

O-378-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2482940A
IN THE NAME OF MEDICOM HEALTHCARE LTD

AND

OPPOSITION THERETO UNDER NO 98227
BY STEPHEN SPENCER HASTINGS

TRADE MARKS ACT 1994

IN THE MATTER OF application
No.2482940A in the name of
Medicom Healthcare Ltd and
Opposition thereto under No. 98227
by Stephen Spencer Hastings

Background

1. Application No 2482940A has a filing date of 20 March 2008 and is for the mark LUMECARE. It stands in the name of Medicom Healthcare Ltd ("Medicom"). The application originally sought registration for a range of goods in classes 3, 5 and 10 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. Following publication of the application in the *Trade Marks Journal* on 8 August 2008, Notice of Opposition was filed by Stephen Spencer Hastings. The application was subsequently amended to divide it into two parts (Parts A and B) with the Part B application proceeding to registration in respect of the goods in class 10. The Part A application, which is before me, was itself subject to further amendment by which the goods in class 3 were deleted from the application. Thus, the application now seeks registration for the following goods:

Class 5

Pharmaceutical preparation; ophthalmic preparations; eye drops; eye care products; food products and supplements for medical use.

3. Mr Hastings' opposition is based on grounds under section 5(2)(b) of the Act. He relies on his earlier registration No 2413993, which was registered on 11 August 2006, insofar as it is registered for *soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices*. As the mark relied on was registered less than five years before the date of publication of the mark applied for, Mr Hastings is not required to show proof of use of his mark, in line with the provisions of The Trade Marks (Proof of Use, etc.) Regulations 2004.

4. Medicom filed a counterstatement in which, essentially, it denied the grounds of opposition. Neither party filed evidence and neither sought to be heard though Medicom did file written submissions which I take into account in reaching my decision and will refer to as necessary.

The Law

5. The ground of opposition is founded on section 5(2)(b) of the Act which reads:

(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.


6. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma Ag*, paragraph 24;
- (g) in determining whether similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer inc*; mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;

- (h) further, 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; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29;
- (j) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*;
- (k) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L Laudato & C. Sas v OHIM*.

7. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

8. For ease of reference I set out the respective marks and their specifications of goods:

Medicom's application	Mr Hastings' earlier mark
LUMECARE	
Pharmaceutical preparation; ophthalmic preparations; eye drops; eye care products; food products and supplements for medical use (Class 5)	Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices (Class 3)

Relevant public and the purchasing act

9. Each of the respective products is an item for personal care or for health or medical purposes. Some, such as *dentifrices* are everyday items which are likely to be of relatively low cost and bought on a regular basis with a fairly low degree of attention being paid to their selection. Others, such as a *perfumery* are likely to vary

in price and may be bought rather more irregularly and with a higher degree of attentiveness being paid to the purchase (see Case T146-06 *Sanofi-Aventis v OHIM –G D Searle (Aturion)*). All are goods that will be bought by the general public either by self selection in a store or supermarket or via the Internet or by mail order, though some pharmaceutical preparations and items for medical use may be supplied only on prescription and may also be bought or prescribed by those in the medical profession. The purchasing act is one based predominantly on the visual aspects but not to the extent that I should ignore aural and conceptual considerations.

Comparison of marks

10. From the case law set out at paragraph 6 above, I derive the following principles. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed, therefore, by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind though he/she is deemed to be reasonably well informed and reasonably circumspect and observant. I also bear in mind that the assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public (*Succession Picasso v OHIM –DaimlerChrysler (Picaro) Case T-185/02*).

11. Each of the respective marks is presented as a single word. Those words are not, as far as I know or have been made aware, dictionary words. Whilst in each case, the words end in the four letters making up the known word CARE, which is not distinctive in relation to many of the particular goods involved and may lead to greater emphasis being placed on the earlier part of each mark, there is nothing, such as a change of font, which serves to separate this word within the marks or which otherwise makes it stand out: I recognise that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. In my view neither mark has any dominant component: the distinctiveness of each mark lies in the trade mark as a whole.

