

O-587-15

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION BY
GLAXO GROUP LIMITED
UNDER NO 3085533 FOR THE TRADE MARK**

EVONTRUS

AND

**IN THE MATTER OF OPPOSITION NO. 403995 THERETO
BY EVONIK INDUSTRIES AG**

THE BACKGROUND AND THE PLEADINGS

1) On 11 December 2014 Glaxo Group Limited (“the Applicant”) filed application no. 3085533 to register the following mark:

EVONTRUS

The application was published for opposition purposes on 19 December 2014 for the following goods in Class 5:

Class 5: *Pharmaceutical and medicinal preparations and substances; vaccines.*

2) On grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) Evonik Industries AG (“the Opponent”) opposes the registration of the Applicant’s mark for all the goods for which the Applicant seeks registration.

3) For the purposes of its claim the Opponent relies on the international trade mark (EC) no. 918426 (“the earlier mark”), as shown below:

EVONIK

The earlier mark is registered for goods and services in a number of classes, but only the following are relied on for the purposes of the present opposition proceedings:

Class 5: *Pharmaceutical, veterinary and sanitary preparations.*

The earlier mark has an international registration date of 2 October 2006 and was granted protection in the EU on 4 February 2013, which is less than five years before the publication date of the opposed mark. The significance of these dates is that (1) the earlier mark constitutes an “earlier mark” for the purposes of section 5(2)(b) of the Act, and (2) the proof of use provisions in section 6A of the Act do not apply in respect of it.

4) The Applicant filed a notice of defence and counterstatement, denying the grounds of opposition. Neither party filed evidence. Neither side requested a hearing. Both filed written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the papers before me.

SECTION 5(2)(b)

5) Sections 5(2)(b) of the Act reads 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”.

I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments. The following principles are gleaned from the decisions 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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods

6) In the judgment of the 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”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity also included users and channels of trade of the respective goods.

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

8) The Applicant’s *pharmaceutical preparations and substances* are clearly covered by the Opponent’s *pharmaceutical preparations*. The Applicant’s specification also includes *medicinal preparations and substances* and *vaccines*. In its submissions the Applicant “*acknowledges that the respective goods are either identical or similar and therefore the comparison must be made primarily on the basis of the similarities of the marks*”. In effect this amounts to a concession that the competing goods are either identical or highly similar. This is manifestly correct. I consider these terms to be included within the broader term *pharmaceutical preparations*. The parties competing goods are therefore identical. Even if *vaccines* and some *medicinal preparations* were not already covered by the term *pharmaceutical preparations* there would in any case be high similarity between them by virtue of use, users, purpose, channels of trade and complementary or competing nature.

The average consumer and the purchasing process

9) 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*. 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.”

10) In its submissions the Opponent points out that the respective goods include such things as headache tablets available off the shelf at supermarkets and even petrol stations. On this point the Applicant submits that, where goods are purchased over the counter or, for example, on the internet, the level of attention will still be high, owing to the nature of the goods. It refers to case T-33//09 *Novartis v OHIM* at paragraph 28, which reads: “*Contrary to the applicant’s submissions, the fact that an end consumer could possibly obtain on the Internet a medicinal product sold without prescription, without the advice of a pharmacist or physician, is not such as to lower that consumer’s degree of attentiveness when purchasing such goods.*”

11) In *Mundipharma AG v OHIM*, Case T-256/04, the General Court accepted that there were two groups of relevant consumers for a pharmaceutical product, professional users and the general public. The parties’ goods in this case include pharmaceutical preparations and the like at large, not restricted to specific conditions or procedures. I accept that they would include products used exclusively by medical professionals. They would also include both general prescription medication and over-the-counter or self-selected goods. The Applicant’s goods also expressly include *vaccines*, which are clearly normally selected and administered by healthcare professionals.

12) In *Armour Pharmaceutical Co v OHIM*, Case T-483/04, the GC stated:

“79. The Court finds that the level of attention of the average consumer of pharmaceutical preparations must be determined on a case-by-case basis, according to the facts in the case-file, especially the therapeutic indications of the goods in question. Likewise, the Court finds that, in the case of medicinal products subject to medical prescription such as those being considered in the present case, that level of attention will generally be higher, given that they are prescribed by a physician and subsequently checked by a pharmacist who delivers them to the consumers.”

