

BLO/064/20

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3350531
BY VIVO CANNABIS INC.
TO REGISTER AS A TRADE MARK:**

LUMINA

IN CLASSES 5 & 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 415487
BY CRISTALFARMA S.R.L.**

BACKGROUND AND PLEADINGS

1. On 2 May 2018, Vivo Cannabis Inc. (“the applicant”) applied to register the trade mark **LUMINA**, under number 3350531 (“the application”).¹ The application was published for opposition purposes on 16 November 2018 in respect of the following goods and services:

Class 5: Cannabis and marijuana for medical use; Oils, salves, concentrated pastes, tinctures, tablets and capsules each containing resins and oils derived from cannabis for medical use; topical skin creams, body creams, body oils, face and body lotions, and skin care preparations each containing derivatives of cannabis, all the aforementioned products for the relief of pain and treatment of medical conditions; transdermal patches medicated with cannabis extracts for medical treatment uses; inhalers medicated with cannabis in vapour form.

Class 35: Providing regulated and compliant retailing, wholesaling and distribution of marijuana and cannabis, cannabis-related products, derivatives of cannabis for medical use; online retail sale of marijuana and cannabis, cannabis-related products, derivatives of cannabis for medical use.

2. On 15 February 2019 CRISTALFARMA S.r.l. (“the opponent”) filed a notice of opposition. The opposition is brought under s. 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods and services in the application.

3. Under s. 5(2)(b), the opponent relies upon its European Union trade mark number 11934239, **ILLUMINA** (“the earlier mark”). The earlier mark was filed on 26 June 2013 and was entered into the register on 26 April 2019. It is registered in respect of the following goods:

Class 5: Dietetic substances for the treatment of the cognitive and cerebral system.

¹ The application claimed a priority date from Canada (filing no. 1897085). The UK application was made on 2 November 2018

4. The opponent's mark is an earlier mark, in accordance with s. 6 of the Act, but as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements as per s. 6A of the Act.

5. Under s. 5(2)(b), the opponent relies upon all the goods registered in class 5 of the earlier mark.

6. The opponent claims that the marks are highly similar, including the applicant's mark being contained in the earlier mark, resulting in a high level of visual and phonetic similarity. Moreover, the opponent contends that both marks are conceptually based around the root word 'lum', meaning 'light'. The opponent claims that the goods and services in the application are identical or highly similar to the goods of the earlier mark. The opponent claims that these factors will result in a likelihood of confusion, especially considering the earlier mark is fanciful and of at least average distinctiveness.

7. The applicant filed a counterstatement denying the grounds of opposition. As these are the only comments I have from the applicant, they are reproduced in full, and as written, below:

1. We deny that the contested mark and the Opponent's earlier trade mark are similar.
2. We deny that the goods and services applied for are similar to those covered by the Opponent's earlier application.
3. We deny that there is any likelihood of confusion between the contested mark and the Opponent's earlier application.
4. The Opponent is put to strict proof of each of the claims in the opposition.
5. We request that the opposition be refused and that an award of costs be made in favour of the applicant.

8. Both parties have been professionally represented throughout these proceedings; the applicant by Bird & Bird LLP and the opponent by Dehns. Only the opponent filed evidence; it also filed written submissions in lieu of a hearing. Both parties were given the choice of a hearing but neither asked to be heard on this matter. I have read all of the papers carefully and I will bear both parties' comments in mind, referring to them as necessary below.

EVIDENCE

Opponent's evidence

9. The opponent's evidence consists of a witness statement of Clare Mann, Partner of the opponent's representatives, together with Exhibits CLM1 to CLM9. I will summarise only what I consider to be the most relevant evidence and refer to it when appropriate later in this decision.

DECISION

Section 5(2)(b)

10. Section 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.”

11. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

12. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

13. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. Moreover, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

15. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations" ...anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

16. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...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”.

18. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

19. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

20. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Albingia SA v Axis Bank Limited*, BL O/253/18, a decision of the Appointed Person, Professor Phillip Johnson, at paragraph 42).

