

O-786-19

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF**  
**TRADE MARK APPLICATION NO. 3381406**  
**BY VIVOZON, INC.**  
**TO REGISTER**

**UNAFRA**

**AS A TRADE MARK IN CLASS 5**

**AND**

**OPPOSITION THERETO**  
**UNDER NO. 600001162**  
**BY ROTTAPHARM MADAUS GMBH**

## Background and pleadings

1. On 07 March 2019, Vivozon, Inc. (“the applicant”) applied to register the trade mark shown below under number 3381406:

UNAFRA

2. The application was published for opposition purposes on 05 April 2019. The list of goods has been subject to amendment and now reads as follows:

*Medicines for human purposes namely, pain treatment preparations; veterinary preparations namely, pain treatment preparations.*

3. Rottapharm Madaus GmbH (“the opponent”) filed a notice of opposition under the fast-track opposition procedure on 3 July 2019. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon the following European Union trade mark (“EUTM”):

**Mark:** UNAFRA

**EU registration no.** 017886956

**Filing date:** 11 April 2018

**Date of entry in register:** 09 August 2018

**Goods relied upon:**

Class 5 *Pharmaceutical and medical preparations; contraceptives; oral contraceptives; contraceptive foams; contraceptive sponges.*

4. The opponent argues that there is a likelihood of confusion, including the likelihood of association, because the respective marks are similar and the goods are identical. The applicant filed a counterstatement denying the grounds of opposition.

5. Rules 20(1)-(3) of the Trade Marks Rules (“TMR”) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

6. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Only the opponent filed written submissions, which I take into account. This decision is taken following a careful reading of all of the papers.

8. The opponent is represented by Withers & Rogers LLP and the applicant is represented by Wilson Gunn.

## **DECISION**

### **Section 5(2)(b)**

9. Section 5(2)(b) of the Act reads as follows:

“5 (2) 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 of the part of the public, which includes the likelihood of association with the earlier trade mark”.

10. An earlier trade mark is defined in s. 6 of the Act, the relevant parts of which state:

“6. - (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

11. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than five years before the application date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

### **Section 5(2)(b) – case law**

12. The following principles are gleaned from the judgments 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 C3/03, *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 the 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 to mind the earlier mark, is not sufficient;

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

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

### **Comparison of goods**

13. In reaching a conclusion, I will keep in mind the decision of the General Court (“GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

14. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] 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”.

15. The competing goods are as follows:

Opponent’s goods	Applicant’s goods
<p><u>Class 5</u> Pharmaceutical and medical preparations; contraceptives; oral contraceptives; contraceptive foams; contraceptive sponges.</p>	<p><u>Class 5</u> Medicines for human purposes namely, pain treatment preparations; veterinary preparations namely, pain treatment preparations.</p>

16. In the counterstatement, the applicant admitted that the respective goods are similar as its goods fall within the phrase “pharmaceutical and medical preparations” in the opponent’s specification. The opponent submits that these goods are identical. I note that the *Oxford English Dictionary* (“OED”) defines “pharmaceutical” as “of, relating to, or engaged in pharmacy; used in pharmacy, of the nature of a medicinal drug; of or relating to the manufacture, use, or sale of medicinal drugs.”<sup>1</sup> As appears to be confirmed by the above definition, the term pharmaceutical preparations is broad enough to cover medicinal drugs for both human and veterinary use: I see no reason why pain treatment preparations for veterinary, as opposed to human, use, would not be considered medical or pharmaceutical products. Accordingly, the applicant’s pain treatment preparations for human and veterinary use are included in the broader category of pharmaceutical preparations. Applying the *Meric* principle, I consider that the applicant’s *medicines for human purposes namely, pain treatment preparations and veterinary preparations namely, pain treatment preparations* are identical to the opponent’s *pharmaceutical and medical preparations*.

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<sup>1</sup> <https://www.oed.com/view/Entry/142229?redirectedFrom=pharmaceutical#eid> [Accessed 16 December 2019]

17. That being the case, I do not consider it necessary to compare the rest of the opponent's goods with the contested goods, as it will not place the opponent in a better position in these proceedings.

### **Comparison of marks**

18. 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

19. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

20. The trade marks to be compared are as follows:

<b>Opponent's trade mark</b>	<b>Applicant's trade mark</b>
UNAFA	<b>UNAFRA</b>

21. The opponent's mark is comprised of the word "UNAFRA" presented in capital letters. The mark has no additional stylisation. The overall impression and the distinctiveness of the mark, therefore, lie in the single word of which it is composed.

22. The only component of the applicant's mark is the word "UNAFRA" presented in bold capital letters. Although filed as a figurative mark, the typeface appears entirely ordinary and there is no additional stylisation. The overall impression and the distinctiveness of the mark lie in the word "UNAFRA".

