

O/029/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO 1 034 195  
DESIGNATING THE UNITED KINGDOM IN THE NAME OF**

**DENOMEGA NUTRITIONAL OILS AS**

**TO REGISTER IN CLASS 05 THE TRADE MARK:**



**AND**

**OPPOSITION THERETO UNDER NO 722 16  
BY TEVA PHARMACEUTICAL INDUSTRIES LIMITED**

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**The Background and Pleadings**

1. Denomega Nutritional Oils AS (the holder) applied to extend protection to the United Kingdom in respect of their international trade mark registration (as shown above) on 12<sup>th</sup> January 2010, with a priority date of 13<sup>th</sup> July 2009. The application was published in the Trade Marks Journal on 8<sup>th</sup> October 2010 in respect of the following contested goods in class 05:

*Pharmaceutical preparations, cod liver oil and fish oil and food supplements.*

2. Teva Pharmaceutical Industries Limited (the opponent) opposes the registration on the basis of their earlier trade mark: 360° which is registered in class 05 in respect of *pharmaceuticals, pharmaceutical products, pharmaceutical preparations*. The ground upon which the opposition is based is Section 5(2)(b) of the Trade Marks Act 1994 ("the Act) in that the contested goods are identical and or similar to those of the earlier trade marks. Further, that the respective trade marks are similar. As such, there is a likelihood of confusion.
3. The holder filed a counterstatement denying the ground of opposition. Specifically, it argues that 360° is commonly used in the pharmaceuticals industry and so the earlier trade mark has only a low degree of distinctiveness. As such, the penumbra of protection to be granted to it should be limited to virtually identical marks for virtually identical goods. In respect of

the contested *cod liver oil and fish oil, food supplements* the holder argues that these are natural products, sold over-the-counter and widely available to the general public for the improvement of general well-being whereas the earlier goods are chemical substances intended for use in the medical diagnosis, cure, treatment and prevention of disease, such goods being strictly regulated. As such, the respective goods are distinguishable from one another.

### **The opponent's evidence**

4. This takes the form of submissions, which I will not summarise here. However, they will be fully taken into account in reaching my decision and will be referred to as and where appropriate during this decision.

### **The holder's evidence**

5. Some of the "evidence" is comprised of submissions. As above, these will not be summarised here but have been fully taken into account and will be referred to where appropriate during this decision.
6. There is a witness statement, dated 3<sup>rd</sup> August 2011, from Alistair Gay, a trade mark attorney and the representative of the holder in these proceedings. The crux of the witness statement is in respect of evidence which, according to Mr Gay, supports the holder's position regarding the low degree of distinctiveness of the earlier trade mark. This evidence comprises the following:
  - Exhibit ARG1 are printouts from the Trade Mark Registry and OHIM databases, detailing co-existing 360/360° trade mark registrations in class 05.
  - Exhibit ARG2 are printouts from websites featuring the use of the term 360 and 360° in the field of pharmaceuticals and healthcare. I note that all the printouts either post date the relevant date in these proceedings, namely 13<sup>th</sup> July 2009 or are dated in a manner that is unclear as to whether they pre or post date, for example, "2009" is mentioned.
7. I will consider the impact of this evidence further below.

### **The opponent's evidence in reply**

8. This is a witness statement, dated 29<sup>th</sup> September 2011, from Graham Farrington, a trade mark attorney and representative of the opponent in these proceedings. The content of Mr Farrington's witness statement focuses upon the assertion from the holder as to the differences between the contested goods and those of the earlier trade mark (with the exception of

pharmaceutical products, for which it is accepted they are identical). Mr Farrington refutes that there is a clear difference between cod liver oil and fish oil and food supplements and the earlier goods and attaches a number of exhibits in support of this. These are:

