

O-057-08

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. 2412508 AND 2412509 IN THE
NAME OF OPAL HEALTHCARE LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NOS. 94471 AND 94467
BY AFFINITY PETCARE S.A.

TRADE MARKS ACT 1994

IN THE MATTER OF application
Nos. 2412508 and 2412509 in
the name of Opal Healthcare Limited
and in the matter of opposition thereto
under Nos. 94467 and 94471 by
Affinity Petcare S.A.

Background

1. Application Nos. 2412508 and 2412509 stand in the name of Opal Healthcare Ltd. Both applications were filed on 31 January 2006 and are for the following marks:

2412508



2412509 (series of two)



2. Registration is sought in both cases in respect of the following goods and services:

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Class 35: Wholesale services connected with the sale of pharmaceutical and veterinary preparations and substances.

Class 39: Storage, warehousing, packaging, delivery, distribution and transport of goods; arranging for the transportation of goods; storage, warehousing, packaging, delivery, distribution and transport of pharmaceutical and veterinary preparations and substances; arranging for the transportation of pharmaceutical and veterinary preparations and substances and materials for dressings; rental of warehouses and other storage facilities.

3. Following publication of the applications, notices of opposition were filed on behalf of Affinity Petcare S. A. against the goods and services in classes 5 and 35 only. There is a single ground of attack, under section 5(2)(b), based on the opponent's earlier community trade mark No. 3224805 as follows:



for the following goods and services:

Class 5: Veterinary and sanitary preparations for animals; preparations for destroying vermin; additives for animal foods; pesticides, powders, sprays and collars, all for killing fleas and for use with animals.

Class 31: Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; litter for animals; malt; preparations for use as additives for animal foods; beverages for pets; fodder.

Class 35: Advertising, marketing or promotion of products for animals; import and export of goods for animals; commercial retailing of products for animals.

Class 41: Providing of education; providing of training; entertainment; sporting and cultural activities; arranging of congresses, conferences, seminars, colloquiums and contests.

Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

4. The applicant filed counter-statements essentially denying the grounds of opposition.

5. Both parties filed evidence in these consolidated proceedings. The matter came to be heard before me on 6 February 2008 when the applicant was represented by Claire Lazenby. The opponent did not attend but written submissions in lieu of attendance were filed by Murgitroyd & Company, its legal representatives in these proceedings.

Opponent's evidence

6. A separate witness statement was filed in respect of each opposition by Caitriona Mary Desmond. The witness statements are dated 6 March 2007 and 29 March 2007. Ms Desmond is a trade mark attorney assistant with Murgitroyd & Company.

7. Each of Ms Desmond's witness statements consist wholly of submissions rather than evidence of fact. I do not intend to summarise them for that reason, but I do take them into account in reaching my decision.

Applicant's evidence

8. This takes the form of a witness statement dated 6 June 2007 by Joanne Claire Lazenby, the applicant's legal representative in these proceedings. Ms Lazenby recounts a visit she made to a branch of Boots the Chemist and the purchases she made. She gives details of the products she bought on that occasion and exhibits the following:

- JCL1: pages from the "Boots" website downloaded 31 May 2007
- JCL2: receipt for purchases made from a Boots store on 4 April 2007
- JCL3: exterior packaging of the goods bought on that occasion
- JCL4: product information leaflets from the goods bought on that occasion
- JCL5: pages from the "Nurofen" website downloaded on 5 June 2007.

9. Ms Lazenby indicates that the purpose of her evidence is to provide information which may assist in considering the likelihood of confusion of the respective marks. Ms Lazenby's visit took place on 4 April 2007, some 14 months after the relevant date in these proceedings. Despite her submissions that she could not see "why it would not be a representation of what had happened before the relevant date", I do not consider this evidence to be of any assistance to me in reaching my decision.

10. No further evidence was filed by either party.

Decision

11. There is a single ground of opposition based on section 5(2)(b) of the Act. This 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."

12. The term "earlier trade mark" is defined in section 6 of the Act as follows:

“6.- (1) In this Act an “earlier trade mark” means-

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

13. There is no dispute that the opponent’s mark is an earlier trade mark within the definition of Section 6 of the Act. It is not subject to the requirements of the Trade Marks (Proof of Use, etc.) Regulations 2004.

14. In determining the question under Section 5(2), 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 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723. 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) 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.

15. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address 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 and services, the category of goods and services in question and how they are marketed whilst bearing in mind their distinctive and dominant components.

