

O-611-17

TRADE MARKS ACT 1994

IN THE MATTER OF THE REQUEST FOR PROTECTION IN THE UK  
OF INTERNATIONAL REGISTRATION NO 1286919  
BY REBECCA ANN MCKEAN

FOR THE TRADE MARK

**MEDIHEMP**

IN CLASSES 5 AND 35

AND

OPPOSITION THERETO UNDER NO 407216  
BY INTEGRIA HEALTHCARE (AUSTRALIA) PTY LTD

## Background

1. Rebecca Ann McKean (“the holder”) is the holder of International trade mark registration number 1286919, MEDIHERB. The holder requested protection in the UK for her international registration (“IR”) on 7 December 2015 (claiming a priority date of 4 December 2015 from Australia) for goods and services in classes 5 and 35 which I set out later in this decision.

2. The IR was accepted and published in the *Trade Marks Journal* on 20 May 2016. Integra Healthcare (Australia) Pty Ltd (“the opponent”) opposes the IR under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act (“the Act”). Under sections 5(2)(b) and 5(3) the opponent relies upon the following earlier European Union trade mark (“EUTM”) registration:

EUTM 850230



Class 3

Perfumes; fragrances; perfumes and essences for soap; soap; cosmetics; skin and hair care preparations; essential oils

Class 5

Pharmaceutical preparations and substances; ointments and syrups; vitamins; vitamin preparations; creams and lotions; herbs and herbal preparations; dried herbs; liquid herbal extracts; herbal formulations and creams; herbal tea

Class 30

Dried and processed herbs; flavourings; essences; condiments

Filing date: 11 June 1998

Date of entry in the register: 19 October 1999

3. The opponent claims to have used its mark in the UK since 1 January 1998. Under section 5(2)(b) of the Act, it claims that there exists a likelihood of confusion between the respective marks owing to their similarities and the identity or similarity of the respective goods and services. Under section 5(3) of the Act, the opponent claims that the earlier mark has a reputation in the goods relied upon, that use of the IR would take unfair advantage of or be detrimental to the distinctive character or reputation of that earlier mark and that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks. It also claims that the use of the later mark would be out of its control and that goods and services of inferior quality would unfairly reduce the power of attraction of its mark.

4. The opponent's claims under section 5(4)(a) of the Act are based upon use of the following signs:



and

MEDI HERB

throughout the UK since 1 January 1998 in relation to the goods set out at paragraph 2 above. It claims that the use of the IR would constitute a misrepresentation and damage its goodwill and that such use is liable to be prevented under the law of passing off.

5. EUTM 850230 is an earlier mark. That earlier mark had been registered for more than five years on the date on which the opposed IR was published. It is therefore subject to the requirement, under section 6A of the Act, that proof of its use be shown. In her counterstatement, the holder requests that the opponent's claim to

have made genuine use of its mark is made good and denies each of the grounds of opposition.

6. Both parties are professionally represented and both have filed evidence. Neither party sought to be heard but both filed written submissions in lieu of a hearing. I give this decision after a careful review of all the papers before me.

### **The evidence**

7. The opponent's evidence consists of two witness statements (one filed as evidence in reply) from Anna Kuperman, its General Counsel. The holder's evidence consists of a witness statement from Michelle Ann Ward, her trade mark attorney in these proceedings. I do not summarise the evidence here but will refer to it as necessary in this decision.

### **Proof of use**

8. Section 6A of the Act states:

“(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and,
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects-

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

9. The enquiry under section 6A of the Act is identical to that set out under section 46, which is the part of the Act which deals with the issue of revocation of a registration on the grounds of its non-use, as both deal with the issue of genuine use of a mark.

10. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

11. Section 100 of the Act is also relevant and states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12. In *Plymouth Life Centre* O-236-13, Mr Daniel Alexander Q.C., sitting as the appointed person, observed:

“22. The burden lies on the registered proprietor to prove use... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

13. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0-404-13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all

depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

14. The opponent’s evidence of use of its mark is given in the first witness statement of Ms Kuperman who states the opponent was founded in 1986 by Mr Kerry Bone. She goes on to state that it is:

“now Australia’s largest supplier and manufacturer of herbal medicine products to the professional market...[and] has processed around 300 different species of herbs in liquid or tablet forms, which are sold to healthcare practitioners, including herbalists, naturopaths, pharmacists, chiropractors, GPs, vets and medical specialists”.

15. In respect of its trade in the UK, Ms Kuperman states the opponent has “used the brands MEDI HERB and MEDI HERB & logo since October 2003 in the United Kingdom, consistently and extensively”. I note that this date of first use is later than that claimed in the notice of opposition though nothing rests on this.

