

O-311-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2390776
BY WYETH
TO REGISTER THE TRADE MARK:**

TORIMA

IN CLASS 5

AND

**THE OPPOSITION THERETO
UNDER NO 94245
BY F HOFFMANN-LA ROCHE AG**

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by Wyeth
to register the trade mark:
TORIMA
in class 5
and the opposition thereto
under no 94245
by F Hoffmann-La Roche AG**

INTRODUCTION

1) On 29 April 2005 Wyeth filed an application to register the trade mark **TORIMA**. The application was published for opposition purposes in the *Trade Marks Journal* on 23 December 2005 with the following specification:

pharmaceutical preparations for treating cancer and diseases and disorders of the central nervous systems; anti-inflammatory pharmaceutical preparations all in Class 5.

2) On 23 March 2006 F Hoffmann-La Roche AG , which I will refer to as Hoffmann, filed a notice of opposition to the application. Hoffmann is the owner of United Kingdom trade mark registration no 1263427 of the trade mark **TOREM**. The application for registration was made on 26 March 1986. It is registered for the following goods:

pharmaceutical preparations and substances.

The above goods are in class 5 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. Hoffmann claims that, in the five year period ending with the date of the publication of the application, it has used its trade mark in “relation to a torasemide containing diuretic product indicated for people with high blood pressure, oedema of congestive heart failure, hepatic and renal diseases”.

3) Hoffmann claims that the respective trade marks are similar and that the respective goods are identical or similar. Consequently, registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act). Hoffmann seeks the refusal of the application and an award of costs.

4) Wyeth filed a counterstatement. It does not accept the claim in relation to use of the trade mark and requires proof of this use. Wyeth denies that the respective trade marks are similar. It states that TOREM is “derived directly from the treatment in respect of which it is used (torasemide). This would be apparent to medical professionals who prescribe and dispense the treatment in question.” Wyeth states that TOR is a common prefix for trade marks in class 5 and in respect of this attaches details of United Kingdom, Community and international trade marks. Wyeth has attached printouts of details of

such trade marks. Wyeth claims that the respective trade marks are not similar and that, based on the claimed use, the respective goods of the earlier trade mark are not similar. It seeks the dismissal of the opposition and an award of costs.

5) Both sides filed evidence.

6) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing. Wyeth submitted written submissions.

EVIDENCE

Main evidence of Hoffmann

7) This consists of a witness statement by Dr Hans-Friedrich Czekay who is the assistant manager of Hoffmann. Dr Czekay has worked for Hoffmann since 1991. Paragraph 6 of Dr Czekay's statement is the subject of a confidentiality order. This paragraph gives details of sales figures.

8) The TOREM product is used primarily in relation to the treatment of heart failure, hypertension and oedema (water retention). Exhibited at HFC2 are printouts for packaging of the product, for 2.5, 5 and 10 mg tablets. TOREM appears boldly on the packaging, the design of which emanates from 7 June 2005. The address of Roche Products Limited in Welwyn Garden City is given on the packaging. Beneath TOREM 'torasemide' appears. Also included in the exhibit are information sheets for the product, emanating from 17 October 2005. The information sheets explain that torasemide is a diuretic, this increases the amount of urine passed. The information sheets advise that this helps to lower blood pressure. The information sheet for 5mg and 10mg TOREM tablets advise that the 5mg tablet can be used to lower high blood pressure and the 5mg and 10mg tablets for treating oedema. The packaging exhibited is designed specifically for the United Kingdom market; Roche Products Limited is the product licence holder and manufacturer of the product in the United Kingdom.

9) The TOREM product has been used in the United Kingdom under licence by Hoffmann since May 1994. Pages from *MIMS*, the monthly index of medical specialities, for May 1994 is exhibited at HFC3. TOREM is shown as a new product, it is described as a "loop diuretic with a once daily dosage for congestive heart failure and hypertension". Dr Czekay states that *MIMS* is the industry standard in providing an index of prescription medicines. Also included at HFC3 is page 2319 from *MIMS*, this page shows a number of medicines that begin with TOR. Other than the generic term torasemide, TOREM is the only medicine shown that is for use in the United Kingdom, as indicated by the country codes on the page.

