

O/101/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2579448  
BY TIBOTEC PHARMACEUTICALS TO REGISTER THE TRADE MARK**

**SCIELO**

**IN CLASS 5**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 102255  
BY MERCK KGaA**

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**IN THE MATTER OF Application No 2579448  
By Tibotec Pharmaceuticals to register the trade mark**

**SCIELO**

and

**IN THE MATTER OF opposition thereto under No 102255 by Merck KGaA**

### BACKGROUND AND SUBMISSIONS

1. On 26<sup>th</sup> April 2011 Tibotec Pharmaceuticals ('Tibotec') applied to register the mark as above in class 5 for 'Human pharmaceutical preparations'.
2. The application was allocated number 2579448 and was published in the Trade Marks Journal on 10<sup>th</sup> June 2011. On 3<sup>rd</sup> August 2011 Merck KGaA ('Merck') lodged an opposition against the goods specified above.
3. Merck has opposed on the sole basis of section 5(2)(b) of The Trade Marks Act 1994 ('the Act'), citing the following earlier trade mark:

Mark. Relevant dates	Goods and services relied upon
International Registration 993931 (EC)  <b>CIZELLO</b>  Date of international registration: 5 <sup>th</sup> February 2009  Date of protection in the EC: 5 <sup>th</sup> February 2009	<b>Class 5</b>  Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use.

4. In its submissions, Merck says there is a likelihood of confusion on the basis of visual similarity; that is, the marks are of roughly the same length, both end in 'LO', the vowels have identical placement in the marks and the letters –CI-E-LO are also in identical sequence. It also says the marks are aurally similar to a high degree. That is, as the letter 'C' in both marks is followed by the vowel 'I', this has the effect the 'C' in its mark will result in a

pronunciation similar to 'CIDER', ie 'SIZE –ELLO'. Tibotec's mark will have a similar pronunciation as, when 'SC' are together, as in the words 'SCISSORS' or 'SCIENCE', the 'C' becomes soft or silent. Thus, Tibotec's mark will be pronounced 'SI –LO' or 'SE-LO'. Conceptually, Merck says neither mark has any conceptual meaning and as far, then, as any similarities and dissimilarities are concerned there can be none; conceptually, the marks are 'neutral'. In consequence, this results in the visual and aural similarities becoming more significant. It says, further, that it is common to order pharmaceuticals over the counter and this places emphasis on aural use in particular and the consequences of any confusion could be severe<sup>1</sup>. Overall, says Merck, there is a likelihood of confusion under section 5(2)(b) of The Trade Marks Act 1994 ('the Act').

5. Tibotec filed a counterstatement and submissions denying that there is any likelihood of confusion. Specifically it says that, visually, the marks are very different to each other; its mark having the initial letters 'SCI' and Merck's, 'CIZ'. This will be immediately apparent to the consumer who notices such obvious differences in smaller marks. Aurally, Tibotec says its mark will be pronounced 'SKI – LO' (in other words, the 'C' will not be lost or softened), whereas Merck's will be pronounced 'SIZ – ELLO'. The 'SIZ' element will rhyme with 'BIZ'. This phonetic difference between the marks in their respective prefixes (being the most important element) heightens or amplifies their different pronunciations, such that the respective marks are aurally different. Conceptually, Tibotec agrees with Merck that the marks are neither similar nor dissimilar, but given the differences in visual and aural similarity it asserts there will be no likelihood of confusion.
6. Both parties filed written submissions at the conclusion of the proceedings which I have recorded above and shall obviously take into account. Neither party wished to be heard and consequently this decision is made after a careful reading of the papers. Both parties sought costs.

## **DECISION**

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

7. The opposition is founded upon Section 5(2)(b) of the Act. This reads:

5. - (1) .....

(2) A trade mark shall not be registered if because –

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<sup>1</sup> It places specific reliance on Case R 2557/2010-2 KARVEZIDE v CARDEXID, a case before the OHIM Board of Appeal ('BoA'), in which the Opposition division was criticised for not taking proper account of the likely pronunciations of the average French speaking consumer, and also the fact that pharmaceuticals can be bought over the counter aurally.

(a) .....

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

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

8. 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), 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,

9. By virtue of the Act and The Trade Marks (International Registration) Order 2008 (as amended), Merck’s mark is a protected international trade mark (EC) and is an earlier mark under the Act. Protection of this mark was within 5 years of the publication of the subject application, and accordingly the earlier mark is not subject to proof of use requirements.

10. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & 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* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead

rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

## ***Comparison of the goods and services***

11. It is self-evident the respective goods are identical.

## ***The average consumer and nature of the purchase***

12. I need to assess who exactly the average consumer is and the nature of acquisition and purchase.

13. Both parties' specifications contain the term 'pharmaceuticals'. There is no indication from either party that the products covered by their specifications are for prescription only. In such circumstances I am required to consider a range of consumers, including both the end-user of the pharmaceutical and intermediaries such as health care professionals.<sup>2</sup> The TRAVATAN case referred to in my footnote states further, that even if the specifications were clearly prescription only this would not, of itself, have precluded a likelihood of confusion as the process by which the pharmaceutical is acquired by the patient engages *both* patient and professional in a dialogue.

14. Having said that my analysis of the average consumer must include both the healthcare professional and end-users, plainly the identities of those respective groups for each parties' specification must overlap.

15. The nature of the purchase will, in both parties' cases, and in general be well considered, given these are pharmaceutical products. The consumer will be alert, for example, to specific conditions, contra-indications and, in some cases, past medical history.

16. Merck asks me to be especially alert to aural selection in this case; that is to say it is entirely possible that a consumer may ask a pharmacist, for

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<sup>2</sup> In, eg Case C-412/05P (TRAVATAN) before the Court of Justice of the European Union it was held:

"56 In the present case, having regard to that case-law, the Court of First Instance was fully entitled to hold, which indeed is not disputed by any party in these appeal proceedings, that the healthcare professional at issue must be included in the relevant public for the purposes of the application of Article 8(1)(b) of Regulation No 40/94, the function of the trade mark as an indication of origin being also relevant to intermediaries who deal with the goods commercially in so far as it will tend to influence their conduct in the market (see, to that effect, Case C-371/02 *Björnekulla Fruktindustrier* [2004] ECR I-5791, paragraphs 23 and 25).

57 However, contrary to what the applicant claims, the fact that intermediaries such as healthcare professionals are liable to influence or even to determine the choice made by the end-users is not, in itself, capable of excluding all likelihood of confusion on the part of those consumers as regards the origin of the goods at issue."

example, for a particular drug by name. I think this is a fair submission but I do not think it fair to thereby exclude other means of selection. Some pharmaceuticals for example are available by visual selection in a self service environment. Others, as I have said, may engage other healthcare professionals in their selection. In summary, I do not think it correct to skew my deliberations in the direction of aural selection in this case but to be aware of the mix of selection processes involving pharmaceuticals.

17. I will need to factor in these observations into my final analysis of likelihood of confusion.

**Comparison of the marks**

18. The case law makes it clear I must undertake a full comparison of the marks, taking account of visual, phonetic and conceptual similarities and dissimilarities, from the perspective of the average consumer. Marks need to be considered in their totalities and taking account of overall impression, giving recognition to any distinctive and dominant elements.

19. The marks to be compared are as follows:

Merck's mark	Tibotec' s mark
CIZELLO	SCIELO

20. Visually, Merck's mark comprises a single, seven letter word which, to the average UK consumer, would not be recognisable. It is a mix of vowels and consonants, with the vowels i, e, and o, present in that order, but separated by consonants. The word begins with the letters CIZ and ends with ELLO. Tibotec's mark is also a single word mark which would not be recognised by the average UK consumer. It has six letters, being a mix of vowels and consonants; the vowels i, e and o appearing in that order. The word begins with the letters 'SCI' and then has a visually similar ending to Merck's mark with the letters 'ELO'. Although the marks have some degree of visual similarity in terms of their length and the sharing of certain letters, there are also obvious dissimilarities, notably as regards the first letters. On that basis, and taking these similarities and dissimilarities into account, I find that the respective marks are similar to a low degree.

21. The parties are markedly divergent in their submissions regarding aural similarity and I must consider this aspect carefully, and from the perspective of the average English speaking UK consumer.

22. At the outset I would observe that, as neither word has any clear or obvious meaning or derivation from a known word, there is danger in adopting a

particular pronunciation as being the only and inevitable way these words will be pronounced. I am free to consider a range of possibilities which may be adopted in the everyday purchasing process. I may, in that consideration, favour a particular pronunciation but it would be unwise to assume that will only ever be the way such words will be pronounced.

