O/429/21

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3479210
BY HEALTHSPAN LIMITED
TO REGISTER:

ImmunoVit

Immunovit

(SERIES OF TWO)

AS A TRADE MARK
IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 420733
BY NEWPORT PHARMACEUTICALS LIMITED

Background and Pleadings

1. On 3 April 2020, Healthspan Limited ("the applicant") applied to register the series of two trade marks ImmunoVit and Immunovit in the UK. The application was accepted and published in the Trade Marks Journal on 24 April 2020 in respect of the following goods:

> **Class 5:** *Dietary supplements; dietetic food preparations; nutritional supplements; vitamin and mineral preparations; food supplements; health food supplements made principally of vitamins; vitamin supplements for foodstuffs for human consumption; vitamin tablets; vitamin supplements.*

2. Newport Pharmaceuticals Limited ("the opponent") opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act").

3. The opposition is based on the earlier UK Trade Mark no. 1191323 for the trade mark IMUNOVIR which was filed on 1 March 1983 and became registered on 1 March 1983 in relation to the following goods:

> **Class 5:** *Anti-viral and immuno-stimulant preparations, all for pharmaceutical use.*

4. The opponent submits that there is a likelihood of confusion, including a likelihood of association, because the respective marks are similar, and the goods are either identical or similar.

5. The applicant filed a defence and counterstatement denying claims made and putting the opponent to proof of use for the earlier mark.

6. The opponent is represented by Keltie LLP; the applicant is represented by IP Lab Limited. The opponent filed evidence and written submissions. Although I do not intend to summarise the submissions here, I bear them in mind and will refer to them as necessary throughout the decision. The applicant filed nothing beyond a

counterstatement. No hearing was requested and no written submissions were filed in lieu of a hearing. The decision is taken following a careful perusal of the papers.

Evidence

Opponent's evidence

7. The opponent's evidence consists of the witness statements of Alan Johns dated 4 December 2020 and Conor O'Daly dated 4 January 2021 and six exhibits.

8. Alan Johns is the General Manager of Newport Pharmaceuticals Limited, i.e. the opponent in these proceedings, and in his witness statement he explains the composition and production of the drug IMUNOVIR, and the business relationship between Newport Pharmaceuticals Limited and Kora Healthcare Limited. For the purpose of this decision, it suffices to say that IMUNOVIR is a medicine containing the active ingredient inosine acedoben dimepranol which was invented by Newport Pharmaceuticals Int. Inc (hereafter NPII) in the USA. NPII transferred their intellectual property rights for the IMUNOVIR trade mark to the opponent in 1996. The opponent became the market authorisation holder for the IMUNOVIR product in 1996 and marketed IMUNOVIR in the UK until 2011 when it transferred the market authorisation rights to Kora Healthcare Limited, who has since marketed and used the IMUNOVIR trade mark with the opponent's permission.

9. Conor O'Daly is the Chief Executive Officer of Kora Healthcare Limited. In his witness statement Mr O'Daly confirms that his company acquired the market authorisation rights for the IMUNOVIR product in 2011 and has marketed the IMUNOVIR trade mark, with the permission of the opponent, in the UK continuously since that date. Mr O'Daly states that since his company has acquired the market authorisation rights for IMUNOVIR, they "have sold a significant amount of goods to the public under the brand". The volume and value of the sales reported are as follows:

	2015	2016	2017	2018	2019	2020 to date
100 tab packets sold	1284	1242	1040	1076	1290	1399
Revenue in GBP	50,718	49,059	41,080	42,502	50,955	55,261

Attached to Mr O'Daly's witness statement are the following exhibits:

- **Exhibit COD1** is a marketing authorisation notice granted by the Medicines and Healthcare Products Regulatory Agency to Kora Corporation Limited in relation to Imunovir 500 mg tablets.
- **Exhibit COD2** consists of a selection of invoices for the sale of Imunovir from Kora Healthcare to Alliance Healthcare Distribution Limited, a UK business with an address in Northwich.
- **Exhibit COD3** are images of the packaging of 100 tablets of inosine acedoben dimepranol displaying the Imunovir mark in the following form:

- **Exhibit COD4** is an example of a patient leaflet that is supplied with Imunovir products.
- **Exhibit COD5** are the brand guidelines that Kora Healthcare use in relation to Imunovir products.
- **Exhibit COD6** are further invoices of sale from Kora Healthcare to Alliance Healthcare Distribution Limited for Immunovir products.