23. Visually, the respective marks are comprised of five letters and six letters. The applicant argues that the addition of the letter "R" alters the appearance of the applicant's mark and therefore, the marks are visually "quite" dissimilar. All the letters in the opponent's mark are contained in the applicant's mark and the first 4 letters are in the same order. They also share the same last letter. The only difference between the marks is the presence of the letter "R" in the second to last position in the applicant's mark. Bearing in mind the similarities and differences, I find that the marks are visually similar to a high degree.

24. Both marks consist of three syllables. The marks will be pronounced as U-NA-FA and U-NA-FRA, respectively, of which the first two syllables are identical. Even though, as argued by the applicant, the pronunciation of "FA" in the opponent's mark is not identical to "FRA" in the applicant's mark, this difference in sound, introduced by the additional letter "R", is only in the last syllable and there remain similarities in the pronunciation of this syllable because of the shared letters "F" and "A". Therefore, in my view, the aural similarity between the marks is high.

25. In a conceptual comparison, neither mark has any meaning for the average consumer and the marks will be seen only as invented words. On that basis, there is neither conceptual similarity nor conceptual difference.

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

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer.

27. 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”.

28. In *Mundipharma AG v OHIM*, Case T-256/04, the GC accepted that there were two groups of relevant consumers for a pharmaceutical product, professional users and the general public.

29. In *Bayer AG v EUIPO*, Case T-261/17, the GC held that the average consumer pays a heightened level of attention when selecting pharmaceutical products, including such products available without a prescription<sup>2</sup>.

30. The applicant argues that the average consumer will take greater care in the selection due to the nature of the goods at issue and the importance of selecting the correct goods. The applicant further argues that the pharmaceutical goods are often provided on prescription through a doctor/pharmacist.

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<sup>2</sup> See paragraph 33 of the judgment.

31. I agree with the opponent that there are two groups of average consumer for the goods in Class 5, a professional user or an ordinary member of the public. I also bear in mind that the goods at issue may be available on prescription or without a prescription. Prescribers (doctors and veterinarians, for example) are likely to encounter the marks in medical journals, catalogues or websites. Where the pharmaceutical preparations are sold without a prescription, the member of the public is likely to obtain the goods through self-selection from a shelf, catalogue or online equivalent. Visual considerations are, therefore, likely to dominate the selection process. I bear in mind that professional users may discuss about the goods with a pharmaceutical representative, or a member of the public may seek advice before the purchase or may request the goods orally at a counter. In such circumstances, I consider that aural considerations are also relevant.

32. I find that the general public pays a reasonably high level of attention in selecting the goods at issue as they will take some care in choosing the correct medicine to treat the illness. I also find that where the goods are for professional users, the level of attention is high, as professional users take into account various factors, for example, the right dosage, potential interaction with other drugs or adverse effects, which may be more severe than for drugs available over the counter.

### **Distinctiveness of the earlier mark**

33. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

34. As the opponent filed no evidence, I have only the inherent position to consider. The earlier mark consists of an invented word with no meaning. I, therefore, conclude that the earlier mark has a high degree of inherent distinctive character.

### **Likelihood of confusion**

35. The factors considered above have a degree of interdependency and must be weighed against one another in a global assessment (*Canon* at [17]; *Sabel* at [22]). They must be considered from the perspective of the average consumer and a determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 (*Lloyd Schuhfabrik* at [26]).

36. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertaking being the same or related).

37. Earlier in this decision, I concluded:

- That the contested goods are identical to the goods covered by the opponent's mark;
- That the goods will be selected primarily by visual means, with a reasonably high degree of attention by the general public and a high degree of attention by professional users;
- That the marks are visually and aurally similar to a high degree, and conceptually neutral;
- That the opponent's mark is distinctive to a high degree.

38. Applying these conclusions, I find that there is a likelihood of direct confusion for the average consumer who is a member of the public. The high degree of visual and aural similarity between the respective marks is likely to counteract any visual and aural differences. Given that the goods are identical, and the earlier mark is inherently highly distinctive, the average consumer, even though he/she pays a reasonably high degree of attention, is likely to confuse one mark for the other, particularly when factoring in imperfect recollection. Confusion is also likely even for those average consumers who exhibit a high degree of attention. The level of visual and aural similarity between the marks, even though they are only five and six letters long respectively, and the lack of a conceptual hook in either mark to aid in differentiating between the two, result in a likelihood that they will be misremembered even by those paying a high degree of attention.

## **Conclusion**

39. The opposition has succeeded in full. The application will be refused.

## **Costs**

40. The opponent has been successful and is entitled to an award of costs. Awards of costs in fast-track proceedings are governed by Tribunal Practice Notice ("TPN") 2/2015. The opponent has made a request for an award of £500. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Filing written submissions:	£200
Total:	£500

41. I order Vivozon, Inc. to pay Rottapharm Madaus GmbH the sum of **£500**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this day Tuesday 24<sup>th</sup> December 2019**

**Karol Thomas  
For the Registrar  
The Comptroller-General**