16. In contrast to her earlier statement quoted above at paragraph 14, Ms Kuperman goes on to state that the use made of the marks has been in respect of:

“dietary supplements, nutritional products, skin and haircare preparations, ointments, syrups, vitamins, dried and processed herbs, essences, herbal tea, liquid herbal extracts, herbs, pharmaceutical preparations, creams, lotions, herbal formulations, herbal preparations, herbal tablets and liquid formulations for healthcare purposes and the other listed items in Exhibit AK2.”

17. Exhibit AK2 consists of three pages headed “Material Description” but no explanation is given of what this document might be. By my reckoning there are 252 items listed and all but two are various herbal products in liquid and tablet (or capsule) form such as Calendula 1:2 500ml, Rosemary 1:2 500ml and Horsechestnut Complex 60 Tablets. The remaining two are Herbal Throat Spray 25ml and Vitamin E Cream Base 500g.

18. Ms Kuperman states that sales in the UK “have been primarily via our UK distributor Balance Healthcare Limited”. At AK1, she exhibits what she states are copies of various invoices issued by the opponent to its distributor along with orders, packing lists, shipping documents, customs documents and an interim receipt. There are some eleven invoices. Seven of them refer to the same order number and date from June and July 2011. The remaining four date from May 2016. All therefore date from within the relevant period albeit at either end of that period. Each of the invoices list various “MediHerb” products in liquid or tablet form e.g. St John’s Wort 1:2 500ml, Fennel 1:2 500ml, Garlic Forte 1000 tablets and Olive leaves 1:2 500 ml.

19. Ms Kuperman states that the opponent’s “branded product in the UK is also available for purchase from a number of online websites in the United Kingdom”. She does not give any information to show whether any such goods may have been available during the relevant period nor what specific goods may have been involved but, at AK5 and AK6 she exhibits extracts from a number of websites in support of her claim. Some of the material at AK5 does not appear to refer to UK websites, e.g. the printouts at pages 16 to 19 show prices only in dollars. In addition, all of the material within the exhibit appears to date from well after the relevant period in that it was all downloaded in January 2017 and the only other dates shown on some of the pages are copyright or “page last updated” dates also in 2017. The material

exhibited at AK6 is equally poorly directed to the relevant dates and none shows any particular goods for sale.

20. Ms Kuperman states that the opponent owns and operates the mediherb.co.uk website:

“that is used to promote our branded products in the UK. This provides full product information to consumers and they can then order products by telephone, fax or email.”

Ms Kuperman gives no information as to when this website went live nor does she give any information about any sales which may have been made through any of the avenues mentioned during the relevant period or indeed at any time. At AK3 she exhibits what she states are “images of our packaged products showing use of the registered mark from our co.uk website and also found by a Google image search”. Ms Kuperman gives no explanation of the possible relevance of the Google image search but, in any event, whilst on some of these pages the EUTM can be seen, the only dates shown on these pages are download or copyright dates in 2017 which is well after the relevant date.

21. Ms Kuperman states:

“Our annual UK turnover under the brand has been around £280,000 for each of the last few years.”

This figure is not broken down in any way.

22. Ms Kuperman states that the “registered brand appears on the packaging of all our range of products” and that the opponent spends around £7000 per annum on advertising its “branded MEDI HERB & logo in the UK”. She states that marketing:

“primarily consists of direct-mail email campaigns and printed material, such as flyers and product catalogues”.

Ms Kuperman does not give any details of where or when any specific advertising took place, how or to whom it was distributed or how many people may have seen it but, at AK4, she exhibits what she states are examples of promotional material. The exhibit consists of some six pages. Pages 1 and 2 are headed “Herbal Liquid Dosage Chart” and have October 2014 handwritten on them. The remaining pages are undated and show two specific products (DiGest Forte tablets and Nevaton® Forte tablets) which appear to be directed at professionals as they include the words “Try it in your clinic today!” Each of the pages show bottles bearing the EUTM. Ms Kuperman states this material “is consistent with materials distributed over the years in the UK.”

23. Ms Kuperman states that promotion of the opponent’s products has also taken place at the National Institute of Medical Herbalists’ Annual Conference where it has had a trade stand and that it has exhibited in various cities including London, Oxford, Edinburgh, Birmingham and Bristol. She gives no details of when such events have taken place or the number of attendees.

24. At AK7 and AK8 Ms Kuperman exhibits further extracts from a number of websites. Those at AK8 do not appear to be from UK websites. Those at AK7 consist of extracts from three blog pages. All were downloaded in January 2017 though the first two show entries made either “3 years ago” or in March 2014. The first two each make a single reference to a “Mediherb/Medi Herb” herbal supplement. The third simply makes a reference to “A company out of Australia called Medi-Herb”.

