

O-338-16

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO 3110444
BY MEDICOM HEALTHCARE LTD
TO REGISTER THE TRADE MARK**

Medax

IN CLASSES 05 & 10

AND

**OPPOSITION THERETO (UNDER NO. 405097)
BY
MEDAC GESELLSCHAFT FÜR KLINISCHE SPEZIALPRÄPARATE MBH**

BACKGROUND

1) On 26 May 2015, Medicom Healthcare Ltd ('the applicant') applied to register the following trade mark for the goods listed below:

Medax

Class 5: Pharmaceutical preparations for the eye; ophthalmic preparations; eye drops; eye care products; food products and supplements for medical use all relating to the eye, none of which relating or containing honey, royal jelly, propolis or other bee related products.

Class 10: Pharmaceutical apparatus and medical devices relating to eye care; none of the aforesaid to include lights, lighting equipment or light therapies.

2) The application was published on 19 June 2015 in the Trade Marks Journal and notice of opposition was subsequently filed by Medac Gesellschaft für klinische Spezialpräparate mbH ('the opponent').

3) The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It directs its opposition against class 05 of the application only. The following European Union Trade Mark ('EUTM') is relied upon:

EUTM details	Goods relied upon
<p>EUTM No: 3106135</p> <p>medac</p> <p>Filing date: 24 March 2003</p>	<p>Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax;</p>

Date of entry in the register: 05 October 2004	disinfectants; preparations for destroying vermin; fungicides, herbicides.
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4) The opponent's trade mark is an earlier mark in accordance with section 6 of the Act and, as it had been registered for more than five years before the publication date of the applicant's mark, it is subject to the proof of use requirements, as per section 6A of the Act. The opponent made a statement of use in respect of all of the goods in class 05 shown in the table above.

5) The applicant filed a counterstatement denying, with explanation, any similarity between the respective marks and goods and any likelihood of confusion. Although the applicant also requested proof of use of the earlier mark, it failed to provide a list of goods for which it required proof of use.¹ This deficiency was brought to the attention of the applicant in the official letter of 10 December 2015 and again in the official letter of 07 January 2016. Both of the aforementioned letters provided the applicant with an opportunity to amend its Form TM8 and counterstatement but the applicant did not avail itself of those opportunities. The later letter also included the following warning to the applicant:

“If you choose not to file an amended counter-statement the proceedings will continue without proof of use being requested; i.e. the opponent's statement of use will be accepted with the consequence that the earlier mark may be relied upon for all the goods/services identified in the statement of use.”

As no response was received by the applicant within the period allowed, the official letter of 21 January 2016 advised the parties that the proceedings would continue without the applicant having requested proof of use. The applicant gave no response to this letter either. Consequently, I will proceed on the basis that the opponent is not required to provide proof of use. The effect of this is, as stated in the official letter

¹ The relevant part of Q.7 of the Form TM8 states “**List of goods and/or services:** List goods/services for which you require proof of use. Please use a continuation sheet if not enough space”

of 07 January 2016, that the opponent is entitled to rely on all of the goods for which it made a statement of use.

6) Neither party filed evidence; only the opponent filed written submissions. A hearing was not requested by either party. I therefore make this decision on the basis of the papers before me.

DECISION

7) Section 5(2)(b) of the Act provides:

“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.”

8) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

9) The goods to be compared are:

Opponent's goods	Applicant's goods
Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides	Class 5: Pharmaceutical preparations for the eye; ophthalmic preparations; eye drops; eye care products; food products and supplements for medical use all relating to the eye, none of which relating or containing honey, royal jelly, propolis or other bee related products.

10) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) ('Meric'), the General Court ('GC') held:

"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).”

The applicant’s ‘Pharmaceutical preparations for the eye; ophthalmic preparations; eye drops; eye care products’ falls within the broad term ‘Pharmaceutical and veterinary preparations’ in the opponent’s specification. Further, the opponent’s ‘dietetic substances adapted for medical use’ falls within the applicant’s ‘food products and supplements for medical use all relating to the eye, none of which relating or containing honey, royal jelly, propolis or other bee related products’. It follows that the respective goods are identical in accordance with *Meric*.

