

O/0173/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003676429

BY STADA ARZNEIMITTEL AG

TO REGISTER THE TRADE MARK:

MOVicare

IN CLASSES 5, 9, 10, 35, 38, 41, 42 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 431127 BY

VELINOR AG

BACKGROUND AND PLEADINGS

1. On 3 August 2021, STADA Arzneimittel AG (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was made pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union. Under the terms of that Agreement, the applicant is entitled to rely upon the earlier EU filing date i.e. 18 July 2019. The application was published for opposition purposes on 19 November 2021 and registration is sought for the services set out at paragraph 18 below.

2. On 17 February 2022, the application was opposed by Velinor AG (the opponent”) based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b), the opponent relies upon the following trade marks:



(series of 2)

UKTM no. 3315709

Filing date 5 June 2018; registration date 31 August 2018

Class 5 Pharmaceutical preparations; pharmaceutical preparations and substances for prevention, diagnosis, treatment and relief relating to gastrointestinal diseases; pharmaceutical preparations and substances for the treatment of gastrointestinal diseases; laxatives, preparations for enemas; preparations for diagnosis, prevention, relief and treatment of gastrointestinal diseases and disorders; diagnostic preparations for medical use; dietetic substances for medical use.

Class 10 Surgical and medical apparatus and instruments; diagnostic apparatus for medical use; enema apparatus for medical use.

Class 42 Scientific and technological services, as well as research and design relating thereto; scientific and medical research and development.

(the First Earlier Registration)

MOVICOL

UKTM no. 918051520

Filing dated 12 April 2019; registration date 5 September 2019

Class 10 Medical devices for treating gastrointestinal conditions and diseases including constipation and faecal impaction.

(the Second Earlier Registration)

MOVICOL

IR no. WO0000000612930

International registration date 14 December 1993

Date of designation of the UK 14 May 2010

Date protection granted in UK 14 October 2010

Class 5 Pharmaceutical preparations, namely preparations for treating chronic constipation and faecal occlusion.

("the Third Earlier Registration")

(together "the earlier registrations")

3. The opponent relies upon all of the goods and services for which the earlier registrations are registered.

4. The opponent claims that there is a likelihood of confusion because the trade marks are similar and the goods and services are identical or similar.

5. Under section 5(3), the opponent relies upon the First and Third Earlier Registrations. The opponent claims that it has a reputation in relation to the class 5 goods for which the First Earlier Registration is registered and all of the goods covered by the Third Earlier Registration. The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the First and Third Earlier Registrations.

6. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of the Third Earlier Registration.

7. The applicant is represented by Potter Clarkson LLP and the opponent is represented by Keltie LLP.

8. Only the opponent filed evidence. Neither party requested a hearing, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

9. The opponent's evidence consists of the witness statement of Geraldine Tahsin dated 11 July 2022. Ms Tahsin is the Director of Trade Marks with the Norgine Group of Companies, a position she has held since January 2015. Norgine Limited, Ms Tahsin's employer, shares the same parent company (Norgine BV) as the opponent. Ms Tahsin states that she has delegated authority to deal with trade mark matters on the opponent's behalf. Her statement was accompanied by 18 exhibits.

10. Both parties filed written submissions in lieu dated 28 November 2022.

11. I have taken the evidence and submissions into account in reaching this decision.

RELEVANCE OF EU LAW

12. 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. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

Section 5(2)(b)

13. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

14. 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.”

15. By virtue of their earlier filing dates, the earlier registrations upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. The First and Second Registrations had not completed their registration process more than 5 years before the application date and, consequently, are not subject to proof of use. The Third Earlier Registration is, however, subject to proof of use.

16. As the Third Earlier Mark is subject to proof of use and its specification covers goods which are covered by broader terms within the First Earlier Mark, I will begin by assessing the opposition on the basis of the First and Second Earlier Registrations, returning to the Third Earlier Registration only if it is necessary to do so.