Section 5(2)(b)

10. Section 5(2)(b) of the Act is as follows:

> (2) A trade mark shall not be registered if because –
>
> (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."

11. An earlier trade mark is defined in Section 6 of the Act, the relevant parts state:

> "6(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered."

12. The opponent's mark qualifies as an earlier mark within the meaning of Section 6(1) of the Act because it has an earlier filing date than the contested application. The earlier mark had been registered for more than five years on the date on which the opposed application was filed and, as a result, is subject to proof of use.

13. Although the UK has left the EU, Section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Proof of use

Relevant statutory provision: Section 6(A)

14. (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

15. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

"114……The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and

frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

16. Section 100 of the Act states that:

> "100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

17. The burden of proof is on the opponent to show genuine use of the earlier mark as requested.

Form of the mark

18. The earlier mark is IMUNOVIR. There are examples of the earlier mark being used in blue, in title case, in a Calibri font and with a registered trademark symbol, for

example, on packaging and on a patient leaflet. Clearly, this will be use upon which the opponent can rely, because word-only marks cover use in all possible fonts, typefaces and colour.

19. Although Mr O'Daly explained in his evidence that in some of the invoices the products are referred as "Immunovir" (rather than "Imunovir") due to a typographical error, the use shown on packaging and on the patient leaflet shows use of the correct name, i.e. Imunovir, and it is sufficient, in my view, to demonstrate use of the mark as registered.

Genuine use

20. The goods for which the opponent must prove use are:

> **Class 5:** Anti-viral and immuno-stimulant preparations, all for pharmaceutical use.

21. The relevant period for proving use is 4 April 2015 – 3 April 2020.

22. The evidence is that NPII transferred their intellectual property rights for the mark IMUNOVIR to the opponent in 1996. In 2011 the opponent transferred the market authorisation rights to Kora Healthcare Limited who have marketed and used the mark with the opponent's consent from then and up to this date. On that basis, I am satisfied that Kora Healthcare Limited has used the earlier mark with the consent of its proprietor.

23. The evidence also confirms that between 2015 and 2020 the following quantities of products (in packets of 100 tablets) were sold: 1284 (2015), 1242 (2016), 1040 (2017), 1076 (2018), 1290 (2019) and 1399 (2020) for a total of 7,331 units of product sold. A revenue of about £50,000 a year was generated from these sales for a total of £289,575 over the same period.

24. Although the evidence is sufficient to establish there have been some sales of IMUNOVIR branded products in the UK within the relevant period, the relevant test is

whether the use shown is sufficient to qualify as genuine - if there has been a real attempt to carve out a share in the market.

25. Whilst there is no de minimis rule for finding genuine use in the UK, not every instance of commercial use may be found to be genuine use. In making my assessment I am required to consider all the relevant factors.

26. Genuine use is not a test of a company's economic success, but I must be satisfied that the use is "warranted in the economic sector concerned to maintain or create a share in the relevant market for the goods or services protected by the mark".

27. In *Naazneen Investments Ltd v OHIM*, Case T-250/13, the General Court (GC) upheld a decision by the OHIM Board of Appeal that the sale of EUR 800 worth of non-alcoholic beverages under a mark over a 5 year period, which had been accepted was not purely to maintain the trade mark registration, was insufficient, in the economic sector concerned, for the purposes of maintaining or creating market share for the goods covered by that Community trade mark. The use was therefore not genuine use. The relevant part of the judgment of the GC is as follows:

> "46. In the fifth place, the applicant argues that, in accordance with the case-law cited in paragraph 25 above, use of a trade mark is to be regarded as token if its sole purpose is to preserve the rights conferred by the registration of the mark. It claims that the Board of Appeal contradicted itself by stating, on the one hand, in paragraph 31 of the contested decision, that the total amount of transactions over the relevant period seemed to be token, and by stating, on the other hand, in paragraph 42 of the contested decision, that it did not doubt the intention of the proprietor of the mark at issue to make real use of that mark in relation to the goods in question.
>
> 47. In this connection, suffice it to point out that the applicant's argument is based on an incorrect reading of the contested decision. The Board of Appeal used the term 'token' to describe the total amount of transactions, approximately EUR 800, and not to categorise the use of the mark at issue.

