

TRADE MARKS ACT 1994

**IN THE MATTER OF International Registration No. 837013
standing in the name of Obshchestvo s organichennoy otvetstvennostyu
“LEOVIT” nutrio
and**

**IN THE MATTER OF an application for a declaration
of invalidity thereto under No. 16071
by LEO Pharma A/S**

BACKGROUND

1. International Registration No. 837013 has been protected in the United Kingdom since 24 May 2005. The mark in question is LEOVIT and it stands registered in Classes 5, 29, 30 and 35 for the following:

Class 5: Dietetic substances adapted for medical use; mineral food-supplements; nutritional additives for medical purposes; candy for medical purposes; candy, medicated; medicines for human purposes; dietetic beverages adapted for medical purposes; medicinal infusions; decoctions for medical purposes; vitamin preparations; preparations of trace elements for human and animal use; dietetic foods adapted for medical purposes; syrups for pharmaceutical purposes; tonics (medicine); nervines; digestives for pharmaceutical purposes; herbs teas for medicinal purposes.

Class 29: Bouillon concentrates; vegetables, cooked; tomato puree; preparations for making soup; soups; vegetable soup preparations; potato flakes.

Class 30: Gruel, with a milk base, for food; ice cream; sherbets (ices); cocoa beverages with milk; tea-based beverages; infusions, not medicinal; powder for edible ices; spices; oat-based food; starch products for food.

Class 35: Opinion polling; marketing studies; sales promotion (for others); distribution of samples; direct mail advertising; advertising; advertising by mail order; television advertising.

2. On 8 February 2006, LEO Pharma A/S (“LEO”) applied for a declaration of invalidity against the above registration. The statement of case accompanying the application set out the ground of action, which is that under sections 47(2)(a)/section 5(2)(b) of the Trade Marks Act 1994, the registered mark LEOVIT is similar to the applicant’s earlier marks LEO and LEO RED and is protected for identical or similar goods in so far as class 5 is concerned. In the case of classes 29, 30 and 35, the goods are similar to those covered by the applicant’s LEO marks. The applicant also asked for an award of costs in its favour.

3. The applicant’s earlier marks, which it states have been put to genuine use in the United Kingdom in relation to the goods covered by them within the five year period ending with the date of this application for invalidity, are:

No.	Mark	Class	Specification
1447755	LEO	05	Pharmaceutical and veterinary substances and preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; disinfectants; preparations for destroying vermin and fungicides for pharmaceutical and veterinary use; all included in Class 5.
1150617	LEO RED	05	Veterinary substances and preparations.

4. On 28 February 2006, a copy of the application for invalidation and the statement of grounds were sent, by recorded delivery, to the registered proprietor at its address as recorded on the register. In the accompanying letter, it was stated that the registered proprietor would need to file a Form TM8 and counterstatement to defend the registration on or before 11 April 2006. The registered proprietor did not file a Form TM8 and counterstatement.

5. It does not follow, however, that the uncontested nature of this action will automatically mean success for the applicant for the declaration of invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant to prove why it is that the registration should be declared invalid and, with this in mind, the Registry invited the applicant, by letter dated 15 June 2006, to file evidence or submissions to substantiate a prima facie case in support of its invalidity action by 27 July 2006. The letter drew the applicant's attention to the Hearing Officer's comments in *Firetrace* [2002] RPC 15, paragraph 17:

“17. It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

6. The rationale behind this is section 72 of the UK Trade Marks Act 1994, which says:

“72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

This is the law relating to trade marks filed in the United Kingdom: “domestic” trade marks. By way of a letter dated 20 June 2006, the attorneys acting for the applicant challenged the Registry's statement that a prima facie case must be made out, stating that section 72, as domestic law, did not apply to the UK designation of an international registration. The attorneys further stated that there is no parallel provision in the Trade Marks (International Order) 1996.

7. The Registry responded on 29 June 2006, maintaining the prima facie burden on the applicant, stating that it would be inequitable to treat domestic and international registrations differently in terms of validity. The applicant did not argue the point further and filed written submissions on 27 July 2006. A hearing was not requested and this decision is, therefore, taken from the papers.

SUBMISSIONS

8. The applicant argues, in its submissions of 27 July 2006, that:

- (i) the LEO marks are sufficiently similar to the mark LEOVIT for there to be a likelihood of confusion;
- (ii) the whole of 1447755 – LEO - exists as the prefix in the mark LEOVIT;
- (iii) 1150617 – LEO RED – shares the same prefix as LEOVIT;
- (iv) the suffix “VIT” is a common abbreviation for “vitamin”;
- (v) the foregoing means that there is a very strong prima facie case that LEOVIT is invalid as far as it covers class 5 goods.

