

O-202/10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2499774  
BY HIMALAYA GLOBAL HOLDINGS LTD TO REGISTER A  
TRADE MARK IN CLASS 5**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 98844 BY MERCK KGaA**

## BACKGROUND

1. On 22 July 2004, Himalaya Global Holdings Ltd (Himalaya) applied to the Office for Harmonization in the Internal Market (Trade Marks & Designs) (OHIM) for registration of the trade mark **DIABECON** for a range of goods in classes 3, 5 & 30; the application was accorded CTM No. 3956976. The class 5 element of that application was subsequently converted into a United Kingdom application and accorded No. 2499774. This application was then examined, accepted and subsequently published for opposition purposes on 12 December 2008 in Trade Marks Journal No.6765 for the following goods in class 5:

“Herbal based nutritional substances; herbal based dietetic substances for medical use.”

2. On 10 March 2009, Merck KGaA (Merck) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). In their Statement of Grounds Merck indicate that the opposition is based upon the following trade mark:

Trade Mark	No.	Application Date	Registration Date	Goods
DIABION	CTM 3082682	4.03.2003	7.12.2006	5 - Dietetic preparations for medical use, especially multivitamins.  29 –Food supplements, dietetic preparations not for medical use on the basis of proteins.  30 – Food supplements, dietetic preparations not for medical use on the basis of carbenic hydrates.

3. I note that the opposition is directed against all of the goods contained in Himalaya’s application. In their Notice of Opposition Merck say:

“The first four letters of the earlier trade mark and the opposed trade mark are identical and the final two letters of both marks are also identical; the only differences between the two marks are the letters EC interposed between the prefix DIAB and the suffix ON. Neither mark has any inherent meaning and this increases the chance of imperfect recollection. The slight difference between the marks is not sufficient to avoid a likelihood of confusion on the part of the public. Therefore, the marks are similar.

The earlier goods and the opposed goods both relate to nutritional substances for medical or non-medical use and therefore they are identical or similar.”

4. On 15 May 2009, Himalaya filed a counterstatement in which they admit that the goods contained in their application:

“are the same or similar to the goods of the registration.”

5. Insofar as the respective trade marks are concerned, they say:

“It is denied that the marks have no inherent meaning. DIAB- or DIABE- is commonly used as a prefix for a product suitable for diabetics. In the context of the goods in question, the inherent meaning is that these are such products. It is denied that the marks are confusingly similar.”

6. Only Himalaya filed evidence. While neither party asked to be heard, both filed written submissions which I will refer to as necessary below. In their written submissions, dated 29 December 2009, Himalaya asked for their specification of goods to be amended to read:

“Ayurvedic herbal preparations for diabetics.”

7. I note that The Oxford Dictionary of English (revised edition) 2005 defines Ayurveda thus:

“**noun**

[mass noun] the traditional Hindu system of medicine (incorporated in Atharva Veda, the last of the four Vedas), which is based on the idea of balance in bodily systems and uses diet, herbal treatment, and yogic breathing.

- DERIVATIVES **Ayurvedic adjective** .

- ORIGIN from Sanskrit *āyus* ‘life’ + *veda* ‘(sacred) knowledge’.”

8. Following correspondence with the Trade Marks Registry, on 15 February 2010 Himalaya filed a Form TM21 to amend their specification to read:

“Ayurvedic herbal based nutritional substances for diabetics; ayurvedic herbal based dietetic substances for diabetics.”

9. The Trade Marks Registry considered this amendment acceptable and it was advertised in Trade Marks Journal No. 6829 on 26 March 2010. In a letter dated 19 May 2010, Merck confirmed that the amendment did not overcome their opposition and asked for the opposition to continue.

10. After a careful consideration of all the material before me, I give this decision.

## **EVIDENCE**

### **Himalaya's evidence**

11. This consists of a witness statement, dated 16 September 2009, by Harpreet Dhaliwal who works in the trade mark department of Reddie & Grose, Himalaya's professional representatives in these proceedings. Attached as exhibit 1 to his statement is an extract downloaded on 16 September 2009 from the website [www.merck.co.uk](http://www.merck.co.uk). The extract reads as follows:

"Everyday Health Protection

Bion® is world's first high quality probiotic multivitamin and is available in over 15 countries globally. Bion®3 contains three carefully selected probiotics combined with 12 vitamins and 12 minerals in a unique 3-layer tablet. It is also available as Multibionta® in the United Kingdom.

Cebion has been a "classic" among vitamin C preparations for more than 75 years in Latin America and Europe. Cebion® now available with zinc and histidine.

Diabion® has been specifically developed for diabetics. Due to its balanced combination of ingredients, Diabion® can help against the risks associated with diabetes and thus improve the quality of life of those affected."

12. That concludes my summary of the evidence filed.

## **DECISION**

13. The opposition is based solely upon section 5(2)(b) of the Act which 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 on the part of the public, which includes the likelihood of association with the earlier trade mark."

