O/0162/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3622005
IN THE NAME OF PHILIP MORRIS PRODUCTS S.A.
IN RESPECT OF THE TRADE MARK

CEMAkit

IN CLASSES 5 & 10

AND

OPPOSITION THERETO UNDER NO. 426668
BY ADVANCED ACCELERATOR APPLICATIONS INTERNATIONAL SA

Background and pleadings

1. Philip Morris Products S.A. (“the applicant”) applied to register the trade mark CEMAkit in the UK on 6 April 2021. The application was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and retains the EU filing date of 23 October 2020. It was accepted and published in the Trade Marks Journal on 4 June 2021 in respect of the following goods:

> Class 5: *Diagnostic biomarker reagenses and diagnostic preparations for medical use.*
>
> Class 10: *Diagnostic devices for medical use.*

2. ADVANCED ACCELERATOR APPLICATIONS INTERNATIONAL SA (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act"). This is on the basis of its earlier UK designation of International Trade Mark registration no. 1115453 and its UK comparable mark registration no. 801236760 based upon the EU designation of an International Registration. Further details of the registrations and the goods relied upon in this opposition are outlined below:

Trade Mark/Registration number	**Date of protection**	**Goods relied upon**
SOMAKIT / 1115453	Designation date: 3 February 2017 Date of protection in the UK: 11 May 2017	Class 5: Radiopharmaceuticals for use in the field of nuclear medicine, intended for medical imaging and therapy.
SOMAKIT-TOC / 801236760	Priority date: 24 June 2014 Filing date 17 December 2014	Class 5: Radiopharmaceutical products used in the field of nuclear medicine, for medical imaging and therapy.

	Registration date: 29 December 2015	

3. By virtue of their earlier designation and priority dates, the above marks constitute earlier marks in accordance with section 6 of the Act.

4. The opponent argues that the respective goods are identical or similar and that the marks are similar and share a common suffix, and that as such there is a likelihood of confusion on the part of the public.

5. The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier trade mark no. 801236760 relied upon.

6. Both sides filed evidence in these proceedings. This will not be extensively summarised at the outset of this decision but will be referred to the extent that it is considered necessary throughout.

7. A Hearing took place on 24 November 2022. The opponent is represented in these proceedings by Abel & Imray LLP, and appointed Stephanie Wickenden of Searle Court to be its representative at the hearing. The applicant is represented in these proceedings by Reddie & Grose LLP, and appointed Jamie Muir Wood of Hogarth Chambers to be its representative at the hearing.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

9. As mentioned above, I do not intend to provide an in-depth summary of the evidence at this stage. However, for ease of reference later in this decision, I will briefly identify the witness statements and exhibits filed by the parties.

10. The opponent's evidence in chief comprises a witness statement in the name of Wojciech Kreft, senior IP Counsel at the opponent's parent company Novartis AG, and an authorised signatory for the opponent. The statement introduces 6 exhibits, namely Exhibit WK1 – Exhibit WK6 and is dated 17 March 2022.

11. The applicant's evidence comprises a witness statement in the name of Daniel Sullivan, a trade mark attorney at the applicant's representative firm Reddie and Grouse LLP. The statement introduces 16 exhibits, namely Exhibit DS1 to Exhibit DS16 and is dated 17 May 2022.

12. The opponent opted to file evidence in reply in the form of a witness statement from Rebecca Atkins, a trade mark attorney and senior associate at the opponent's representative firm Abel & Imray LLP. The statement introduces a single exhibit, namely Exhibit RA1 and is dated 11 July 2022.

Proof of use

13. Within its TM8, the applicant originally requested that the opponent provide proof of use of its earlier mark SOMAKIT-TOC, registration no. 801236760. However, it was stated at paragraph 5 of the skeleton arguments provided on behalf of the applicant:

> "The Applicant accepts that the evidence shows proof of use of the Earliest Mark so that is no longer in dispute. The applicant has informed the Opponent of this."

14. The opponent may therefore rely upon all the goods as pleaded in respect of both of its earlier marks relied upon.

Preliminary issues

15. Within the opponent's skeleton arguments, it stated as follows:

> '*Preliminary point on Applicant's pleaded case and evidence*':

> “18. It is important to note that the entirety of the pleaded case on similarity of marks is that “They are distinct on the basis of a visual, aural and conceptual comparison” (§4 of Counterstatement) which is coupled with a bare denial of likelihood of confusion (§6 Counterstatement). No further reasoning or submissions have been set out by the Applicant in support of its denials. The Opponent fully reserves its position to allege that the Applicant cannot rely on arguments for which there is no foundation in the pleadings.
>
> 19. It is difficult to anticipate what the Applicant’s evidence will be relied upon for given the lack of pleading and submissions. This is problematic in principle and the Opponent fully reserves its position on lack of pleading as aforesaid. The Opponent did its best to interpret the Applicant’s evidence by way of its evidence and observations in reply dated 11 July 2022, and it is addressed below to the extent anticipated in that reply. To the extent that any argument is run which goes beyond that which the Opponent has sought to anticipate in this document, those arguments shall certainly be resisted.”

16. The evidence filed by the applicant at Exhibit DS1 is a definition of the word ‘Soma’ from what Mr Sullivan describes as an online medical dictionary with the web address www.medical-dictionary.thefreedictionarty.com within his witness statement. Exhibit DS2 also provides information on parts of words medical words and what they mean from Appendix A of what Mr Sullivan explains is the National Library of Medicine website at https://medlineplus.gov/. This includes the definition of ‘somat’, ‘somatico’ and ‘somato’. This exhibit also provides an extract from the Miriam Webster Dictionary defining ‘soma’, and Exhibit DS3 provides a page from the website www.britannica.com defining ‘somatosatin’.