10) Exhibited at HFC4 are two printouts of promotional material for TOREM. The first printout is of a dosage card that bears the date 8/11/01. The product is described as a

diuretic and advises that TOREM is for diuretic control in heart failure. The card advises that the product is to be used for the following indications: “[e]ssential hypertension; oedema due to congestive heart failure; hepatic pulmonary or renal oedema”. The name and address of Roche Products Limited in Welwyn Garden appears upon the card. The other piece of promotional material is an advertisement for TOREM from *MIMS* of July 1994; when the product was licensed in the United Kingdom to Boehringer Mannheim UK (Pharmaceuticals) Limited.

11) Sales figures for the TOREM product in the United Kingdom are given from 1999 – 2005 (inclusive). Exhibited at HFC5 are two sales invoices from Roche Products Ltd to Unichem Limited, dated 9 July 2004 and 9 April 2003. Both invoices show sales of TOREM products at the 5mg, 10mg and 2.5mg levels.

12) Exhibited at HFC6 is a list of the trade marks provided with Wyeth’s counterstatement. Dr Czekay makes submissions about this list and about various other matters. I bear in mind the submissions of Dr Czekay in reaching my decision but as they are not evidence of fact I will say no more about them here.

13) Dr Czekay states that pharmaceutical preparations for the treatment of hypertension/heart failure and oedema and preparations for treating cancer or anti-inflammatory preparations would often be used by the same patients in combination. He states that, for example, patients suffer from hypertension, especially those who are elderly, may also be taking anti-inflammatory preparations and/or cancer treatment medication. Dr Czekay also states that the handwriting of medical practitioners is notoriously poor and that there have been a number of documented cases in which this has resulted in confusion.

Evidence of Wyeth

14) This consists of a witness statement by Ms Angela Claire Thornton-Jackson, who is a trade mark attorney acting for Wyeth. Ms Thornton-Jackson criticises Dr Czekay for making submissions in his evidence whilst only making submissions in her own evidence. I bear in mind Ms Thornton-Jackson’s submissions in reaching my decision but will say no more about them here other than on one point. Ms Thornton-Jackson, in relation to the proof of use requirement, states the many of the materials are outside the relevant timescale eg they postdate the date of the application opposed. The five year period in relation to proof of use in an opposition ends with the date of publication of the application, it is not related to the date of the application for registration.

Evidence in reply of Hoffmann

15) This consists of another witness statement made by Dr Czekay. All of Dr Czekay’s statement consists of submissions rather than evidence of fact. I will, therefore, say no more about it here, but bear in mind the submissions in reaching my decision.

DECISION

Likelihood of confusion – section 5(2)(b) of the Act

16) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

The trade mark the subject of registration no 1263427 is an earlier trade mark as per section 6(1)(a) of the Actⁱ.

17) To consider the grounds of opposition under both section 5(2)(b) of the Act, it is necessary to decide what the use shown by Hoffman establishes as per section 6A of the Actⁱⁱ. There is clear and definite use of TOREM in the United Kingdom in the five year period ending with the date of the publication of the application, ie 23 December 2005, in relation to goods that fall within the specification. There is nothing sham or coloured about the use, it satisfies the criteria for genuine use set out by the European Court of Justice (ECJ) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 [2003] ETMR 85ⁱⁱⁱ. It is necessary to decide what a fair specification based upon this use should be^{iv}. A description of the goods should not be overly specific and picky. The specification of the registration is wide and readily subject to division into coherent sub-categories. The finding of the Court of First Instance (CFI) in *Mundipharma AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-256/04 is indicative that even where use in relation to only one specific pharmaceutical product is claimed a wider specification should be arrived at, if there is a relevant, coherent sub-category^v. In *Mundipharma AG* the CFI decided that the specification should be defined by the therapeutic use of the product. In this case the product is a diuretic, a product that increases the amount of urine passed. Diuretics can be used for more than one indication, as shown by the evidence; to limit the diuretics to specific indications appears to me to be overly picky. It also ignores the potential use in other indications. From the evidence diuretics are clearly a recognised category of pharmaceutical product; something that I am also aware of from my own knowledge. I cannot see that they can be further divided into further sub-categories. **I consider that the appropriate specification of Hoffmann’s registration, for the purposes of this case, is *diuretics* and I will conduct the analysis of the likelihood of confusion upon this basis.**

Average consumer

18) In its submissions Wyeth states that its product is “delivered intravenously by oncology specialists within a hospitalised or clinical environment, the average consumer of it’s (sic) TORIMA product can be said to be medical and healthcare professionals”.