25. Ms Kuperman states that the opponent has won several awards but the only two she specifically mentions are awards made in Australia in 2002 and by the US Botanical Council in 2015.

26. In its written submissions, the applicant submits that the opponent has:

“...failed to provide evidence of use for the Relevant Period sufficient to demonstrate use of the Opponents Earlier Registration, in the form registered, for any of the goods covered [by it]. Even if the highly inconclusive material is considered sufficient to demonstrate some use, this is on a highly limited

range of goods far narrower than the goods of the [earlier mark] and far narrower than the statement of use made at the time of the filing of the Opposition...”

27. I remind myself that the relevant period within which use must be shown is 21 May 2011 to 20 May 2016. In my summary of the opponent’s evidence set out above, I have referred to the fact that much of the evidence either post-dates the relevant period or is undated and that some of it refers to matters outside the United Kingdom. Nevertheless, turnover in the UK is said to amount to “around £280,000 for each of the last few years”. The turnover for any specific year is not entirely clear, however, Ms Kuperman’s witness statement is dated 6 February 2017 and therefore, on the balance of probabilities, the turnover figures given can be taken to apply to at least some years within the relevant period. What is clearer, is that the invoices provided show sales within the relevant period to the company which is said to be the opponent’s UK distributor.

28. In *Laboratoire de la Mer Trade Mark* [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Neuberger L.J. (as he then was) stated:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

29. The exhibited invoices are dated within the relevant period and show sales totalling approximately Aus\$137,500 (at the current exchange rate, around £80,000). The unit price of the goods shown on the invoices range from a low of \$Aus8.73 (Chaste Tree 90 tablets) to a high of \$Aus233.72 (Echinacea Premium 1000 tablets). The goods are listed on the invoices as MediHerb products and, on other materials, the EUTM is shown on the labels of the various bottles. There is no evidence to show the size of the relevant market in the UK but it is likely to be a very large one. I have no evidence which shows the opponent’s share of that market but the sales shown to have been made to a single entity within the relevant period and do not strike me as being quantitatively significant. That, however, is not fatal to the opponent’s case. Whilst the evidence has a number of flaws as set out above, taking it as a whole and in light of the case law set out above, I am satisfied that the opponent has made genuine use of its earlier mark in the UK within the relevant period.

30. In determining what is a fair specification which reflects the extent of the use made, I take note of the comments of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, where he stated:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

31. Further, in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation

to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them;

*Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”*

32. As I indicated earlier, the EUTM is registered for a range of goods in classes 3, 5 and 30 and, in her witness statement, Ms Kuperman has referred to the opponent producing a wide range of goods as set out above at paragraph 16. The evidence, however, has been challenged by the holder and was not further addressed in the opponent's evidence in reply.

33. Ms Kuperman's claims as to the extent of use are somewhat contradictory or unclear in that in contrast to the wide range of goods referred to in paragraph 16 above, she also states the opponent “has processed around 300 different species of herbs in liquid or tablet forms”. This later claim accords with the goods listed on the invoices etc. at AK1: the invoices dating from 2011 all refer to the supply of goods in 500ml units (presumably bottles of liquids) whilst the invoices from 2016 list goods supplied in 500ml units and as tablets. In addition, the chart within AK4 is entitled *liquid dosage chart*. It also accords with the other exhibits (albeit largely undated or post-dating the relevant period) to which I have referred above such as the pages taken from the websites of both the opponent and third parties. Taking the evidence as a whole, I find the opponent has not shown use of any of the goods for which the EUTM is registered in classes 3 or 30. I am satisfied, however, that there is evidence of use in relation to some of the goods for which the mark is registered in class 5. The use has been shown to have been made in relation to various herbs and herbal supplements. Whilst the evidence shows these goods to have been in liquid or tablet form, I do not consider it appropriate to limit the goods in such a way as the average consumer would not do so. I find that a fair specification for the use shown is *herbs and herbal supplements* and it is these goods on which the opponent is entitled to rely.

## **The objection under section 5(2)(b) of the Act**

34. Section 5(2)(b) states:

“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.

35. In determining whether there is a likelihood of confusion, I take note of the following principles which 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 greater 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 the goods and services**

36. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

“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 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”.

37. As to what constitutes similar goods and services, in the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23:

“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”.

38. ‘Complementary’ was defined by the GC in *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* Case T325/06:

“82 It is true that goods are complementary if 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...”.

39. I also take note of the relevant factors for assessing similarity identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281 which were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;

- e) 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.

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

“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.”

41. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... 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.”