14. An earlier trade mark is defined in section 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.”

15. In these proceedings Merck is relying on the registered trade mark shown in paragraph 2 above, which has an application date of 4 March 2003 i.e. prior to that of the application for registration which has an application date of 22 July 2004; as such, it qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 12 December 2008 and Merck’s earlier trade mark was registered on 7 December 2006. As a result, Merck’s earlier trade mark is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

### **Section 5(2)(b) – case law**

16. The European Court of Justice (ECJ) has provided guidance in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) 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; *Sabel BV v. Puma AG*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(j) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks 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 Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

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

17. 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 in the course of trade. Merck's goods in class 5 (which are the only goods in their registration I need to consider - see my comments in paragraph 22 below) are dietetic preparations for medical use especially multivitamins, whereas Himalaya's goods are ayurvedic herbal based nutritional and dietetic substances for diabetics. As neither specification is further limited in any way (for example to goods only available on prescription), both parties' goods may be purchased by a member of the public either over the counter in, for example, a pharmacy or from a shelf in, for example, a supermarket, and not only as Himalaya suggest in their written submissions, through "specialised channels".

18. As with most goods which are purchased by self selection, visual considerations are, in my view, likely to be the most important. Aural considerations cannot of course be ignored as they may also play a part in the selection process.

19. I note that in their written submissions Merck say:

“...the average consumer of the goods in question is held to be normally informed and reasonably attentive and aware..”

20. In their written submissions Himalaya say:

“...diabetics must pay attention to what they eat. This results in a carefully considered purchase.”

21. Given the nature of the goods concerned all of which relate to a person’s health and well-being and despite what may be their relatively low cost, it is, I think, fair to assume that in general a reasonable amount of care will be taken in their purchase. However, as Himalaya mention in their written submissions, the average consumer’s level of attention is likely to increase somewhat when selecting goods suitable for use by diabetics.

**Comparison of goods**

22. I noted in paragraph 4 that in their counterstatement Himalaya admitted the goods contained in their application were the same or similar to the goods contained in Merck’s registration. Himalaya’s subsequent request to amend their specification was initially included in their written submissions. In the absence of any comments from them to the contrary in either those written submissions or since the amendment was approved by the Trade Marks Registry, I intend to proceed on the basis that their concession also applies to the now limited specification of goods. However, for the avoidance of doubt should Himalaya’s view be different, the phrase “Dietetic preparations for medical use especially multivitamins” contained in class 5 of Merck’s registration is, in my view, broad enough to encompass all of the goods contained in Himalaya’s amended specification. The respective goods are therefore identical.

**Comparison of trade marks**

23. For the sake of convenience, the trade marks to be compared are as follows:

<b>Himalaya’s trade mark</b>	<b>Merck’s trade mark</b>
DIABECON	DIABION

24. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind

25. In their written submissions Himalaya focus on what both parties' refer to as the DIAB prefix appearing in each trade mark. The conclusions they reach on this point permeate their comments on the distinctive and dominant elements of the respective trade marks as well as the manner in which the visual, aural and conceptual comparison should be approached. Given its importance to the conclusions I need to reach later in this decision it is, I think, necessary for me to deal with this issue here.

26. Himalaya say, inter alia:

“The use of the prefix, DIAB- suggests that the products are especially designed for diabetics as it evokes a connection with the disease diabetes. This explains why the applicant chose the prefix, DIAB- for their product. So, the only element between these two marks, the prefix-DIAB-, is used to characterise products specifically for use by diabetics.

Evidence submitted by the applicant...is an extract of the opponent's website further illustrating the above argument regarding the prefix DIAB-. The website clearly shows that the mark BION is used in relation to a multivitamin, whereas, the mark, DIABION is used in relation to an equivalent product specifically developed for diabetics.”

27. In their written submissions Merck say inter alia:

“We would dispute any suggestion that the letters DIAB have any significance or stand for diabetes. The Applicant has not provided any evidence of this and we submit this is not an abbreviation which is common in the trade or one which would be recognised by a consumer. The letters DIAB do not describe the products of interest to either party.”

28. In my view the position appears to be as follows. Himalaya chose the DIAB prefix as in their view it evoked a connection with diabetes and in turn suggested that the products to be sold under the DIABECON trade mark were specifically designed for diabetics. Merck have a product called Bion® which they use in relation to a multivitamin product. They also have a product called Diabion® which has been specifically designed for diabetics. On the basis of these circumstances Himalaya conclude that the prefix DIAB is used to characterise products specifically for use by diabetics and that as a result my comparison should focus on the endings which are, in their view, the distinctive and dominant element of each trade mark. Merck say that no

evidence has been provided which indicates that DIAB is an abbreviation which is common in the trade or one which would be recognised by the average consumer.

29. Having considered the competing submissions I agree with Merck's position. As they say no evidence has been provided to show that other traders use the letters DIAB in their trade marks to indicate that their goods are for use by diabetics, nor has any evidence been provided to indicate that the average consumer would construe the letters DIAB in this way.

30. As a result of those conclusions neither parties' trade mark can, in my view, be said to have a distinctive and dominant component. Rather, the distinctiveness in each trade mark resides in its totality.