There is no limitation of the goods to the products described above. If these are the goods of interest to Wyeth, it has had plenty of time to limit its specification and it has decided not so to do; the goods of the specification are not even limited to being prescription only. On the basis of the specifications before me the claim in relation to the relevant public is contrary to various judgments of the CFI^{vi}. The relevant public for the goods of Wyeth and Hoffmann “is made up of patients in their capacity as end consumers, on the one hand, and health care professionals, on the other” (*Mundipharma AG*). *Anti-inflammatory pharmaceutical preparations* of the application includes ibuprofen, a product that can be picked up from the shelves of a supermarket. In relation to such goods I do not consider that there a particularly careful purchasing decision. In relation to all the other goods of the application and the registration, they are used to treat serious conditions, or potentially serious conditions, and that patients taking them will be “generally well informed and particularly attentive and circumspect in the choice of the medication that is appropriate for them” (*Mundipharma AG*).

Comparison of goods

19) In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose^{vii}, their method of use and whether they are in competition with each other or are complementary^{viii}. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J gave guidance as to how similarity should be assessed^{ix}. The basis of the argument of Wyeth appears to be that because the respective goods are used to treat different ailments that they are not similar. This might mean that the goods are not identical, it certainly does not mean that they are not similar. In *Armour Pharmaceutical Co v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-483/04 the CFI considered the similarity between goods with different therapeutic indications. I adopt its reasoning in this case:

“70. Suffice it to note that the goods in question are of the same nature (pharmaceutical preparations), have the same function or intended purpose (treatment of human health problems), are directed at the same consumers (professionals in the health sector and patients), use the same distribution channels (typically pharmacies) and can be complementary. Their difference, however, lies in their different therapeutic indications.

71. Accordingly, the Court finds that the similarities between the goods outweigh the differences and concludes that there exists, as correctly found by the Board of Appeal in the contested decision, some degree of similarity between the goods in question.”

I find that diuretics and the goods of the application are similar.

Comparison of trade marks

20) The trade marks to be compared are:

Trade mark of Hoffmann

Trade mark of: Wyeth

TOREM

TORIMA

21) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^x. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^{xi}. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{xii}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xiii}.

22) I cannot see that the either trade mark lends itself to any division into dominant and distinctive components. Both trade marks are invented words and so there is no conceptual similarity but equally no conceptual dissimilarity or dissonance. Both trade marks have the same first three letters and fifth letter. The second vowel of Hoffmann's trade mark is likely to have an 'eh' (as in hem) sound rather than an 'ee' sound. The second vowel of Wyeth's trade mark could be pronounced with a short 'i' sound (as in him) or with a long 'ee' sound (as in cream). In the former case there is greater phonetic similarity. The final vowel of Wyeth's case is likely to fall away in speech, the emphasis in the word coming on the first syllable. Hoffman's trade mark has two syllables and Wyeth's three. I am of the view that the similarities are such that there is a good deal of phonetic similarity between the trade marks. The common letters in the trade marks appear in the same order and form, therefore, the same pattern. I am of the view that there is a good deal of visual similarity between the two trade marks. **I find that the respective trade marks are similar.**

Conclusion

23) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xiv}. In this case there is a degree of similarity between the respective goods and a good deal of phonetic and visual similarity. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion^{xv}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xvi}. In determining the distinctive character of a 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 mark to identify the goods 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^{xvii}. In its counterstatement Wyeth makes comments about the derivation of TOREM; I cannot imagine that the relevant public is going to indulge in a philological analysis of the trade mark. The best that can be said for Wyeth's argument is that the health care professional might pick up an allusion to torasemide, if he or she analyses the trade mark but that there is no evidence to this effect. In its submissions Wyeth accepts that TOREM is an invented word. The trade mark is not descriptive, there is only a possibility of allusion; in these circumstances I consider that Hoffmann's trade mark enjoys a reasonable degree of inherent distinctiveness. (Hoffmann has made no claim to increased distinctiveness through use, quite wisely, taking into account the extent of use.) Even if Hoffmann's trade mark had limited inherent distinctiveness I do not consider that, owing to the similarities between the trade marks, that this would affect the outcome of the case^{xviii}.

