

O-020-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2633649
BY THE ASKLEPAEDIA LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 35, 41 & 45:**

Asklepaedia

AND

OPPOSITION THERETO (NO. 104384) BY ASKLEPIOS KLINIKEN GMBH

The background and the pleadings

1) The Asklepaedia Limited (“the applicant”) applied for the trade mark: **Asklepaedia** on 2 September 2012. It was published in the Trade Marks Journal on 19 October 2012. Registration is sought for the following services:

Class 35: Business and administrative management consultancy services related to clinical services, including, but not limited to, health records, practice premises, personnel organisation, policies and procedures, clinician-patient relationship, health care delivery systems, and remuneration.

Class 41: Education and training services related to administrative management of clinical services, including, but not limited to, health records, practice premises, personnel organisation, policies and procedures, clinician-patient relationship, health care delivery systems, remuneration, and academic faculty development; providing education and training related to clinical management of patients.

Class 45: Health and safety consultancy services related to administrative management of clinical services, including, but not limited to, health records, practice premises, personnel organisation, policies and procedures, clinician-patient relationship, health care delivery systems, remuneration, and academic faculty development.

2) Asklepios Kliniken GmbH (“the opponent”) opposes the registration of the mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). It relies on four earlier trade marks as follows:

- i) Community trade mark (“CTM”) registration 585935 for the mark **Asklepios** which was filed on 16 July 1997 and which completed its registration process on 25 January 1999. It relies upon all of the services for which its mark is registered, namely:

Class 35: Clearing services for health insurance businesses.

Class 36: Health insurance brokerage.

Class 42: Medical assistance, nursing homes, services in the fields of health care and health promotion, physiotherapy, rehabilitation initiatives, remedial sports.

Given the date on which the mark completed its registration process, it is subject to the proof of use provisions set out in section 6A¹ of the Act; the opponent made a statement of use equating to all of the services for which its mark is registered.

- ii) CTM 5153201 for the mark **Asklepios** which was filed on 22 June 2006 and which completed its registration process on 20 December 2007. It relies only upon certain of the services for which its mark is registered, namely:

Class 35: Processing, maintenance and systematic ordering of data in computer databases for the exchange of patient-oriented documents and information, including data relating to equipment and the location thereof, necessary for patient care; organisation of treatment and management processes in clinics and doctors' practices, via computer networks.

Class 42: Installation and maintenance of network systems, configuring computer networks by means of software; development and rental of software and hardware for the identification and location of patients and medical equipment and apparatus.

Class 44: Medical services, in particular patient care by means of computer-aided communications and computer-aided information transmission, patient care, including the identification of patients and the identification and location of medical equipment and apparatus using RFID (radio frequency identification) technology.

The proof of use provisions are not applicable to this mark.

- iii) CTM 6285555 for the mark **Asklepios** which was filed on 18 September 2007 and which completed its registration process on 25 August 2008. It relies upon all of the services for which its mark is registered, namely:

Class 35: Advertising; business management services; business administration; office functions; clearing services for health insurance businesses.

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; health insurance brokerage; mergers and acquisitions, namely financial consultancy with regard to the purchase or sale of businesses and business investments; mutual funds; financial management;

¹ The provisions provide, in summary, that an earlier mark which has been registered for five years or more (measured at the date on which the new trade mark was published in the Trade Marks Journal) may only be relied upon to the extent to which it has been genuinely used.

issuing of financial investments, in particular shares, securities, unit trusts.

Class 44: Medical services, healthcare; hospitals; services provided by a health clinic.

The proof of use provisions are not applicable to this mark.

- iv) IR 1048511 for the mark **Asklepios** which designated the EU for protection on 17 May 2010 with protection being conferred on 26 July 2011. It relies only upon certain of the services for which its mark is protected, namely:

Class 35: Advertising; business management; business administration; office functions; administrative processing of all kinds of contracts, property and real estate owner communities (office functions); retail and wholesale services (also by way of distance selling) in relation to goods of classes 3, 5, 9, 10, 14, 16, 18, 20, 21, 22, 24, 25, 27, 28, 29, 30, 31 and 32; updating, maintenance and systematization of data and computer databases for exchange of patientoriented documents and information including data on apparatus and their location which are required for patient care; organization of treatment and management processes in hospitals and doctors' practices under inclusion of a computer network; business and organizational consultancy of doctors, hospitals as well as other inpatient and outpatient service providers. Goods and services limited to: Advertising; business management; business administration; office functions; administrative-technical treatment of all kinds of contracts, property and real estate owner communities (office functions); retail and wholesale services (also by way of distance selling) in relation to goods of classes 3, 5, 9, 10, 14, 16, 18, 20, 21, 22, 24, 25, 27, 28, 29, 30, 31 and 32; compilation of statistics through updating of data in computer databases; updating, maintenance and systematization of data in computer databases for exchange of patientoriented documents and information including data on apparatus and their location which are required for patient care; organization of treatment and management processes in hospitals and doctors' practices under inclusion of a computer network; business and organizational consultancy of doctors, hospitals as well as other inpatient and outpatient service providers.