12. Both marks consist of a single word of eight letters. For its part Medicom states there is little visual similarity between the respective marks and submits that Mr Hastings' mark:

“consists of a device containing lowercase letters save for the letter “L”. These letters are blue in colour and are displayed on a grey background. All the letters have a shadow attached in the colour white and are displayed in a specific font type”.

It goes to submit that its own mark is:

“displayed all in capital letters and not in any particular colour. This along with the existence of an “E” forming the fourth letter of the mark differentiates it from the Opponent’s mark visually”.

13. Whilst I agree with these descriptions in terms of the capitalisation (or otherwise) of letters within the marks (which, in my view, has no effect on how the marks will be seen), I note that the earlier mark is not subject to any claim to colour. Furthermore, whilst there is, on close inspection, something of a shadow to each of the letters of the earlier mark, the stylisation is quite unremarkable in any material sense. The marks differ only in respect of the fourth of their eight letters; in each case this fourth letter is a vowel. There is a high degree of similarity between the two marks from a visual perspective.

14. As to the aural comparison, Medicom submit that the two marks are phonetically different. It submits that this is because:

“..both marks do not share the same fourth letter and this changes the composition of the Applicant’s sign and therefore the way that it sounds;

(a) The Applicant’s sign consist of two syllables. “LUME” and “CARE”. “LUME” being pronounced in one motion.

(b) The Opponent’s mark contains three syllables. “Lum” and “I” and “care”. The consumer would pronounce the forth (sic) letter as “I” and not “E”.”

15. There is little aural difference between a letter I and a letter E especially when placed in the middle of a fairly long word (as is the case, for example, with the words complement and compliment). And whilst it is possible that some, on seeing Medicom’s mark would pronounce it in the way it is suggested i.e. loom-care, it is equally possible that others would pronounce it as having three syllables i.e. loo-me-care. In any event I find this argument somewhat academic as whether pronounced as loom-care or loo-me-care it is aurally highly similar to the earlier mark.

16. Both marks are, as far as I am aware, invented words and, whilst the word CARE may, to some, be identifiable within each mark and may bring to mind something for use in tending to something, the marks as wholes are unlikely to bring any specific conceptual meaning to mind by the average consumer. From this perspective, the matter is neutral.

17. The respective marks are similar to a very high degree.

Comparison of goods

18. The goods to be compared are classified as being in classes 5 (Medicom’s) and 3 (Mr Hastings’) respectively. The significance of classification and the relevance of class numbers have been considered by the courts in *Altecnic Ltd’s Trade Mark Application (CAREMIX)* [2002] RPC 639, by the Court of Appeal and in *Avnet Incorporated v Isoact Limited* [1998] FSR 16, by the High Court. In *Proctor & Gamble*

Company v Simon Grogan O-176-08, Anna Carboni, sitting as the appointed person, referred to *Altecnic* and said:

“32. The International Classification system also applies to Community trade marks. Rule 294 of Commission Regulation 2868/95/EC implementing the Regulation on the Community trade mark (40/94) states as follows:

(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

33. It is thus made plain under the Community trade mark system that class numbers are irrelevant to the question of similarity of goods and services.

34. There is no similarly plain provision in the Act or the Directive. The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd's trade Mark Application (CAREMIX)* [2001] EWCA Civ 1928, [2002] RPC 639. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.

35. In *British Sugar PLC v James Robertson & Sons Ltd* [1996] RPC 280 (“*Treat*”), Jacob J said (at 289):

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

36. He went on (at 295) to set out the following factors as being relevant to the question of similarity (insofar as relevant to goods), without reference to the classes in which they fell:

- (a) the respective uses of the respective goods;
- (b) the respective users of the respective goods;
- (c) the physical nature of the goods;
- (d) the respective trade channels through which the goods reach the market;

- (e) in the case of self-service consumer items, where in practice they are respectively found or likely to be found in supermarkets;
- (f) the extent to which the respective goods are competitive. This enquiry may take into account how those in trade classify goods, for instance whether market research companies put the goods in the same or different sectors.

37. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc.* (referred to above), the ECJ stated the following:

23. In assessing the similarity of the goods or services concerned,... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

38. None of these authorities supports the Applicant's contention that goods in different classes should be considered to be dissimilar. Nor do they support the contention, which it seems to me underlies the Applicant's central submissions, that lack of similarity in the physical nature of goods overrides all other factors."

19. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-325/06, the General Court explained when goods would be complementary. It said:

"82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM -Sissi Rossi (SISSI ROSSI) [2005] ECR II 685, paragraph 60, upheld on appeal in Case C 214/05 P Rossi v OHIM [2006] ECR I 7057; Case T- 364/05 Saint Gobain Pam v OHIM-Propamsa (PAM PLUVIAL) [2007] ECR II 757, paragraph 94; and Case T 443/05 El Corte Inglés v OHIM –Bolaños Sabri (PiraÑam diseño original Juan Bolaños) 2007 ECR I-0000, paragraph 48."

20. The term *pharmaceutical preparation* as applied for is not limited in any way and thus includes any products intended for use in the treatment, prevention or diagnosis of disease and by those seeking to prevent, alleviate or treat some sort of medical condition. The nature of such goods may vary markedly taking into account on which part of the body it is to be used and whether that use was internal or external. Whilst these goods have different natures, uses and users to most of the goods of the earlier mark, further consideration is required as regards *soaps*. I am aware that some pharmaceutical preparations are intended for personal cleansing and moisturising purposes and take the form of a soap substitute for those unable or unwilling to use soap itself and these are goods which are therefore in direct competition with each other. Both *pharmaceutical preparations* and *soaps* (a term which includes medicated soaps and soap in solid or liquid form) are goods which

are likely to be supplied by health and personal care manufacturers and will be sold in pharmacies (whether or not on prescription) as well as in the health and personal care section of a supermarket. To the extent that the term *pharmaceutical preparation* includes such products intended for use as a soap substitutes, there is similarity between the respective goods.

21. *Ophthalmic preparations*, a term which includes the separately specified *eye drops* and *eye care products*, are products used by those seeking to prevent, alleviate or treat conditions of the eye. Again they will be sold in pharmacies or the health and personal care section of a supermarket but, given the vulnerability and sensitivity of the eye itself they are goods likely to be bought with some care. They are clearly different goods to most of the goods appearing within the earlier mark given their respective purposes and, whilst *cosmetics* within the specification of the earlier mark, will include cosmetics for use on the eye area, the natures of these respective goods will differ given that these latter goods are to beautify. They are not complementary to or in competition with the goods of the earlier mark. They are not similar goods to those of the earlier mark.

22. This leaves *foods products and supplements for medical use*. These are products intended for ingestion and are nutritional products for use by those wanting to treat or prevent a specific condition or deficiency. Whilst they may be sold in the same places as the goods of the earlier mark, their nature and purpose differ markedly and they are not complementary to or in competition with the goods of the earlier mark. They are not similar goods to those of the earlier mark.

Likelihood of confusion

23. In reaching a decision on whether there is a likelihood of confusion, I must make a global assessment based on all relevant factors. The decision of the General Court in *New Look Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, indicates that the circumstances in which the relevant goods and the marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. But I also have to make an assessment of all relevant factors and take into account the fact that the consumer will rarely have an opportunity to compare marks side by side but will instead rely on the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27).

24. Another factor to be taken into account is the distinctive character of the earlier trade mark having regard to its inherent characteristics and the reputation it enjoys with the public. No evidence of any use of the earlier mark has been filed and therefore I have only the mark's inherent characteristics to consider. I have already indicated that the earlier mark is an invented word and therefore it is inherently reasonably high in distinctive character.

25. I have found that the respective marks are similar to a very high degree. I have found *pharmaceutical preparation* to be similar goods to *soaps* but all other goods I have found not to be similar. Taking all matters into account and applying the global

approach as I am required to do, I find that the opposition succeeds in relation to *pharmaceutical preparation* but fails in respect of all other goods.

Costs

26. Both parties have achieved a measure of success. In view of this, I think it appropriate that each bears its own costs in relation to these proceedings.

Dated this 28 day of October 2010

**Ann Corbett
For the Registrar
The Comptroller-General**