17. Exhibits DS4 – DS16 comprise print outs from the UK IPO register and print out from third party websites showing other marks making use of the ‘SOMA’ prefix under which various medical products are sold. Two of these marks are owned by Ipsen Pharma SAS, ten are owned by Siemens Healthcare GmbH, and one is owned by Pfizer Inc.

18. Referring to Exhibit DS1 and Exhibit DS2 within its submissions in reply to the applicant's evidence, the opponent stated:

> "It is unclear what the relevance of this evidence is, as there is no direct link between the meaning of SOMA and the Opponent's goods."

19. In addition, when referring seemingly to the evidence filed at Exhibit DS4 – Exhibit DS16 within its submissions in reply, the opponent submits:

> "For all of the above reasons, we submit that the presence of, in effect, three other SOMA marks on the trade mark register or on the market for different goods is insufficient to render that element descriptive in relation to the particular goods for which the Opponent has used its Earlier Mark, or those covered by the contested mark."

20. Within the skeleton arguments filed by the applicant, the following arguments are made at least partially based on the evidence filed:

> "Inherent distinctive character of the earlier marks
>
> 23. Starting with the Second Earlier Sign, it is for the word 'SOMAKIT'. The 'KIT' element is lowly distinctive, as it simply implies that the product is a tool or mechanism for delivering a particular service. The word 'SOMA' has two possible meanings.
>
> 24. One, as indicated in the evidence of Daniel Sullivan, is that 'SOMA' means 'the body of an organism' from the Greek, 'sôma', meaning 'body'. In those circumstances, the Second Earlier Sign simply means a kit for the body."
>
> 25. The second is indicated in the evidence filed by Wojciech Kreft. Whilst he is careful not to refer expressly to it in his statement, exhibits WK1 and WK2 both make it clear that the product sold under the Earliest Sign is designed to attach to receptors called somatostatin receptors [**Tab 4, p3**]. In those

circumstances, the Second Earlier Sign means a kit to identify somatostatin receptors, with ‘SOMA’ being a shortening of ‘somatostatin’.

And

“39. For the reasons set out above, the average consumer, paying a very high degree of attention, will differentiate between the signs, despite any similarity in goods. In the circumstances, there will be no likelihood of confusion.

40. This is particularly the case where ‘SOMA’, as a prefix, is being used by others in the industry, for example Siemens in SOMATOM, a full-body tomography machine. Medical professionals will not expect Siemens to be behind SOMAKIT and nor would they expect the Opponent to be behind CEMAkit.”

21. At the hearing, I took submissions from both Ms Wickenden for the opponent and from Mr Muir Wood for the applicant on the point raised by the opponent within its skeleton arguments. Ms Wickenden reiterated that the entirety of the argument originally made by the applicant regarding the marks was that they are distinct based on basis of the visual, conceptual and aural comparison, and that no point was made that the earlier marks are lacking in inherent distinctiveness. Ms Wickenden submitted that it is then argued in quite specific terms that there is a lack of inherent distinctiveness on a number of bases. At the hearing, Ms Wickenden submitted:

“I think it is fairly well accepted that if an argument of acquired distinctiveness is to be relied upon it needs to be properly pleaded and we say it should follow that if specific criticisms are made on the basis of low inherent distinctiveness that should be properly pleaded so that, if need be, that can be rebutted by way of pleadings and evidence on acquired distinctiveness. That is the basis upon which we make that point. We say that it is not open to the applicant to make these specific arguments on the basis of low inherent distinctiveness where it is not pleaded.”

22. On the contrary, Mr Muir Wood submitted for the applicant:

> “I think it is understood that you need to plead acquired distinctiveness, but the inherent distinctiveness of the mark is a matter of submission based on the evidence that has been put forward in the pleadings.
>
> On the points that my learned friend made the meaning of the word SOMA has been put forward in evidence by the applicant, the fact that the opponent's products are used in respect of somatostatin receptors only came out in their own evidence which they provided to provide of use of the SOMAKIT-TOC mark. To suggest that one needs to plead the precise level of inherent distinctiveness of a mark at the outset I do not know, I do not understand any basis for that position. Where it is, as it is here, in a TM8 counter statement, there is no pleading in response to that so there is no opportunity for the other side to say "I am going to introduce an argument of acquired distinctiveness". It is for the opponent to plead acquired distinctiveness or not at the outset if that is what it chooses to do. It has not done so here and the evidence that is before you certainly would not support that in any event.
>
> It is really for you to decide the inherent distinctiveness of the mark before you on the basis of the evidence and the submissions. I do not understand the basis for excluding those submissions as my learned friend puts forward just now.”

23. I note at this stage that I consider the references to ‘acquired’ distinctiveness made by the parties to be referring to the possible enhanced distinctiveness of a mark, as appropriate in the context of section 5(2)(b). I do not consider that the applicant has at any point attempted to argue that the earlier marks are entirely devoid of distinctive character, and indeed the case law tells us it would be wrong to do so in the context of this ground.[1]

24. As I explained to the parties at the hearing, it is my view that filing dictionary definitions or evidence pointing towards the meaning of the mark in a medical context

[1] See *Formula One Licensing BV v OHIM,* Case C-196/11P

does foreshadow an argument regarding the level of distinctiveness of the mark, and I note the opponent has commented on that evidence in relation to the distinctiveness and the lack of descriptiveness of the mark and within its submissions in reply during the evidence rounds. I therefore do not consider this to be an argument that the opponent could not and did not foresee prior to the hearing. Further, as I also explained at the hearing, it is incumbent on me to consider the level distinctive character held in a trade mark, based on my own assessment, with consideration to the evidence and arguments before me. I do not therefore consider that an argument that a mark holds only a low level of distinctive character needs to be specifically pleaded, or that I must dismiss evidence and subsequent arguments made on this point if it is not.