The applicant goes on to say that 1447755 – LEO- covers, amongst other things, “food for babies”; that the whole of the mark is included as the prefix in LEOVIT and “VIT” is lacking in distinctive character; and that therefore there is sufficient similarity to LEOVIT in classes 29 and 30 and LEO for there to be a likelihood of confusion: all of the goods in those classes could constitute food for babies.

9. The applicant concludes its submissions by requesting confirmation that the application for invalidity has succeeded in relation to classes 5, 29 and 30. Although class 35 was originally included in the pleadings, I have taken the later submissions to mean that the application for a declaration of invalidity is directed only at classes 5, 29 and 30 of international trade mark registration number 837013.

DECISION

10. The applicant has brought a single ground of action against the registration: section 47(2)(a)/section 5(2)(b) of the Act:

Section 47

“(2) The registration of a trade mark may be declared invalid on the ground –

- (a) that there is an earlier trade mark to which the conditions set out in section 5(1), (2) or (3) obtain...
- (b)

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

and Section 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.”

11. I take into account the well established guidance provided by the European Court of Justice in *Sabel BV v. Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723. The guidance from these cases is that I must assess whether there are similarities between 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 various elements, taking into account also the degree of identity/similarity between the goods and services and how they are marketed. In comparing the marks I must have regard to the distinctive character and the dominant components of each, and assume normal and fair use of the marks across the full range of the goods and services within their respective specifications. The matter must be considered from the perspective of the average consumer who is deemed to be reasonably well informed and reasonably circumspect and observant.

Comparison of goods

12. The earlier of the two marks upon which the applicant bases this claim for a declaration of invalidity is 1150617 – LEO RED – which is registered for “veterinary substances and preparations” in class 5. The attack is directed at classes 5, 29 and 30, whether for identical or for similar goods. Taking the registration in class 5 to begin with, it largely covers dietetic, nutritional or vitamin substances. There are also “medicines for human purposes”. Given that the applicant has cover only for veterinary substances and preparations, I cannot find that these are similar to human medicines without submissions that the average consumer sees it differently. I think it highly unlikely that the same substance would bear the same branding for animals as it would for humans and I have not been directed to consider otherwise.

13. I also think it unlikely that animals would drink herb teas. However, the remainder of the specification is considerably closer, if not identical, to the applicant’s

goods in this class, as they are not limited to human use. In the case of “preparations of trace elements for human and animal use”, I am aware that vitamin manufacturers claim similar benefits for humans and animals by the taking of various vitamins and minerals. The following are either identical or are similar goods to those of the applicant’s registration 1150617:

“Dietetic substances adapted for medical use; mineral food supplements; nutritional additives for medical purposes; candy for medical purposes; candy, medicated; dietetic beverages for medical purposes; medicinal infusions; decoctions for medical purposes; vitamin preparations; preparations of trace elements for human and animal use; dietetic foods adapted for medical purposes; syrups for pharmaceutical purposes; tonics (medicine); nervines; digestives for pharmaceutical purposes.”

14. Thus, “medicines for human purposes” and “herbs teas for medicinal purposes” are immune from attack under section 5(2)(b) of the Act. The applicant makes no submissions as regards classes 29 and 30, in relation to its registration 1150617 and, given that animal foods and beverages belong in Class 31 and that the applicant’s mark is in class 5 for veterinary substances and preparations, there is no similarity of goods in classes 29 and 30, compared with the applicant’s 1150617 registration.

15. The position is different in relation to the applicant’s other registration upon which it relies: 1447755 – LEO. The class 5 specification covers all that is encompassed within the registration in issue: there is identity of goods. Further, the applicant submits that the goods in classes 29 and 30 are similar to some of its own goods in class 5 of its registration 1447755. The applicant’s mark has cover for “food for babies” and it submits that all of the goods covered by the registered proprietor’s mark in classes 29 and 30 could constitute food for babies. I must take the specifications at face value, not stretching the meaning of individual terms beyond what the average consumer, about whom I shall say more below, would take them to mean.

16. In the case of class 29, it is true that babies eat vegetables, cooked. However, mothers do not feed ready-prepared vegetables meant for consumption by older children and adults; baby food is a very specific sort of preparation. There is a degree of similarity between the goods, but this item is the closest in the class 29 specification to anything covered by the applicant’s mark 1447755. As regards class 30, I am prepared to say that “gruel” (being an oat-based item) and “oat-based food” constitute similar goods to baby food, as babies are fed some of the products found in the cereal aisle in supermarkets, such as wheat biscuits and porridge-like cereal. The applicant did not make any submissions as to whether the confectionery and tea-based items in class 30 were similar to its registration 1447755. I have looked at this and conclude that there is also similarity in the case of “ice cream; sherbets (ices); cocoa beverages with milk; tea-based beverages and infusions, not medicinal”, when considered against the applicant’s cover for “pharmaceutical” and “dietetic substances”.