Section 5(2)(b) – case law

17. 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 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 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 goods and services

18. The competing goods and services are as follows:

Opponent's goods and services	Applicant's goods and services
The First Earlier Registration <u>Class 5</u>	<u>Class 5</u> Pharmaceuticals, medical and veterinary preparations; Sanitary preparations for

<p>Pharmaceutical preparations; pharmaceutical preparations and substances for prevention, diagnosis, treatment and relief relating to gastrointestinal diseases; pharmaceutical preparations and substances for the treatment of gastrointestinal diseases; laxatives, preparations for enemas; preparations for diagnosis, prevention, relief and treatment of gastrointestinal diseases and disorders; diagnostic preparations for medical use; dietetic substances for medical use.</p>	<p>medical purposes; Diagnostic preparations for medical purposes; Dietetic food and substances adapted for medical or veterinary use, food for babies; Dietary supplements for humans and animals; Plasters, materials for dressings; Material for stopping teeth, dental wax; Disinfectants.</p>
<p><u>Class 10</u> Surgical and medical apparatus and instruments; diagnostic apparatus for medical use; enema apparatus for medical use.</p>	<p><u>Class 9</u> Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; Information technology and audiovisual equipment; Recorded and downloadable media, computer software, Document management software, Virtual reality software, Artificial intelligence and computer training software, Artificial intelligence software for healthcare, Augmented reality software, Machine-learning software for healthcare purposes, Mobile apps, Downloadable software applications, Interactive software, Mobile software, Content management software; Humanoid robots with artificial intelligence; Electronic</p>
<p><u>Class 42</u> Scientific and technological services, as well as research and design relating thereto; scientific and medical research and development.</p>	
<p>The Second Earlier Registration <u>Class 10</u> Medical devices for treating gastrointestinal conditions and diseases including constipation and faecal impaction.</p>	

	<p>publications, downloadable; Computer databases.</p> <p><u>Class 10</u> Surgical, medical, dental and veterinary apparatus and instruments; Medical apparatus and instruments; Prosthetics and artificial implants; Artificial limbs, eyes and teeth; Orthopedic articles; Orthopedic and mobility aids; therapeutic and assistive devices adapted for the disabled; Physical therapy equipment; Massage apparatus; Applicators for medications; Medical apparatus for introducing pharmaceutical preparations into the human body.</p> <p><u>Class 35</u> Business consultancy and advisory services, In particular counselling provided by doctors' surgeries and clinics; Wholesale and retail services in connection with computer hardware, computer software, mobile apps, diagnostic apparatus for medical purposes, application devices for medicines and medical apparatus for introducing pharmaceutical preparations into the human body, namely needles and syringes.</p> <p><u>Class 38</u></p>
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	<p>Providing of user access to internet platforms, in particular in connection with patient support programmes; Transmission of information relating to pharmaceuticals, medicine and hygiene; Providing of internet forums; Electronic communication by means of chatrooms, chat lines and Internet forums; Electronic message exchange; Communication by online blogs.</p> <p><u>Class 41</u> Education; Providing of training; Entertainment; Sporting and cultural activities; Arranging and conducting of training courses and seminars, including online; Educational services in the healthcare sector; Publication of information relating to health-related training courses, health and fitness training and physical exercise, including via the internet and via mobile apps.</p> <p><u>Class 42</u> Scientific and technological services and research and design relating thereto; Research and development in the field of medicine and veterinaries; Pharmaceutical research and development; Design and development of computer hardware and computer software; Computer software design; Computer software consultancy;</p>
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	<p>Providing online, non-downloadable software; Creation, maintenance and adaptation of software; Design and development of virtual reality software in the health sector.</p> <p><u>Class 44</u> Medical services; Medical care; Human hygiene and beauty care; Consultancy relating to health care and diet; Provision of medical information relating to diseases via the internet; Dissemination of medical information by means of an interactive platform in connection with the treatment of osteoporosis.</p>
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19. When making the comparison, all relevant factors relating to the goods and services 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 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.”

20. Guidance on this issue has also come from Jacob J. (as he then was) 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.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“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 für 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.”

Class 5

Pharmaceuticals, medical [...] preparations

22. These goods in the applicant’s specification are identical on the principle outlined in *Meric* to “pharmaceutical preparations” in the specification of the First Earlier Registration.

[...] Veterinary preparations

23. These goods may overlap in nature with the opponent's "pharmaceutical preparations" as both could take the form of tablets or medicines. The user will also overlap to a degree, as both could be purchased by members of the general public. However, the purpose of the goods differs (one is to treat humans, the other is to treat animals), although there will be some overlap due to both being intended to treat a particular condition or ailment. The method of use will also differ, as one will need to be administered to the animal whereas the other is to be taken by the user. I have no evidence before me to suggest that there is any overlap in trade channels. There is no competition or complementarity.¹ Consequently, I consider these goods to be similar to a medium degree.

Sanitary preparations for medical purposes

24. I do not consider these to be the same as pharmaceutical preparations, which, in my view, would primarily relate to medications. These are goods used for keeping things (such as cuts and wounds) clean. There could be an overlap in trade channels as both goods are likely to be available from medical suppliers and pharmacies. There will, clearly, be an overlap in user. The nature of the goods will differ, as will the method of use. Any overlap in purpose is likely to be at a high level. I do not consider the goods to be in competition or complementary. Consequently, I consider these goods to be similar to "pharmaceutical preparations" in the specification of the First Earlier Registration to between a low and medium degree. I can see no other term in the opponent's specifications which would put it in a stronger position.