25. In addition, I note that distinctiveness may be inherent, but that it may also be enhanced through use. In the UK Intellectual Property Office decision issued by Mr Oliver Morris in the opposition against the trade mark NEXT LEVEL,[2] Mr Morris stated as follows:

> "In my view, and whilst I accept the general point that pleadings should be as full as possible so as to set out the scope of the dispute, the absence of any specific reference in the pleadings to enhanced distinctiveness is not fatal to the opponent's case. This is because the assessment of distinctiveness is one of the fundamental factors that needs to be assessed in every case and, as is clear from the case-law, this can come from either the inherent nature of the mark, its use, or indeed a combination of both. Therefore, if evidence has been filed, which it has in the case before me, it is incumbent upon me to factor that evidence into the assessment to decide upon the overall distinctiveness of the earlier mark. It would be perverse to do otherwise, as it would require a pretence as to the true level of distinctiveness on the part of the average consumer, based on a technicality."

26. Whilst I am not bound by the decisions issued by other Hearing Officers in UK opposition proceedings, I agree fully with the reasoning set out by Mr Morris above,

[2] Case O-379-19

and I find this to be the correct approach to take in instances where enhanced distinctive character (or indeed a low level of distinctive character of the earlier mark) is not specifically pleaded.

27. On the basis of the above, as I explained to the parties at the hearing, I do not find there to be any reason for me to dismiss evidence or arguments made regarding the distinctiveness of the marks by either party based on a lack of pleadings at this stage. Of course, that is not to say that all of the evidence filed is convincing or sufficient to support the arguments made by the parties, and this will be properly assessed at the relevant stage within this decision.

28. One further point raised at the hearing that I find it appropriate to address at this stage is whether the first earlier sign SOMAKIT is a word mark or a figurative mark. This international registration is displayed on the UK IPO register as 'SOMAKIT'. This was raised by Ms Wickenden in particular, who submitted that the way the mark is displayed is due to the international registration system using a different font to the UK IPO register, but that it is classified as a word mark, and that she had confirmed as such using 'TMview'. I agree with Ms Wickenden that this mark appears to be a word mark and I will proceed with this decision on this basis. However, if I am wrong, I also agree with Ms Wickenden's submission that nothing will turn on this point.

Decision

Section 5(2)(b)

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

> "5(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".

30. Section 5A of the Act is as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

The Principles

31. 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.

> *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 might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

32. 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".

33. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

> (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.

34. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "… 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) (IP TRANSLATOR)* [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."

35. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06, the General Court ("GC") stated there is "complementary" where:

> "...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".

36. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the GC stated that:

> "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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

37. With these factors in mind, the goods for comparison are set out below:

Earlier goods	**Contested goods**
Class 5: Radiopharmaceuticals for use in the field of nuclear medicine, intended for medical imaging and therapy.[3]	*Class 5: Diagnostic biomarker reagenses and diagnostic preparations for medical use.* *Class 10: Diagnostic devices for medical use.*

38. Both parties made submissions on the similarity of the goods at the hearing. The opponent in particular also directed me to various parts of the evidence filed. Whilst I will not summarise these submissions in full here, I have fully considered the arguments made, and I have outlined below some of the main points below.

39. The opponent's arguments made regarding *diagnostic preparations for medical use* and *Diagnostic devices for medical use*:

- Within his witness statement, Mr Kreft refers to the use of the opponent's SOMAKIT-TOC mark as being in respect of "diagnostic preparations.[4] He also later references the product as comprising "radiopharmaceutical diagnostic medicine, containing active substance, edotreotide".[5] As the request for proof of use is not being pressed, it is not open to the applicant to argue that the goods under the mark are not the same as radiopharmaceuticals for diagnostic use, and it is clear on the face of it that "radiopharmaceuticals for use in the

[3] Whilst the goods under earlier mark 801236760 differ by way of the omission of the word 'intended', this makes no impact on the protection provided, and as the results of the comparison will not be affected by considering the specification covered by 1115453 only. As such, I intend to conduct the goods comparison on the basis of the specification as registered under 1115453 only, with the outcome applicable to both earlier marks.
[4] See paragraph 2 of the witness statement of Mr Kreft.
[5] See paragraph 3 of the witness statement of Mr Kreft.

field of medicine, intended for medical imaging and therapy" are diagnostic preparations for medical use.

- Exhibit WK5 references the legal category of the SOMAKIT-TOC product as a medicinal product for diagnostic use, and also refers to a package kit for radiopharmaceutical preparation, supporting the contention that the class 5 goods registered and the class 5 goods applied for are "diagnostic preparations for medical use", which includes radiopharmaceuticals for use in the field of nuclear medicine intended for medical imaging and therapy.
- If the class 5 goods are not identical, given that the same product is described as both a radiopharmaceutical for diagnostic use and a diagnostic medicine they are at least highly similar.
- Mr Kreft's witness statement also confirms that after injection, a patient undergoes a tomography PET scan. This is significant because the goods are to be used in conjunction with a PET scan which is a diagnostic device. The SOMAKIT-TOC product is a radiopharmaceutical used for nuclear medicine and that is injected prior to medical imaging. Medical imagining requires a diagnostic device, so it is inherent in the specification and further supported by the evidence that there is complementarity with diagnostic devices for medical use as one is essential for the use of the other.

40. When questioned on whether there were any submissions to be made on behalf of the opponent regarding the contested *diagnostic reagenses for medical use*, Ms Wickenden submitted:

> "[…] we interpret […] *diagnostic biomarker reagenses and diagnostic preparations for medical use* as an overall broad category. We would say effectively that is one category within which we say the Class 5 goods fall within, so we are treating them as a broad umbrella category. If you would like me to address them as if they were separate, diagnostic biomarker reagenses, the same submissions can be made even if that it is looked at separately because effectively they are diagnostic preparations that react in a specific way, and radiopharmaceuticals for use in nuclear medicine would include those as well."

