

O/568/18

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No. 3130489

IN THE NAME OF CONJOINT EXPORT SERVICES (SOUTH AMERICA) LTD

AND

APPLICATION NO. CA501797

BY BRITANNIA PHARMACEUTICALS LIMITED

FOR A DECLARATION OF INVALIDITY

BACKGROUND AND PLEADINGS

1. Conjoint Export Services (South America) Ltd (herein “the Proprietor”) is the registered proprietor of UK trade mark registration No. 3130489 as detailed here:

The Proprietor’s contested registered mark	
“Britannia Med”	Date of filing application: 7 October 2015
	Published for opposition purposes: 8 January 2016
	Registration date: 18 March 2016
Registered for goods in Class 10:	

2. On 19 September 2017, Britannia Pharmaceuticals Limited (herein “the Applicant”) filed an application, on Form TM26(l), to invalidate the whole of the Proprietor’s registration, based on two grounds under the Trade Marks Act 1994 (“the Act”), namely sections 5(2)(b) and 3(6)¹.

The section 5(2)(b) claim (likelihood of confusion)

3. The Applicant relies, for its section 5(2)(b) claim, on its ownership of two trade mark registrations (one UK, one EU) as detailed below, both in respect of the word “Britannia”.

The Applicant’s earlier registered marks
UK Trade mark No. 2043054 for the word “Britannia”
Relying on certain of its registered goods as follows:
Class 5 <i>Pharmaceutical preparations and substances</i>
Class 10 <i>Medical and surgical apparatus, instruments and products</i>
Date of filing application: 31 October 1995
Published for opposition purposes: 29 May 1996
Registration date: 13 September 1996

¹ Applicable by virtue of section 47 of the Act.

EU Trade mark No. 5968268 for the word “Britannia”

Relying on certain of its registered goods and services as follows:

Class 5 *Pharmaceutical preparations and substances*

Class 10 *Medical and surgical apparatus and instruments; medical and surgical products for the administration and dispensing of drugs and pharmaceuticals*

Class 44 *Medical services; provision of information relating to pharmaceuticals and/or medical services*

Date of filing application: 4 June 2007

Published for opposition purposes: 17 December 2007

Registration date: 26 June 2008

4. The Applicant claims that visually, aurally and conceptually the respective marks are highly similar and that the Applicant’s goods in Class 10 fully encompass the Proprietor’s goods and are therefore identical; it also claims that the Proprietor’s goods are similar to the other goods and services on which the Applicant relies. In those circumstances it claims that there is a strong likelihood of confusion between the respective trade marks. The Applicant states that it has used its marks within the five years prior to the application for invalidity in relation the goods and services on which it relies.

The section 3(6) claim (bad faith)

5. The Applicant claims that when the Proprietor applied for its trade mark registration (No. 3130489) it had no bona fide intention to use the Britannia Med mark in the UK and that consequently the application to register the mark was made in bad faith, offending against section 3(6) of the Act. In support of its claim of a lack of intention to use, the Applicant relies on points arising from a conversation between the managing director of the Proprietor company and the Applicant’s legal representatives. Those points included: that the Proprietor stated that it exports goods under the Britannia Med mark to Central and South America only; that the Proprietor chose the name Britannia Med because its preferred name, Nova Med (which does appear to be in use in the UK), could not be protected in certain countries in Central and South America; that the Proprietor has shown no evidence of ever affixing the mark to products or packaging in the UK and that the conversation elicited no clear explanation as to why the company registered the Britannia Med mark in the UK.

The Proprietor's counterstatement

6. The Proprietor filed a Form TM8 notice of defence and counterstatement resisting the application for cancellation, making the following points:
 - The Proprietor company trades "in the whole world, including the UK" and has applied for and "been granted the right to trade under the brand BritanniaMed [sic] with the intention of using the brand name wherever this was necessary or opportune, and [has] done so since that date."
 - It regards "the brand name BritanniaMed [sic] as sufficiently different from any other name, but [is] ready to co-operate with anybody who feels threatened in their business on an informal and amicable basis." It claims to have stated as much repeatedly to the witness for the Applicant and that some of the Proprietor's remarks from the conversation to which the witness refers "were cited out of context".
 - The Proprietor intends "to continue to use the brand name in the future."
7. The UK IPO sought further information from the Proprietor in relation to its Form TM8, and in response (by email on 3 January 2018, with copy to Applicant's representatives) the Proprietor additionally stated that it "also intended to affix the mark BritanniaMed to [its] products, in the UK and elsewhere."