48. In the sixth place, the applicant claims that the Board of Appeal, by relying solely on the insufficient use made of the mark at issue, did not comply with the case-law according to which there is no quantitative threshold, determined a priori and in the abstract, that must be chosen in order to determine whether use is genuine. The Board of Appeal also failed to comply with the case-law according to which even minimal use may be sufficient in order to be deemed genuine.

49. According to the case-law, the turnover achieved and the volume of sales of the goods under the mark at issue cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking using the trade mark and the characteristics of the goods or services on the relevant market. As a result, use of the mark at issue need not always be quantitatively significant in order to be deemed genuine (see, to that effect, judgments in *VITAFRUIT*, cited in paragraph 25 above, EU:T:2004:225, paragraph 42, and *HIPOVITON*, cited in paragraph 27 above, EU:T:2004:223, paragraph 36). Even minimal use can therefore be sufficient in order to be deemed genuine, provided that it is warranted, in the economic sector concerned, to maintain or create market shares for the goods or services protected by the mark. Consequently, it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine. A de minimis rule, which would not allow OHIM or, on appeal, the General Court, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order of 27 January 2004 in *La Mer Technology*, C-259/02, ECR, EU:C:2004:50, paragraphs 25 and 27, and judgment of 11 May 2006 in *Sunrider* v *OHIM*, C-416/04 P, ECR, EU:C:2006:310, paragraph 72).

50. In the present case, contrary to what the applicant claims, the Board of Appeal did not determine a minimum threshold ‘a priori and in the abstract’ so as to determine whether the use was genuine. In accordance with the case-law, it examined the volume of sales of the goods in question in relation to other factors, namely the economic sector concerned and the nature of the goods in question.

51. The Board of Appeal accordingly took the view that the market for the goods in question was of a significant size (paragraph 28 of the contested decision). It found also that the goods in question, namely non-alcoholic beverages, were for everyday use, were sold at a very reasonable price and that they were not expensive, luxury goods sold in limited numbers on a narrow market (paragraph 29 of the contested decision). Furthermore, it took the view that the total amount of transactions over the relevant period, an amount of EUR 800, seemed to be so token as to suggest, in the absence of supporting documents or convincing explanations to demonstrate otherwise, that use of the mark at issue could not be regarded as sufficient, in the economic sector concerned, for the purposes of maintaining or creating market shares for the goods covered by that mark (paragraph 31 of the contested decision).

52. It is therefore apparent, contrary to what the applicant claims, that it was in accordance with the case-law cited in paragraph 49 above that the Board of Appeal took the view that, in the present case, minimal use was not sufficient to be deemed genuine."

28. The judgment of the GC was upheld on further appeal to the CJEU: see Case C-252/15 P. See also the decisions of the Appointed Person in *Jumpman,* BL O/222/16 and *Strada Del Sole* BL O/528/15.

29. Although I have no evidence or submissions from the parties to assist me on the matter of the size of the UK market for the goods concerned, i.e. anti-viral and immuno-stimulant preparations, for pharmaceutical use, I believe the market in the UK to be substantial, numbering in millions, if not billions, of pounds per annum. The evidence of sales totals £289,595 from 2015 to 2020 and a total of 7,331 units were sold during that time. Although the sales appear to have taken place consistently over the five-year period, these figures are very small, taking into account the likely size of the market for the goods and the number of units sold.

30. Further, all of the goods have been purchased by one customer in the UK. Although use of the mark by a single client can be sufficient to demonstrate genuine use, I also take into account the territorial and quantitative limits of the use shown and

the likely impact upon the market concerned of selling 7,331 units of products within a 5-year period. Furthermore, no evidence has been provided relating to advertising material or advertising spend.

31. On balance, my conclusion is that the evidence is not sufficient to conclude that the opponent had genuinely used the mark in the UK during the relevant period. If I was wrong about this, I will proceed to assess what would be a fair specification in the circumstances and make a decision based on that specification.