41. The applicant's position:

- There is no particular evidence to show that the class 5 goods are identical, and the hearing officer must compare the specifications of the goods as filed and registered, and not compare the specification as filed with what Mr Kreft says that the earlier specifications might mean or what he says the earlier mark might be used for.
- The earlier goods are registered for radiopharmaceuticals for medical imaging and therapy. The later goods are biomarkers, biomarker reagenses and diagnostic preparations. There is no overlap between those goods and there is no evidence to show an overlap between radiopharmaceuticals for imaging and therapy with biomarkers, nor is there any evidence that radiopharmaceuticals for imaging and therapy are diagnostic preparations.
- However, it is admitted there is some similarity between the class 5 goods, and that whilst the class 10 goods are further away, it is accepted that there may be a very low level of similarity between these goods based on the *Treat* factors and the *Boston Scientific* decision.

42. Having considered the evidence and submissions from both parties, I agree with the argument made on behalf of the applicant that it is the specification as filed and registered that is to be considered, and not the particular product offered under the opponent's mark that is important. Further, whilst I have considered the argument I believe to have been made by Ms Wickenden, that as the applicant has accepted the proof of use of the earlier mark SOMAKIT-TOC they have essentially accepted that the use made is use of the goods as registered, the sections of the opponent's evidence that have satisfied the applicant's request for proof of use have not been identified, and they have not conceded that all parts of the evidence provided by the opponent shows use of the exact goods as registered.

43. However, notwithstanding the points above, I note the evidence provided does assist the opponent in showing that radiopharmaceuticals such as the type described in their specification can and are used for diagnostic purposes, and that these may be injected into a person to highlight medical issues such as tumours during medical imaging. This supports what I find to be the ordinary and natural reading of the opponent's specification, which is that *radiopharmaceuticals for use in the field of*

nuclear medicine, intended for medical imaging and therapy are radioactive pharmaceutical substances that may be used either to help identify and thus diagnose medical issues during medical imaging, or to help treat a medical issue via the therapy specified.

44. I find the ordinary and natural meaning of the applicant's class 5 goods *Diagnostic biomarker reagenses* to mean a type of reactive substance[6] for use in biomarker diagnostics, which I consider to be the process of identifying particular 'biomarkers' or signs of a disease or medical issues for the purpose of diagnosing that issue. I consider that *diagnostic preparations for medical use* will include all types of preparations for use in diagnosing a medical problem.

45. As I have found *radiopharmaceuticals for use in the field of nuclear medicine, intended for medical imaging* to at least include, if not solely comprise those for diagnostic purposes, and I find these goods to be identical to the broad category of *diagnostic preparations for medical use* in line with the principles set out in *Meric*.

46. In the case of the *diagnostic biomarker reagenses* covered by the application, it is less clear to me from the evidence provided whether radiopharmaceuticals will be used as diagnostic *biomarker* reagenses in particular, which I find to be a narrower term. However, I still consider that they will likely have at least a very similar intended purposes, that being for use in medical diagnostics, they will likely share users by way of specialist medical professionals and hospitals. I consider that both being diagnostic medical substances they will likely share a similar method of use and nature. It is unclear whether the goods will be complementary or in competition, however, overall if these goods are not identical, I still find them to be similar to a high degree.

[6] I note the word '*reagenses*' was included within the specification originally recorded on the EU Intellectual Property Office register, and when this application to duplicate the EU mark on the UK IPO register was made, the term '*reagenses*' was then recorded within the specification of the application filed at the UK IPO. When writing this decision, I have noted that '*reagenses*' does not appear to feature in English dictionaries, with the closest word to this appearing to be 'reagents'. Regents are generally defined as reactive substances. This possible spelling or language error was not raised by either party at the hearing, and I note that Ms Wickenden defined *diagnostic biomarker reagenses* as meaning 'diagnostic preparations that react in a certain way'. Mr Muir Wood did not seek to define these goods nor did he seek to challenge this definition. I therefore take reagenses in the circumstances to mean a type of reactive substance.

47. In respect of the applicant's class 10 goods, namely *diagnostic devices for medical use* I consider these will include goods such as medical imaging devices. I consider these to differ in nature and method of use to the applicant's class 5 goods. However, I find the goods may be used together meaning they may share users, and I note that they share a broad intended purpose for diagnosing medical conditions. It is not clear whether the goods will share trade channels, with the apparatus likely to be expensive and possibly purchased directly from the manufacture. In any case, these are specialist goods and I do not have any evidence on how often (if at all) the trade channels will overlap, and in the absence of convincing evidence or submissions on this point I do not find this will be the case. In addition, whilst I consider that the goods will be at least important for one another, I agree with the submissions of Mr Muir Wood at the hearing that it is not clear whether these goods will typically come from the same origin, or whether the consumers of the goods, who in this case will be professionals, are likely to believe this to be the case. Further, I do not find the goods will be in competition with one another. Considering all of the factors, I consider the goods to be similar to between a low and medium degree.

Distinctive character of the earlier trade mark

48. 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 *WindsurfingChiemsee* 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)."