Diagnostic preparations for medical purposes;

25. I consider this term to be identical on the principle outlined in *Meric* to "substances for [...] diagnosis [...] relating to gastrointestinal diseases" in the specification of the First Earlier Registration.

¹¹ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

Dietetic food and substances adapted for medical [...] use, food for babies;

26. These goods will be identical on the principle outlined in *Meric* to “dietetic substances for medical use” in the specification of the First Earlier Registration.

Dietetic food and substances adapted for [...] veterinary use, [...];

27. I do not consider this to be identical to “dietetic substances for medical use” in the specification of the First Earlier Registration as, in my view, “medical use” typically refers to treatment of humans (as opposed to animals). There is clearly potential for there to be an overlap in nature and user. However, the method of use will differ as one will be taken by the user themselves, with the other being administered to animal. The purpose of the goods will differ, as one will be to improve the diet of the user, with the other being to improve the diet of an animal. However, I recognise that there is some overlap due to both being to supplement the diet of the recipient. I have no evidence before me to suggest that there is an overlap in trade channels. There is no competition or complementarity. I consider these goods to be similar to a medium degree.

Dietary supplements for humans [...];

28. This will be identical on the principle outlined in *Meric* to “dietetic substances for medical use” in the specification of the First Earlier Registration.

Dietary supplements for [...] animals;

29. I make the same finding in relation to these goods as set out at paragraph **27** above.

Plasters, materials for dressings;

30. I do not consider these to be the same as pharmaceutical preparations, which, in my view, would primarily relate to medications. However, there could be an overlap in

trade channels as both goods are likely to be available from pharmacies. There will, clearly, be an overlap in user. The nature of the goods will differ, as will the method of use. Any overlap in purpose is likely to be at a high level. I do not consider the goods to be in competition or complementary. Consequently, I consider the goods to be similar to between a low and medium degree.

Material for stopping teeth, dental wax;

31. I do not consider this to be a pharmaceutical preparation. I can see no point of overlap in terms of method of use, nature or purpose with the specifications of the earlier registrations. I can also see no obvious point of overlap in trade channels, in the absence of any evidence to assist me. Any overlap in user would be at a very general level. There is no competition or complementarity. I consider the goods to be dissimilar.

Disinfectants.

32. In my view, the term “disinfectants” could include substances used to disinfect wounds. Consequently, I consider this to be similar to the opponent’s goods to between a low and medium degree for the same reasons set out in paragraph 24 above.

Class 9

Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data;

33. I note that the specification of the First Earlier Registration includes “surgical and medical apparatus and instruments”. However, these are not the same as the applicant’s scientific instruments. Clearly, if there was any medical purpose they would be included in class 10. I recognise that the specification of the First Earlier Registration also covers “scientific and technological services, as well as research and

design relating thereto". Clearly, there could be an overlap in user for the goods and services. However, I see no likely overlap in purpose, method of use, trade channels or nature. The goods and services are unlikely to be in competition or complementary. Taking all of this into account, I consider the goods and services to be dissimilar. I can see no other point of overlap which would put the opponent in a stronger position.

Recorded and downloadable media, computer software, Document management software, Virtual reality software, Artificial intelligence and computer training software, Artificial intelligence software for healthcare, Augmented reality software, Machine-learning software for healthcare purposes, Mobile apps, Downloadable software applications, Interactive software, Mobile software, Content management software; Humanoid robots with artificial intelligence; Computer databases.

34. I recognise that there may be some overlap with "scientific and technological services, as well as research and design relating thereto" in the specification of the First Earlier Registration. This is because the opponent's services could include those used to develop and update these goods in the applicant's specification. The same businesses that sell goods of this kind often provide services for update and maintenance of such goods. There will also be an overlap in user. However, I do not consider there to be an overlap in nature, method of use or purpose. I do not consider the goods and services to be in competition. There may be complementarity. Taking all of this into account, I consider the goods and services to be similar to a medium degree.

Information technology and audiovisual equipment;

35. I do not consider that the same applies to this term as set out at paragraph **34** above. This is because businesses that sell equipment of this kind (i.e. hardware) are unlikely to offer the same development and update services and I have no evidence before me that they do. Consequently, I do not consider that the same overlap in trade channels apply, nor is there complementarity. Consequently, I consider the goods and services to be dissimilar.

