

O-339-16

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO 3109307

BY MOHAMED SHAWKI EL MORSY YOUSEF & BIOCEUTICS UK LTD

TO REGISTER THE TRADE MARK



IN CLASSES 01 & 05

AND

OPPOSITION THERETO (UNDER NO. 405488)

BY

BIOCEUTICALS LIMITED

BACKGROUND

1) On 19 May 2015, Mohamed Shawki El morsy Yousef and Bioceutics UK Ltd ('the applicants') applied to register the following trade mark in respect of a number of goods in class 01 (which are not in dispute and therefore I will not set them out here) and goods in class 05 (which are subject to dispute) as shown below:



Class 05: Pharmaceutical preparations for animal skincare; Pharmaceutical skin lotions; Pharmaceutical implants; Pharmaceutical and veterinary preparations; Pharmaceutical compositions; Pharmaceutical creams; Pharmaceutical lipsalves; Pharmaceutical preparations for animals; Pharmaceutical preparations for veterinary use; Pharmaceutical preparations in strip form; Pharmaceutical sweets; Pharmaceutical preparations for skin care; Pharmaceutical preparations.

2) The application was published on 21 August 2015 in the Trade Marks Journal and notice of opposition, directed against class 05 only, was subsequently filed by Bioceuticals Limited ('the opponent').

3) The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It relies upon three UK Trade Marks ('UKTM'), details of which are set out in the table below:

UKTM details	Goods relied upon
UKTM No: 2634600 BIOCEUTICALS LTD	Class 05: Dietary and nutritional supplements; food supplements; herbal supplements; mineral supplements;

<p>Filing date: 12 September 2012 Date of entry in the register: 21 December 2012</p>	<p>vitamin supplements; protein supplements; dietetic food and substances adapted for medical use; food for babies; dietary supplements for humans and animals; vitamin, mineral, amino acid and protein preparations and substances; pharmaceutical and veterinary preparations; sanitary preparations for medical purposes.</p>
<p>UKTM No: 2634407</p> <p>BIOCEUTICALS ONEWOMAN</p> <p>Filing date: 12 September 2012 Date of entry in the register: 21 December 2012</p>	<p>Class 05: Dietary and nutritional supplements; food supplements; herbal supplements; mineral supplements; vitamin supplements; protein supplements; dietetic food and substances adapted for medical use; food for babies; dietary supplements for humans and animals; vitamin, mineral, amino acid and protein preparations and substances; pharmaceutical and veterinary preparations; sanitary preparations for medical purposes.</p>
<p>UKTM No: 2634599</p> <p>BIOCEUTICALS ONEMAN</p> <p>Filing date: 12 September 2012 Date of entry in the register: 28 December 2012</p>	<p>Class 05: Dietary and nutritional supplements; food supplements; herbal supplements; mineral supplements; vitamin supplements; protein supplements; dietetic food and substances adapted for medical use; food for babies; dietary supplements for humans and animals; vitamin, mineral, amino acid and protein preparations and</p>

	substances; pharmaceutical and veterinary preparations; sanitary preparations for medical purposes.
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4) The trade marks relied upon by the opponent are all earlier marks in accordance with section 6 of the Act and, as none had been registered for five years or more before the publication date of the applicants' mark, they are not subject to the proof of use requirements, as per section 6A of the Act.

5) The applicants filed a counterstatement denying that there is any similarity between the respective marks.

6) Neither party filed evidence. Only the opponent filed submissions. Neither party requested to be heard. Accordingly, I 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 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	Applicants' goods
Class 05: Dietary and nutritional supplements; food supplements; herbal supplements; mineral supplements; vitamin supplements; protein supplements; dietetic food and substances adapted for medical use; food for babies; dietary supplements for humans and animals; vitamin, mineral, amino acid and protein preparations and substances; <u>pharmaceutical and</u>	Class 05: Pharmaceutical preparations for animal skincare; Pharmaceutical skin lotions; Pharmaceutical implants; Pharmaceutical and veterinary preparations; Pharmaceutical compositions; Pharmaceutical creams; Pharmaceutical lipsalves; Pharmaceutical preparations for animals; Pharmaceutical preparations for veterinary use; Pharmaceutical

<u>veterinary preparations</u> ; sanitary preparations for medical purposes. (my emphasis)	preparations in strip form; Pharmaceutical sweets; Pharmaceutical preparations for skin care; Pharmaceutical preparations.
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10) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*‘Meric’*), the 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).”