42. I also take note of the following comments of the Appointed Person in *Separode Trade Mark* BL O-399-10:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the

extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

43. With all of the above in mind, the goods and services to be compared are as follows:

| <b>Earlier mark (following proof of use)</b>    | <b>The IR</b>   |
|---|---|
| <p>Class 5<br/>Herbs and herbal supplements</p> | <p>Class 5<br/>Acne creams (pharmaceutical preparations); anti-bacterial pharmaceutical preparations; anti-cancer pharmaceutical preparations; chemico-pharmaceutical preparations; elixirs (pharmaceutical preparations); filled ampoules of pharmaceutical preparations; materials for use in applying pharmaceutical preparations; pharmaceutical preparations; pharmaceutical preparations containing vitamins; pharmaceutical preparations for animals; pharmaceutical preparations for skin care; pharmaceutical preparations for topical use; pharmaceutical products; pharmaceutical substances; pharmaceutical drugs; drugs; tablets (pharmaceuticals); wipes (tissues) impregnated with pharmaceutical lotions; transdermal patches for administering pharmaceuticals; preparations for body care</p> |

|  |  |
|--|--|
|  | <p>(pharmaceuticals); plant extracts for pharmaceutical use; moisturisers (pharmaceuticals); medical foodstuff additives for pharmaceutical use; oils adapted for medical use; oils adapted for pharmaceutical purposes; extracts of plants in capsule form (for pharmaceutical use); digestives for pharmaceutical purposes; chemical preparations for pharmaceutical purposes; capsules for pharmaceutical purposes; biological preparations for pharmaceutical purposes; homeopathic pharmaceuticals; natural pharmaceutical products; pharmaceutical sweets; pharmaceutical tonic preparations; skincare preparations (pharmaceutical); syrups for pharmaceutical purposes; therapeutic drugs (medical); anti-cancer drugs; drugs for medical purposes; dietary food preparations for medical use (medical food); dietary food supplements; mineral dietary supplements for humans; plant compounds for use as dietary supplements (medicinal); plant extracts (dietary supplements); vitamin supplements; vitamin drinks; analgesics; adhesive bandages (dressings); compresses; detergents for medical purposes; dog washes; energy drinks (adapted for medical purposes);</p> |
|--|--|

|  |  |
|--|--|
|  | <p>first-aid boxes (filled); food for babies; gum for medical purposes; herbs for medicinal purposes; herbs for smoking (for medicinal purposes); infusions for medicinal purposes made from herbs; extracts of medicinal herbs; antiseptics; cough syrups; protein dietary supplements; herbal remedies; skin care products (medicated); dietetic infusions for medical use; protein preparations for use as additives to foodstuffs for human consumption (adapted for medical purposes); dietetic foods for use in clinical nutrition; cough mixtures; mixtures of germicides and antiseptics in ointment form; medicines for human use; medicines for veterinary purposes; liniments; medicinal infusions; medicinal tea; mineral waters for medical purposes; mud for baths; mouthwashes for medical purposes; narcotics; nutritional supplements; sedatives; sunburn ointments; suppositories; tissues impregnated with pharmaceutical lotions; vaginal washes; biological agents (bacterial, fungal or other fungicides, weedkillers, herbicides, insecticides, parasiticides, pesticides); sanitary preparations for medical purposes.</p> <p>Class 35</p> |
|--|--|

|  |  |
|--|--|
|  | Retail services connected with the sale of pharmaceutical products; advertising and marketing. |
|--|--|

**The holder's goods in class 5**

44. The holder accepts that its *herbs for medicinal purposes; extracts of medicinal herbs; herbal remedies* are identical to the opponent's goods for which I have found it to have proved use. I agree but go further and find that the following goods of the application are also identical on the basis of *Meric: plant extracts for pharmaceutical use; extracts of plants in capsule form (for pharmaceutical use); biological preparations for pharmaceutical purposes; homeopathic pharmaceuticals; natural pharmaceutical products; plant compounds for use as dietary supplements (medicinal); plant extracts (dietary supplements); herbs for smoking (for medicinal purposes)*.

45. The holder's *dietary food supplements; mineral dietary supplements for humans; vitamin supplements; protein dietary supplements; nutritional supplements* are each supplements and will include herbal supplements. I find these are also identical goods.

46. The holder's *infusions for medicinal purposes; dietetic infusions for medical use; medicinal infusions; medicinal tea*; are goods which are commonly made from herbs and will be consumed for their therapeutic properties. There is a degree of overlap with the users, uses, nature and channels of trade with the opponent's goods such that I find them similar to a reasonably high degree.

47. The holder's *medical foodstuff additives for pharmaceutical use and protein preparations for use as additives to foodstuffs for human consumption (adapted for medical purposes)*; and are each, self-evidently, additives to foodstuffs intended to provide the user with a health benefit. To that extent, there is a degree of overlap with the users and uses of the opponent's herbal supplements. The channels of trade, however, differ and I do not consider the respective goods to be in competition or complementary. The respective goods have a low degree of similarity.