49. Firstly, I consider the evidence filed and pointed to by the applicant, and the arguments made on behalf of the same submitting that the earlier marks hold only a low degree of inherent distinctive character. In respect of register extracts for 'SOMA' prefix marks submitted between Exhibits DS4 – DS16, it is well established that state of the register evidence is not sufficient to show the distinctive character of an earlier mark has been weakened,[7] and I do not consider this evidence to hold any weight on its own. Whilst I note in this instance that this evidence has been backed up with websites showing use of the several 'SOMA' prefix marks on the market for medical related goods, I consider that these marks are only shown to derive from three separate entities, and I do not find this evidence to be particularly persuasive in showing that the element 'SOMA' will appear any less distinctive to the consumer based on this use. Further, I note the screenshots are all dated after the relevant date, that being after the filing date of 23 October 2020.

50. I also consider the evidence filed providing the definitions of the element 'SOMA' in the earlier mark. Exhibit DS1, that being a page from 'The Free Dictionary' provides several meanings for this element of the mark. These include the meaning of 'Soma' as the body of an organism or individual, a cell body, or as a hallucinogenic plant juice drink. Exhibit DS2 provides the definition of the word parts 'somat-, somatico-, and somato-as referring to 'body' or 'bodily' from the National Institutes of Health National Library of Medicine, as well as a print out from the Merriam-Webster dictionary which provides the same definitions for SOMA as outlined at Exhibit DS1, with the first and

[7] See *Zero Industry Srl v OHIM*, Case T-400/06

second definition given at DS1 being confirmed under the heading ‘Medical definition’ (albeit being slightly cut off in the print out).

51. Exhibit DS3 provides a page from the website www.britannica.com defining ‘somatosatin’. A passage from the page explains:

> “**somatostatin**, polypeptide that inhibits the activity of certain pancreatic and gastrointestinal hormones. Somatostatin exists in two forms: one composed of 14 amino acids and a second composed of 28 amino acids. The name somatostatin, essentially meaning stagnation of a body, was coined when investigators found that an extract of hypothalamic tissues inhibited the release of growth hormone from the pituitary gland. Somatostatin subsequently was found to be widely distributed throughout the central nervous system and to occur in other tissues.”

52. At the hearing, Mr Muir Wood for the applicant drew my attention to a reference in the opponent’s Exhibit WK2 as follows:

> “If you have WK2 open, however, on the second page, "how the SOMAKIT-TOC work?" We can see that the active substance in SOMAKIT-TOC...attaches specifically to receptors called somatostatin receptors. It is plain that the word SOMA in SomaKit is alluding to the somatostatin receptors which the particular product is used for. I accept my learned friend's submission, she wants to rely on the evidence to say one thing but she does not want to in respect of another thing, the specification is not limited to a kit that enables a radiopharmaceutical to attach to somatostatin receptors, but a medical professional familiar with somatostatin receptors is a liable to consider the possibility that a SomaKit is designed when it is a radiopharmaceutical that it is a radiopharmaceutical for attaching to somatostatin receptors.”

53. In light of the above, the applicant argues that the earlier marks hold a low level of distinctiveness in respect of the goods. The opponent argues on the other hand that the mark would most likely be considered to be a made-up word and it does not lend

itself to being broken up into the elements SOMA and KIT. However, the opponent submits that even if there is some recognition of SOMA (and its meaning in relation to the body) and KIT by medical professionals, this will not be significant enough to actually affect the level of distinctiveness of the mark given that overall it forms the distinctive created word of SOMAKIT.

54. Considering the evidence provided, it is my view that there will likely be a portion of medical professionals who recognise the 'SOMA' element of the earlier mark as alluding to the body. Whilst I agree with the submission made at the hearing by Ms Wickenden that it cannot be taken on judicial notice that the medical profession will have an understanding of Greek from which this word derives, I do not find that prevents me from finding that some medical professionals will have an understanding of the dictionary definitions of the word as provided. However, I do agree with Ms Wickenden that it seems unlikely and is at best unclear from the evidence that this meaning will be common knowledge amongst all professionals working in the medical sector, and that everyone involved in the purchasing process of the goods will be familiar with this meaning of SOMA.

55. In respect of the evidence that the opponent's particular product attaches specifically to receptors called somatostatin receptors, I accept that there will again likely be certain specialist medical professionals who will have a good knowledge of how some of the goods within the opponent's category of *radiopharmaceuticals for use in the field of nuclear medicine, intended for medical imaging and therapy* may work, and to whom the mark will allude to somatostatin receptors. However, I again find it unlikely and unclear from the evidence that all professionals working in the medical sector dealing with the category of goods as filed, including everyone involved in the purchasing process of these goods, will be familiar with this process, and it is not clear how common it is for goods within this category to work in this way.

56. Overall, I accept that for a significant portion of consumers, the use of SOMA in the earlier mark may allude to somatostatin receptors or to 'the body' generally. I find that for these consumers, the word KIT is also likely to be identified within the earlier mark SOMAKIT and will be considered to mean a set of items needed to carry out a specific job. In these instances, and in the context of the goods, overall the

distinctiveness of the earlier mark will fall at a below medium level.

57. However, I consider there will be a further significant portion of consumers to whom SOMA will appear to have no discernible meaning. Despite this, I still find it likely that the majority of these consumers within the medical field will recognise the word common word 'kit' at the end of the mark, and that this element will at least allude to the fact the goods may be provided in the form of a kit of some description. However, this does not mean that the distinctiveness of the mark as a whole will be inherently low, and on the basis that these consumers will not know what a 'SOMAKIT' comprises, I find the mark will hold a fairly high degree of distinctiveness inherently for this consumer group. I consider it unlikely that there will be a significant portion of consumers who will not identify the word KIT within the earlier mark as argued by the opponent, but if this were to be the case, I note the inherent distinctiveness of the mark would not be significantly affected and would remain fairly high.

58. The above conclusions may also be applied to the second earlier mark SOMAKIT-TOC, with SOMAKIT conveying the same meaning in the marks, and 'TOC' being a short additional element with no obvious meaning to the consumer.