Fair specification

32. I must consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon.

33. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

34. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)*,* Mr Justice Carr summed up the law relating to partial revocation as follows.

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

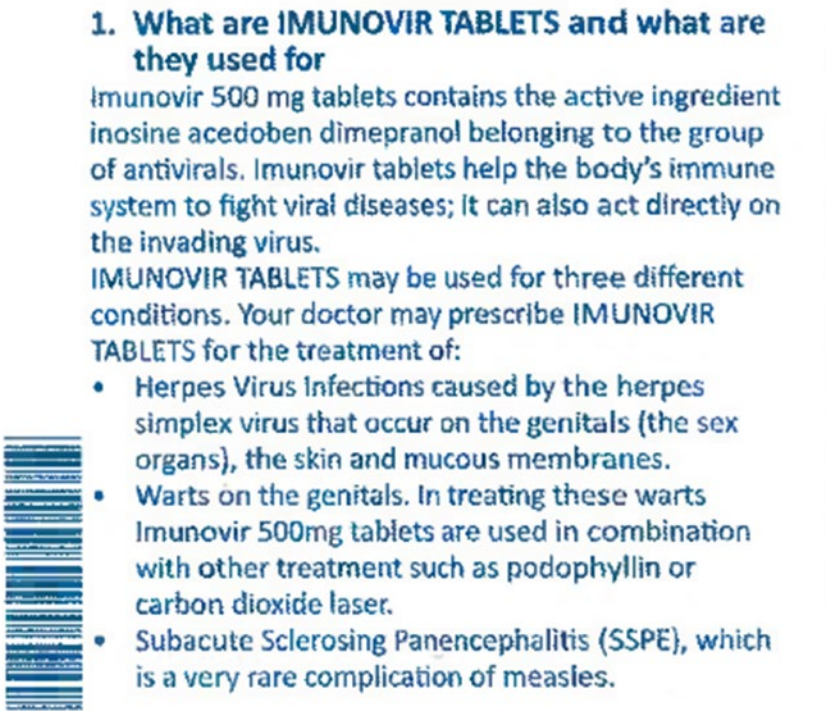
vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Pl*c [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

35. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the

purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs.

36. The opponent relies on *Anti-viral and immuno-stimulant preparations, all for pharmaceutical use* in class 5. I note from the evidence provided that the mark IMUNOVIR has been used in the UK in relation to pharmaceutical products for treating herpes virus infections, warts on the genitals and subacute sclerosing panencephalitis as confirmed by the copy of the leaflet filed by the opponent which is shown below:[1]



1. What are IMUNOVIR TABLETS and what are they used for

Imunovir 500 mg tablets contains the active ingredient inosine acedoben dimepranol belonging to the group of antivirals. Imunovir tablets help the body's immune system to fight viral diseases; it can also act directly on the invading virus.

IMUNOVIR TABLETS may be used for three different conditions. Your doctor may prescribe IMUNOVIR TABLETS for the treatment of:

- Herpes Virus Infections caused by the herpes simplex virus that occur on the genitals (the sex organs), the skin and mucous membranes.
- Warts on the genitals. In treating these warts Imunovir 500mg tablets are used in combination with other treatment such as podophyllin or carbon dioxide laser.
- Subacute Sclerosing Panencephalitis (SSPE), which is a very rare complication of measles.

I also note that the UK figures do not include sales of pharmaceutical preparations for treating any conditions other than those listed above.

37. Taking all of this into account, I do not consider the use shown to be broad enough to allow the opponent to rely on *Anti-viral and immuno-stimulant preparations, all for pharmaceutical use*. I consider a fair specification of the mark to be:

> **Class 5**: *Anti-viral and immuno-stimulant preparations, for the treatment of herpes virus infections, warts on the genitals and subacute sclerosing panencephalitis.*

Exhibit COD4

Section 5(2) - Case law

38. The following principles are gleaned from the decisions of the EU courts in *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.