48. *Dietary food preparations for medical use (medical food); vitamin drinks; energy drinks (adapted for medical purposes); food for babies; dietetic foods for use in clinical nutrition; mineral waters for medical purposes;* are each an item of food or drink. Whilst they would include such items flavoured, fortified or supplemented in some way including by way of herbs, the fact that herbs may be used as an ingredient in an item of food and drink does not of itself make the respective goods similar (see, *Les Éditions Albert René v OHIM*, Case T-336/03). The nature of the respective goods, their users and uses and the channels of trade differ and they are neither in competition nor complementary. I find them to be dissimilar goods. By the same reasoning, I find the holder's *pharmaceutical sweets; and gum for medical purposes* to be dissimilar to the opponent's goods.

49. *Herbs and herbal supplements* are goods made from plants which are used as alternative therapies to conventional medicine and are intended to prevent, alleviate or otherwise treat various deficiencies, illnesses or symptoms whether in humans or animals. To that extent there is a degree of competition and some overlap with the users and uses of the holder's *acne creams (pharmaceutical preparations); anti-bacterial pharmaceutical preparations; anti-cancer pharmaceutical preparations; chemico-pharmaceutical preparations; elixirs (pharmaceutical preparations); filled ampoules of pharmaceutical preparations; pharmaceutical preparations; pharmaceutical preparations containing vitamins; pharmaceutical preparations for animals; pharmaceutical preparations for skin care; pharmaceutical preparations for topical use; pharmaceutical products; pharmaceutical substances; pharmaceutical drugs; drugs; tablets (pharmaceuticals); preparations for body care (pharmaceuticals); moisturisers (pharmaceuticals); oils adapted for medical use; oils adapted for pharmaceutical purposes; digestives for pharmaceutical purposes; chemical preparations for pharmaceutical purposes; capsules for pharmaceutical purposes; pharmaceutical tonic preparations; skincare preparations (pharmaceutical); syrups for pharmaceutical purposes; therapeutic drugs (medical); anti-cancer drugs; drugs for medical purposes; analgesics; cough syrups; skin care products (medicated); cough mixtures; mixtures of germicides and antiseptics in ointment form; medicines for human use; medicines for veterinary purposes; liniments; narcotics; sedatives; sunburn ointments; suppositories.* I find the respective goods similar to a low degree.

50. The holder's *adhesive bandages (dressings)* and *compresses* are materials used to e.g. cover or help treat a wound. The uses, users and nature of these goods differ from those of the opponent, the trade channels are not the same and the respective goods are not in competition nor are they complementary. They are dissimilar goods. *Materials for use in applying pharmaceutical preparations; wipes (tissues) impregnated with pharmaceutical lotions; transdermal patches for administering pharmaceuticals; tissues impregnated with pharmaceutical lotions* are each materials which enable the transfer of pharmaceuticals to the skin. Whilst I accept that the pharmaceuticals on or in them could include those made from herbs, the uses and nature of the respective goods differ as do the trade channels and I find that they are dissimilar goods to those of the opponent. *First-aid boxes (filled)* are containers holding various items which may be used in the treatment of e.g. a relatively minor injury, such as a cut, in the home or workplace. There is no evidence before me to show what such boxes contain but, in my experience, they are supplied containing items such as bandages, plasters, scissors and tweezers and, again for the same reasons as set out above, I find there is no similarity with the opponent's goods.

51. The holder's *detergents for medical purposes* are cleansing agents as are its *dog washes, vaginal washes* and *mouthwashes for medical purposes*. Her *mud for baths* are goods which, self-evidently, are intended to be used in the bath. The nature of these goods differ from those of the opponent as do the users and trade channels. One is not a substitute for the other and they are not complementary goods. I find them to be dissimilar goods. For similar reasons, I find the opponent's goods are also dissimilar to the holder's *antiseptics* and *sanitary preparations for medical purposes*.

52. The holder's *biological agents (bacterial, fungal or other fungicides, weedkillers, herbicides, insecticides, parasiticides, pesticides)* are goods intended to eradicate plants, insects etc. The users and uses of the respective goods therefore differ as do the channels of trade and they are neither in competition nor complementary goods. They are dissimilar goods to those of the opponent.

### The holder's services in class 35

53. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC 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.

54. 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.”

55. On the basis, however, of the European courts' judgments in *Sanco SA v OHIM*<sup>1</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>2</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>3</sup>, 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

---

<sup>1</sup> Case C-411/13P

<sup>2</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>3</sup> Case C-398/07P

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).