17. My conclusion in relation to comparison of goods is that the registered proprietor’s goods in class 5 are identical to those of 1447755; that there is a slight degree of similarity between “vegetables, cooked” in class 29 and “food for babies in

1447755; and that there is similarity between the applicant's class 5 goods and all of the class 30 goods, except for "powder for edible ices; spices; starch products for food".

Comparison of marks

18. The applicant submits that the whole of 1447755 – LEO – exists as the prefix in the registration LEOVIT; that LEOVIT shares the same prefix LEO with the applicant's other mark LEO RED (1150617) and that VIT is a common abbreviation for "vitamin". I take this last point to mean that the applicant is saying that "VIT" does not possess much distinctive character in relation to goods of nutritional value.

19. The applicant has not said what it thinks is the level of distinctive character of LEO, so I must formulate my own view of that in relation to the goods for which each mark covers. In the absence of any submission or evidence as to what LEO signifies, I attribute to it three possible meanings; the first is that it might be seen as a male forename; the second is that it is a sign of the zodiac and the third is that it is the Latin word for "lion". None of these describe the goods of either party and I conclude that the marks are highly distinctive for the goods they cover. LEO is the only element in 1447755 and it is a clearly separate and identifiable element in 1150617 – LEO RED – although RED may well serve to describe some colour aspect of some goods. The distinctive and dominant component of the applicant's marks is therefore LEO.

20. In the case of the registration which the applicant seeks to invalidate, LEO is also highly distinctive for the goods which it covers. The applicant has said that VIT is a common abbreviation for vitamin and, in the absence of any challenge to that statement by the registered proprietor, I am prepared to accept that. LEOVIT is a single, invented, word mark which in an English-speaking territory would be likely to be perceived as a combination of LEO and VIT; the dominant component of LEOVIT, in so far as the class 5 goods are concerned, is LEO, the VIT element being necessarily descriptive for vitamin/nutritional preparations and substances. LEO is also the beginning of the mark; visually and aurally, the marks are resonant of each other. It shares a conceptual significance and a high level of distinctive character with the applicant's marks. Whether VIT is so descriptive in relation to the goods in classes 29 and 30 is more debateable. Finally, there are more points of similarity between LEO and LEOVIT than there are between LEO RED and LEOVIT. The applicant made no comment as to whether or not LEO may be seen as a "house mark", but I will go on to consider this from the perspective of the average consumer.

Likelihood of confusion

21. It is a principle tenet of the jurisprudence referred to above that I must assess the likelihood of confusion between the marks from the standpoint of the average consumer of the goods. This must include an assessment of the amount of attention that the average consumer is likely to pay to selecting the goods, factoring in the risk of imperfect recollection. In the case of these goods, the average consumer ranges from the health professional to the general public. Particularly in relation to pharmaceutical and nutritional goods, I believe the level of attention to be reasonably high by the majority of those consumers and perhaps less so for the goods in classes 29 and 30, although a diabetic or a coeliac will doubtless scrutinize food labelling to a

level exceeding that of someone without a dietary condition. A higher level of attention is likely to reduce, but not eliminate, the risk of imperfect recollection.

22. In making my global appreciation, taking into account a number of factors, I consider that, whilst the marks may not be directly confused, the average consumer may be caused to believe (wrongly) that the goods come from the same or economically linked undertakings and that there is a likelihood of confusion (*Canon*). I have reached the view that this is the case in relation to all of the registered proprietor's goods in class 5. In relation to classes 29 and 30, I bear in mind that "a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa (also *Canon*). I have found that the marks are similar and that certain goods in class 30 are also similar, whilst those in class 29 are less so. Adopting this 'interdependency principle', I have decided that there is a likelihood of confusion in relation to the class 30 goods which I have identified in paragraph 17 and that there is not a likelihood of confusion as far as the class 29 goods are concerned.

23. In accordance with Sections 47 (5) and (6) of the Act, the international registration will be deemed never to have been protected in the United Kingdom in respect of the whole of class 5 and in respect of "Gruel, with a milk base, for food; ice cream; sherbets (ices); cocoa beverages with milk; tea-based beverages; infusions, not medicinal; oat-based food" in class 30. The international registration may remain protected in the United Kingdom for the whole of classes 29 and 35 and for the following goods in class 30:

"Powder for edible ices; spices; starch products for food."

COSTS

24. The applicant has been largely successful and I order the registered proprietor to pay the applicant for invalidity £500. 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 23rd day of October 2006

**JC Pike (Mrs)
For the Registrar
The Comptroller-General**