

O-311-17

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK REGISTRATION NO. 3101830
FOR THE TRADE MARK**

SERIVEO

**IN CLASSES 5 AND 10
OWNED BY PROSONIX LIMITED**

AND

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 501295
BY IVAX INTERNATIONAL B.V.**

Background and pleadings

1. SERIVEO is a trade mark owned by Prosonix Limited (“the registered proprietor”). It was applied for on 30 March 2015 and was registered on 26 June 2015 for the following goods:

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

Class 10: *Medical apparatus and instruments; inhalers.*

2. IVAX International B.V. (“the applicant”) has applied to have SERIVEO declared invalid under sections 47(2)(a)¹/5(2)(b) of the Trade Marks Act 1994 (“the Act”), based upon the applicant’s two earlier trade marks, as follows:

(i) EUTM 11481181

AERIVIO

Class 5: *Pharmaceutical preparations for the treatment of respiratory diseases.*

Filing date: 11 January 2013; completion of registration procedure: 23 May 2013

(ii) EUTM 13661046

AERIVIO

SPIROMAX

Class 5: *Pharmaceutical preparations and substances for human use, all for the treatment of respiratory diseases.*

¹ Section 47(2)(a) of the Act provides that the registration of a trade mark may be declared invalid on the ground that there is an earlier trade mark in relation to which the conditions set out in section 5(2) obtain.

Class 10: *Inhalation devices, inhaler, metered dose inhalers, parts components and fittings for the aforesaid goods.*

Filing date: 21 January 2015; completion of registration procedure: 29 June 2015

3. Section 5(2)(b) of the Act states that:

“(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.”

4. The applicant filed written submissions during the evidence rounds which were at odds with its pleadings. The statutory form TM26(I), which is the notice of application for a declaration of invalidity, provides the means by which the claim is particularised. In relation to earlier right EUTM 11481181 AERIVIO, registered in class 5, question 4 on the form asked, “Which goods or services in the registration that you are seeking to be declared invalid do you claim are identical or similar to those covered by the earlier mark and listed at Q1 or Q3a (whichever is applicable)”. The applicant ticked the box which says “Some goods and services”, and the goods in the attacked registration which were specified as being similar were “Pharmaceutical and medicinal preparations and substances” (with a further claim under question 5 that the goods are identical). However, in its written submissions, the applicant refers to its class 5 goods as being similar to the registered proprietor’s class 10 goods. This was not pleaded.

5. In contrast, in relation to earlier right EUTM 03661046 AERIVIO SPIROMAX, the answer given to question 4 was that all of the goods of the attacked registration were considered to be similar or identical (with a further claim under question 5 that they are identical).

6. The applicant chose not to attend the hearing. I will examine the case as pleaded because it would be unfair if I, unilaterally (i.e. without an application to amend the pleadings), were now to extend it to cover the registered proprietor's goods in class 10, in relation to earlier mark AERIVIO.

7. The registered proprietor denies the claim in its defence and counterstatement.

8. Both parties are professionally represented. Neither filed evidence. The registered proprietor made oral submissions at a video conference hearing before me on 19 June 2017, when it was represented by Mr Ben Mooneapillay of JA Kemp, its trade mark attorneys. The applicant filed written submissions in lieu of attendance. In making this decision, the submissions of both parties are fully borne in mind.

Decision

9. The following principles to be borne in mind when considering section 5(2)(b) of the Act 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.

The principles

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

10. Even if the parties' goods are described in different words, the law requires that they be considered identical where the words used are alternative descriptions of the same goods. The same applies where the registered proprietor's description of its goods encompasses the specific goods covered by the applicant's descriptions (and vice versa): see *Gérard Meric v Office for Harmonisation in the Internal Market* (OHIM), Case T-33/05, where the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

11. The registered proprietor's class 5 goods are *Pharmaceutical and medicinal preparations and substances*. These goods cover the applicant's goods in class 5 in both its earlier marks, which have been limited as pharmaceutical preparations and substances for the treatment of respiratory diseases. They are identical.

12. The registered proprietor's class 10 goods are *Medical apparatus and instruments; inhalers*. These goods cover the applicant's class 10 goods as

registered under its AERIVIO SPIROMAX mark, which are *Inhalation devices, inhaler, metered dose inhalers, parts components and fittings for the aforesaid goods*. They are identical.

Average consumer and the purchasing act

13. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

14. In *Mundipharma AG v OHIM*, Case T-256/04, the GC stated:

“44 Second, it has not been disputed in the present case that the relevant public for the goods covered by the mark applied for, namely therapeutic preparations for respiratory illnesses, is made up of patients in their capacity as end consumers, on the one hand, and health care professionals, on the other.

45 As to the goods for which the earlier mark is deemed to have been registered, it is apparent from the parties' written submissions and from their answers to the questions put at the hearing that some therapeutic preparations for respiratory illnesses are available only on prescription whilst others are available over the counter. Since some of those goods may be purchased by patients without a medical prescription, the Court finds that the relevant public for those goods includes, in addition to health care professionals, the end consumers.”

15. The goods of the later mark are not limited to those which must be prescribed and so could be purchased over the counter or via self-selection from a supermarket shelf. The goods of the earlier marks are also not limited to prescribed medication/inhalers; although the goods cover those intended to treat asthma, which

are likely to be prescribed, they also cover remedies for treating hayfever, which are available over the counter and via self-selection. The relevant public for over the counter or self-selected goods is the general public; for prescription-only goods it is both the prescriber and the patient.

