

BL NO. O/346/11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2497564
BY
PARAS PHARMACEUTICALS LIMITED
TO REGISTER THE TRADE MARK



IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO 98728
BY
LYNPHA VITALE SRL

**Trade Marks Act 1994
IN THE MATTER OF application number 2497564
By Paras Pharmaceuticals Limited
To register the trade mark**



**In Class 5
AND IN THE MATTER OF opposition thereto
Under no. 98728
By Lynpha Vitale SRL**

BACKGROUND

1. On 12 September 2008, Paras Pharmaceuticals Limited (hereafter “PPL”) applied to register the above mark in respect of goods in classes 3 and 5 of the Nice Classification System¹. Following a voluntary amendment its list of goods was limited to:

Class 5

Preparations of all kinds for joint pains and inflammation, backache, sprains, myositis, fibrositis, sciatica or pain relieving preparations included in Class 5.

2. The application was published on 12 December 2008 in the Trade Marks Journal.

3. On 12 February 2009, Lynpha Vitale SRL (hereafter “LV”) filed a notice of opposition, claiming that registration would be contrary to sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

4. The opposition is directed against all of PPL’s goods. The opponent relies on its earlier Community trade mark (CTM) detailed below:

Mark details and relevant dates	Goods and services relied upon
CTM: 6080899 MOOV Date of application: 8 July 2007 Date of completion of registration procedure: 12 March 2009	Class 03: Essential oils including blended essential oils, essential oils for personal use, fractions of essential oils; none of the aforesaid for use as or in connection with hair lotions. Class 05:

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

	<p>Pharmaceutical and medical preparations containing essential oils for the treatment of inflammatory diseases, namely inflammatory bowel diseases, inflammatory connective tissue diseases and arthritis disinfectants.</p> <p>Class 44:</p> <p>Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.</p>
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5. LV's mark was applied for on 8 July 2007 and its registration procedure was completed on 12 March 2009. PPL's application was published for opposition purposes on 12 December 2008. LV's mark is, therefore, an earlier mark not subject to proof of use because at the date of publication, of the application, it had not been registered for five years.²

6. PPL subsequently filed a counterstatement on 15 April 2009, denying the grounds of opposition.

7. Neither side filed evidence, nor did they request a hearing or file written submissions in lieu of a hearing, both being content for a decision to be made from the papers on file.

DECISION

8. The opposition is based upon, inter alia, sections 5(1), 5(2)(a) and 5(2)(b) of the Act. These read as follows:

"5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

the public, which includes the likelihood of association with the earlier trade mark.”

9. I turn first to the objection based upon section 5(1) of the Act. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34 (*Sadas*), the CJEU said in relation to what constitutes an identical trade mark:

“51. There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.


*52. However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] E.C.R. I-3819 at para.[26]).*

53. Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

Comparison of marks

9. The marks to be compared are:

LV's earlier mark	PPL's mark
MOOV	

10. LV's mark consists of the word 'MOOV' in upper case. PPL's mark also consists of the word 'moov' presented in lower case on a rectangular background which is coloured pink. The mark is not limited to colour and, as such, it is necessary for me to consider it as being *“drained of colour”* in line with the guidance provided in *Specsavers* [2010] EWHC 2035 (Ch), para 119. Despite the differences in case, this

is only evident when the letter 'M' is compared in both marks. The remaining letters 'o', 'o' and 'v' are identical whether in upper or lower case. Further, in both marks all of the letters are of a uniform height.

11. Paragraph 4 of LV's statement of grounds states:

"The opponent contends that the Subject Application is visually, aurally and conceptually identical to the earlier mark."

12. PPL submit:

"The opposed mark consists of a device with the word 'MOOV' contained within it which distinguishes it from the earlier mark."

13. The 'device' referred to is the coloured rectangular background. The average UK consumer is used to trade marks presented on different coloured backgrounds and in a variety of typefaces. As the CJEU stated in *Sadas*:

"...insignificant differences between the sign and the trade mark may go unnoticed by an average consumer."

14. Having applied the test in *Sadas* to the competing trade marks, I agree with LV and conclude that PPL's mark as filed should be considered identical to LV's earlier mark as the differences are so insignificant as to go unnoticed by the average consumer.