59. During the hearing Ms Wickenden stated that the opponent would like it to be considered that the distinctiveness of the earlier marks has been enhanced through use. As I have set out previously, I also find it is incumbent on me to consider this at this stage.

60. When considering if the distinctiveness of a mark has been enhanced through use, it is the perception of the UK consumer that is key. I note the majority of the evidence focuses on the second earlier mark, that being SOMAKIT-TOC. The witness statement provided by Mr Kreft confirms that 'SomaKit TOC' was first approved for sale in the EU in 2016. UK sales of the goods since that stage are provided as follows:

Year	**Total no. of units sold**	**Total value of units sold (GBP)**
2016	35	13,000
2017	186	125,000

2018	297	221,000
2019	208	193,000
2020	442	437,000

61. I also note the invitations provided at Exhibit WK5 which Mr Kreft confirms were distributed to academics and healthcare professionals to meetings held between December 2017 and September 2020. The invitations all make reference to 'SomaKit TOC'.

62. There is no evidence showing of the size of the market for the goods offered under the opponent's mark, however, the sales figures provided by the opponent for goods sold in the UK under the mark appear to be relatively modest. Further, the opponent has not provided significant advertising or promotional material that might assist in showing the distinctiveness of its marks has been enhanced amongst the UK consumer. Overall, I do not consider the evidence provided to be sufficient to show the distinctiveness of either of the earlier marks has been enhanced amongst UK consumers above its inherent level.

Comparison of marks

63. 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 Court of Justice of the European Union 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."

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

65. The respective trade marks are shown below:

Earlier trade mark	**Contested trade mark**
SOMAKIT	CEMAkit
SOMAKIT-TOC	

66. Earlier in this decision I noted that the two earlier marks are registered in respect of a materially equivalent specification and hold an equivalent level of distinctiveness in respect of these goods. I also note that the '-TOC' element of the second earlier mark has no counterpart or similar element in the contested mark, and it is significantly longer than both the first earlier mark and the contested mark, the two of which are of equal length. Considering these factors it is clear that the opponent's earlier mark SOMAKIT is its strongest earlier right, and if there is no likelihood of confusion based on the earlier mark SOMAKIT, it follows there will be no likelihood of confusion based on the earlier mark SOMAKIT-TOC. I therefore intend to proceed with the decision from this point onwards based on the opponent's earlier mark SOMAKIT only, as I do not consider the opponent will be disadvantaged by this approach.

67. It is my view that the majority of consumers will consider the earlier mark to be a single word made up of two identifiable elements, namely 'SOMA' and 'KIT'. Where the meaning of SOMA is unknown to the consumer it will appear to be the most distinctive element of the mark in these situations. However, I do not consider the KIT element to be negligible, and the overall impression resides in the mark as a whole. Where the meaning of SOMA is known to the consumer, both SOMA and KIT will play largely equivalent roles in the overall impression of the mark. Should the word KIT not

be identified within the earlier mark (which I have found to be unlikely) the overall impression will reside in the mark as a whole.

68. The contested mark appears to contain two identifiable elements, namely CEMA and kit. Appearing at the beginning of the mark in capital letters, the element CEMA appears to be dominant. Further, appearing to have no identifiable meaning to the consumer unlike 'kit' which I have defined above, I consider this to be the most distinctive element of the mark in the context of the goods. However, I do not find 'kit' to be negligible, and again the overall impression resides in the mark as a whole.

Visual comparison

69. Visually, the marks share the five letters MAKIT situated in the middle and end of the marks. The marks do differ by way of the first two letters at the start of each mark, which appear as SO in the earlier mark and CE in the contested mark. Being placed at the beginning of the mark where the consumer tends to pay more attention, the differences between these letters make a larger visual impact then if they were placed in the middle or at the end of the marks. Overall, I find the marks to be visually similar to a medium degree.

Aural comparison

70. Within his skeleton arguments and at the hearing, there was a suggestion from Mr Muir Wood for the applicant that the 'C' in the contested mark would be pronounced as a 'KAY' by medical professionals, on the basis that they will have an understanding that many medical terms derive from Greek etymology, and there is no 'C' in Greek. I do not accept this line of argument, and I find it to be unsupported by the evidence. In this case, I consider the contested mark will most likely be pronounced as 'SEE-MAH-KIT', although I accept that a smaller portion of consumers may pronounce this as 'KEH-MAH-KIT'. I find the earlier mark will most likely be pronounced as 'SOW-MAH-KIT'. The marks differ aurally by way of the first syllable, although I note this shares the initial 'sss' sound in the first scenario. The marks also share final two syllables identically. Overall, I find the marks to be aurally similar to between a medium and high degree.

Conceptual comparison

71. It is my view that in this instance there is not one straight forward way that the marks will be considered by all consumers conceptually, and instead there will be several possible scenarios. However, I found the majority of consumers will recognise two elements to each mark and attribute a meaning to 'kit' in both. I do not consider CEMA to have a meaning. Where no meaning is attributed to SOMA, whilst it will not be known what a 'CEMA-KIT' or a 'SOMA-KIT' will comprise, they will share identically the (fairly weak) concept of a 'KIT'.

72. For those consumers that attribute a meaning to SOMA, as either meaning body or alluding to 'somatostatin', the earlier mark as a whole to will at least allude to the concept of a 'somatostatin kit' or a 'body kit'. In these instances, the earlier mark will appear to be conceptually similar to the contested mark to a low degree by virtue of the shared (weak) concept of a 'kit'. As I have mentioned, I find the opponent's position that 'KIT' will not be recognised in the earlier mark (or the contested mark) to be unlikely, but if this were to be the case, this would act to remove the common concept between the marks.

Average consumer and the purchasing act

73. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

74. 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."