16. The level of attention will vary according to the nature of the pharmaceutical. In *Armour Pharmaceutical Co v OHIM*, Case T-483/04, the GC stated:

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

17. Further in *Aventis Pharma SA v OHIM*, Case T-95/07, the GC stated:

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

18. The medical professional displays a high degree of attention in relation to prescribing medication, but the general public also displays a high degree of attention when given a prescribed medication. For products sold without prescription, even those of low cost, the general public will be reasonably well informed, observant and circumspect and will pay a reasonable level of attention to the selection of a product, without the benefit of a prescription and hence the medical professional's expertise. The consumer is more likely to be subject to the effects of imperfect recollection than the medical professional whose level of attention and expertise will be greater than those of a member of the general public.

Comparison of 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 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.”

20. 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.

21. The two earlier marks are:

AERIVIO

and

AERIVIO

SPIROMAX

22. The later mark is SERIVEO.

23. AERIVIO and SERIVEO both consist of single words which comprise the sole aspect of their overall impressions. AERIVIO SPIROMAX consists of two words which, as registered, are on two separate lines. Neither word is visually more prominent than the other, save that AERIVIO is the top or first of the two words so, from this perspective, is marginally the more dominant element.

24. AERIVIO and SERIVEO both consist of seven letters. The second to fifth letters are identical, in identical sequence: -ERIV-, and the final letter in each mark is O. The penultimate letters are different (I and E) and the first letters are different: A and S. As the average consumer in the UK reads words from left to right, a differing first letter, where those letters look nothing like one another, will have visual impact. Therefore, notwithstanding that five of the seven letters are the same and in the same position, there is a medium degree of visual similarity between the marks.

25. There are four syllables in AERIVIO and SERIVEO and several possibilities for pronunciation, depending on which syllable one places emphasis. The similarities already noted between the letters mean that the RIVIO/RIVEO parts will be similarly pronounced. The differing penultimate letters, which are vowels, will sound highly similar. However, the first letter and the first syllable of each mark will be pronounced very differently. Consumers will be familiar with AER from words such as 'aeroplane' and 'aerial' and will pronounce AER like the common word 'air'. SER will sound either like the common word 'sir' or a shorter vowel sound, as in 'se(ntry)'. The marks are aurally similar to a medium degree.

26. Both AERIVIO and SERIVEO are invented words. Mr Mooneapillay submitted that the AER in AERIVIO would be seen by the average consumer as a reference to the therapeutic properties of the applicant's goods; i.e. they are for improving the respiratory function, which means the flow of air to the lungs. It was his submission that AER provided AERIVIO with a concept which is missing from SERIVEO.

27. Invented words can be evocative of an idea². However, in this case, I consider that two factors militate against the average consumer perceiving an evocation of 'air' in AERIVIO. Firstly, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. Secondly, AER is a relatively unusual combination of letters and is not a word in its own right (unlike air). It is too disguised in the mark as a whole to bring to mind the concept of air. Consequently, neither mark has a concept. There is no conceptual similarity between the marks.

28. There is also no conceptual similarity between AERIVIO SPIROMAX and SERIVEO. The additional element SPIROMAX, is invented. It neither looks nor sounds anything like SERIVEO. Considered as wholes, there is (at best) a low degree of similarity between AERIVIO SPIROMAX and SERIVEO.

Distinctive character of the earlier marks

29. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*³ 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*

² *Usinor SA v OHIM*, Case T-189/05.

³ Case C-342/97.

Cases C-108/97 and C-109/97 *WindsurfingChiemsee 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)."

30. The applicant has not filed any evidence of use of its marks, so I have only the inherent position to consider.

31. I found above that AERIVIO and AERIVIO SPIROMAX consist of invented words. No submissions have been made by either party as to whether SPIROMAX is evocative of any particular concept. Consequently, I find that both of the earlier marks have a high degree of inherent distinctive character because they do not describe or allude to the goods or any characteristic of the goods.

Likelihood of confusion

32. The applicant's best case lies with its AERIVIO mark since the level of similarity on a visual and aural level is medium, rather than low which is the case for AERIVIO SPIROMAX.

33. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may

be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the parties' goods are identical, that there is a medium level of visual and aural similarity between the marks, but no conceptual similarity because both marks are invented words with no evocative meaning. I have also found that there will be a high level of attention on the part of the medical professional and at least a reasonable level of attention on the part of the general public. This factor mitigates any potential for imperfect recollection of the marks by average consumers.

34. It is a rule of thumb that the attention of average consumers is usually directed to the beginning of marks. In this case, the high/reasonable level of attention of average consumers means that it is more than likely that the very different beginnings of the marks will be noted. The beginnings of the marks are not descriptive or weak in distinctive character, so the differences will have an impression on the average consumer, reducing the potential for imperfect recollection. Despite the high level of distinctive character of AERIVIO, I find that the combination of the (only) medium level of visual and aural similarity, no conceptual similarity, very different beginnings of the marks and the high/reasonable level of attention of the average consumer is enough to offset the identical goods. There is no likelihood of confusion between AERIVIO and SERIVEO. It follows that if the applicant cannot succeed with AERIVIO, it will also not succeed with AERIVIO SPIROMAX.

Outcome

35. The application for a declaration of invalidity fails.

Costs

36. The registered proprietor has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. The award breakdown is as follows:

Considering the application and filing a counterstatement	£200
Preparation for and attending the hearing	£400
Total	£600

37. I order IVAX International B.V. to pay Prosonix Limited the sum of £600 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 7th day of July 2017

Judi Pike
For the Registrar,
the Comptroller-General