Electronic publications, downloadable;

36. Even where such goods may be aimed at the medical sector, I can see no meaningful overlap in trade channels, method of use, purpose or nature with the goods and services covered by the specifications of the earlier registrations. Any overlap in user would be at a very general level. There is no competition or complementarity. Consequently, I consider these goods and services to be dissimilar.

Class 10

Surgical, medical, [...] apparatus and instruments; Medical apparatus and instruments;

37. These goods are self-evidently identical or identical on the principle outlined in *Meric* to “surgical and medical apparatus and instruments” in the specification of the First Earlier Registration.

[...] Dental [...] apparatus and instruments;

38. I recognise that in some cases dental apparatus and instruments may be used in the course of surgery. Consequently, I consider these goods to be identical on the principle outlined in *Meric* to “surgical and medical apparatus and instruments” in the specification of the First Earlier Registration.

[...] Veterinary apparatus and instruments;

39. The opponent’s “surgical [...] apparatus and instruments” does not limit itself to goods used in surgery carried out upon humans only. Consequently, I consider these goods to be identical on the principle outlined in *Meric*.

Prosthetics and artificial implants; Artificial limbs, eyes and teeth; Orthopedic articles; Orthopedic and mobility aids; therapeutic and assistive devices adapted for the disabled; Physical therapy equipment; Massage apparatus;

40. I do not consider these to be covered by the specifications of the earlier registrations. They are likely to be provided by specialist businesses and so I see no reason for there to be an overlap in trade channels with the opponent's goods and services. The nature, method of use and purpose of the goods and services will differ. I recognise that there may be an overlap in user. I do not consider there to be competition or complementarity. Taking all of this into account, I consider the goods and services to be dissimilar.

Applicators for medications; Medical apparatus for introducing pharmaceutical preparations into the human body.

41. In my view, these goods fall within the broader category of "surgical and medical apparatus and instruments" in the specification of the First Earlier Registration. They are, therefore, identical on the principle outlined in *Meric*.

Class 35

Business consultancy and advisory services, In particular counselling provided by doctors' surgeries and clinics;

42. In my view, there are issues with the interpretation of this term. Business consultancy and advisory services are services that would be used to provide advice and support to a business with the intention of growing or improving the business in some way. However, in this specification, these services have been described by use of the words "in particular" to "counselling provided by doctors' surgeries and clinics". The latter services are medical services proper to class 44. Consequently, I will deal with these services on the basis that they are, in fact, business services in class 35. Business consultancy and advisory services clearly differ in purpose, nature, method of use, user and trade channels with the opponent's goods and services. They are clearly dissimilar.

Wholesale and retail services in connection with computer hardware [...]

43. In my view, these services have no overlap with the opponent's goods and services. The goods to which the retail services relate are different to those covered by the opponent's specification and I can see no point of overlap in nature, purpose, method of use or trade channels. Any overlap in user is insufficient, in my view, to result in a finding of similarity. There is no competition or complementarity. Consequently, I consider these services to be dissimilar.

Wholesale and retail services in connection with computer software, mobile apps, [...]

44. These services may overlap in trade channels with "scientific and technological services, as well as research and design relating thereto" in the specification of the First Earlier Registration. This is because businesses that develop and update technological goods of this kind are also often responsible for selling them. The user may overlap. However, the nature, purpose and method of use of the services will clearly differ. The goods and services are neither in competition nor complementary. Taking all of this into account, I consider the services to be similar to between a low and medium degree.

Wholesale and retail services in connection with [...] diagnostic apparatus for medical purposes, application devices for medicines and medical apparatus for introducing pharmaceutical preparations into the human body, namely needles and syringes.

45. Clearly, there will be an overlap in trade channels with the "surgical and medical apparatus and instruments" in the specification of the First Earlier Mark. Businesses that produce surgical and medical apparatus and instruments may also provide retail services relating to those goods. There will clearly be an overlap in user. The nature, purpose and method of use of the goods and services will differ, but they will be complementary. Taking all of this into account, I consider the goods and services to be similar to a medium degree.

Class 38

Providing of user access to internet platforms, in particular in connection with patient support programmes; Transmission of information relating to [...] hygiene; Providing of internet forums; Electronic communication by means of chatrooms, chat lines and Internet forums; Electronic message exchange; Communication by online blogs.

46. I can see no overlap in method of use, nature or purpose with the specifications of the earlier registrations. I accept that there may be some overlap in user, particularly for those services aimed at patients in the medical sector. However, I have no evidence that there would be any overlap in trade channels and I can see no reason, on the face of it, why there would be. Consequently, I consider the goods and services to be dissimilar.