Class 36: Insurance, in particular services of a health insurance as well as brokerage of health insurances and all other types of insurances and building savings contracts; billing services for insurance businesses; mergers and acquisition services, namely financial advisory in relation to the sale or purchase of businesses or shares in businesses; brokerage of investment in funds; asset

management; emission of securities, in particular shares, bonds, funds as service of a financial service provider; financial affairs; monetary affairs; real estate affairs; providing financial opinions in relation to insurance businesses; financial structuring of new insurance products.

Class 41: Education; providing of training; entertainment; sporting and cultural activities.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software, in particular for identification and localization of patients as well as medical devices and apparatus; installation and servicing of network systems (software) and configuration of computer networks by means of software. Goods and services limited to: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software, in particular for identification and localization of patients as well as medical devices and apparatus as well as IT-aided communication and IT-aided information transmission in and between hospitals, nursing homes and doctor's practices; installation and servicing of network systems (software) and configuration of computer networks by means of software.

Class 43: Services for providing food and drink; temporary accommodation.

Class 44: Medical and veterinary services, in particular services of a doctor, a hospital, a rehabilitation clinic, a medical care center and an outpatient clinic; hygienic and beauty care for human beings or animals; health fostering by inpatient or outpatient treatments and inpatient or out-patient consulting; physiotherapy, rehabilitation therapy, sports for the purpose of health therapy. Goods and services limited to: Medical and veterinary services, in particular services of a doctor, a hospital, a rehabilitation clinic, a medical care center and an outpatient clinic; hygienic and beauty care for human beings or animals; health fostering by inpatient or outpatient treatments and inpatient or out-patient consulting, in particular nutritional and prevention consultancy; physiotherapy, rehabilitation therapy, sports for the purpose of health therapy and prevention.

The proof of use provisions are not applicable to this mark.

3) The applicant filed a counterstatement denying the claims. It put the opponent to proof of use in relation to CTM 585935. Both sides filed evidence. The matter then came to be heard before me on 18 December 2013 at which the opponent

was represented by Mr Terry Rundle of Wilson Gunn and the applicant by Ms Melanie Harvey of ip21 Ltd.

4) CTM 585935 is the only earlier mark subject to proof of use. However, as Mr Rundle highlighted at the hearing, the services for which it is registered are covered by the other earlier marks (and the marks themselves are all the same as CTM 585935) the opponent relies on. Consequently, I do not need to consider CTM 585935 in any detail, nor the proof of use provisions which are applicable to it as it takes the opponent no further forward.

5) All of the remaining earlier marks are for the same mark: **Asklepios**. Whilst they all constitute separate registrations, I will not differentiate between them, other than bearing in mind that they are registered for various (and sometimes differently worded) specifications.

The opponent's evidence

6) The evidence was given by Mr Rundle in the form of a witness statement. He exhibits a number of the opponent's annual reports, advertisements and other types of publicity material. It is not necessary to summarise any of this in detail. Mr Rundle accepted at the hearing that the evidence did not advance the opponent's case because the use of the earlier mark(s) was limited to Germany. Like Mr Rundle, I can see nothing pertinent in the evidence to assist my determinations. However, simply for the record, I highlight that the services offered under the opponent's mark relate to private medical hospitals and that, for example, the opponent has a 20% share of the German market.

The applicant's evidence

7) Evidence, in the form of a witness statement, is given by Mr Chu-Kwan Wong, the applicant's "founder and 100% owner". Mr Wong explains how the mark was coined. He states that he first encountered the term ASKLEPIOS during research into the history of medicine in 1986; the term is the name of the Greek god of medicine. Mr Wong wanted a novel and unique trade mark for his services so he combined the prefix ASKLE- with the word -PAEDIA; the latter word being Greek for education and which is used as a suffix in words such as encyclopedia. He did not know of the opponent's business. He considers that people in the medical field will know of the name ASKLEPIOS and, thus, it has a different concept to ASKLEPAEDIA. He also considers that the -PAEDIA suffix of his mark (which he considers people in general will know of) also prevents the marks from being confused.