- Exhibit GF1 which is an extract from the website of The Medicines and Healthcare Products Regulatory Agency (MHRA). The extract contains text describing both medicines and “borderline” products. The MHRA indicates that whilst dietary supplements are not normally regarded as a medicinal product, however “a pharmacologically active substance or make medicinal claims (claims to treat or prevent disease, or to interfere with the normal operation of a physiological function of the human body are regarded as medicinal)”.
- Exhibit GF2 is an extract from Wikipedia defining fish oil as being “known to reduce inflammation throughout the body...thought to have many health benefits”.
- Exhibit GF3 is an extract from Wikipedia providing a definition of cod liver oil in which it is stated that “it is widely taken to ease the symptoms of arthritis and for other health benefits”.
- Exhibit GF4 is the result of a search for “fish oil products” conducted on the Boots website (Boots being a retailer of pharmaceuticals and cod liver oil, fish oil and food supplements). Of the 43 products listed in the search results, 21 products bear a label which mentions the term “Boots Pharmaceuticals” in conjunction with the term “cod liver oil” or the term “fish oil”.
- Exhibit GF5 is a copy of the Shorter Oxford English Dictionary Third Edition, giving a definition of cod liver oil as “oil expressed from the liver of the cod fish, much used in medicine”.
- Exhibit GF6 are online extracts taken from The Independent dated 13<sup>th</sup> February 2004 and from the BBC News website dated 13<sup>th</sup> June 2011. Both articles refer to the medicinal/pharmaceutical uses of cod liver oil.

## **DECISION**

### **Likelihood of Confusion – Section 5(2)(b)**

9. Section 5(2)(b) of the Act reads:

“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.”

10. In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [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 + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

### **The average consumer and the purchasing act**

11. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

12. The goods in question are pharmaceutical products which aim to treat, manage or prevent disease *and to maintain general good health or are products* closely related to such purposes. Bearing in mind the nature of the goods, I would expect the level of attention to be at least medium and may indeed be high, dependent on the exact nature of a particular product. As to *the nature of the purchasing act*, this is likely to vary in that many of the relevant products can be purchased over the counter, off the shelf or via a prescription from a medical professional. It is likely therefore that both visual and aural considerations are important.

## Comparison of goods

13. In terms of the comparison to be made, all relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

14. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”

15. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in 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 the trade”<sup>1</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given

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<sup>1</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

an unnaturally narrow meaning<sup>2</sup>. Finally, when comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play<sup>3</sup> even if there may be other goods within the broader term that are not identical.

16. The contested goods include *pharmaceutical preparations* which are self evidently identical to the earlier goods (indeed this is agreed by the parties).

17. The remaining contested goods are *cod liver oil and fish oil, food supplements*. The holder is of the view that these goods are readily distinguishable for the reasons already outlined above, whereas the opponent argues that they are at least similar and has filed evidence (already described above) in support of its position.

18. Bearing in mind the case law as regards the comparison of goods, it seems to me that the remaining contested goods and the earlier goods are both, broadly speaking, related to health. They each aim to help treat, manage and/or prevent disease and otherwise promote health and well-being. Further, it is not unrealistic to suppose that such items could be used together, for example, a person with joint problems may use a drug to manage pain and also a food supplement or fish oil to promote joint health. The end users therefore can also coincide. They are also similar in nature as each can realistically be available in capsule, sachet and/or liquid form. All of the relevant goods can be sold in a pharmacy and so the channels of distribution can coincide. The holder's argument regarding the need for a medical professional and so a prescription does not, in my view, have a definitive impact which will enable distinguishing between the products as a large number of pharmaceuticals can be purchased over the counter or off the shelf. As such, the distribution channels have potential to be even closer. I therefore conclude that there are clear points of similarity between these goods and assess the degree of similarity as being medium.

### **Comparison of the marks**

19. 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

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<sup>2</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

<sup>3</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* Case T-133/05 (“*Gérard Meric*”).

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. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

20. The respective trade marks are displayed below:

360°	
Earlier trade mark	Contested trade mark

21. The marks coincide in that each contain the element 360°. They differ in respect of the additional elements in the contested trade mark, namely the element OMEGA and the circular device present which have no counterpart in the earlier trade mark. Though these additional elements have a visual impact, the element 360° is clearly visible within the contested sign. They are therefore visually similar, to a low to medium degree.

22. Aurally, the signs will differ in the same respects as already described under the visual comparison. There is, in my view, also a low to medium degree of aural similarity.

23. Conceptually, the earlier sign will be understood as referring to three hundred and sixty degrees, namely a complete circle or is otherwise related to completeness in some way. The contested sign is likely to be understood in more than one manner.

24. The first meaning that is likely to be apparent is “Omega 3”. This meaning, in my view, is likely to be grasped upon a visual inspection of the mark as the numeral 3 is larger in size than the remaining 6 and 0 and is closer in size to the verbal element OMEGA. Omega 3 will be understood as referring to essential fatty acids which are found in fish oils and are said to be essential for the brain and nervous system. It is also likely that three hundred and sixty degrees will be understood in the contested sign due to the complete inclusion of the numerals 360 and the addition of the ° (degree) symbol. It is likely therefore that even though the structure of the sign is playing with the language and is attempting to merge two concepts, a consumer may well understand two messages simultaneously from the contested sign, that of omega 3 and that of 360° and it is also likely that one message continues on from the other, in a sense of the omega 3 being complete in some way. It follows

therefore that is at least a degree of similarity between the signs, centred around the 360 element. I pitch the degree of the conceptual similarity as being low to medium.