56. In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the GC held that a registration for 'retail services', which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar.

57. Taking the above case law into account, I find that the holder's *Retail services connected with the sale of pharmaceutical products* are similar to a medium degree to the opponent's goods. I find the holder's *advertising and marketing* are dissimilar to the opponent's goods.

### **The average consumer and the nature of the purchasing process**

58. 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*.

59. 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.”

60. The respective goods are such as will be used in or on the body, whether human or animal, as foodstuffs, to supplement a diet or to prevent, remedy, alleviate or otherwise treat a particular illness or symptom. The cost of the goods will vary and some will be a more frequent purchase than others but they each are goods which are widely available (though some are unlikely to be available as over-the-counter products and will only be available on prescription). The average consumer may be a member of the general public or professionals such as medical or alternative practitioners who may act as intermediaries. Whichever purchaser is involved, these are goods that are likely to be bought with a reasonable degree of care, not least because of their suitability for intended purpose and possible contra-indications of their use. The primary factor in the purchase is likely to be visual with goods being bought e.g. from a shelf or identified from the pages of a formulary or catalogue whether online or otherwise. The aural aspects, however, also have a part to play given that the goods may be bought following recommendations from (alternative) practitioners. Similar considerations apply to the holder’s services.

### **Comparison of the respective marks**

61. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, 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.”

62. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

| Earlier mark  | Holder's mark   |
|---|-----------------|
|  | <b>MEDIHEMP</b> |

63. In its written submissions, the opponent states:

“MEDIHE is a dominant and distinctive component in both marks and whilst the earlier mark has some additional elements, this does not undermine this finding...The Component MEDIHE is likely to be the image of the mark which the relevant public keeps in mind, where the marks are compared as a whole.”

I disagree. Given their individual presentations, I see no reason why the average consumer would see MEDIHE as a separate component of either mark.

64. The opponent's earlier mark has a number of elements. There is a central square device which contains a highly-stylised device of a flower made up of eight petals surrounding a circle. The square is divided in two on the horizontal plane with the upper half of the square having a black background with white petals and the lower half a white background with black petals. The centrally-placed petals and circle are therefore cut in two horizontally and so are half white and half black. To the left of the device is the word MEDI and to the right, the word HERB. Each word is presented in plain block capitals and, whilst they are in line with the bottom edge of the device, the tops of each letter extend slightly above its central horizontal dividing line.

65. As the opponent accepts in its written submissions, the word MEDI is a well-known abbreviation for things medical<sup>4</sup> whilst the word HERB is not distinctive of the goods. The device element is highly stylised and is a distinctive element, however, the word elements form the larger part of the mark and have a degree of dominance within it.

66. The holder's mark is presented as a single word but it naturally breaks down into its component parts MEDI and HEMP. I have commented above on the meaning of the word MEDI. The word HEMP refers to a plant of that name. The mark is presented in plain block capitals and its distinctiveness rests in its whole.

67. There are some visual similarities between the respective marks in that they share the element MEDI and have a second word element consisting of four letters beginning with the same two letters H-E. There are also some visual differences in that (the word elements of) each ends with the different letters RB/MP and the earlier mark contains a device of a stylised flower which has no equivalent in the application. Comparing them as wholes, I find the respective marks share a medium degree of visual similarity.

68. It is well-established that when a trade mark consists of a combination of words and figurative elements it is by the word elements that it is most likely to be referred.

---

<sup>4</sup> See also the First Board of Appeal's decision in Case R0475/2003-1

Both marks therefore consist of four syllables and begin with the element MEDI which will be pronounced identically. Whilst HERB and HEMP both begin with the same two letters H-E, they will be pronounced differently; the word HERB will be pronounced with a long “ur” sound, the word HEMP with a short “em” sound. Whilst the final two letters of each differ, the final letters of both are plosive consonants which are indistinguishable unless very carefully enunciated. Comparing them as wholes, I find the respective marks share a medium degree of aural similarity.

69. The opponent submits the respective marks are conceptually similar. It submits:

“Conceptually, both marks have connotations of medications and medicaments, due to the initial two syllables MEDI. Both therefore suggest medical matters. HEMP suggests a particular herb, known as hemp. The earlier mark has connotations of herbs. Therefore the later mark suggests one particular herb and the earlier mark suggests all herbs.”

70. In her witness statement, Ms Kuperman submits that “hemp is not only a herb, but Herb is a popular name that is used to refer to Hemp” and that “hemp is often referred to as being a herb”. In support of this submission she exhibits, at AK11 printouts from various webpages. Many of the pages bear dates which post-date the relevant period and some at least appear to be from US websites so do not necessarily reflect the position in the UK at the relevant date.