24) Wyeth has looked to state of the register evidence to support its case. This does not show what is happening in the market place^{xix}. In the one page from *MIMS* there is no indication that TOR prefixed trade marks are common in the United Kingdom market place; of course, other pages if exhibited might have indicated that this was the case, I can only deal with the evidence before me. I do not put any great weight on the *MIMS* page as it emanates from well before the date of application for Wyeth's trade mark. There is an absence of evidence to show that medical professionals and patients are used to distinguishing between a variety of trade marks for pharmaceuticals that begin with the prefix TOR. The state of the register evidence tells me nothing.

25) There are no conceptual hooks in the respective trade marks, being invented words, for the relevant public to hang onto, increasing the possibilities of imperfect recollection. Taking into account the high degree of similarity between the trade marks, the similarity between the goods, the relevant public and the distinctiveness of the earlier trade mark, I consider that there is a likelihood of confusion. The degree of similarity of the trade marks is such that, even if the only relevant public was the health care professional and even if Wyeth had limited its specification to the goods referred to in its submissions, I still consider that there would be a likelihood of confusion.

26) Wyeth in its submissions has referred to a decision in South Korea; this decision was not adduced in evidence and so I cannot take it into account. Even if it were before me it would emanate from a non English speaking country and a country with a different law and so I cannot see that it would be of assistance to me. Wyeth has also referred to the preliminary indication in this case. I am obliged to take no cognisance of the preliminary indication^{xx}. Hoffmann referred to the possibility of confusion arising because of bad handwriting. This argument does not relate to the nature of the trade marks but to the potential nature of the handwriting of a medical practitioner, something that is extrinsic to the trade mark, consequently, I do not consider that it is relevant to my deliberations. It is an argument that could be applied to any trade mark, which might, for instance, be written on a shopping list or a list for Santa Claus. It is the sort of argument that did not

find favour with the CFI in *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 353/04*^{xxi}. I would also note that nowadays, in the United Kingdom, the norm is for scripts to be printed rather than written in hand, other than for home visits.

27) There is a likelihood of confusion and the application is refused in its entirety.

COSTS

28) F Hoffmann-La Roche AG has been successful and is entitled to a contribution towards its costs. I award costs on the following basis:

Opposition fee	£200
Notice of opposition	£300
Considering the counterstatement	£200
Evidence	£500
Considering evidence of the other side	£100
TOTAL	£1300

I order Wyeth to pay F Hoffmann-La Roche AG the sum of £1300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of October 2007

David Landau
For the Registrar
the Comptroller-General

ⁱ Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK), 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”.

ⁱⁱ Section 6A of the Act reads:

“(1) This section applies where –

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- (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).”

ⁱⁱⁱ “1. Article 12(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark that is not used for goods newly available on the market but for goods that were sold in

the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

^{iv} There is now a tranche of case law in relation to arriving at a fair specification:

Thomson Holidays Ltd v Norwegian Cruise Lines Ltd [2003] RPC 32:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark

at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

Animal Trade Mark [2004] FSR 19:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on

the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

^v “25 The Court notes that although, in the present case, the applicant has not demonstrated genuine use of the earlier mark for any goods, the fact remains that the intervener has not requested that proof of such use be adduced with respect to ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’. Moreover, as the Board of Appeal observed in paragraph 25 of the contested decision, because under Article 43(2) of Regulation No 40/94 proof of use of the mark on which the opposition is founded need be furnished only when requested by the applicant, it is for the latter to determine the scope of its request for proof. Accordingly, since the intervener’s request for proof did not cover the ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’, it is not necessary to explore whether the earlier mark has been put to genuine use in Germany for those products.

26 Next, it should be borne in mind that the earlier mark was registered for ‘pharmaceutical and sanitary preparations; plasters’. That category of goods is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently. Consequently, the fact that the earlier mark must be regarded as having been used for ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’ confers protection only on the sub-category within which those goods fall.