Representation and Papers filed

8. The Applicant is represented by HGF Limited; the Proprietor is without legal representation in these proceedings. During the evidence rounds the Applicant filed evidence as I describe below. The Applicant also filed written submissions in lieu of an oral hearing. The Proprietor did not formally file evidence or submissions, but, on 6 October 2017, ahead even of the service of an admissible Form TM26(I), the Proprietor sent to the UKIPO materials (an invoice with covering email), to which the Applicant refers in its amended statement of grounds and elsewhere. In those circumstances, despite their atypical reception into these proceedings, I have taken note of those materials.
9. I bear in mind the parties' claims and submissions and refer to them where appropriate.

EVIDENCE

10. The Applicant filed just two pages of evidence: the first is a **Witness Statement by Jonathan Thurgood** dated 14 March 2018. Mr Thurgood is Trade Mark Attorney and Partner at HGF Limited, the Applicant's legal representatives in these proceedings. Mr Thurgood's makes his statement to set out the details of the telephone conversation that he had on 7 June 2017 with Mr Paul Wohanka, the Managing Director of the Proprietor company. The accompanying **Exhibit JMT1** is an edited version of a contemporaneous note of the telephone conversation (in the form of a dated email to Mr Thurgood's colleagues that same morning). The contents of the witness statement and its exhibit are essentially those points relied on in the Applicant's statement of grounds for its claim of a lack of intention to use, with the additional point that the Mr Thurgood states that Mr Wohanka advised him that "the company does not produce or sell pharmaceuticals or devices under the name in the UK."

DECISION

Relevant legislation

11. Section 47 of the Act provides for invalidity of a registration and the immediately relevant parts of that section are set out below:

47 Grounds for invalidity of registration

- (1) *The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).*

[...]

- (2) *The registration of a trade mark may be declared invalid on the ground—*
(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(3) [...]

(4) [...]

(5) *Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.*

(6) *Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.*

The section 5(2)(b) claim

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

“... 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.”

13. Since the Applicant's trade marks have dates of application for registration earlier than that of the Proprietor's trade mark, each is clearly an “earlier trade mark” as defined by section 6(1)(a) of the Act; and since the earlier marks had been registered for more than five years when the Proprietor's mark was published for opposition they are therefore potentially subject to the proof of use provisions under section 6A of the Act.

14. The Applicant confirmed in its Form TM26(I) that its earlier trade marks had been registered for five years or more at the relevant time, and stating that the mark had, in relation to all the goods and services on which it relies, been used within the five years prior to the application for invalidity. Although the earlier marks are potentially subject to proof of use, the Proprietor chose not to put the Applicant to proof of use (as indicated by its response to question 7 in its Form TM8). Consequently, the Applicant is able to rely on the goods as claimed under its earlier mark, with no obligation to show that the mark has been used at all.

15. I bear in mind the relevant principles from decisions² of the EU courts when considering section 5(2)(b) of the Act and I will refer to those principles as appropriate.

Comparison of goods

16. Since the Applicant claims that its goods in Class 10 fully encompass and are therefore identical to the Proprietor's goods, I will consider this decision initially on the basis of the Applicant's goods in Class 10. I therefore compare the following goods:

The Proprietor's registered goods
Class 10:
The Applicant's goods in Class 10 under its earlier marks
(UK registration) <i>Medical and surgical apparatus, instruments and products</i> (EU registration) <i>Medical and surgical apparatus and instruments; medical and surgical products for the administration and dispensing of drugs and pharmaceuticals</i>

17. It is clear from case law such as *Meric*³ that 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 registration or vice versa. I agree with the Applicant's claim that the goods at issue in Class 10 are identical. (I note too that the Proprietor at no stage contests that aspect of the claim.)

The average consumer and the purchasing process

18. It is necessary to determine who is the average consumer for the respective goods and services and how the consumer is likely to select them. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods

² *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; *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P.

³ See paragraph 29 of the judgment of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05

or services in question⁴. In *Hearst Holdings Inc*,⁵ 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 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 word “average” denotes that the person is typical... [it] does not denote some form of numerical mean, mode or median.”

19. In this case the relevant average consumer will be those working in hospitals and other healthcare settings, particularly those responsible for sourcing and ordering the equipment resources to meet the needs of patients, surgical staff and other medical practitioners. In considering and purchasing such goods, the average consumer will exercise an **above average degree of attention** to ensure that the goods selected are of suitable quality and consistency such that they are fit for the purpose of securing a safe and reliable healthcare provision for patients.
20. Visual considerations will be particularly influential in the purchasing act because the goods of the type under the marks are likely to be selected visually from images on websites or in catalogues.⁶ However, aural considerations may also play a part, such as on the basis of word of mouth recommendations, so the way the marks are said is also relevant.