21. The goods and services to be compared are:

Opponent's goods	Applicant's goods and services
Class 5: Dietetic substances for the treatment of the cognitive and cerebral system.	Class 5: Cannabis and marijuana for medical use; Oils, salves, concentrated pastes, tinctures, tablets and capsules each containing resins and oils derived from cannabis for medical use; topical skin creams, body creams, body oils, face and body lotions, and skin care preparations each containing derivatives of cannabis, all the aforementioned products for the relief of pain and treatment of medical conditions; transdermal patches medicated with cannabis extracts for medical treatment uses; inhalers medicated with cannabis in vapour form. Class 35: Providing regulated and compliant retailing, wholesaling and distribution of marijuana and cannabis,

	cannabis-related products, derivatives of cannabis for medical use; online retail sale of marijuana and cannabis, cannabis-related products, derivatives of cannabis for medical use.
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Class 5

22. Taking into account the guidance from the caselaw outlined above, it is noted that all of the goods in the application are cannabis or cannabis-based goods for medical purposes. All goods included in class 5 of the application are medical or medicated in nature and, when attributed their ordinary and natural meanings, would be used in the same context. Therefore, for the purposes of considering the similarity between the respective goods, I consider the applicant’s goods to all be sufficiently comparable meriting an assessment in essentially the same way and for the same reasons.

23. It is considered that the respective uses of the goods being assessed would be for medical treatment and, similarly, the respective users of all class 5 goods would be those seeking or undergoing some form of medical treatment. As the opponent has submitted, the wording of the applicant’s class 5 specification broadly outlines the purpose of the goods as ‘medical’, which could include the opponent’s ‘treatment of the cognitive and cerebral system’. While I accept that there is a level of divergence regarding the physical nature of the respective goods, I find favour with the opponent’s submission that the goods covered by the earlier mark could be provided in the form of derivatives of cannabis. Furthermore, it is considered that all the assessed goods would share common trade channels, namely, health stores, medical dispensaries, pharmacies, or from medical practitioners. In this regard, the respective goods are all likely, in practice, to be found in the same places and the opponent’s evidence is consistent with this finding, presenting a number of the respective goods sharing common distribution channels.² Although, it has already been accepted that some of the goods vary in their physical nature, it is considered that the respective goods are in competition with one another to a significant extent. All of the goods are for medical

² Exhibit CLM3 and Exhibit CLM4

purposes and there is often a range of options for medical treatment, whether by dietetic means, by applying external creams, or by medication. It is considered that somebody seeking medical relief is likely to reflect upon a number of different options, encompassing varying forms of treatment. Evidence submitted by the opponent demonstrates that the respective goods are likely to be offered as competing options of treatment, all sharing a common purpose.³ I find that the above factors result in at least a medium degree of similarity between the respective goods.

Class 35

24. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

25. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

³ Exhibit CLM3 and Exhibit CLM5

26. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*⁴, and *Assembled Investments (Proprietary) Ltd v. OHIM*⁵, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*⁶, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

27. Bearing in mind the principle above from *Oakley*, although the applicant's retail services are different in nature, purpose and method of use to the goods covered by the opponent's earlier mark, I find the retail services in the application to be complementary to the goods covered by the earlier mark. While the goods in the application may not be considered identical to that of the earlier mark, the decision in *Oakley* stipulated that retail services do not have to relate to exactly the same goods

⁴ Case C-411/13P

⁵ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁶ Case C-398/07P

to be regarded as similar. In keeping with *Sanco SA v OHIM*, and *Assembled Investments (Proprietary) Ltd v. OHIM*, I feel that the complementarity between them is sufficiently pronounced, in so far as they are likely to be offered by one and the same undertaking from the consumer's point of view, especially envisaging the retail services which would normally be associated with the opponent's goods; the retailed goods in the application may be distributed through the same trade channels as those covered by the earlier mark. As a result, in my view the applicant's retail services and the opponent's goods are similar to an average degree.

The average consumer and the nature of the purchasing act

28. I will next consider who the average consumers are for the goods and services and how they are purchased.

29. 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.”

30. Moreover, 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.

31. In *Bayer AG v EUIPO*, Case T-261/17, the GC held that the average consumer pays a heightened level of attention when selecting pharmaceutical products, including such products available without a prescription (see paragraph 33 of the judgment).

32. The goods concerned are medical in nature and, as previously stated, will be used for the purposes of some form of medical treatment. While many of the goods at issue can be purchased in retail outlets and health stores, it is likely that some would need to be prescribed or made available through medical professionals. Therefore, it is necessary to identify two groups of relevant consumers in this instance, namely, the general public and professional users, as was confirmed by the GC in *Mundipharma AG v OHIM*, Case T-256/04.

33. Due to the medical purpose of the goods outlined above, there is potential for the goods to be purchased quite frequently by the general public for the treatment of a medical condition. In my view, it is likely that the act of purchasing would follow a considerable thought process. I do not consider the purchasing act of the goods concerned to be merely casual; it would be an important choice for the consumer. In my view, the purchasing process for these goods would be a combination of visual and aural; some consumers may peruse the shelves at a health store or website to select the goods, while others may receive word of mouth recommendations or have consultations with healthcare professionals. For medical types of products, the level of attention of the general public may be heightened to ensure that the product is appropriate for their treatment. As for the purchasing process for services, I would consider this to also be visual and aural in nature; some of the general public are likely to seek information from printed matter, material from the internet and the products themselves, while others may engage in conversation with store assistants for information prior to purchasing the products.