Transmission of information relating to pharmaceuticals, medicine [...];

47. These are services that could reasonably be expected to be provided by the same businesses that provide medical goods and pharmaceutical products. There could also, clearly, be an overlap in user. The nature, method of use and purpose of the goods and services will clearly differ. I do not consider the goods and services to be in competition, however, there may be complementarity. Taking all of this into account, I consider the services to be similar to a medium degree with “pharmaceutical preparations” in the specification of the First Earlier Registration.

Class 41

48. I do not consider there to be any meaningful overlap between the applicant’s class 41 services and the opponent’s goods and services. Even where the applicant’s services are aimed at the healthcare sector, I have no reason to consider that there would be any real overlap in trade channels, method of use, purpose or nature. An overlap in user is insufficient, on its own, for a finding of similarity. There is no competition or complementarity. Taking all of this into account, I consider the goods and services to be dissimilar.

Class 42

Scientific and technological services and research and design relating thereto;

49. This term is identical to the term “scientific and technological services, as well as research and design relating thereto” in the specification of the First Earlier Registration.

Research and development in the field of medicine and veterinaries; Pharmaceutical research and development; Design and development of computer hardware and computer software; Computer software design; Computer software consultancy; Providing online, non-downloadable software; Creation, maintenance and adaptation of software; Design and development of virtual reality software in the health sector.

50. In my view, these are all technological and scientific services. Consequently, they are identical on the principle outlined in *Meric* to “scientific and technological services, as well as research and design relating thereto” in the specification of the First Earlier Registration.

Class 44

Medical services; Medical care; Consultancy relating to health care and diet; Provision of medical information relating to diseases via the internet; Dissemination of medical information by means of an interactive platform in connection with the treatment of osteoporosis.

51. These are all services that could be provided through various healthcare settings such as doctors, pharmacies and health clinics. Even those services that are provided online, could still be provided by the same undertakings. Clearly, those undertakings would also be responsible for providing pharmaceutical preparations in relation to a range of conditions. Consequently, I consider there to be an overlap in trade channels with the “pharmaceutical preparations” in the specification of First Earlier Registration. The users will clearly overlap. The nature, method of use and purpose of the goods and services differ. I do not consider them to be in competition, but there may be

complementarity. Taking all of this into account, I consider the goods and services to be similar to a medium degree.

Human hygiene and beauty care;

52. I can see no point of overlap with the specifications of the earlier registrations. I consider the goods and services to be dissimilar.

53. Similarity of goods and services is essential for a finding of likelihood of confusion. Consequently, where I have found the goods and services to be dissimilar, the opposition under section 5(2)(b) must fail.

The average consumer and the nature of the purchasing act

54. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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.”

55. The average consumer for the goods and services will include members of the general public and professional users. I agree with the applicant that where the goods and services are medical in nature, the average consumer is likely to pay a high degree of attention. Even where the goods and services are not medical in nature, they are

technological and, given the specific user requirements are likely to attract at least a medium degree of attention.

56. The purchasing process for the goods and services is likely to involve perusal of goods on shelves or perusal of signage and physical premises. Consequently, visual considerations are likely to dominate the purchasing process. However, given that requests may be made over the counter, discussions had with healthcare professionals or advice sought from retail assistants, I do not discount that aural components will also play a part.


Comparison of trade marks

57. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, being in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

58. It would be wrong, therefore, to artificially dissect the trade marks, 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.

59. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
 <p data-bbox="411 719 580 752">(series of 2)</p> <p data-bbox="284 775 703 808">(the First Earlier Registration)</p> <p data-bbox="419 887 568 920">MOVICOL</p> <p data-bbox="261 943 727 976">(the Second Earlier Registration)</p>	<p data-bbox="1027 293 1166 327">MOVicare</p>

60. The applicant's trade mark consists of the word MOVICARE, with the first three letters (MOV) presented in uppercase, and the last five letters presented in lower case. There are no other elements to contribute to the overall impression which lies in the word itself.

61. The First Earlier Registration consists of the word MOVICOL presented in uppercase, in a swirling font, with one mark in blue and the other in dark grey. I do not consider that the differing colours has any impact upon the overall impression, which lies predominantly in the word MOVICOL. The use of a swirling font plays a lesser role. The Second Earlier Registration consists of the word MOVICOL. There are no other elements to contribute to the overall impression, which lies in the word itself.