### **Distinctive and Dominant components**

25. To my mind, neither of the marks have any clear dominant (visually outstanding) component. Indeed the earlier mark has only one component. Rather, each mark will be appreciated instantly as a whole.

26. As regards the earlier trade mark and as already outlined above, the holder asserts that it is low in distinctiveness and has filed evidence in support. The issue of the degree of distinctiveness of the earlier trade mark is important because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The evidence filed is comprised of register entries from both the UK trade marks registry and that of the European Community (OHIM), together with examples of use of the combination in the health and pharmaceutical industry. Looking at the register entries, I note that all are the numerals 360 with additional elements, be they other distinctive words, devices, or even descriptive words. There are no examples of the element alone. The evidence from the marketplace is in the same vein, with descriptive words used alongside the numerals 360. Some of the evidence, namely that of Immune 360 describe the products as “building your circle of defence” thus alluding (perhaps even strongly so) to the idea of a completeness to the product or products and the idea that this is all that one would need to take or the only program one would need to follow. However, in my view, the additional elements that are joined with 360° have an impact in that they ensure its allusive nature. The earlier trade mark is 360° alone, which to my mind is at least marginally less allusive and more abstract. Though it may therefore allude to an idea of completeness, it is only barely allusive and so does contain at least a degree of distinctive character, even if that degree can be assessed as being relatively low. I will consider the impact of this further below in the global assessment.

27. Though there is no requirement for me to consider the degree of distinctiveness of the contested trade mark per se, I must bear in mind whether there are any particular components of it which are distinctive in order to reach a view as to the overall degree of similarity between the signs. Bearing in mind I have already found that OMEGA 3 is likely to be read and understood in the contested sign (at least where it is appreciated visually) and bearing in mind the meaning of the term, I consider this to be entirely descriptive of at least some of the contested goods, namely *cod liver oil and fish oil, food supplements*, the first two of which are the fatty acids and the latter which can contain them. The distinctiveness of the contested sign therefore lies in its combination as a whole, which includes the 360° element. Bearing in mind all of the above, I consider the marks to be similar to a low to medium degree.

## **Global Assessment – Conclusions on Section 5(2)(b)**

28. In considering the likelihood of confusion therefore, it is clear that the factors assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that 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.

29. I will firstly consider the position in respect of the contested goods found to be identical. Further, the marks have been found to be similar to a low to moderate degree. It is true that the marks coincide in an element which has a fairly low degree of distinctive character. However, this is only one factor to be considered in the global assessment and to my mind must be weighed up in the mix. To my mind, the degree of similarity between the signs which is not insignificant, together with the identical nature of the goods and bearing in mind the principle of imperfect recollection is enough to conclude that confusion here is likely. The opposition therefore succeeds in respect of the identical goods.

30. As regards the remaining contested goods, I bear in mind the descriptive nature of OMEGA 3 which I consider will inevitably be understood by the relevant consumer upon a visual inspection of the mark. Bearing in mind the nature of the purchasing act which can include a visual inspection and self selection from a shelf, visual impressions are important. The situation therefore is that the marks are similar and the goods are similar. It remains true that the earlier trade mark is relatively low in distinctiveness. However, it is only one factor and others, such as imperfect recollection must also be considered. Further, the element OMEGA 3 in the contested sign is even less distinctive in respect of fish oils and the remaining contested goods than 360. They therefore coincide in respect of the contested sign's more distinctive element. Bearing in mind all of the aforesaid and the fact that 360° can clearly be read and understood in the contested trade mark, this leads me to conclude that confusion is likely. The opposition therefore also succeeds in respect of these similar goods.

## **COSTS**

31. The opponent has been successful and is entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither party sought a hearing. In the circumstances I award the opponent the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Statutory fee for filing opposition - £200

Filing notice of opposition and considering counterstatement- £300

Filing evidence and submissions and considering the applicant's evidence -  
£500

Total - £1000

32. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 31<sup>st</sup> day of January 2012**

**Louise White**

**For the Registrar,**

**The Comptroller-General**