Distinctive character of the earlier trade mark

21. The distinctive character of the earlier mark must be considered. The more distinctive an earlier mark, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel*). In *Lloyd Schuhfabrik*⁷ the CJEU stated that:

⁴ *Lloyd Schuhfabrik Meyer*, Case C-342/97

⁵ *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),

⁶ See *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 at paragraphs 49 -50.

⁷ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

“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 ...

*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).”*

22. The word “Britannia” is not an invented word, but it has no descriptive message in relation to the goods at issue and therefore inherently has an ordinary level of distinctiveness. The level of inherent distinctiveness of a trade mark may be enhanced through use in the UK. The Applicant filed no evidence as to the use of its earlier marks, so there is no possibility of considering whether the Applicant’s trade mark may have an enhanced level of distinctiveness in the perception of the UK consumer through use.

Comparison of the marks

23. It is clear from *Sabel*⁸ 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 Court of Justice of the European Union (CJEU) stated in *Bimbo*⁹ that: “.....it is necessary to ascertain, in each individual case, the overall

⁸ *Sabel BV v Puma AG*, Case C-251/95

⁹ *Bimbo SA v OHIM*, Case C-591/12P (paragraph 34)

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.”

24. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

The Applicant’s earlier registered mark:	Britannia
The Proprietor’s contested trade mark:	Britannia Med

25. The overall impression of the Applicant’s earlier trade mark is that it is simply the word “Britannia”. The average consumer will understand the word to evoke a connection to Great Britain.
26. The overall impression of the Proprietor’s contested trade mark is that it is that same word followed by the short word “Med”, which the average consumer in this case will interpret to be an abbreviation of the word “medical” (or possibly “medicine”). The word “Med” has a clear descriptive reference to the goods registered under the Proprietor’s mark (various medical and surgical apparatus and instruments) so has a very low degree of distinctiveness in that context. The “Britannia” element is more striking in the overall impression because it carries greater brand significance, will be read first and is considerably longer than the word low-distinctive “Med”.

Visual similarity

27. The Proprietor’s mark includes the entirety of the Applicant’s mark and the marks differ only by the addition of the second, short, low-distinctive word “Med”. Since the word “Britannia” plays the dominant role in the overall impressions of both marks I find them to be **visually similar to a high degree.**

Aural similarity

28. The marks will be pronounced in the same way, except that the Proprietor's mark adds a final syllable "Med". I find that the marks are **aurally similar to a high degree**.

Conceptual similarity

29. There is a very strong conceptual overlap between the parties' marks arising from the shared word 'Britannia'. The word may or may not recall for average consumer the name of the Roman province or goddess, or even the icon for the British Isles, celebrated in the anthem "Rule Britannia", but the word will be understood approximately to evoke a connection to Great Britain and the word will be understood to carry the same meaning in both marks. Taking into account the low-distinctive difference arising from the word "Med", I find the respective marks to be conceptually similar to **a very high degree**.

Conclusion as to likelihood of confusion

30. Deciding whether there is a likelihood of confusion requires a global assessment, of all relevant factors in accordance with case law. Thus, I factor in my finding that the Proprietor's registered goods are identical to those for which the Applicant's earlier mark is registered and that the respective marks are highly similar. I take into account that the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, and I allow too for the elevated level of attention by the relevant consumer in the purchasing process for the goods at issue. Nonetheless, since the Proprietor's mark contains the whole of the Applicant's inherently distinctive earlier mark the additional presence of the word Med (which has a very low degree of distinctiveness in the present circumstances) does not prevent a likelihood of confusion, including the likelihood of association with the earlier trade mark creating a risk that the public might believe that the respective goods come from the same or economically-linked undertakings.

OUTCOME

31. **Consequently, the application for a declaration of invalidity succeeds and the Proprietor's registration is deemed never to have been made and will be removed as from its date of application (7 October 2015).**
32. In the circumstances, it is not necessary to consider the other ground of the Applicant's claim and in this instance, given the strong and clear basis for the Applicant's success on its section 5(2)(b) ground, I decline to deal with the section 3(6) claim.

COSTS

33. The Applicant has been successful and is entitled to a contribution towards its costs, which I calculate taking into account the costs scale published in Tribunal Practice Notice 2/2016, as follows:

Reimbursement of the official fee for Form TM26(I):	£200
Preparing a statement of grounds and considering the other side's counterstatement:	£200
The evidence was minimal and I factor it in to an award component along with preparing submissions in lieu of a hearing	£500
Total:	£900

34. I therefore order Conjoint Export Services (South America) Ltd to pay Britannia Pharmaceuticals Limited the sum of £900 (nine hundred pounds) to be paid within fourteen days of the expiry of the appeal period, or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of September 2018

Matthew Williams
For the Registrar,