13) Further in *Aventis Pharma SA v OHIM*, Case T-95/07, the CFI stated:

“29. First, as noted in the case-law, medical professionals display a high degree of attention when prescribing medicinal products. Second, with regard to end consumers, it can be assumed, where pharmaceutical products are sold without prescription, that the consumers interested in those products are reasonably well informed, observant and circumspect, since those products affect their state of health, and that they are less likely to confuse different versions of such products (see, to that effect, Case T-202/04 Madaus v OHIM – OptimaHealthcare (ECHINAID) [2006] ECR II-1115, paragraph 33). Furthermore, even supposing a medical prescription to be mandatory, consumers are likely to display a high degree of attention when the products in question are prescribed, having regard to the fact that they are pharmaceutical products (ATURION, paragraph 27).”

14) The average consumer for the competing goods consists of medical and healthcare professionals and members of the general public. The level of attention may vary, depending on such factors as the price and purpose of the relevant goods, therapeutic indications, and whether they are sold with or without prescription. In the case of pharmaceutical preparations administered in hospital, the relevant public is more likely to consist of physicians and hospital pharmacists, whose level of attention will be high. Where the goods are prescription medication the average consumer will consist both of a medical professional and the patient who is the end user. A medical professional is likely to pay a higher degree of attention when prescribing medication. Pharmaceutical products sold without prescription, even where they are low cost, will require a certain level of attention to be paid to their selection which takes into account ingredients, side effects and the condition for which treatment is required. Although I accept that consumers are in general likely to pay greater attention to the purchase of goods which affect their health, their attention will not normally be as high as that of medical and healthcare professionals, and will vary with the purpose and price of the particular products.

15) Medical professionals would be aware of these products from articles in medical journals, approaches from medical sales representatives and medical literature, including medical catalogues. The general public would learn of products through display on shelves, on the internet, advertisements, word-of-mouth, and consultations with medical professionals and pharmacists. In the absence of evidence it is difficult to assess the relative importance of visual and aural aspects in the purchasing process, and both will be taken into account in my assessment.

Comparison of the marks

16) 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.”

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.

17) The marks to be compared are shown below:

The opposed mark	The earlier mark
EVONTRUS	EVONIK

18) Neither party has suggested that either of the competing marks has a meaning likely to be known to the average consumer. Both marks consist of an invented word, not descriptive or allusive of the respective goods. There are no elements within them which could be characterised as dominant or distinctive, and they must be compared as wholes. The distinctive character in each case resides in the whole word.

19) When it comes to the visual comparison of marks, there is a rule of thumb that it is, in general, the first component of word marks that is more likely to catch the consumer’s attention¹. This is no more than a rule of thumb. Each case must be considered on its merits². My assessment must take account of the overall impression created by the marks. In this case I think the rule of thumb is a useful guide, and that the initial EVON in both marks will catch the consumer’s attention. Having said that, the marks are of different length and their endings are different. In the case of the opposed mark the ending makes up fifty percent of the mark. The Applicant submits that “*As the use of NIK and TRUS at the end of a word are very unusual, they would both stick in the mind of the relevant public because they are uncommon in the English language*”. I agree that IK is an unusual ending, though I bear in mind that “ic” is not, and that consumers are used to quirky spellings being used in trade marks. I do not agree that the endings of either mark are so unusual that they would make a special impression and particularly draw the eye, but they do certainly make a real contribution to the overall visual impression of their respective

¹ See the case law cited by the GC in paragraph 36 of *Hipp & Co KG v OHIM* Case T-41/09

² Cf. *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-438/07 at paragraph 23.

marks. Overall, there is a medium degree of visual similarity between the competing marks.