8) Evidence, in the form of a witness statement, is also given by Ms Harvey. Her evidence is directed at the word ASKLEPIOS (and variant spellings thereof) and the prefix ASKLE- (and variant spellings thereof). A number of exhibits are provided as follows:

- Exhibit MJH1: Prints from Google.co.uk for the search terms ASKLEPIOS, ASCLEPIUS, AESCULAPIUS. The first page of each search is provided. The total number of pages for each search is in the hundreds of thousands. Throughout the results pages, there are numerous references to the Greek god.
- Exhibit MJH2: A print from the website Wikipedia for the entry ASCLEPIUS (ASKLEPIOS is listed as a variant spelling) providing information about the Greek god of healing and medicine.
- Exhibit MJH3: A print from www.adf.org about the Greek god Asklepios.
- Exhibit MJH4: A print from the website Wikipedia for the entry HIPPOCRATIC OATH. This is an oath that healthcare professionals make, which requires them to swear upon the names of certain healing gods (including Asclepius) to practice medicine honestly.
- Exhibit MJH5: A print from the website Wikipedia for the entry ROD OF ASCLEPIUS (ASKLEPIOS is listed as a variant spelling). This is a symbol which, the entry states, is widely used in the medicine and health care field.
- Exhibit MJH6: A print from the website www.asclepiusglobal.com. It is a company website trading under the name ASCLEPIUS. The company is a healthcare recruitment firm and operates in the UK.
- Exhibit MJH7: A print from the website www.abioresearch.com. It is a company website trading under the name ASCLEPIOS BIORESEARCH. It offers investment opportunities (to UK business) in the biopharmaceutical field.
- Exhibit MJH8: Pages from the publication PHARMACEUTICAL MEDICINE. In a long list of contributors to this publication, there is a Mr John Griffin of Asklepieion Consultancy Limited based in Hertfordshire.
- Exhibit MJH9: A print from the website www.esor.org, a European School of Radiology. It offers a number of courses, one of which is named ASKLEPIOS. The course is provided in the UK.
- Exhibit MJH10: A print relating to ASKLEPIOS ORCHESTRA, the orchestra of the Medical School of the University of Birmingham.
- Exhibit MJH11: Prints from Google.co.uk for the search term ASKLE. The first page of 81,500 hits is provided. Some of the hits relate to foreign language websites, some to a body positioning device/cushion, two appear to relate to medical content of some sort.

- Exhibit MJH12: A print from the website of Companies House showing a number of companies with the prefix ASCLE. Some (but certainly not the majority) have indications in the rest of the name indicating that they may operate in the health/medicine field.
- Exhibit MJH13: A similar print to that above, but relating to companies with the prefix ASKLE. There is less in number and less that can be tied to the health/medicine field.

9) Ms Harvey also conducted a search of the trade marks register and found four marks which contain the prefix ASKLE/ASKLE for medical related goods or services: ASKLE, ASCLEPION-MEDITEC, ASCLEPION, ASKLE SANTE. Ms Harvey states that the prefix of the opponent's mark is not, given her evidence, unusual. She considers the scope of monopoly of the opponent's mark to be narrower than claimed.

Opponent's reply evidence

10) This comes from Mr Rundle. He takes issue with the trade marks referred to by Ms Harvey which she states relate to medical and/or health related services. He states that they do not. He highlights that ASKLEPION was successfully opposed by the opponent and that it proceeded to registration only in relation to cultural activities.

Section 5(2)(b) - the legislation and the leading case-law

11) Section 5(2)(b) of the Act reads:

“5.-(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.”

12) The Court of Justice of the European Union (“CJEU”) has issued a number of judgments² which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs

² The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

Comparison of the services

13) When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* 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.”

14) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

15) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v*

OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

16) In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

17) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in 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 the trade”³ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁴. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of “dessert sauce” did not include jam, or because the ordinary and natural description of jam was not “a dessert sauce”. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

³ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁴ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

18) I will go through the applied for services class by class:

Class 35: Business and administrative management consultancy services related to clinical services, including, but not limited to, health records, practice premises, personnel organisation, policies and procedures, clinician-patient relationship, health care delivery systems, and remuneration.