75. In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, EU:T:2021:41, the GC considered the average consumer for and level of attention which would be paid in the selection of pharmaceutical and medical products in class 5. It said:

"39 Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis* v *OHIM – Sanochemia Pharmazeutika (TOLPOSAN)*, T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma* v *EUIPO – Ipsen Pharma (COLINEB)*, T-36/17, not published, EU:T:2017:690, paragraph 49).

40 Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, *TOLPOSAN*, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).

41 […]

42 In the present case, having regard to the nature of the goods concerned, namely medical or pharmaceutical products in Class 5, the Board of Appeal acted correctly in finding in paragraphs 18 to 21 of the contested decision – which, moreover, is not disputed by the applicant – that, in essence, the relevant public was made up of medical professionals and pharmacists and consumers belonging to the general public with a higher than average degree of attentiveness."

76. In this case, the opponent submits that the average consumer of the goods will include both medical professionals and administrative clinical workers. Whilst the applicant stated it did not dispute that it may be the case that administrative workers are involved in ordering the goods, it submits there is no evidence to that effect. However, both parties appear to be in agreement that there will be at least a high degree of attention paid by the consumer, with Ms Wickenden submitting at the hearing:

"The level of attention paid, I think the difference between us is "high" versus "very high". We accept that medical professionals pay a high level of attention, but it is probably not right to say "very high". Medical professionals are not infallible. Obviously there are the settings that they work in, there is often a lot of pressure and mistakes do happen. It is not open to argue that the level of attention is paid to the extent that there would never be a mistake of any kind."

77. In respect of the class 5 goods, it is my view that in this instance, the average consumer of the goods will undoubtably comprise professionals in the field of medicine. However, I accept the argument that these consumers may not be strictly limited to doctors or consultants. These goods appear to be the type that will be sold to hospitals and large healthcare providers. Whilst I do not doubt they may primarily be handled by doctors, consultants or nurses, it does appear likely there may also be other professionals involved in the ordering process, including various administrative staff who may be responsible for placing orders for preapproved of goods. It seems

likely this may include hospital procurement staff for example, but I note I do not have evidence from either side on this point, or regarding how exactly the procurement process works within the medical sector. However, I do not consider that this makes a material difference to the level of attention paid by the consumer in this instance. It is my view that regardless of which type of professional in the medical field actually purchases and/or administers the goods, there will be a high level of attention paid due to the high level of responsibility and liability associated with stocking and administering the correct goods in these types of environments. I do not consider that any part of the process will be undertaken casually or without paying a significant level of attention. It also seems very unlikely the general public will have much interaction with these goods or the administration or purchase of the same in this instance.

78. In respect of the class 10 goods, I also consider that consumers will be professionals in the field of medicine, and for the same reasons as set out above, I find that these consumers will pay a high degree of attention towards the goods and the purchase of the same.

79. It is my view the goods will primarily be purchased visually, with the goods likely being displayed to professionals on visual advertisements, websites, information leaflets and in brochures. However, I consider that there may also be verbal recommendations between the professionals. Further, I consider there may be verbal promotion at meetings such as those advertised on the invitations provided by the opponent at Exhibit WK5, and whilst these are likely to be supplemented with visual material such as the invitations provided, I cannot completely discount the aural considerations.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

80. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 31 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their

mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be increased through use, and that the distinctiveness of the common elements is key.[8] I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are obtained will have a bearing on how likely the consumer is to be confused.

81. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.[9]

82. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

83. I found the opponent's best case to be based on its earlier mark SOMAKIT, which I considered to hold a fairly high degree of distinctive character for a significant portion of consumers. I found the goods in this instance to range from identical to similar to a between a low and medium degree. I found the marks to be visually similar to a

[8] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.
[9] *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

medium degree, and aurally similar to between a medium and high degree. I found the conceptual similarity to vary depending on the consumers interpretation of the marks, but I found the best case for the opponent in this respect will be where the consumer considers the marks will share the identical concept of a type of 'kit'. However, I note that 'kit' simply refers to a collection of articles needed to carry out a particular task, and I therefore find this concept to be fairly weak. I found the consumers to primarily comprise medical professionals, and that in all instances the consumer will be paying a high degree of attention to the goods.

84. At the hearing, Ms Wickenden set out some scenarios in which the opponent believes there may be direct confusion between the marks. She submitted:

> "The first example I pose was in relation to a radiographer asking for the products to be reordered saying "we are nearly out of DOTA-TOC please order Somakit". If this was a request put in orally over the phone then that staff member may think they heard CEMAkit when they look at a list of products which they could order, obviously taking into account imperfect recollection. We do say that the administrative staff members who are ordering this inventory would still perhaps pay a higher level of attention than average as they are ordering products for use in a medical environment, but not quite as high level of attention as medical professionals who are using the product.
>
> Even on a visual basis, SOMAKIT and CEMAkit are sufficiently similar we say that when taking into account identical goods and imperfect recollection there is a likelihood of confusion just on a visual basis.
>
> Another example I set forward, communication between senior and junior doctors. We say effectively once again it could be aural or visual instructions, certainly on the aural basis there would be considerable opportunity for confusion which could be misheard."

85. Earlier in her submissions, Ms Wickenden submitted as follows:

> "As I have already covered, to some extent if there is confusion based on an

aural hearing of SOMAKIT for CEMAkit, then really the level of attention paid, even if it is high, that is not going to prevent confusion because there has already been that confusion made."