34. In respect of medical practitioners and other professional users, it is likely that the goods concerned will be frequent, repeated purchases for e.g. stocking a pharmacy. For the professional user, the choice would be an important one as they will thereafter be recommending and, in some cases, prescribing use of the products for medical treatment. I do not consider the act of purchasing the goods concerned to be casual in respect of the professional user; in my view, the professional user would possess a heightened level of attention for the selection of products to be recommended or prescribed. I feel that the purchasing process for the professional user would be predominantly visual in nature; information about the products would likely be sought primarily from brochures and webpages. However, I do not discount aural

considerations as the purchasing process may also include verbal representations from pharmaceutical salespersons or product presentations at pharmaceutical exhibitions.

Comparison of trade marks

35. 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

36. Accordingly, it would be wrong to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

37. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
ILLUMINA	LUMINA

38. The opponent has submitted that the marks are “highly similar” visually and aurally, and that the marks “also have a similar conceptual basis”. Visually, the opponent draws attention in its submissions to six shared letters between the marks, all appearing in the same order. Aurally, the opponent has submitted that the marks share three “identical syllables” and that the “phonetic comparison is not significantly impacted” by the omission of the first syllable from the applicant’s mark. Conceptually, the opponent contends that both marks have “a common meaningful link” due to the shared root word ‘lum’ and has provided a dictionary definition in its evidence.⁷ The applicant denies that the contested mark and the earlier trade mark are similar. I have no further submissions from the applicant on the matter of similarity between the marks.

39. The earlier mark is a plain word mark consisting of the word “ILLUMINA”. As this is the only element of the mark, the overall impression is dominated by the word “ILLUMINA”.

40. The applicant’s mark is a plain word mark comprising the word “LUMINA”. The overall impression of the mark is dominated by the word itself, being the only element of the mark.

41. Visually, the marks are similar because they share six letters in the same order; the word “LUMINA” is the entirety of the applicant’s mark and appears within the earlier mark. There are visual differences between the marks, namely, that the earlier mark begins with the letter ‘I’ and contains a double letter ‘L’, which would be read first. However, bearing in mind my assessment of the overall impressions, I consider there to be a reasonably high degree of visual similarity between the marks.

42. Aurally, the earlier mark consists of a four-syllable word (“IL-LU-MI-NA”) and the application comprises a three-syllable word (“LU-MI-NA”). It is noted that the first syllable of the earlier mark (“IL”) does not appear in the application. However, notwithstanding the presence of the first syllable (“IL”) in the earlier mark, I am of the opinion that the second syllable (“LU”) phonetically dominates the beginning of the

⁷ Exhibit CLM9

mark. Moreover, the remaining aural identities of the marks are indistinguishable (“LU-MI-NA”). Taking into account the overall impression, I consider that the marks are aurally similar to a high degree.

43. Conceptually, neither marks have any obvious meaning per se and, as such, would likely be understood by some as invented terms. The opponent has submitted that the respective marks share the root word ‘lum’ and contends that this results in a degree of conceptual similarity. I note that the opponent has provided a dictionary definition, though it has not provided any evidence that the average consumer of the goods and services concerned would attach this meaning to the marks. The word is not in common parlance amongst average consumers in the United Kingdom and is derived from the Old French language, so I cannot assume they would. However, although the marks are invented words, I feel that they are both evocative of words such as ‘luminous’ or ‘illuminations’, denoting ‘light’. In *Usinor SA v OHIM*, Case T-189/05, the General Court found that:

“62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57).

63. In the present case, the Board of Appeal correctly found that the signs at issue have a common prefix, ‘galva’, which evokes the technique of galvanisation, that is, the act of fixing an electrolytic layer to a metal to protect it from oxidation.

64. By contrast, the Board of Appeal incorrectly took the view that a conceptual comparison of the second part of the signs was not possible, because the suffixes ‘llia’ and ‘lloy’ were meaningless.

65. That conclusion is based on an artificial division of the signs at issue, which fails to have regard to the overall perception of those signs. As stated in paragraph 59 above, the relevant public, which is French-speaking but has knowledge of the English language, will recognise in the mark applied for the presence of the English word 'alloy', corresponding to 'alliage' in French, even if the first letter of that word ('a') has merged with the last letter of the prefix 'galva', according to the usual process of haplology. That mark will therefore be perceived as referring to the concepts of galvanisation and alloy.

