

MEDOMON

IN CLASS 5

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 103680
BY FERRING B.V.**

BACKGROUND AND PLEADINGS

1) On 10 April 2012, Medreich Plc (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark MEDOMON in respect of goods in Class 5.

2) On 11 May 2012 the application was published in the Trade Marks Journal and on 8 August 2012, Ferring B.V. (“the opponent”) filed notice of opposition to the application. The single ground of opposition is that the application offends under Section 5(2)(b) because it is in respect of a similar mark and similar or identical goods to an earlier mark in the name of the opponent. The relevant details of this earlier mark are as follows:

Mark Details	List of Goods
Community Trade Mark (“CTM”) 8695686 MENOGON Filing date: 18 November 2009 Date of entry in register: 28 April 2010	Class 5: <i>Pharmaceutical products and substances.</i>

3) The mark relied upon by the opponent is a registered mark and its date of application is earlier than that of the applicant’s mark. It, therefore, qualifies as an “earlier mark” under Section 6 of the Act. Further, its registration procedure was completed less than five years before the publication of the applicant’s mark and, consequently, it is not subject to the proof of use provisions in Section 6A of the Act. Therefore, the opponent is entitled to rely upon all of the goods listed in its earlier mark.

4) The applicant filed a counterstatement denying the opponent’s claims and also it voluntarily limited its specification of goods and therefore, the opposition is directed at the following list of goods:

Pharmaceutical preparations and substances for the treatment of cardiovascular conditions and disorders

5) Neither side filed evidence in these proceedings, but both filed written submissions in lieu of attending a hearing. I take full consideration of these when making my decision. Both sides ask for an award of costs.

DECISION

6) Section 5(2)(b) 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.”

7) 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] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 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. 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 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*

Comparison of goods

8) In its written submissions the applicant concedes that its goods are included in the broad list of goods of the opponent's registration. It goes on to say that the broad nature of the list of goods relied upon by the opponent disguises the fact that it uses its mark in respect to pharmaceuticals concerned with the

menopause or menstruation. Whilst I note this claim, it has no bearing on the outcome of the proceedings because, as I said earlier, the opponent is entitled to rely upon its full list of goods and consequently, I must undertake a notional analysis of the similarity of goods based upon the full list of goods in both parties' marks. As such, I conclude that the respective goods are identical as per the guidance provided by the General Court ("the GC") in *Gérard Meric v OHIM*, T-133/05, paragraph 29 when it said that goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application, or *vice versa*.

The average consumer

9) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

10) Further, in *Armour Pharmaceutical Co v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-483/04 the GC stated:

"79 The Court finds that the level of attention of the average consumer of pharmaceutical preparations must be determined on a case-by-case basis, according to the facts in the case-file, especially the therapeutic indications of the goods in question. Likewise, the Court finds that, in the case of medicinal products subject to medical prescription such as those being considered in the present case, that level of attention will generally be higher, given that they are prescribed by a physician and subsequently checked by a pharmacist who delivers them to the consumers."

11) The applicant submits that the goods at issue are rarely directly purchased by the average consumer but rather are more likely to be prescribed by a medical practitioner and either handed to the consumer by a professional pharmacist or directed to the product by such a pharmacist. It argues that, as a result, the person who selects the product will have greater awareness than the average consumer. It further claims that even in the event that products are selected "off-the-shelf", it is reasonable to assume that the consumer will exhibit a greater degree of attention than is the case with the proverbial "bag of sweets". Certainly, insofar as the applicant's goods are concerned, I agree that they are unlikely to be available over the counter due to the medical conditions for which they are intended. Such goods are likely to be available via prescription only. This brings with it, an enhanced level of attention, but it is still unlikely to be of the highest level. The opponent's goods are, however, not so limited, and includes goods that may be generally available over the counter as well as pharmaceutical

preparations where distribution will be more controlled. Consequently, the purchasing process will vary, but I accept that even where such goods are bought over the counter or off the shelf, the level of attention paid by the consumer will be greater than that in respect of goods bought on a more regular or everyday basis.

