

O-240-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2300153
BY INNOVATA BIOMED LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 90916 BY SCHERING – PLOUGH LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2300153
by Innovata Biomed Limited**

and

**IN THE MATTER OF Opposition thereto
under No. 90916 by Schering – Plough Ltd**

Background

1. On 9 May 2002 Innovata Biomed Limited applied to register the mark TWINHALER in respect of the following specifications of goods:

Class 05:

Pharmaceutical preparations and substances.

Class 10:

Surgical and medical apparatus and instruments; inhalers; parts and fittings for all the aforesaid goods.

The application is numbered 2300153.

2. On 2 August 2002 Schering – Plough Ltd filed notice of opposition to this application. They are the proprietors of the mark TWISTHALER registered under No. 2184247 in respect of “Medical devices; inhalation devices for pharmaceutical products.” No. 2184247 is an earlier trade mark within the meaning of Section 6(1)(a) of the Act. Objection is taken under Section 5(2)(b) of the Act on the basis that there is a likelihood of confusion having regard to the similarity between the marks and the identity/similarity between the goods.

3. The applicants filed a counterstatement denying the above ground and referring to the many marks on the UK and Community registers with the suffix – HALER. Both sides have also offered what amount to submissions principally in relation to the issue of similarity of marks.

4. Both sides ask for an award of costs in their favour. The only evidence that has been filed consists of a confirmatory extract from the UK register showing the opponents’ registration.

5. Neither side has asked to be heard. The opponents have filed written submissions in support of their case. Acting on behalf of the Registrar I give this decision on the basis of the papers referred to above.

6. This action is brought under Section 5(2)(b) which reads:

“5.-(2) A trade mark shall not be registered if because –

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77.

Comparison of goods

8. The applicants have not commented on this issue in their counterstatement. I infer that they accept the opponents’ view of the matter that identical and similar goods are involved. That must be true particularly so far as the Class 10 goods are concerned. Both specifications cover medical apparatus/medical devices and both have inhalation devices/inhalers. The applied for specification also includes Class 5 goods, some of which may not be similar to the opponents’ Class 10 registration. But the term pharmaceutical preparations and substances would include such goods for use in or with inhalers. In those circumstances there is likely to be a close link between the active ingredient (in Class 5) and the means of delivery (in Class 10). The goods are thus similar.

Distinctive character of the respective marks

9. The distinctive and dominant components of the respective marks is a factor that must be taken into account (*Sabel v Puma*, paragraph 23). Both marks are composed of single words. Although submissions have been offered on the component elements of the words in question, I take TWINHALER and TWISTHALER to be invented words. There are nevertheless degrees of invention. Neither side has offered any explanation for their choice of mark. The applicants have approached the matter from the point of view that the first elements of the respective marks are dictionary words and the – HALER suffix alludes to the nature of the underlying goods (inhalers etc). Print-outs of various UK and CTM marks with this suffix were submitted with the counterstatement but not filed in evidential form. For the reasons given in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 and *Torremar Trade Mark* [2003] RPC 4 (paragraph 25) state of the register evidence tells me nothing about how marks are perceived and remembered by consumers. The most that can be said is that the number of registrations/applications incorporating the element suggests that it is seen by a number of different traders as conveying a desirable reference to the nature of the underlying goods. For

my part I do not think it would be surprising, if the suffix – HALER was applied to an inhalation device, that consumers would learn to recognise the allusive nature of that element. But that would in part depend on the extent to which they had been educated by trade usage to approach marks in this way. There is no evidence on this point. Furthermore neither party's goods are limited to inhalers. The element – HALER is likely to assume a more distinctive role in relation to goods outside this category.

10. Basing my consideration on the totality of the marks I take TWINHALER and TWISTHALER to be invented and distinctive words albeit that the quantum of invention may not be at the upper end of the scale.

Similarity of marks

11. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by those marks bearing in mind their distinctive and dominant components, *Sabel v Puma* paragraph 23. The matter must be judged through the eyes of the average consumer of the goods/services in question, *Sabel v Puma*, paragraph 23, the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant but rarely has the chance to make direct comparisons between marks. Imperfect recollection must, therefore, be allowed for, *Lloyd Schuhfabrik v Klijsen Handel*, paragraph 27.

12. The opponents' main submissions are that the mark TWINHALER is visually and phonetically similar to the earlier trade mark in view of the TWI – HALER letter sequence; and conceptually both marks consist of the TWI prefix and the suffix HALER. The applicants contend that the marks are visually different because TWIST differs from TWIN in its final two letters; that the same reasoning applies to phonetic considerations; TWIST and TWIN are well known words with quite different meanings; and that –HALER is a common suffix.