27 In the contested decision, the Board of Appeal held that the earlier mark was to be taken into consideration only in so far as it covered goods the genuine use of which was not contested. It thus defined a sub-category corresponding to those goods, namely ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’.

28 That definition is incompatible with Article 43(2) of Regulation No 40/94, as interpreted in the light of *ALADIN*, and applicable to earlier national marks pursuant to Article 43(3) of that regulation.”

^{vi} *Mundipharma AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 256/04*:

“44 Second, it has not been disputed in the present case that the relevant public for the goods covered by the mark applied for, namely therapeutic preparations for respiratory illnesses, is made up of patients in their capacity as end consumers, on the one hand, and health care professionals, on the other.

45 As to the goods for which the earlier mark is deemed to have been registered, it is apparent from the parties’ written submissions and from their answers to the questions put at the hearing that some therapeutic preparations for respiratory illnesses are available only on prescription whilst others are available over the counter. Since some of those goods may be purchased by patients without a medical prescription, the Court finds that the relevant public for those goods includes, in addition to health care professionals, the end consumers.

46 Third, as pointed out by the intervener, since many respiratory illnesses are serious conditions, patients suffering from those illnesses are generally well informed and particularly attentive and circumspect in the choice of the medication that is appropriate for them.

47 The Court thus finds that the relevant public comprises German health care professionals, on the one hand, and German patients suffering from respiratory illnesses, on the other, the latter generally showing a higher than average level of attention.”

Armour Pharmaceutical Co v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-483/04:

“66 Moreover, since the goods in question are pharmaceutical preparations, the relevant public is composed of medical professionals, on the one hand, and patients, as the end consumers, on the other (Case T-130/03

Alcon v OHIM – Biofarma (TRAVATAN) [2005] ECR II-0000, paragraph 49, and Case T-154/03 *Biofarma v OHIM – Bauch & Lomb Pharmaceuticals (ALREX)* [2005] ECR II-0000, paragraph 46).”

Biofarma SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-154/03:

“45 Furthermore, since the applicant’s tablets, like the intervener’s eye drops, are to be taken by patients at home, the latter, as end users, are also part of the relevant public in the same way as pharmacists who sell those medicinal products in their pharmacies.

46 Both the professionals in the medical sector (specialist doctors, general practitioners and pharmacists) and patients, contrary to the finding of the Board of Appeal, therefore form part of the relevant public.”

vii The earlier incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected.

viii *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

ix He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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.”

x *Sabel BV v Puma AG* [1998] RPC 199.

xi *Sabel BV v Puma AG* [1998] RPC 199.

xii *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

xiii *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

xiv *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

xv *Sabel BV v Puma AG* [1998] RPC 199.

xvi *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

xvii *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

xviii See *L’Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-235/05 P:

“45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

^{xix} See *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04 and *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 re state of the register evidence.

^{xx} Lindsay J in *esure Insurance Limited v Direct Line Insurance plc* [2007] EWHC 1557 (Ch):

“17. As a subsidiary argument, esure argues before me that the Hearing Officer was wrong to reject the Registrar's preliminary view in the way that he did. Mr Hobbs, drawing attention to the Rules to which I have referred and also to Article 6 ECHR, argues that the Hearing Officer was right in doing as he did. I have no doubt but that the Hearing Officer was right to do as he did. The Registrar's view was arrived at before there was any evidence on either side, before there was any argument on either side and in a context in which it could not be regarded as a decision against the interests of either side without the prospective loser being given an opportunity to be heard, an opportunity which was not given. So far from it being an error of principle to fail to take the Registrar's preliminary view into account, it would, in my judgment, have been a serious error of principle for it to have been taken into account.”

^{xxi} 74 First of all, as regards the applicant's claim that the Board of Appeal should have taken into consideration the fact that the marks at issue are very similar when written by hand in small letters and/or presented in cursive script, it must be noted that the two marks at issue are Community word marks. A word mark is a mark consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element (*Faber*, cited in paragraph 60 above, paragraph 33). The protection which results from registration of a word mark concerns the word mentioned in the application for registration and not the specific graphic or stylistic elements accompanying that mark. The applicant's assertion is for that reason unfounded.