All of the applicants’ goods fall within the opponent’s ‘pharmaceutical and veterinary preparations’ (underlined in the table above, for ease of reference). 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 General Court (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.”

13) The respective goods are not limited in any way; they could be prescription-only or self-selected from a retail shelf or requested over the counter. In terms of prescription-only goods the average consumer will be both the prescriber (doctors, pharmacists and veterinarians, for example) and the general public; for self-selected goods it will be the general public only.

14) As regards the level of attention that is likely to be paid, in *Aventis Pharma SA v OHIM*, Case T-95/07, the GC 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).”

15) Accordingly, whilst I would expect factors such as the cost, potency and potential side effects of the particular pharmaceutical/veterinary product in question to cause the level of attention to vary to a certain degree, it is always likely to be of a high level, both for the general public and the prescriber. Prescribers are likely to encounter the marks in medical journals/catalogues and discussions with pharmaceutical sales representatives. The general public are likely to obtain the goods through self-selection from a shelf, over the counter purchases, word of mouth recommendations or by prescription after discussion with a medical professional. Bearing all of this mind, I find that both visual and aural considerations are important in relation to both users.

The opponent’s best case

16) The opponent is relying on three earlier marks, as shown in the table above. It appears to me that the first mark listed in the table offers the opponent its best prospect of success since, aside from the word ‘BIOCEUTICALS’, the mark contains the abbreviation ‘LTD’ which is also present in the applicants’ marks. If the opponent does not succeed on the basis of that mark, it is even less likely to succeed on the basis of its other marks, given that the second words in those marks have no counterpart in the applicants’ mark (creating an additional point of difference). I will

therefore make the comparison solely on the basis of the opponent's 'BIOCEUTICALS LTD' mark.

Distinctive character of the earlier mark

17) 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).”

18) There is no evidence before me in this case and therefore, I can only take into account the inherent qualities of the earlier mark. The opponent submits that its mark is highly distinctive as it is not descriptive of the goods in its specification. The applicants makes no submissions on the point.

19) Dealing firstly with the 'Ltd' aspect of the mark, this is entirely non-distinctive as it simply indicates that the opponent is a limited company. The word BIOCEUTICALS does not appear to be present in any dictionary; it may be that it is invented. That is not to say, however, that it is incapable of portraying any meaning. When faced with a word, it is a natural instinct to attempt to make sense of it. There are certain invented words which may be evocative or suggestive of a concept(s) if there are aspects of the mark which resemble known words.¹ I think it likely that, whilst perceiving the mark as a whole, the average consumer will nevertheless recognise the 'BIO' part of the mark and the 'CEUTICAL' part of the mark as being suggestive of the words biological and pharmaceutical respectively. Accordingly, BIOCEUTICALS is allusive in relation to the opponent's 'pharmaceutical and veterinary preparations' and I find that its distinctiveness is low. As it is that element which imbues the mark with any distinctive character, I find that the distinctive character of the mark, as a whole, is also low.

Comparison of marks


20) 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.”

¹ *Usinor SA v OHIM* (Case T-189/05)

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.

21) For ease of reference, the marks to be compared are:

Opponent's mark	Applicants' mark
<p>BIOCEUTICALS LTD</p>	

22) The opponent's mark consists of the words BIOCEUTICALS LTD presented in plain block capitals. For reasons already given, the 'Ltd' aspect of the mark is entirely non-distinctive. It is the word BIOCEUTICALS which, although allusive of the nature of the goods for the reasons stated above, is nevertheless a distinctive element; indeed, it is the only distinctive element, and the one which overwhelmingly dominates the overall impression.