71. The holder disputes the respective marks are conceptually similar submitting, in the counterstatement, that:

“The second word of the Opponent’s Registration is a general term “herb”, whereas the suffix of the Application is “hemp”. Hemp is a plant with a wide variety of uses, most famously, and most commonly, for a fibre for use in textile and paper production. Therefore, conceptually, the two marks are quite distinct from each other”.

She also submits:

“Hemp is not well known or widely recognised as a herb...”

In her written submissions she submits:

“Whilst the Opponent has presented arguments and evidence that hemp is technically classed as a herb, this is not one commonly seen in herb lists, and it is notable that none of the material submitted by the Opponent shows hemp as a product that they provide despite working with numerous herbs.”

72. The holder’s evidence consists of a witness statement from Michelle Anne Ward, her legal representative in these proceedings. At MAW3 Ms Ward exhibits extracts from thefreedictionary.com. They include references to the word ‘hemp’ and she points out that the extract makes no reference to it being a herb. At MAW5 she exhibits an extract which she states is taken from the Shorter Oxford English Dictionary. The entry for ‘hemp’ defines it as being an herbaceous plant. Ms Ward’s intentions in filing this latter evidence is not clear as it tends to contradict the earlier evidence but nevertheless she submits:

“If hemp is not generally seen as a herb by consumers, they will not make any connection or correlation between hemp and herb.”

73. Whatever the exact botanical position, I have to consider what the average consumer will make of the respective marks. I consider that a substantial proportion will know that hemp is a plant but that whilst some may know that hemp is an herbaceous plant, many, even medical professionals, will not. As for the word HERB, I do not consider it will bring a particular plant to mind but instead it is likely to be taken to describe a particular family of plants. To the extent that both marks will bring to mind products for medical purposes derived from plants, there is a high degree of conceptual similarity between them.

#### **The distinctiveness of the earlier mark**

74. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM* (LITE) [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to

make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

75. As set out above, the opponent first sold its goods in the UK in October 2003. The very limited number of invoices and other documentation exhibited show those goods being supplied to a single distributor. Sales are said to be in the region of £280,000 per annum but there is no evidence to show the size of the relevant market (which is likely to be substantial) or the opponent's place within it. Some £7000 annually is said to have been spent on marketing, primarily via direct-mail email campaigns though no details of any such marketing has been provided which allows me to evaluate the reach of that marketing at any given point in time. I have no evidence from customers or the trade and I do not consider the few blog entries at AK7 materially improves matters for the opponent. The evidence as filed is not sufficient to show that the opponent has a reputation in the UK or that the distinctive character of the earlier mark has been enhanced to any material extent. Considered as a whole and taking my earlier comments into account, I find the earlier mark has an average degree of inherent distinctive character.

### **The likelihood of confusion**

76. In determining whether there is a likelihood of confusion, 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision I indicated:

- Some of the respective goods and services are identical, some are similar and others are dissimilar;
- the average consumer is either a member of the general public or a professional user who is likely to select the goods and services at issue primarily by visual means and who will pay an average degree of attention during the selection process;
- the device element within the earlier mark is highly stylised and is a distinctive element, however, the word elements form the larger part of the mark and have a degree of dominance within it ;
- the respective trade marks have a medium degree of visual and aural similarity and are conceptually similar to a high degree;
- the opponent's earlier trade mark is possessed of an average degree of inherent distinctive character which has not been shown to have been enhanced to any material extent through its use.

77. There can be no likelihood of confusion where there is no similarity of goods and/or services. As Lady Justice Arden stated in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA:

“49...I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

78. For those goods and services which I have found are dissimilar to the opponent's goods, the opposition under section 5(2)(b) fails.

79. The remaining goods and services I have found to be identical or similar to varying degrees and I go on to consider the likelihood of confusion in respect of them.

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

81. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O-375-10, Mr Iain Purvis Q.C. as the Appointed Person noted 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

82. Due to the differences between them which I have set out above, I do not consider the average consumer, on seeing the respective marks, would directly confuse them. The medium degree of visual and aural similarity and the high degree of conceptual similarity between the marks are such, however, that even if the consumer notices the differences between the competing trade marks, the similarities I have identified above and the distinctiveness of the opponent’s trade mark are likely to lead the consumer to conclude that the applicant’s goods and services either emanate from the opponent or from an undertaking related to the opponent i.e. there will be indirect confusion.

83. That being the case, the opposition succeeds in respect of all goods and services for which the application was made and which I have found to be identical or similar to whatever degree.