19) Earlier CTM 6285555 includes various terms in class 35 including: “business management services; business administration” which would cover business and administrative management consultancy services as per the applied for mark. The earlier terms are not limited to any particular field with the consequence that the services include those which relate to clinical services etc as per the applied for mark. **In view of this the applied for services fall within the ambit of the earlier services and are considered identical.**

Class 41: Education and training services related to administrative management of clinical services, including, but not limited to, health records, practice premises, personnel organisation, policies and procedures, clinician-patient relationship, health care delivery systems, remuneration, and academic faculty development; providing education and training related to clinical management of patients.

20) Earlier IR 1048511 includes various terms in class 41 including: “Education; providing of training”. The earlier terms are not limited to any particular field with the consequence that the services include those which relate to clinical services etc as per the applied for mark. **In view of this the applied for services fall within the ambit of the earlier services and are considered identical.**

Class 45: Health and safety consultancy services related to administrative management of clinical services, including, but not limited to, health records, practice premises, personnel organisation, policies and procedures, clinician-patient relationship, health care delivery systems, remuneration, and academic faculty development.

21) At the hearing, Mr Rundle argued for similarity on the basis that the services covered by the various earlier marks could all be offered in the healthcare sector, and that this also applies to the applied for services in class 45 which were specifically limited to health and safety consultancy related to the administrative management of clinical services etc. This, though, is a somewhat superficial argument as the nature of the services is very different, effectively healthcare services or business management/administration on the one hand, and health and safety consultancy on the other. The purpose is different. The methods of use are different. The services do not compete. Mr Rundle also argued for similarity on a complementary basis. He highlighted that the applied for services were likely to be part of a complete package offered in the clinical field. However, beyond the fact that the applicant has applied for a range of services there is no evidence to suggest that the channels of trade co-exist. There is nothing inherent

in the nature of the services, nor any evidence presented, to suggest that the services are similar on a complementary basis. The same applies, for similar reasoning, to the other services covered by the various earlier marks. **The services are not similar.**

The average consumer

22) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting services can, of course, vary depending on what is involved. In the medical field, services could potentially have average consumers made up of both healthcare professionals on the one hand and members of the general public on the other⁵; members of the general public could be relevant on the basis of them being end users, and also as consumers in their own right purchasing certain medical services. However, the area in which the services of the respective marks conflict strike me as services which are only likely to be offered to businesses in the health care field. It is not likely that the general public will form an end user of the conflicting services. Therefore, the relevant average consumer I will focus upon will be in the healthcare field. Further, and as put forward by Mr Rundle, the average consumer will be a person running or administering a clinical or other healthcare service as opposed to a doctor per se.

23) Marks used in this field will often be encountered visually, for example, via the perusal of brochures and websites. However, there is some potential for aural use so even though the visual impact of the marks is likely to take on more importance, the aural impact will not be ignored completely. The services in question are not everyday casual selections. A good deal of consideration will go into the selection of an appropriate service provider.

Comparison of the marks

24) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

Asklepaedia v Asklepios

25) Neither mark breaks down into separate elements, so the marks in totality represent their dominant and distinctive components.

26) The average consumer is someone working in the health care or clinical sector, but more on the administrative side of things. The reason why the nature

⁵ See, by analogy, *Mundipharma AG v OHIM*, Case T-256/04

of the average consumer is important in this instance is because one of the issues I need to determine is whether the average consumer would be aware of the meaning of Asklepios. If the average consumer was simply a member of the general public, with no specific knowledge of medical or clinical matters, my view would have been that the degree of knowledge of Asklepios would be relatively thin and, thus, the average consumer should not be deemed to know of Asklepios. On the flip-side, if the average consumer was a doctor or other health care practitioner, my view would be that the meaning of Asklepios would be relatively widely known. I come to this view due to the use of the name as part of the Hippocratic Oath, and the name and associated imagery appears to be used in the medical field. This is supported by the use of the name (or variants of it) by other businesses and by the other more general evidence relating to the name itself (although little weight has been placed on the state of the register evidence). Although the use is not overwhelming, and whilst it does not necessarily demonstrate that the word has a low degree of distinctiveness (a point I will come back to), it at least demonstrates that others in the field have used the name and that its selection was likely to have been based upon the recognition of the name.