23) The applicants' mark consists of: i) an abstract device at the beginning of the mark presented in the colours pink and orange, ii) the words BioCeutics UK Ltd presented in green (with the BIO aspect being in a bold) and iii) the words PHARMACEUTICAL INDUSTRIES presented in grey. The first element is distinctive. The distinctiveness of the second element lies purely in the 'BioCeutics' aspect since UK and Ltd will be seen as entirely descriptive ('Ltd' meaning a limited company and UK' meaning United Kingdom). The third element is entirely non-distinctive, simply describing the nature of the applicants' business; it is likely to have little impact on the consumer. The 'BioCeutics' part of the mark has the greatest weight in the overall impression. The device also contributes to the overall impression but to a lesser extent.

24) I now turn to consider the visual similarities between the marks, reminding myself, firstly, that the colour in the applicants' mark is not a distinguishing feature because the opponent's mark, although presented in black and white, could be used in the same colours.² Whilst there are some visual differences between the marks owing to the presence of the device element, the word UK and the words PHARMACEUTICALS INDUSTRIES in the applicants' mark which are absent from the opponent's mark, the respective words 'BIOCEUTICALS' and 'Bioceutics' are clearly similar; although the former is longer than the latter and their endings differ ('ALS' on the one hand and 's' on the other), the first nine letters are clearly identical. On the whole, I consider there to be a reasonable degree of visual similarity between the marks.

25) The opponent's mark will be pronounced BY-OH-SUIT-IC-ALS LIM-IT-ID. The applicants' mark will be pronounced BY-OH-SUIT-ICS UK LIM-IT-ID. The device element will not be vocalised and I consider it unlikely that the 'Pharmaceutical Industries' element will be pronounced. On that basis, there is a high degree of aural similarity between the marks. However, if the whole of the applicants' mark were to be vocalised, there would still be a good degree of aural similarity.

26) In terms of the conceptual comparison, I bear in mind my earlier comments at paragraph 19 regarding the opponent's mark. As to the applicants' mark, the abstract device element evokes no concept and all of the other elements of the mark, aside from the word 'BioCeutics', are purely descriptive of the nature/location of the applicants' business. The word 'BioCeutics', in my view, will be perceived in much the same manner as the word 'Bioceuticals' in the opponent's mark, with the consumer being likely to recognise the 'Bio' part and 'Ceutics' part as being suggestive of the words biological and pharmaceutical respectively. I therefore find that, to the extent that the respective words 'Bioceuticals' and 'BioCeutics' do evoke the concepts I have identified, there is a high degree of conceptual similarity between the marks as a whole.

² *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96] Kitchin LJ stated: "A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours."

Likelihood of confusion

27) 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 principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of 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.*).

28) In reaching a conclusion, I bear in mind the following comments of the CJEU in *L'Oréal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (case C-235/05 P):

“42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

43. It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

44. In the second place, as was pointed out at paragraphs 35 and 36 of this judgment, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.

45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

29) I have found that, despite its low level of distinctiveness, the word BIOCEUTICALS overwhelmingly dominates the overall impression of the earlier mark (with 'Ltd' being entirely non-distinctive). I have also found that the element which carries the greatest weight in the overall impression of the contested mark is BioCeutics, with the other word elements being entirely non-distinctive, and the device being distinctive but less dominant than BioCeutics. Bearing those conclusions in mind, I went on to find that the marks have a high/good degree of aural similarity and a reasonable degree of visual similarity; both of these are important factors weighing in the opponent's favour, owing to the average consumer being likely to encounter the marks both orally and visually during the purchase. I have also found that the marks share a highly similar, albeit allusive, concept. Having carefully considered all of these factors, I come to the conclusion that the degree of similarity between the marks and the identity of the goods is such as to result in a likelihood of confusion, notwithstanding the high degree of attention that will likely be paid during the purchase.

OUTCOME

30) The opposition succeeds.

- The application is to be refused in respect of the goods in class 05.
- The application will proceed to registration in respect of the goods in class 01 which were not subject to opposition.

COSTS

31) 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:

Preparing the notice of opposition and considering the counterstatement	£200
Opposition fee	£100
Written submissions:	£300
Total:	£600

32) I order Mohamed Shawki El morsy Yousef & Bioceutics UK LTD, being jointly and severally liable, to pay Bioceuticals Limited 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**