Comparison of goods

15. LV's best case lies with its goods in class 5 and I will confine my consideration to the respective class 5 lists. For ease of reference the respective goods are listed below:

LV's goods and services	PPL's goods
Class 05: Pharmaceutical and medical preparations containing essential oils for the treatment of inflammatory diseases, namely inflammatory bowel diseases, inflammatory connective tissue diseases and arthritis disinfectants.	Class 05: Preparations of all kinds for joint pains and inflammation, backache, sprains, myositis, fibrositis, sciatica or pain relieving preparations included in Class 5.

16. In *Gérard Meric v OHIM*, Case T-133/05, the GC held that:

"29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade

mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

17. PPL’s goods are ‘*preparations of all kinds for joint pains and inflammation, backache, sprains, myositis, fibrositis, sciatica ...*.’ I will begin by considering the nature of the conditions that PPL’s preparations are intended to treat.

18. All of the aforementioned conditions are defined in the Oxford English Dictionary as follows³:

- A ‘sprain’ is defined in as “*to wrench the ligaments of (an ankle, wrist, or other joint) violently so as to cause pain and swelling but not dislocation.*” As swelling and inflammation are synonymous, I am bound to conclude that a sprain is an inflammatory condition.
- ‘Myositis’ is defined as “*inflammation and degeneration of muscle tissue.*” This is also, self evidently, an inflammatory condition.
- The definition of ‘fibrositis’ is “*inflammation of fibrous connective tissue, typically affecting the back and causing stiffness and pain.*” This is also, clearly, an inflammatory condition.
- ‘Sciatica’ is defined, as “*Severe pain in the back and radiating down one or other leg, along the course of the sciatic nerve. It is usually caused by inflammation of the sciatic nerve or by pressure on the spinal nerve roots.*” Therefore, this is also an inflammatory condition.

Backache is a broad term which can encompass many different medical conditions and can be a general description of some of the symptoms of some of the conditions listed in PPL’s specification. There is no evidence before me which provides any further explanation in respect of any of the conditions named in either specification. As someone who does not possess expert knowledge in the medical field, I assume, reasonably to my mind, that a pharmaceutical product for use in treating inflammatory diseases could similarly be used to treat inflammatory conditions not caused by diseases such as those listed in PPL’s specification. Therefore, whilst the respective medical conditions listed in both parties’ specifications may not be identical, the respective goods share a common purpose in that they all treat inflammation. Insofar as LV’s pharmaceutical preparations treat the symptoms of an inflammatory disease, as opposed to any underlying cause, the respective goods will have an identical effect and may in fact be identical products. Taking this into account there is a clear overlap between the respective pharmaceutical products.

19. Consequently, taking all of these factors into account, I conclude that terms in PPL’s specification cover identical goods to those included in LV’s class 5 specification.

³ *Oxford Dictionary of English*. Edited by Angus Stevenson. Oxford University Press, 2010. *Oxford Reference Online*. Oxford University Press

Conclusion

20. In view of my conclusions that the respective marks and the respective goods are identical, LV's opposition based upon section 5(1) of the Act succeeds, in its entirety. That effectively decides the matter, however, if I am found to be wrong in respect of the identical nature of the marks at issue, I will comment briefly upon the case based on Section 5(2)(b) of the Act.

21. I have already identified that the only differences between the respective marks is the background rectangle present in PPL's mark's and that the word element of its mark is presented in lower case whilst LV's mark is presented in upper case. These differences, even if noticed, are such as to only have a minor impact upon the perception of the consumer, and the marks must still be considered as being very highly similar. I factor this into the global assessment required by the relevant case law and also that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). Taking all of this into account, together with my earlier finding that identical goods are in play, it follows that there is a very high likelihood of confusion. Therefore, the opposition would clearly succeed under the grounds based on 5(2)(b) of the Act.

Costs

21. The opposition having succeeded, LV is entitled to a contribution towards its costs:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Total:	£400

22. I order Paras Pharmaceuticals Limited to pay Lynpha Vitale SRL the sum of £400. 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 12 day of October 2011

**Ms Al Skilton
For the Registrar,
the Comptroller-General**