27) However, as already stated, the average consumer in these proceedings is to be regarded as a person engaged more in the administrative side of a clinical operation. The service provider is, though, likely to be engaged by someone with a high level of authority. I come to the view that the average consumer is likely to have some form of clinical background and even if this is only in an administrative capacity they will have been exposed to medical and clinical terminology, with the consequence that the average consumer should also be deemed to know of the name Asklepios. This is not undermined by the fact that there are variant spellings of the name. It is clear that Asklepios is a variant spelling and even if the average consumer were more used to seeing another spelling, the similarity in the variants means that they will see, straightaway, an approximation.

28) The consequence of the above finding is that there is a conceptual difference given that Asklepios has a particular meaning which is not shared by asklepaedia. The latter will be perceived as an invented word, although I accept that the -paedia suffix will be recognised as relating to education as in encyclopedia. Ms Harvey referred to the word paedia having other meanings in the medical field – whilst this is so, I consider the “education” meaning to be the one most likely to be perceived by the average consumer. I add that for some average consumers (although probably the minority) the ASKLE- prefix will be recognised as the first part of the name ASKLEPIOS. I will bear this in mind when I decide whether there is a likelihood of confusion.

29) There are some points of visual similarity and some points of difference. The marks are of similar (but not identical) length and both begin with the same six letters ASKLEP-. However, the endings are very different –EDIA/-IOS. Mr Rundle

argued that the beginnings of the marks would attract most attention, whereas Ms Harvey argued for the opposite. I consider the nature of the respective marks to be one which results in neither the beginning or ending garnering significantly more attention than the other. The marks are visually similar, but not to a high degree.

30) The most likely pronunciation of the applied for mark is ASK-LE-PEA-D-UH. The earlier mark is likely to be pronounced as either ASK-LE-PIE-OS, ASK-LEP-I-OS, ASK-LE-PEA-OS or ASK-LEP-E-OS. I accept, as Ms Harvey submitted, that the respective articulations result in a four syllable v five syllable articulation. Whichever way the earlier mark is pronounced, there are, again, points of similarity and difference. I again consider that the marks have some aural similarity, but not to a high level.

Distinctiveness of the earlier mark

31) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The use made does not assist so I will say no more about this. In terms of inherent qualities, whilst the name of the Greek god of medicine will be known in the field, it does not allude or describe any particular characteristic of the services. Whilst it is not highly distinctive, it is nevertheless an averagely distinctive trade mark.

Likelihood of confusion

32) The factors assessed so far have a degree of interdependency. A global assessment of them must be made when determining whether there exists a likelihood of confusion. There is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

33) I come to the view that the marks Asklepios and Asklepaedia will not be directly confused. Although the services are identical, the nature of the purchasing process together with the fact that the name Asklepios will be known by the average consumer means that the differences between the marks will be noticed and kept in mind and they are not likely to be imperfectly recalled as one another. **There is no likelihood of direct confusion.** There is also indirect confusion to consider. In *L..A. Sugar Limited v By Back Beat Inc* (BL-O/375/10) Mr Purvis QC, sitting as the Appointed Person, explained the difference between direct confusion and indirect confusion in the follow way:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no

process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

34) If the average consumer saw ASKLEPAEDIA as an invented word based purely on the suffix –PAEDIA (with ASKLE having no meaning) then I see no reason whatsoever for the average consumer to put the common presence of ASKLE at the beginnings of the marks down to the service providers being the same or being related. It will be seen (even if the similarity is noted at all) as coincidence, one word being the name of the Greek God of medicine the other being a made up word with a PAEDIA suffix. There is, though, greater room for argument if the average consumer saw ASKLEPAEDIA as being based upon the first part of the name of the Greek God of medicine together with the -PAEDIA suffix. However, even if this were countenanced, I come to the view that there is still no indirect confusion. The average consumer will likely put this down to unrelated undertakings simply making use, albeit in different ways, of a trade mark based upon the name of the Greek God of medicine. Given the significance of the name in the relevant field this will not be seen as a surprising co-incidence, one using the name per se, the other using the beginning of the name but combining it with PAEDIA to create an invented word. The average consumer will

not believe that the responsible undertakings are the same or are related. **There is no likelihood of indirect confusion. The opposition is rejected.**

Costs

35) The applicant having been successful, it is entitled to a contribution towards its costs. My assessment of costs is as follows:

Preparing a statement and considering the other side's statement: £300

Filing and considering evidence: £800

Attending the hearing: £500

Asklepios Kliniken GmbH is ordered to pay The Asklepaedia Limited the sum of £1600. 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 15th day of January 2014

**Oliver Morris
For the Registrar,
The Comptroller-General**