31. As I mentioned above many of Himalaya's comments on the visual, aural and conceptual similarity between the respective trade marks are predicated on the assumption that the prefix DIAB is used to characterise products for diabetics, and as a result the endings of the respective trade marks are the most important for the purposes of comparison. As I have rejected that submission, it follows that I also reject their approach to the comparison of the respective trade marks based on that assumption. As the case law dictates in those circumstances, it is the totality of the respective trade marks that I must consider.

### **Visual similarity**

32. I noted Merck's views on the visual similarity between the respective trade marks in paragraph 3 above. In their written submissions they add:

"Additionally, the similarity is furthered by the fact that the first part of the sign is regarded as the most significant. This is justified due to the fact that the public reads from left to right so that the part of the sign on the left (the beginning) is that which initially attracts the reader's attention..."

33. In their written submissions Himalaya say:

"...-ECON of the applied for mark is visually different from -ION of the opponent's mark."

34. Himalaya's trade mark consists of the eight letter word DIABECON presented in upper case, whereas Merck's trade mark consists of the seven letter word DIABION also presented in upper case; neither trade mark isolates or accentuates any element in any way. Given their similarity in length and as both trade marks begin with the same first four letters and end with the same two letters, there is, in my view, a reasonably high degree of visual similarity between them.

## **Aural similarity**

35. In their written submissions Merck say:

“From an aural point of view, both the marks contain three syllables.”

36. Himalaya say:

“The presence of the C results in a significant aural difference; DIABECON ends with a hard sound, -CON, which is unlikely to be slurred or confused with other letters and sounds. On the other hand, -ION has a more soft sound.”

37. I disagree with Merck’s submission to the effect that both trade marks contain three syllables; in my view both trade marks contain four syllables i.e. DI-AB-E-CON and DI-AB-I-ON. The manner in which the respective trade marks will be pronounced is always (to some extent at least) a matter of speculation. However, in my view, Himalaya’s trade mark is most likely to be pronounced as DI (as in die), AB (as in the beginning of the word abstract), E (as in the letter itself) and CON (as in the beginning of the word convince). That said, the letters DI may also be pronounced as DEE (as in the name Dionne). Insofar as Merck’s trade mark is concerned many of the same considerations apply. It is, I think, most likely to be pronounced as DI (as above) – AB (as above) and I-ON (pronounced as in eon). However, regardless of exactly how the respective trade marks are pronounced, there will always, in my view, remain a reasonable degree of aural similarity between them.

## **Conceptual similarity**

38. In their written submissions Merck say:

“Conceptually, neither mark has a particular meaning in English.”

39. I have already rejected Himalaya’s submissions on the meaning to be attributed to the letters DIAB. In my view both trade marks consist of invented words and as such there is neither conceptual similarity nor conceptual dissonance.

## **Distinctive character of Merck’s trade mark**

40. I must now assess the distinctive character of Merck’s trade mark. As Merck are not relying on any evidence of the use they may have made of their trade mark, I have only the inherent characteristics of the trade mark to consider. 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.

41. I have already concluded that Merck's trade mark consists of an invented word. It is therefore a trade mark possessed of a high level of inherent distinctive character.

### **Likelihood of confusion**

42. 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of Merck's trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process, and 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 they have retained in their mind.

43. In summary, I have concluded that:

(i) the respective goods at issue are identical;

(ii) the average consumer is a member of the general public;

(iii) given the nature of the goods at issue the visual aspect of the comparison is likely to be the most important although aural considerations may also play a part in the selection process;

(iv) the average consumer is likely in general to display a reasonable amount of care when selecting the goods;

(v) neither parties' trade mark has a distinctive and dominant element, the distinctiveness in each residing in their totality;

(vi) there is a reasonably high degree of visual similarity and a reasonable degree of aural similarity between the respective trade marks;

(vii) the respective trade marks are neither conceptually similar nor conceptually dissonant;

(viii) Merck's trade mark is possessed of a high level of inherent distinctive character.

44. I must now apply the global approach advocated to my findings to determine whether direct confusion (where one trade mark is mistaken for the other) or indirect

confusion (where the goods would be assumed to come from economically linked undertakings) is likely to occur. Having done so, I have concluded given the identity in the goods, the degree of both visual and aural similarity between the respective trade marks, the nature of the purchasing process, the traits of the average consumer when purchasing the goods and the high level of inherent distinctive character Merck's trade mark possesses, that direct confusion is likely to occur.

**45. In summary, the opposition has been successful and the application should be refused in its entirety.**

**Costs**

46. As Merck have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Merck on the following basis:

Preparing a statement and considering the other side's statement:	£300
Official fee:	£200
Considering Himalaya's evidence:	£100
Written submissions:	£300
<b>Total:</b>	<b>£900</b>

47. I order Himalaya Global Holdings Ltd to pay to Merck KGaA the sum of £900. 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 23 day of June 2010**

**C J BOWEN  
For the Registrar  
The Comptroller-General**