20) Aurally, both marks consist of three syllables. Since they are both invented words, there is no accepted orthodox pronunciation for them. Consumers will either pronounce the initial E of the marks as a short vowel (as at the beginning of “every”) or a long vowel (as at the beginning of “evoked”); but, whichever way they pronounce it, they are likely to pronounce it in the same way in both marks. The pronunciation of VON is straightforward, with the result that the first two syllables of the competing marks will be pronounced identically. There is a clear difference in the final syllable; TRUS is likely to be pronounced like the “trus” in “citrus”, and IK will be pronounced like the “ic” in “slavonic” (or the “ik” in “bolshevik”). Overall, there is a medium degree of aural similarity between the competing marks.

21) I have already found that both marks are invented words. Neither has any meaning or allusive content for the relevant consumer. There is therefore neither conceptual similarity nor conceptual difference between the marks.

The distinctiveness of the earlier marks

22) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

23) I have no evidence of acquired distinctiveness to consider. This leaves the question of inherent distinctiveness. I have already found that the earlier mark will

be perceived as an invented word, not descriptive or allusive in any way of the relevant goods. It therefore has a high degree of inherent distinctiveness.

Likelihood of confusion

24) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

25) The goods of the competing marks are identical or highly similar, and the earlier mark has a high degree of distinctiveness. I have found a medium degree of both visual and aural similarity, and neither conceptual similarity nor conceptual difference between the competing marks. The average consumer of *vaccines* consists of the medical professionals who select and administer them, and who will have a high level of attentiveness. I accept that, even where the average consumer has a high level of attentiveness, s/he too may only rarely have the chance to make a direct comparison of the marks, relying on the imperfect picture of them that s/he has kept in his or her mind. Nevertheless, medical and healthcare professionals, who deal routinely with pharmaceuticals as an essential part of their job, are likely to be less subject to the effects of imperfect recollection than members of the general public. I consider that the differences between the marks in this case will be sufficient to offset their similarities in the mind of the average consumer of *vaccines*. Accordingly, **I find no likelihood of confusion in respect of vaccines. Therefore the opposition fails in respect of vaccines.**

Revised specification

26) I have found that, in addition to products used exclusively by medical professionals and general prescription medication, *pharmaceutical and medicinal preparations and substances* also include over-the-counter or self-selected goods. I accept that consumers are in general likely to pay greater attention to the purchase of goods which affect their health. However, and in particular bearing in mind the principle of imperfect recollection, I consider that the differences between the marks will not be sufficient to offset their similarities in the mind of members of the general public purchasing the kind of everyday pharmaceutical or medicinal products which are available off-the-shelf in shops, on the internet, etc. For these consumers there is a likelihood of confusion.

27) I have given some thought to whether it is necessary to consider if the specification applied for could be amended so that it would in practice satisfactorily exclude occasion for confusion on the part of consumers who are not medical or healthcare professionals. In this case I have been unable to devise a specification which would achieve this object through simple deletions or by adding a "save for" type of exclusion. In accordance with TPN 1/2012, paragraph 3.2.2 I therefore invite

the Applicant to put forward a revised specification and accompanying submissions detailing any types of goods it wishes to register which

- fall within the ambit of *pharmaceutical and medicinal preparations and substances*;
- are clearly such as to exclude occasion for confusion on the part of consumers who are not medical or healthcare professionals;
- do not fall foul of the guidance issued by the CJEU in the *Postkantoor*³ decision.

The Applicant's written submissions, which should be copied to the Opponent, should explain why it considers its suggested specification will clearly exclude occasion for confusion on the part of consumers who are not medical or healthcare professionals. The Applicant is allowed a period of 21 days from the date of this decision in which to file these submissions. On their receipt the Opponent will be allowed 21 days to comment on them. I shall then issue a supplementary decision in which I shall decide whether the proposed specification is free from objection. If the Applicant submits no revised specification, I shall issue a supplementary decision confirming that the opposition succeeds in respect of the specification *pharmaceutical and medicinal preparations and substances*, since it includes goods for whose consumers there is a likelihood of confusion, as explained in paragraph 26.

28) The appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision, which will also include a decision on costs.

Dated this 10th day of December 2015

**Martin Boyle
For the Registrar,
The Comptroller-General**

³ CJEU Case C-363/99