62. The marks all overlap in the first four letters – MOVI/MOVi. Given that the applicant's mark could be used in any font or colour, I do not consider that the differences in upper/lower case, use of colour and differing fonts make any meaningful difference. The only point of significant difference between the applicant's mark and

the earlier registrations is the end of the marks – CARE in the applicant’s mark and COL in the earlier registrations. In my view, this results in between a medium and high degree of visual similarity.

63. The applicant’s mark is likely to be pronounced MOV-EEE-CARE. The First and Second Earlier Registrations are likely to be pronounced MOV-EEE-COL. As the opponent submits, the first two syllables are identical and the first letter of the third syllable is the same. Taking all of this into account, I consider there to be between a medium and high degree of aural similarity.

64. The First and Second Earlier Registrations consist of the word MOVICOL. This is an invented word with no identifiable meaning. The applicant’s mark consists of the invented word MOVICARE. Whilst it is an invented word, the second part of the mark is clearly a recognisable dictionary word i.e. CARE. Consequently, the applicant’s mark is likely to convey a message of care to the average consumer, even if the word as a whole does not have a particular meaning. Consequently, I agree with the applicant that the marks to be conceptually dissimilar.

Distinctive character of the earlier registrations

65. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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).”

66. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

67. I will begin by considering the inherent position. The word MOVICOL is an invented word with no identifiable meaning. Consequently, I consider it to be inherently highly distinctive. I do not consider that the stylisation and use of colour in the First Earlier Registration adds significantly to this.

68. The relevant market for assessing enhanced distinctive character is the UK market. I note the following from Ms Tahsin’s evidence:

- a) MOVICOL has been continuously available on the UK market since 1996 and the mark is displayed on invoices, products and packaging in relation to laxatives;
- b) Invoices displaying the sign MOVICOL have been issued by Norgine Pharmaceuticals Ltd to customers located across the UK (including Cardiff, Bristol, Brighton, Merseyside, Sheffield, Surrey, Coventry, Leeds and Cheshire).² These are dated between 1 September 2014 and 31 January 2019. They amount to sales of over £56,000.

² Annex 1

c) In addition to these invoices, there are also a selection of invoices issued by a company called Forum Health Products Limited (“Forum”) (to customers located in Romford, Cheshire, Cottingham and Swindon) which display the MOVICOL mark and amount to sales of over £3,500. These are dated between 11 January 2017 and 9 January 2019.³ Ms Tahsin explains that Forum is a distributor for the opponent.

d) Number of units of MOVICOL goods sold in the UK are:

2014	4,753,652
2015	4,051,800
2016	3,948,829
2017	3,618,495
2018	3,279,943
2019	2,934,647 ⁴

e) Various print outs from the Wayback Machine show that the opponent’s packaging appeared as follows prior to the relevant date:⁵



³ Annex 1

⁴ Annex 3

⁵ Annex 5

These print outs also show that the opponent's product was available to purchase from Boots (amongst other pharmacies) prior to the relevant date.

- a) An information leaflet prepared by Oxford University Hospitals NHS Trust Children's Hospital in June 2015 refers to MOVICOL;⁶
- b) An information leaflet prepared in May 2015 by Plymouth Hospital also refers to MOVICOL;⁷
- c) On 27 June 2017, an article entitled "100 Most Commonly Prescribed Medications in UK Hospitals" listed MOVICOL as one of the most commonly prescribed laxatives.⁸

69. Clearly, the evidence shows that the opponent's goods have been sold throughout the UK as the invoices record sales across the country and they had been sold through a national retailer. The number of units sold are not insignificant, although I recognise that they are probably not particularly extensive given the size of this market. There has clearly been common use of the opponent's goods as they have been referenced by two NHS trusts and described as being amongst the most commonly prescribed medications. I have no information about what steps have been taken in promoting the opponent's goods or how much has been invested in it. I also have no overall sales figures for the opponent's goods. Taking all of this into account, I am not satisfied that the opponent has done enough to demonstrate that its mark has acquired enhanced distinctive character through use.

Likelihood of confusion

70. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible

⁶ Annex 12

⁷ Annex 13

⁸ Annex 18

undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the First and Second Earlier Registrations, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

71. I have found as follows:

- a) I have found the goods and services to vary from being similar to between a low and medium degree to identical (except where I have found them to be dissimilar);
- b) The average consumer is a member of the general public or a professional user who will pay at least a medium degree of attention during the purchasing process (although in many cases the level of attention paid will be high);
- c) The purchasing process is predominantly visual, although I do not discount an aural component;
- d) The marks are visually and aurally similar to between a medium and high degree and conceptually dissimilar;
- e) The First and Second Earlier Registrations are inherently distinctive to a high degree for laxatives.