Relevant consumer and the purchasing process

16. As far as the goods of the applications are concerned, there is no indication within the specification that the *pharmaceutical and veterinary preparations* are prescription only. I must take into account therefore, that they could include prescription and non-prescription products and could be bought over the counter or off the shelf. Despite the meaning of the word veterinary, the *veterinary preparations* of the earlier mark are specifically described as being *for animals* but are otherwise not limited so would include non-prescription items. The relevant consumer of all of the goods are the public at large though I do not exclude the possibility that professionals such as clinicians, vets and animal nurses may also make such purchases. These goods could be of low cost. As to the services of the application, the opposition is directed to those in class 35 only. These being *wholesale services* are unlikely to be used by the general public but will instead be the province of retailers and other such providers in trade. All of the goods and services suggest that they are likely to be purchased with some, but not necessarily the highest, degree of care.

Comparison of goods

17. For ease of reference I set out the respective specifications below insofar as they are subject of these proceedings:

Applications	Earlier mark
Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying	Class 5: Veterinary and sanitary preparations for animals; preparations for destroying vermin; additives for animal foods; pesticides, powders, sprays and collars, all for killing fleas and for use with animals.

<p>vermin; fungicides, herbicides.</p> <p>Class 35: Wholesale services connected with the sale of pharmaceutical and veterinary preparations and substances.</p>	<p>Class 31: Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; litter for animals; malt; preparations for use as additives for animal foods; beverages for pets; fodder.</p> <p>Class 35: Advertising, marketing or promotion of products for animals; import and export of goods for animals; commercial retailing of products for animals.</p> <p>Class 41: Providing of education; providing of training; entertainment; sporting and cultural activities; arranging of congresses, conferences, seminars, colloquiums and contests.</p> <p>Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.</p>
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18. Clearly, as both the application and the earlier mark contain the terms *veterinary preparations* and *preparations for destroying vermin*, identical goods are involved. Goods can also be considered identical when the goods of the earlier mark are included in a more general category in the application. (See *Gérard Meric v OHIM* Case T-133/05). *Pharmaceutical preparations* and *veterinary preparations* could cover identical goods and include *plasters, materials for dressings, material for stopping teeth* and *dental wax*. *Food for babies* could, if specially prepared for medical purposes, also be included. I consider *sanitary preparations for animals* is included within the more general category of *sanitary preparations for medical purposes* and that these are also identical goods. Similarly, *disinfectants* are included within the category of *sanitary preparations*. *Additives for animal foods* are covered by *veterinary preparations* and *pesticides, powders, sprays and collars, all for killing fleas and for use with animals* are included within *veterinary preparations* and will include *fungicides* and these are highly similar if not identical goods.

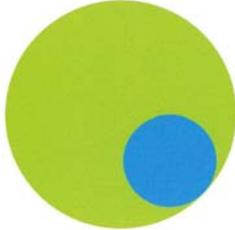
19. The only remaining goods in class 5 that require consideration are *herbicides*. I take into account the guidance set out by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281. The opponent contended that *herbicides* are similar goods to *powders and sprays for killing fleas*. Whilst these

goods may both be sold in the same shop, e.g. a DIY store or garden centre and may have the same nature e.g. a spray or powder, they are unlikely to be sold on the same shelf, the purpose of each is entirely different in that whilst one is, self evidently intended for killing fleas, a herbicide is intended for killing unwanted plants. One would not substitute one product for the other. I do not consider *herbicides* to be identical or similar to the goods of the earlier mark.

20. The application also seeks registration in class 35 for *wholesale services connected with the sale of pharmaceutical and veterinary preparations and substances*. This is a very broad term and I consider these services to be highly similar, if not identical to *commercial retailing of products for animals*.

Comparison of marks

21. For ease of reference I set out below the respective trade marks:

Applicant's marks	Opponent's mark
<p>2412508:</p> 	
<p>2412509:</p> 	

22. In *Nutri-life application O-335-07*, Geoffrey Hobbs Qc sitting as the Appointed Person noted:

“The Applicant used the version of Form TM3 introduced in May 2004. This is reproduced at pp.1432 to 1437 of Morcom et al The Modern Law of Trade Marks 2nd Edition 2005. The Form took account of the changes made to Rule 5 of the Trade Marks Rules 2000 by the Trade Marks (Amendment) Rules 2004. In Box 4 and Guidance Note 4 the Applicant was notified that the colouring shown in the graphic representation would be recorded as a feature of the sign put forward for registration if no requirement to the contrary was stated in the Form. The Form contained no requirement to the contrary. The application was therefore an application for registration of the sign in colour as shown above.”

23. Each of the applicant’s marks were graphically represented in colour in the applications for registration which were made on a version of the Form TM3 introduced in May 2004. No contrary requirement was stated in the Form. Each of the applications therefore is one for registration of the sign in the colours shown above. The opponent’s earlier mark is protected subject to a claim to the colours orange and white.

24. It is clear from the ECJ’s judgement in *Sabel BV v Puma AG* that there may be a greater likelihood of confusion where the earlier trade mark has a highly distinctive character. Furthermore, the similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the marks, bearing in mind their distinctive and dominant components.