23. Merck's mark aurally breaks down into the letters 'CIZ' and then, 'ELLO'. The initial letters open up a range of possible pronunciation. They could, as Tibotec says, be pronounced 'CIZ', the 'C' being hard, as in, a 'K' sound, such as, eg 'KI ZELLO'. That said, the other most likely possibility is that the letters 'CIZ' could also be pronounced with the 'C' as a soft sound, as in 'CI - DER' or 'CINNA-MON'. It has to be said, the latter is the more usual pronunciation for words in the English language that start with the letters 'C' and 'I'. Whether it is hard or soft however, it is clear that the letter 'Z' in the middle of the word will be plainly enunciated, linking the start with the end of the word. The end result, and the most likely pronunciation of the whole word will, in my opinion, be 'SIZE – ELLO' rather than 'KIZ- ELLO', but nothing turns on this particular opinion.
24. Similarly, Tibotec's mark presents something of a challenge to the average English speaker. Merck says the opening 'SC' is likely to render the letter 'C' as silent, as in 'SCISSORS' or 'SCIENCE', given especially that the following letter is 'I'. As a whole then, Merck says the word will be pronounced 'SEE-LO' or 'SIGH-LO'. On the contrary, says Tibotec, for whom the letter 'C' will be sounded in a hard fashion and rendered as a 'K', resulting in the pronunciation 'SKEE – LO', 'SKY-LO,' or even 'SKI-EL-LO'. On balance, I incline to the view that the letter 'c' will be enunciated, whether as 'SKEE-LO' or 'SKY-LO'. I do not believe the average consumer will engage in linguistic analysis, which references other words like 'SCIENCE' and 'SCISSORS' in a way which results in the 'C' being silent. For one thing, the word is a long way, visually, from the known word 'SI-LO', such that, as I have said, in my opinion the letter 'C' will be enunciated (in a hard way) by the average English speaker.
25. Taking my likely pronunciations into account, I find that the marks are aurally similar only to a low degree. I would just add that even if I were wrong as regards my likely pronunciations of the respective marks, my conclusions on similarity of marks and likelihood of confusion would have been no different. Specifically, even if the 'C' in 'SCIELO' were silent, the marks would still possess significant aural *d*issimilarity, namely the presence of the letter 'Z' in Merck's mark which would be impossible to ignore.
26. On a conceptual level, both parties are agreed that as neither mark has any conceptual meaning or reference, the marks are consequently, conceptually neutral, as far as similarity is concerned. I agree with the parties in this respect.



### **Overall finding of similarity of marks, including distinctive and dominant elements**

27. I need to bring my individual findings together in an overall assessment of similarity, bearing in mind any distinctive and dominant elements. In my view, both marks will be seen as wholes rather than broken down into specific elements. I appreciate that pharmaceuticals can be bought or acquired both aurally and visually, with or without the intervention of healthcare professionals. Bearing this in mind and taking account of the various individual findings above, I find that overall, the respective marks are similar to a low degree.

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

28. My discussion above leads me into a final assessment which must be done prior to an assessment of likelihood of confusion, namely, the distinctiveness of the earlier mark. A mark comprising an invented word will inevitably be very high on the scale of distinctiveness, whereas a known word which has a more obvious connection with the relevant goods or services will be lower on the scale of distinctiveness.

29. The earlier mark is an invented word, and as such it must be given an inherently high level of distinctiveness which has not, as there is no evidence on the point, been enhanced through use.

### ***Global assessment under section 5(2)(b) - likelihood of confusion***

30. At this point I need to remind myself of my various findings and bring them together in a global assessment taking, of course, into account, the doctrine of imperfect recollection, namely that consumers rarely have the opportunity to compare marks side by side.

31. I have found the earlier mark to be inherently distinctive to a high degree. I have found the respective marks to be similar to a low degree. I have observed that the nature of the purchases and acquisitions will be well considered. I also remind myself that the nature of 'confusion', whether it be direct or indirect, for the purposes of section 5(2) does not include mere association in the sense of 'bringing to mind'. Bearing all these factors in mind I consider there is no likelihood of confusion in this case.

**32. The opposition under section 5(2)(b) accordingly fails.**

## **Costs**

33. Tibotec Pharmaceuticals has been successful in defending against the opposition and is entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither party sought a hearing. In the circumstances I award Tibotec Pharmaceuticals the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Filing counterstatement and considering Merck's statement- £300

Filing submissions £300

Total £600

34. I order Merck KGaA to pay Tibotec Pharmaceuticals the sum of £600. The sum should 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 6<sup>th</sup> day of March 2012**

**Edward Smith  
For the Registrar,  
the Comptroller-General**