72. In my view, there is a likelihood of direct confusion. This is because the First and Second Earlier Registrations are inherently highly distinctive and there is a medium to high degree of visual and aural similarity. In my view, the common first five letters

(MOVIC/MOVIc) are likely to stick in the mind of the average consumer and, when factoring in the principle of imperfect recollection, they will overlook the differing endings. As submitted by the opponent, consumers tend to pay more attention to the beginnings of marks than the ends. I recognise that the average consumer will in many cases be paying a high level of attention and that this may point away from direct confusion. However, it is important to remember that the average consumer for medical goods includes members of the general public. Whilst they will be paying a high level of attention, they will be far less familiar with the names of pharmaceutical products than professional users and, consequently, it would be easy to foresee circumstances in which they may mistakenly recall the endings of names that are otherwise so similar. I note that the applicant relies on the capitalisation of the first three letters of its mark to distinguish it. However, I consider it unlikely that the position of capitalisation is likely to remain in the mind of the consumer. In my view, this finding of direct confusion will apply when the marks are used on goods and services that are similar to at least a medium degree. For goods and services that are similar to a degree which is less than medium, the distance between the goods and services will be sufficient to offset the similarity between the marks.

73. If the average consumer does recall the differing endings of the marks then they will, in my view, conclude that they come from the same common undertaking. This is because the common prefix MOVI- is, in itself, highly distinctive for the goods and services and they are likely to view the alternative endings as identifying variant products sold by the same business.

74. For the avoidance of doubt, I do not consider that, even if the opponent had been able to prove use of the Third Earlier Registration, it would have been in any stronger position.

75. The opposition based upon section 5(2)(b) succeeds in relation to the following goods and services:

Class 5 Pharmaceuticals, medical and veterinary preparations; Diagnostic preparations for medical purposes; Dietetic food and substances

adapted for medical or veterinary use, food for babies; Dietary supplements for humans and animals;

Class 9 Scientific apparatus and instruments; Recorded and downloadable media, computer software, Document management software, Virtual reality software, Artificial intelligence and computer training software, Artificial intelligence software for healthcare, Augmented reality software, Machine-learning software for healthcare purposes, Mobile apps, Downloadable software applications, Interactive software, Mobile software, Content management software; Humanoid robots with artificial intelligence; Computer databases.

Class 10 Surgical, medical, dental and veterinary apparatus and instruments; Medical apparatus and instruments; Applicators for medications; Medical apparatus for introducing pharmaceutical preparations into the human body.

Class 35 Wholesale and retail services in connection with computer software, mobile apps, diagnostic apparatus for medical purposes, application devices for medicines and medical apparatus for introducing pharmaceutical preparations into the human body, namely needles and syringes.

Class 38 Transmission of information relating to pharmaceuticals, medicine.

Class 42 Scientific and technological services and research and design relating thereto; Research and development in the field of medicine and veterinaries; Pharmaceutical research and development; Design and development of computer hardware and computer software; Computer software design; Computer software consultancy; Providing online, non-downloadable software; Creation, maintenance and adaptation of software; Design and development of virtual reality software in the health sector.

Class 44 Medical services; Medical care; Consultancy relating to health care and diet; Provision of medical information relating to diseases via the internet; Dissemination of medical information by means of an interactive platform in connection with the treatment of osteoporosis.

76. The opposition based upon section 5(2)(b) fails in relation to the following goods and services:

Class 5 Sanitary preparations for medical purposes; Plasters, materials for dressings; Material for stopping teeth, dental wax; Disinfectants.

Class 9 Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; Information technology and audiovisual equipment; Electronic publications, downloadable.

Class 10 Prosthetics and artificial implants; Artificial limbs, eyes and teeth; Orthopedic articles; Orthopedic and mobility aids; therapeutic and assistive devices adapted for the disabled; Physical therapy equipment; Massage apparatus;

Class 35 Business consultancy and advisory services, In particular counselling provided by doctors' surgeries and clinics; Wholesale and retail services in connection with computer hardware.

Class 38 Providing of user access to internet platforms, in particular in connection with patient support programmes; Transmission of information relating to hygiene; Providing of internet forums; Electronic communication by means of chatrooms, chat lines and Internet forums; Electronic message exchange; Communication by online blogs.

Class 41 Education; Providing of training; Entertainment; Sporting and cultural activities; Arranging and conducting of training courses and seminars, including online; Educational services in the healthcare sector; Publication of information relating to health-related training courses, health and fitness training and physical exercise, including via the internet and via mobile apps.

Class 44 Human hygiene and beauty care.