86. Whilst I have considered the submissions made by Ms Wickenden, it is my view that considering all of the factors and keeping in mind the consumers imperfect recollection, the differences between the marks will not go unnoticed by the consumer even where the goods are considered identical, particularly considering the high degree of attention that will be paid in respect of the goods at issue. I acknowledge that the marks share a higher level of aural similarity than visual similarity in this instance, and I acknowledge that whilst the goods will primarily be purchased visually, aural considerations cannot be completely discounted. However, I do not agree with the submissions made by Ms Wickenden at an earlier point in the hearing that the level of attention paid is not relevant to the aural comparison of the marks on the basis that confusion has already taken place by the time the level of attention comes into play. It is my view that a high level of attention will also be paid to the aural elements of the mark, and so in a situation such as the ones described Ms Wickenden, there will still be a high level of attention paid to the pronunciation of the mark at both ends of the telephone (if this is indeed the process that will take place for the replacement of stock), or during aural communications between junior and senior doctors. Further, considering the objective conditions under which the marks are likely to be present on the market, I find the visual considerations to hold more weight than the aural factors in this instance.[10]

87. Whilst I note the use of both marks may convey to the consumer the concept of a 'kit', I do not consider this to be particularly strong, and I do not find it will be sufficient to overcome the differences between the marks in this instance. Overall, I do not find there will be a likelihood of direct confusion between the marks. For completeness, I note here I also find this to be the case if both marks are considered to be entirely

[10] See *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03 in which it was stated that the visual, aural or conceptual aspects of the opposing signs do not always have the same weight, and it is appropriate to examine the objective conditions under which the marks may be present on the market.

made-up words (and are therefore conceptually neutral), as is submitted by the opponent.

88. I therefore consider if there is another basis upon which the consumer may be confused. In *L.A. Sugar* Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

> 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)."

89. In this instance, I do not consider that the marks fall directly into one of these categories. However, I note that the examples above were intended to be illustrative and are not exhaustive.

90. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed,

pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

91. At the hearing, Ms Wickenden for the opponent set out that she believes there to be a basis for a finding of indirect confusion in respect of the class 10 goods. She argued that someone familiar with SOMAKIT which is used with diagnostic devices, would consider that the goods under the mark CEMAkit must derive from the same economic undertaking. However, whilst I have considered these submissions, the argument set out appears to be based on solely on the fact that the marks share the common letters ‘MAKIT’. It is not clear to me why the consumer would view the use of these letters (or indeed the use of the common element ‘KIT’) within both the earlier and contested marks as an indication of a common origin of the goods. I note here I find this in respect of both the class 5 and the class 10 goods. Whilst I accept that the similarities between the marks are such that the contested mark may for some bring the earlier mark to mind (or vice versa), I do not believe that the consumer, having noticed the differences at the beginning of the marks, will logically conclude that they derive from the same economic undertaking in this instance. I therefore find no likelihood of indirect confusion between the marks.

92. As I have found no likelihood of confusion based on the opponent’s earlier mark SOMAKIT, it follows for the reasons previously outlined that there will be no likelihood of confusion based on the opponent’s second earlier mark SOMAKIT-TOC.

Final Remarks

93. The opposition has failed in its entirety, and subject to any successful appeal, the application will now proceed to registration.

COSTS

94. The applicant has been successful and is entitled to a contribution towards its costs. At the hearing, Ms Wickenden set out as follows:

> “I had set out in my skeleton a point on costs relating to genuine use and that

had initially been a reclaim in relation to the evidence of genuine use and the drafting of the skeleton argument. We are no longer seeking any costs in any event relating to the evidence of genuine use if that has turned out to be useful for other factors in particular going to the product. We would however maintain a claim for costs, even in the event we were unsuccessful, as a contribution for drafting the skeleton argument on genuine use as that had already been drafted prior to being informed by the applicant last Friday that it was not being pursued. They had had our evidence for a long time, we should have been informed earlier and costs could have been saved in the preparation for the hearing. Obviously if we are successful and we succeed we would seek our costs in addition to just to that part, but on the scale."

95. I explained to Ms Wickenden at the hearing that I was struggling to follow the logic in seeking costs in the event they were unsuccessful, for drafting the skeleton relating to proof of use on the basis that the applicant had, upon viewing the evidence, decided to accept the proof of use in relation to the second earlier mark prior to the hearing taking place. I explained that in my view, doing so will have saved both parties time and costs at the hearing. Ms Wickenden explained that whilst she accepts the burden was on the opponent to provide proof of use, it is the lateness of the acceptance of the proof of use that the opponent objects to, and the opponent seeks costs for preparing the skeleton arguments in relation to the same.

96. Cost awards are intended to be contributory and are in most instances to be awarded to the successful party. Whilst there may be exceptions to this general rule, for example in respect of instances where one party has run up costs by acting unreasonably, I do not consider the acceptance of the proof of use evidence prior to the hearing to be unreasonable behaviour by the applicant, even if this did take place after the opponent had begun work on its skeleton arguments, just under a week before the hearing. As I have mentioned this will have saved time and money for both parties at the hearing. If the applicant had not accepted the evidence of use and this had successfully been shown by the opponent, but the opponent had nonetheless gone on to be unsuccessful within these proceedings, I would not be allocating the opponent costs for proving use, preparing skeleton arguments relating to proof of use, or making submissions on their case for proof of use at the hearing. I therefore do not

consider it appropriate to award costs to the opponent due to the acceptance of the proof of use by the applicant prior to the hearing, which, as I have said, I believe will have ultimately saved both the parties costs when compared to letting the request run.

97. In the circumstances I award the applicant the sum of £2000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the TM7 and preparing and filing the TM8 and counterstatement:	£300
Preparing evidence and considering the other side's evidence:	£800
Preparing for and attending the hearing:	£900
Total	**£2000**

98. I therefore order ADVANCED ACCELERATOR APPLICATIONS INTERNATIONAL SA to pay Philip Morris Products S.A. the sum of £2000. 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 15th day of February 2023

Rosie Le Breton
For the Registrar