Distinctive character of the earlier trade mark

25. I have to consider the mark as a whole. Ms Lazenby argued that the colours orange and white were the essential ingredients in the mark. She argued that “as simple designs such as circles [...] are generally considered to be devoid of distinctive character”, the dominant element of the earlier mark is the colour orange. In my view, simple geometric signs such as circles do not represent a significant degree of invention and, if they are distinctive at all, are unlikely to command anything more than a modest degree of distinctive character. The earlier mark is a circle within a circle which I consider will have added slightly to its distinctiveness. The two circles are in the colours orange and white respectively. Whilst the earlier mark will be remembered as a circular sign, the dominant and distinctive element of it is the colour orange with the small white circle within it not being overlooked. On balance, I consider the mark has a reasonable degree of inherent distinctiveness.

Comparison of marks in respect of No. 2412508

26. The earlier mark is an orange circle which completely surrounds a small, white, circle positioned towards the 12 o’clock position. The applicant’s mark consists of an outer circle in lime green which contains a contrasting blue inner circle tangentially sited at the four o’clock position.

27. Given that each of the respective marks are figurative ones which contain no words, the primary consideration is visual although I do not exclude the possibility that conceptual considerations may also come into play. There is a degree of visual similarity between the respective marks in that they both contain the circle within a

circle elements. However, in the earlier mark, the “inner” circle is proportionately much smaller than that appearing in the applicant’s mark. The positioning of the respective “inner” circles also markedly differs both in respect of where they sit within the outer circle and in relation to the outside edge of that outer circle.

28. Colour is also an element of both of the respective marks. Whilst the earlier mark is subject to a claim to orange and white, the impression I take from the mark is that the white element is an absence of colour, akin to a hole being punched into the orange circle. It gives me the impression of being a dog tag or key fob. The applicant’s mark is lime green (outer) and blue (inner) circles with no particular impression arising from them.

29. Whilst there are some similarities between the respective marks in that they both comprise of coloured circles, the colours of the respective marks and the positioning of the inner circles lead me to consider the respective marks also have clear visual differences.

Comparison of marks in respect of No. 2412509

30. The earlier mark is as described above. Application No. 2412509 consists of a series of two marks. Each of the marks consists of a circle within a circle device to the left of what the opponent referred to as a road device. I think it fanciful in the extreme that anyone would see this element as anything other than a letter H particularly so in the case of the first mark of the series. In the first mark of the series the larger circle and H is lime green, with the smaller circle, which is positioned slightly away from the outer edge of the outer circle, in blue. Both the circle and H device have a small degree of blue shadowing at the lower right quadrant of the circle and at the bottom and right hand edges of the uprights of the H. The second mark of the series is black with the exception of the smaller circle which is white.

31. Visually, there is some similarity between the respective marks in that they both contain a figurative element of a circle within a circle device. But there are also clear visual differences in that the earlier mark is subject to a claim to the colours orange and white which is visually very different to the colours blue and lime green of the first mark in the series applied for. I acknowledge that the second mark in the series applied for is in black and white and could therefore be used in other colours, however, each of the two marks in the series has the “H” element which leads to further significant visual differences between each of the respective marks.

32. Conceptually and despite the somewhat unusual position of its centre, the marks applied for may bring to mind the letters O and H or the word OH and would be pronounced accordingly.

33. Again, whilst there are similarities between the respective marks in that they consist of or contain coloured circles, the colours of the respective marks (where applicable) and the positioning of the inner circle coupled with the “H” element in the marks applied for lead me to consider the respective marks also have clear differences.

Likelihood of confusion

34. This is a matter of global appreciation taking all relevant factors into account. I have found that each of the respective specifications include identical goods and services. I do not consider that the test for likelihood of confusion in relation to pharmaceutical products is any different to that for other products. (See the comments in *Oropram*, a decision of Professor Ruth Annand sitting as the Appointed Person dated 8 May 2002 under the reference O/208/02). Whilst there are similarities between the earlier marks and application No. 2412508, there are also significant differences. It is my view that the differences outweigh the similarities such that on a global appreciation and allowing for the imperfect picture, there is no likelihood of confusion even where identical goods or services are involved. In respect of application No. 2412509 the differences are even greater and again in my view, there is no likelihood of confusion even where identical goods or services are involved.

Summary

35. The oppositions against application Nos. 2412508 and 2412509 fail in their entirety.

Costs

36. The opposition having failed in respect of all marks applied for, the applicant is entitled to an award of costs on the following basis:

Reviewing the Notices of Opposition:	£200
Preparation of and filing counter-statements:	£300
Filing and reviewing evidence:	£200
Preparation for and attendance at hearing:	£200
Total:	£900

37. In reaching this figure I have taken account of the near identity of the Notices of Opposition and counter-statements and the nature of the evidence.

38. I therefore order the opponent to pay the applicant the sum of £900 as a contribution towards her costs. This sum is to 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 26th day of February 2008

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