Section 5(3)

77. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

78. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

79. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L’Oreal v Bellure and Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

80. I will begin by dealing with this ground on the basis of the First Earlier Registration, returning to the Third Earlier Registration only if it is necessary to do so.

81. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the First Earlier Registration and the applicant's marks are similar. Secondly, the opponent must show that the First Earlier Registration has achieved a knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the First Earlier Registration being brought to mind by the later mark. Finally, and assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link.

82. I can deal with this ground relatively swiftly. I have summarised the opponent's evidence above. In my view, it is not sufficient to establish the requisite reputation as I have no information about promotional activities or expenditure, and no overall sales figures to enable me to assess the opponent's market share. The opposition based upon section 5(3), therefore, falls at the first hurdle.

83. However, for the avoidance of doubt, even if the opponent had established a modest (which is the best case scenario based upon the opponent's evidence) reputation for laxatives, this would not have put it in any stronger position than it already is under section 5(2)(b). The goods for which the opponent would be able to demonstrate a reputation are much narrower than those goods and services covered by the specification of the First Earlier Registration and so the distance between the parties' respective goods and services would be greater. Whilst similarity of goods and services is not essential under section 5(3), the distance between them in this case would, in my view, offset any link and damage that might arise in relation to the goods and services for which 5(2)(b) opposition has failed. I do not consider that the Third Earlier Registration would put the opponent in any stronger position. Consequently, I need address this ground no further.

CONCLUSION

84. The opposition succeeds in relation to the following goods and services for which the application is refused:

Class 5 Pharmaceuticals, medical and veterinary preparations; Diagnostic preparations for medical purposes; Dietetic food and substances adapted for medical or veterinary use, food for babies; Dietary supplements for humans and animals;

Class 9 Scientific apparatus and instruments; Recorded and downloadable media, computer software, Document management software, Virtual reality software, Artificial intelligence and computer training software, Artificial intelligence software for healthcare, Augmented reality

software, Machine-learning software for healthcare purposes, Mobile apps, Downloadable software applications, Interactive software, Mobile software, Content management software; Humanoid robots with artificial intelligence; Computer databases.

Class 10 Surgical, medical, dental and veterinary apparatus and instruments; Medical apparatus and instruments; Applicators for medications; Medical apparatus for introducing pharmaceutical preparations into the human body.

Class 35 Wholesale and retail services in connection with computer software, mobile apps, diagnostic apparatus for medical purposes, application devices for medicines and medical apparatus for introducing pharmaceutical preparations into the human body, namely needles and syringes.

Class 38 Transmission of information relating to pharmaceuticals, medicine.

Class 42 Scientific and technological services and research and design relating thereto; Research and development in the field of medicine and veterinaries; Pharmaceutical research and development; Design and development of computer hardware and computer software; Computer software design; Computer software consultancy; Providing online, non-downloadable software; Creation, maintenance and adaptation of software; Design and development of virtual reality software in the health sector.

Class 44 Medical services; Medical care; Consultancy relating to health care and diet; Provision of medical information relating to diseases via the internet; Dissemination of medical information by means of an interactive platform in connection with the treatment of osteoporosis.

85. The opposition fails in relation to the following goods and services for which the application may proceed to registration:

- Class 5 Sanitary preparations for medical purposes; Plasters, materials for dressings; Material for stopping teeth, dental wax; Disinfectants.
- Class 9 Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; Apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; Information technology and audiovisual equipment; Electronic publications, downloadable.
- Class 10 Prosthetics and artificial implants; Artificial limbs, eyes and teeth; Orthopedic articles; Orthopedic and mobility aids; therapeutic and assistive devices adapted for the disabled; Physical therapy equipment; Massage apparatus;
- Class 35 Business consultancy and advisory services, In particular counselling provided by doctors' surgeries and clinics; Wholesale and retail services in connection with computer hardware.
- Class 38 Providing of user access to internet platforms, in particular in connection with patient support programmes; Transmission of information relating to hygiene; Providing of internet forums; Electronic communication by means of chatrooms, chat lines and Internet forums; Electronic message exchange; Communication by online blogs.
- Class 41 Education; Providing of training; Entertainment; Sporting and cultural activities; Arranging and conducting of training courses and seminars, including online; Educational services in the healthcare sector; Publication of information relating to health-related training courses, health and fitness training and physical exercise, including via the internet and via mobile apps.

Class 44 Human hygiene and beauty care.

COSTS

86. As the parties have enjoyed a roughly equal degree of success, I order both parties to bear their own costs.

Dated this 17th day of February 2023

S WILSON

For the Registrar