(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 impression 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 greater 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 to mind the earlier mark, 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 the goods

39. The goods to be compared are as follows:

Applicant's goods	Opponent's goods
Class 5: *Dietary supplements; dietetic food preparations; nutritional supplements; vitamin and mineral preparations; food supplements; health food supplements made principally of vitamins; vitamin supplements for*	**Class 5:** *Anti-viral and immuno-stimulant preparations, for the treatment of herpes virus infections, warts on the genitals and subacute sclerosing panencephalitis.*

foodstuffs for human consumption; vitamin tablets; vitamin supplements.	

40. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> "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".

41. Guidance on this issue has also come from Jacob J. (as he was then) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> (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."

42. The GC provided guidance on the comparison of pharmaceutical goods in the judgment of 15 December 2010, T-331/09, 'Tolposan', paras 35-36:

> '35 It should be noted that goods such as medicines have the same nature (pharmaceutical products), purpose (treatment of human health problems), consumers (medical professionals and patients) and distribution channels (typically pharmacies). This is apparent from the goods at issue belonging to the same general category of goods: medicines. However, this is a very wide category and includes goods which may be different. Thus it must be concluded that medicines belonging to the same general category of goods only allow the finding of a low degree of similarity between all the medicines.
>
> 36 As the factors taken into account at paragraph 35 above cannot be used to distinguish different sub-categories of medicines, it is necessary to have regard to other factors, in order to properly assess the similarity between the medicines. These factors are, in particular, whether these medicines are in competition with each other or complementary, as well as their purpose and their specific intended use (treatment of specific health problems). In taking these factors into account, a medicine's therapeutic indication is of decisive importance.'

43. The applicant does not clearly submit its view on the similarity of goods at issue. On one hand, the applicant submits that there is a low level of similarity due to differences in trade channels and the opponent's "discrete" goods. On the other hand, the applicant submits that the goods are not the same or confusingly similar due to different trade channels and users. The opponent submits that the goods are similar as they coincide in the purpose and trade channels.

44. The contested specification includes a range of dietary supplements and vitamins, namely *dietary supplements; nutritional supplements; vitamin and mineral preparations; food supplements; health food supplements made principally of*

vitamins; vitamin supplements for foodstuffs for human consumption; vitamin tablets; vitamin supplements. These goods are used to supplement a normal diet or because they are considered beneficial to health. Although I bear in mind the GC's decision about the existence of a low degree of similarity amongst medicines belonging to the same general category of goods, I do not consider the applicant's goods to be medicines. The applicant's supplements and vitamins are products intended to supplement the diet and correct nutritional deficiencies and are not intended to treat, diagnose, mitigate, prevent, or cure diseases. They do not have the same nature or purpose of the opponent's *Anti-viral and immuno-stimulant preparations, for the treatment of herpes virus infections, warts on the genitals and subacute sclerosing panencephalitis* which are medicines used to stimulate the immune system and treat specific infections caused by viruses listed above. The goods have different uses and methods of use and although they might be found in the same pharmacies, they are unlikely to be found in close proximity. In this connection the product leaflet exhibited by the opponent states "this medicine has been prescribed for your use only" which suggests that the opponent's goods are prescription only goods. Finally, the goods are neither in competition nor complementary. Similarly, *dietetic food preparations* differ in nature, purpose and specific intended use, as they are used as diet replacement for weight loss or designed for special dietary requirements, such as for example, infant formulae and foods for elderly, and are neither complementary nor in competition to the opponent's goods. Taking these factors into account, I find that the goods are dissimilar.

45. As some degree of similarity between the goods is necessary to engage the test for likelihood of confusion,[2] the opposition must fail in respect of all of goods in the applicant's specification since I have found that they are all dissimilar to the opponent's goods.

OUTCOME

46. The opposition has failed. The application will proceed to registration.

[2] eSure Insurance v Direct Line Insurance [2008] ETMR 77 CA

Costs

47. The applicant has been successful as it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 2/2016. In the circumstances, I award the applicant the sum of £500 as a contribution towards its costs. The sum is calculated as follows:

Preparing a counterstatement and considering the opponent's statement	£300
Considering the opponent's written submission and evidence	£200
Total	**£500**

48. I therefore order Newport Pharmaceuticals Limited to pay Healthspan Limited the sum of £500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 7th day of June 2021

A Klass
For the Registrar,
the Comptroller - General