13. An issue may arise in relation to the goods at issue as to the group or groups who may be said to constitute the average consumer. Where pharmaceutical products and medical appliances are concerned the relevant constituency may be medical professionals, the public at large or both. It may in some circumstances be possible to further refine even these general groupings. No evidence has been filed in this case. I am unable to say, therefore, whether the goods in question are ones which are subject to prescription or are available over the counter. I approach the matter on the basis that the products are, or maybe, offered to consumers through both channels and that a broad range of consumers should be allowed for. I also take the view that the *Lloyd Schuhfabrik* test (suggesting that the average consumer is deemed to be reasonably well informed, circumspect and observant) should be applied in the context of these goods in a manner which makes due allowance for the particular care that consumers are likely to exercise in selecting products for their health and welfare.

14. Visually, as the opponents point out, the marks TWINHALER and TWISTHALER, share the elements TWI – HALER. Given also that they differ only in respect of certain consonants in the middle of the words that, of necessity, results in some visual similarity. The question is how much. In their totalities both marks are invented words though not invented or distinctive to a high degree. The eye is naturally drawn to recognisable elements or patterns. I think it is

unlikely that the average consumer will notice the visual similarities between the words without also noting that the first element of each is a well known dictionary word (whether those elements are themselves descriptively significant it is not possible to say in the absence of evidence or examples of the goods). In the context of goods such as inhalers I think it is possible that consumers will recognise the allusion inherent in the suffix element even if HALER is not a recognised abbreviation for the word inhaler. But as I have already said the applicants' goods are not limited to inhalers.

15. Both words are composed of three syllables and have the second two (HALER) in common. The first elements of marks are usually held to be of particular importance and are less likely to be slurred or lost in speech than word endings. Added to that is the fact that TWIN and TWIST have quite distinct and different sounds and will make a full and marked contribution to the overall character of the marks when spoken. On that basis there is some phonetic similarity but not of a particularly high order.

16. Where dictionary words are concerned, particularly reasonably well known ones, the public has little difficulty in distinguishing between them (even if visually similar) on the basis of their different semantic content. That is less likely to be the case where truly invented (meaningless) words are involved because any visual similarity is not counteracted by different meanings. The marks in issue here are not words that appear in any dictionary. To that extent they are invented though the presence of recognisable elements will not, I think, go unnoticed. Significantly, the method of construction of the respective marks is the same, each consisting of a dictionary word combined with the suffix HALER. It has not been shown that this is a common or recognised formulation in the relevant marketplace. My overall impression is that there is similarity in terms of the method of composition of the marks even if the conceptual dissimilarity between the first elements is noted.

Likelihood of confusion

17. The likelihood of confusion must be appreciated globally taking account of all relevant factors (*Sabel v Puma*, paragraph 22). There is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character (*Sabel v Puma*, paragraph 24). I also bear in mind the principle of interdependency which indicates that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa (*Canon v MGM*, paragraph 17).

18. Although this case involves no disputed issues of law or fact I have not found it easy to reach a view on the likelihood of confusion. This is particularly so because I have no evidence before me on consumer awareness of, or reaction to, the element – HALER. I bear in mind that consumers do not normally pause to analyse marks (*Sabel v Puma*, paragraph 23). The impression left by these marks is that they share a moderately high degree of visual similarity and are composed in a similar manner. Imperfect recollection may also play a part though whether this would extend to one mark being taken for the other given the different meanings of the first elements must be doubtful. I am inclined to think that on a global appreciation it has not been shown that there is a likelihood of direct confusion.

19. I am nevertheless concerned that, even if reasonably observant etc. consumers did not directly confuse the marks, they might be led to make an association as a result of the similarities between them. If that association causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the Section (*Canon v MGM*, paragraph 29). Approaching the matter as I believe I must on the basis that there is no evidence that consumers have been educated to differentiate between marks constructed in this way (with the HALER suffix) I consider that there is a likelihood that the mark TWINHALER would be attributed to the same trade source as TWISTHALER in the sense that it might be seen as a variant or development of a product with which consumers were already familiar. On that basis the opposition succeeds under Section 5(2)(b).

20. The opponents have been successful and are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £1000. This sum is to be paid within 7 days of the expiry of the appeal period or within 7 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of August 2003

M REYNOLDS
For the Registrar
the Comptroller General