Comparison of marks

12) The respective marks are:

Opponent's mark	Applicant's mark
MENOGON	MEDOMON

13) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). Both marks consist of single words. The applicant contends that it is the prefixes MEDO and MENO respectively that are the dominant and distinctive elements of the marks. The opponent contends that neither mark contains elements that are more distinctive or dominant than other elements. I concur with this latter submission. Both marks consist of invented words that are not readily subdivided. Consequently, I conclude that, in both cases, there is a single distinctive element.

14) From a visual perspective, both marks consist of single seven letter words. Five letters are the same and in the same positions in both marks. Both marks share the same beginning ME- and ending –ON. As the opponent points out, this leads to the marks sharing the same sequence MO*O*ON and the same vowel structure. These are all points of similarity, but this is countered to a degree by the third and fifth letters of both marks being different. Nevertheless, when considering all of these factors, I conclude that the marks share a good deal of visual similarity.

15) Aurally, it is my view that both marks are most likely to be broken into three syllables, namely MEN-O-GON and MED-O-MON respectively and, whilst still possible, I consider it less likely that the marks will be pronounced as ME-NO-GON and ME-DO-MON, as the opponent contends. The applicant submits that the marks are aurally dissimilar choosing to highlight that the respective prefixes MEDO and MENO are different and the respective endings, namely MON and GON are also different. Whilst it is true that these elements are not identical, they do share the same aural rhythm resulting from the identical structure of the marks and also share the same beginning to the first syllable, an identical second syllable and the same ending to the third syllable. Taking all of this into account, I conclude that there is a good deal of aural similarity.

16) The applicant argues that the prefixes of the respective marks will serve to place conceptual distance between the marks submitting that MENO- will be understood as an allusion to “menopause” or “menstruation” and that the prefix “MEDO” will be understood as an allusion to “medical”. On the other hand, the opponent argues that neither mark has any meaning and, consequently, cannot be conceptually differentiated. I am of the view that the conceptual allusions claimed by the applicant may be present in the prefixes of the respective marks on certain occasions but that these allusions are rather weak. I will discuss this further later in my decision.

17) In summary, I have found that the respective marks share a good deal of visual and aural similarity and that, whilst the marks consist of made up words, there may be an element of conceptual dissonance in certain circumstances.

Distinctive character of the earlier trade mark

18) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). There is no evidence of use before me and, consequently, I must conclude that the opponent’s mark does not benefit from any enhanced distinctive character. I only need to consider the inherent qualities of the opponent’s mark.

19) In this respect, as it consists of a made up word it is endowed with a reasonably high level of distinctive character. Whilst noting that the MENO element may, very loosely, allude to menopause or menstruation, such a weak allusion is not sufficient to significantly affect this finding.

Likelihood of confusion

20) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

21) The applicant points out that the prefix MENO will be understood by the medical professional as a reference to “menopause” or “menstruation”, whereas the prefix MEDO will be understood as a “general medicament”. I am not convinced by this approach. The applicant has limited its specification to goods for the treatment of cardiovascular conditions. The opponent’s specification of

goods also includes such goods within its broader definition of its goods. In other words, when considering the notional position (as I must do: see the comments of the GC in *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06, paragraph 76), the opponent may use its mark in respect of identical goods to those of the applicant, namely those goods for the treatment of cardiovascular conditions. In this situation, it is my view that the conceptual significance of the prefix MENO will be lost. That being the case, any potential conceptual dissidence between the marks will be lost, even where medical professionals are involved.

22) I take account of the imperfect picture that the consumer may recall and the similarity in the rhythm and letter sequence of the marks (that result in a good deal of aural and visual similarity) and that identical goods are involved. Even when taking account of the enhanced level of care involved in the purchasing process, I conclude that these factors, together with the reasonably high level of distinctive character of the earlier mark, combine to result in there being a likelihood of direct confusion where the consumer may confuse one mark for the other.

23) Consequently, I conclude that the opposition is successful in its entirety and the application is refused in its entirety.

COSTS

24) The opposition having been successful, the opponent is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place but that both sides filed written submissions in lieu of attendance. I award costs on the following basis:

Notice of Opposition and considering statement of case in reply	£500
Filing written submissions	£400
TOTAL	£900

25) I order Medreich Plc to pay Ferring B.V. the sum of £900. 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 21st day of May 2013

**Mark Bryant
For the Registrar,
the Comptroller-General**