Average consumer and the purchasing process

11) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

12) In *Mundipharma AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-256/04, the GC stated:

“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 the goods at issue includes the general public and professionals such as doctors, pharmacists and optometrists. Insofar as the general public is concerned, the goods are likely to be self-selected from the shelves of, for example, a pharmacy or website page. As such, I would expect the purchase to be mainly visual. I do, however, bear in mind that the consumer may sometimes request the goods orally over the counter in a pharmacy or may obtain the goods after discussion with a medical professional and therefore the aural aspect is also important. In terms of the professional consumer, again I would expect the purchase to be mainly visual with the goods being self-selected by eye from catalogues, websites or from the shelves of a wholesaler perhaps. However, as the goods may, for example, be the subject of discussions with pharmaceutical sales representatives or orders may be placed over the telephone, the aural similarity between the marks is also important here.

13) Generally speaking the cost of the goods is likely to be low. However, given that the goods will be applied to the eye itself, in close proximity to the eye or consumed for medicinal purposes, I would nevertheless expect a high degree of attention to be paid by the general public given their likely interest in factors such as possible side-effects, promised results, recommended frequency of use etc. As to professionals, their duty of care to the general public will necessarily require a high degree of

attention during the purchase. In reaching this view, I have borne in mind the comments of the GC in *Aventis Pharma SA v OHIM*, Case T-95/07 where it stated:

“29 First, as noted in the case-law, medical professionals display a high degree of attention when prescribing medicinal products. Second, with regard to end-consumers, it can be assumed, where pharmaceutical products are sold without prescription, that the consumers interested in those products are reasonably well informed, observant and circumspect, since those products affect their state of health, and that they are less likely to confuse different versions of such products (see, to that effect, Case T-202/04 *Madaus v OHIM – Optima Healthcare (ECHINAID)* [2006] ECR II-1115, paragraph 33). Furthermore, even supposing a medical prescription to be mandatory, consumers are likely to display a high degree of attention when the products in question are prescribed, having regard to the fact that they are pharmaceutical products (*ATURION*, paragraph 27).”

Comparison of marks

14) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would therefore be wrong to artificially dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

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15) Neither mark lends itself to deconstruction into separate components; their respective overall impressions are based solely on the single word of which they consist.

16) It is a general rule of thumb that the beginnings of words will tend to have the greatest impact on the consumer's perception.² The first four letters of the marks are identical to the eye with the only point of difference occurring in the fifth letter, being an 'x' in the contested mark and a 'c' in the earlier mark. By virtue of their position at the end of the marks, those letters are the last to strike the eye and have less visual impact than the letters preceding them. The marks are visually similar to a high degree.

17) In terms of how the marks will be pronounced, the contested mark will be vocalised as MED-AXE and the opponent's mark as MED-AC. The marks consist of two syllables, the first of which are identical and the second of which are highly similar. Overall, there is a high degree of aural similarity.

18) From a conceptual perspective, I agree with the opponent that neither mark is likely to portray any meaning as they both have the appearance of invented words. It follows that the marks are neither similar nor dissimilar; the conceptual position is neutral.

² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 [81] - [83]

Distinctive character of the earlier mark

19) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

As there is no evidence before me, I can only take into account the inherent qualities of the opponent's mark. As a mark which appears to be invented in nature, it in no way describes or alludes to the relevant goods. I find it to be possessed of a high degree of distinctiveness.

Likelihood of confusion

20) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

21) An important point weighing in the applicant's favour is that the consumer is likely to pay a high degree of attention during the purchase. That level of attention militates, to some degree, against the marks being misremembered. However, it does not mean that the effect of imperfect recollection is diminished to the point of playing no role at all. Further, as neither mark evokes any concept, the consumer will have no conceptual hook which may assist in aiding his memory. Bearing all of this in mind, together with the high degree of visual and aural similarity between the marks, the identity of the goods and the high degree of inherent distinctiveness of the earlier mark, I find that there is a likelihood of one mark being mistaken for the other i.e. there is a likelihood of direct confusion.

The opposition against class 05 of the application succeeds.

The application may proceed to registration solely in respect of the goods in class 10 which were not subject to opposition.

COSTS

22) As the opponent has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 4/2007, I award the opponent costs on the following basis:

Official fee (TM7)	£100
Preparing the notice of opposition and considering the counterstatement	£200
Written Submissions	£300
Total:	£600

23) I order Medicom Healthcare Ltd to pay Medac Gesellschaft für klinische Spezialpräparate mbH the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of July 2016

Beverley Hedley
For the Registrar,
the Comptroller-General