#### **The objection under section 5(4)(a) of the Act**

84. The opponent’s claims under this ground are based on two earlier rights. The first is the same mark as I have already considered under section 5(2)(b) grounds which it relies on in respect of all the goods listed at paragraph 2 above (and for most of which it has not shown evidence of use). The opponent can be in no better position under this ground and I decline to deal with it.

85. The second claim under this section is based on its claimed use of the mark MEDI HERB throughout the UK since 1 January 1998 in relation to the same wide range of goods as listed in paragraph 2 above. There is no evidence of use in relation to many of the goods claimed and, in relation to use of the (word only) mark by the opponent, the evidence is lacking and does not persuade me that it has

shown it has the goodwill claimed. Again, the opponent can be in no better position in relation to this mark and I decline to deal with it further.

86. The objections under section 5(4)(a) of the Act fail.

### **The objection under section 5(3) of the Act**

87. The objection under this ground can also be dealt with briefly. I have already found that the opponent has not made good its claim to have used the mark relied on under this ground on all goods and services claimed, in the UK since 1998 as pleaded. In my consideration, earlier in this decision, of the evidence of use of the mark filed by the opponent I found that whilst it had been used in the UK since October 2003 on a very limited range of goods (herbs and herbal supplements), the opponent had not shown that it has the necessary reputation which is the first hurdle it would have to cross to be successful in its objection under this ground. Consequently, the opposition under section 5(3) of the Act fails.

### **Summary**

89. The opposition fails in respect of the following goods and services:

#### **Class 5**

*Dietary food preparations for medical use (medical food); vitamin drinks; energy drinks (adapted for medical purposes); food for babies; dietetic foods for use in clinical nutrition; mineral waters for medical purposes; pharmaceutical sweets; gum for medical purposes; adhesive bandages (dressings); compresses; materials for use in applying pharmaceutical preparations; wipes (tissues) impregnated with pharmaceutical lotions; transdermal patches for administering pharmaceuticals; tissues impregnated with pharmaceutical lotions; first-aid boxes (filled); detergents for medical purposes; dog washes; vaginal washes; mouthwashes for medical purposes; mud for baths; antiseptics; sanitary preparations for medical purposes; biological agents (bacterial, fungal or other fungicides, weedkillers, herbicides, insecticides, parasiticides, pesticides).*

#### **Class 35**

*Advertising and marketing.*

90. The opposition succeeds under section 5(2)(b) in respect of the following goods and services:

#### Class 5

Acne creams (pharmaceutical preparations); anti-bacterial pharmaceutical preparations; anti-cancer pharmaceutical preparations; chemico-pharmaceutical preparations; elixirs (pharmaceutical preparations); filled ampoules of pharmaceutical preparations; pharmaceutical preparations; pharmaceutical preparations containing vitamins; pharmaceutical preparations for animals; pharmaceutical preparations for skin care; pharmaceutical preparations for topical use; pharmaceutical products; pharmaceutical substances; pharmaceutical drugs; drugs; tablets (pharmaceuticals); preparations for body care (pharmaceuticals); plant extracts for pharmaceutical use; moisturisers (pharmaceuticals); medical foodstuff additives for pharmaceutical use; oils adapted for medical use; oils adapted for pharmaceutical purposes; extracts of plants in capsule form (for pharmaceutical use); digestives for pharmaceutical purposes; chemical preparations for pharmaceutical purposes; capsules for pharmaceutical purposes; biological preparations for pharmaceutical purposes; homeopathic pharmaceuticals; natural pharmaceutical products; pharmaceutical tonic preparations; skincare preparations (pharmaceutical); syrups for pharmaceutical purposes; therapeutic drugs (medical); anti-cancer drugs; drugs for medical purposes; dietary food supplements; mineral dietary supplements for humans; plant compounds for use as dietary supplements (medicinal); plant extracts (dietary supplements); vitamin supplements; analgesics; herbs for medicinal purposes; herbs for smoking (for medicinal purposes); infusions for medicinal purposes made from herbs; extracts of medicinal herbs; cough syrups; protein dietary supplements; herbal remedies; skin care products (medicated); dietetic infusions for medical use; protein preparations for use as additives to foodstuffs for human consumption (adapted for medical purposes); cough mixtures; mixtures of germicides and antiseptics in ointment form; medicines for human use; medicines for veterinary purposes; liniments; medicinal infusions; medicinal tea; narcotics; nutritional supplements; sedatives; sunburn ointments; suppositories.

Class 35

Retail services connected with the sale of pharmaceutical products.

**Costs**

91. Taking into account the number of objections raised and the extent to which those objections succeeded, it seems to me that the parties have each achieved a roughly equal measure of success. That being the case, each should bear their own costs.

**Dated this 30<sup>th</sup> day of December 2017**

**Ann Corbett**

**For the Registrar**

**The Comptroller-General**