66. As far as the earlier mark is concerned, the suffix 'allia' is combined with the prefix 'galva' in the same way. The evocative force of the suffix 'allia' will enable the relevant public – on account of its knowledge and experience – to understand that that is a reference to the word 'alliage'. That process of identification is facilitated still further by the association of the idea of 'alliage' (alloy) with that of galvanisation, the suffix 'allia' being attached to the prefix 'galva'.

67. By breaking down the signs at issue, the relevant public will therefore interpret both signs as referring to the concepts of galvanisation and alloy.

68. Consequently, the conclusion to be drawn is, as the applicant correctly maintains, that the signs at issue are conceptually very similar, inasmuch as they both evoke the idea of galvanisation and of an alloy of metals, although that idea is conveyed more directly by the mark applied for than by the earlier mark".

44. On this basis, and in consideration of my assessment of the overall impressions, the marks are conceptually similar to at least a medium degree. If I am wrong about that, and the marks would instead be perceived as invented words, I find the marks conceptually neutral.

Distinctive character of the earlier trade mark

45. 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).”

46. The opponent has submitted that the earlier mark is “a fanciful term...of at least average distinctiveness”. I have no submissions from the applicant regarding the distinctiveness of the earlier mark. As the registration process for the earlier mark was not completed 5 years or more before the application date of the application, the opponent has not been required to provide proof of use. Although the opponent has filed evidence in this matter, none of it goes to the use of the earlier mark and there has been no claim that the mark enjoys an enhanced level of distinctive character. Consequently, I have only the inherent position to consider. As the earlier mark consists of one plain word, the distinctive character lies indivisibly in the word itself.

Invented words usually have the highest degree of distinctive character; words which are descriptive of the goods relied upon normally have the lowest. The word “ILLUMINA” is neither descriptive nor strongly allusive of the goods but, rather, appears to be an invented word. I find that the earlier mark has a high degree of inherent distinctive character.

Likelihood of confusion

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

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

49. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental

process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

50. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.”

51. See also: General Court cases: *Castellani SpA v OHIM*, T-149/06, *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, T-438/07 (similar beginnings important or decisive), *CureVac GmbH v OHIM*, T-80/08 (similar beginnings not necessarily important or decisive), and *Enercon GmbH v OHIM*, T-472/07 (the latter for the application of the principle to a two word mark).

52. I have found the marks to be visually similar to a reasonably high degree and aurally similar to a high degree. I have also found the marks to be conceptually similar to at least a medium degree. I have found the earlier mark to possess a high level of inherent distinctive character as an invented word. I have identified two groups of average consumers, namely, the general public as well as professional users; both of which would pay a high degree of attention during the purchasing process. I have found the purchasing process for the goods to be a combination of visual and aural in nature. I have found the goods of the contested mark and the earlier mark to be similar to at least a medium degree and I have found an average degree of complementarity in respect of the retail services.

53. While I appreciate that the goods are medical in nature and are purchased with a higher level of attention, I must bear in mind the similarity between the goods, the complementarity between the goods and services, as well as the visual, aural and conceptual similarities previously outlined. I have accepted that the beginnings of the marks are different, i.e. “ILLUMINA” and “LUMINA”, and that the caselaw suggests that the attention of the consumer is *usually* directed to the beginning of the word. However, the marks at issue are not considered comparable to those before the GC in *El Corte Inglés, SA v OHIM*⁸ and, in my view, the minor difference between the marks is insufficient to distinguish the goods and services of the applicant from those of the opponent. Given the similarities between the marks, as well as the goods and services, the average consumer may not recall the respective marks with sufficient accuracy to differentiate between them and they may misremember one for the other, assuming they are one and the same. In my view, it is likely that some consumers would misread or mishear LUMINA as ILLUMINA. Taking the principle of imperfect recollection and all the above factors into account, I consider there to be a likelihood

⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

of direct confusion. For the sake of completeness, my conclusion would be the same even if the conceptual comparison was neutral because the other factors point in the opponent's favour.

CONCLUSION

54. The opposition under Section 5(2)(b) of the Act has succeeded in its entirety. Subject to any successful appeal against my decision, the application will be refused.

COSTS

55. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances I award the opponent the sum of £1,100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£200
Preparing evidence	£500
Preparation of submissions in lieu of oral hearing	£300
Official fee	£100
Total	£1,100

56. I therefore order Vivo Cannabis Inc. to pay CRISTALFARMA S.r.l. the sum of £1,100. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 3rd day of February 2020

James Hopkins
For the Registrar,
The Comptroller General