O/252/12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2576047
BY
JOHNSON & JOHNSON
TO REGISTER THE TRADE MARK

ABIRIBA

IN CLASS 05

AND

THE OPPOSITION THERETO
UNDER NO 102207
BY
BOEHRINGER INGELHEIM PHARMA GMBH & CO. KG

Trade Marks Act 1994
In the matter of application no 2576047
by Johnson & Johnson
to register the trade mark:
ABIRIBA
in class 05
and the opposition thereto
under no. 102207
by Boehringer Ingelheim Pharma GmbH & Co. KG

BACKGROUND

1. On 23 March 2011, Johnson & Johnson (the applicant) applied to register the above trade mark in class 05 of the Nice Classification system[1], as follows:

Human pharmaceuticals

2. Following publication of the application, on 17 June 2011, Boehringer Ingelheim Pharma GmbH & Co. KG (the opponent) filed notice of opposition against the application.

3. The ground of opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4. The opponent relies upon the mark shown below.

MARK DETAILS AND RELEVANT DATES	**GOODS RELIED UPON**
CTM: 789529 **Mark:** SPIRIVA **Date of application:** 3 April 1998 **Priority date:** 17 October 1997 **Date of registration:** 16 June 1999	**Class 05:** Pharmaceutical preparations.

5. In its statement of grounds the opponent submits that the marks are visually, phonetically and conceptually similar and that the goods of the parties are identical. In respect of the likelihood of confusion it states:

4. "The average consumer who has previously met the earlier mark and is then

[1] *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

confronted with the later mark does not usually have the earlier mark in front of him or her for comparison purposes. This is especially so when there is no obvious meaning to either mark resulting in the average consumer experiencing more difficulty in retaining the Opponent's mark accurately in the memory. In such a case, the average consumer is more likely to recall the length of the word and the rhythm of it than the actual spelling of the mark and is, therefore, likely to be confused."

6. On 1 September 2011, the applicant filed a counter statement in which it requested the opponent provide proof of its mark on pharmaceutical preparations. It denies the grounds upon which the opposition is based. It states:

"3...notwithstanding any similarity or identity between the two sets of goods this is easily outweighed by the significant differences between the two marks."

7. Only the opponent filed evidence; the applicant filed written submissions at the evidence-in-chief stage of the proceedings. While neither party asked to be heard, both filed written submissions in lieu of attendance at a hearing; I will refer to these various submissions as necessary below.

EVIDENCE

8. The opponent's evidence consists of a witness statement from Maximilian Kammler, dated 4 November 2011, accompanied by 3 exhibits. Mr Kammler is a Senior Trade Mark Counsel for Boehringer Ingelheim GmbH, whom he describes as *'an affiliated company of the Opponent'*. He has held this position since September 2009. The main facts emerging from Mr Kammler's statement are, in my view, as follows:

- 'SPIRIVA' has been used in the UK in relation to pharmaceutical products since August 2002.

- Turnover in the European Union from April 2002 to the end of March 2011 amounted to EUR 5,606,894,000. Figures for the UK are as follows:

Period	**Turnover – EUR (000)**
2002	1,797
2003	19,990
2004	46,835
2005	76,872
2006	96,379
2007	115,292
2008	145,075
2009	162,764
2010	192,422
First quarter 2011	48,945

- Exhibit MK1 consists of an extract from Boehringer Ingelheim's Annual Report dated 2010. It describes the use of SPIRIVA in treating Chronic Obstructive Pulmonary Disease (COPD) and includes two photographs of an inhaler bearing the word 'SPIRIVA', though the writing is not clear on the first of these.

- Exhibit MK2 consists of a five page list of countries in which the SPIRIVA mark is registered and provides details of the date of first marketing in that country. The UK is listed on page 5 with a first marketing date of 1 August 2002. The document itself is undated.

- Exhibit MK3 consists of extracts from Boehringer Ingelheim's Annual Reports from 2005 to 2009. In all five extracts SPIRIVA is shown as the top selling product for that financial year. Each extract contains an article about the product which featured in that year's annual report. In 2007, 2008 and 2009 the product can be seen clearly and features the mark SPIRIVA. In the extracts from 2005 and 2006 the extracts are not clear, though the accompanying text alongside the photographs indicates that it is the SPIRIVA product being referred to.

DECISION

9. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

> *"5. - (2) A trade mark shall not be registered if because -*
>
> *(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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."*

10. 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."*

11. In these proceedings the opponent is relying upon the trade mark shown in paragraph 4 above which constitutes an earlier trade mark under the above provisions. The application was published on 17 June 2011. The opponent's earlier mark completed its registration procedure on 16 June 1999. Consequently, the opponent's registration is subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004, and, as I mentioned above, the applicant has asked the opponent to provide proof of use in relation to pharmaceutical preparations. The relevant sections of the Proof of Use Regulations read as follows:

"6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(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)."

12. The relevant period is the five year period ending on the date of publication of the application, namely 18 June 2006 to 17 June 2011. The onus is on the opponent, under section 100 of the Act[2], to show genuine use of its mark during this period on those goods relied on or, alternatively, to show that there are proper reasons for non-use of the mark during this period.

13. In its submissions dated 30 March 2012 the applicant states:

[2] *"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."*

"3. The Opponent refers at paragraph 7 to a claim that the SPIRIVA product was first marketed in the UK in 2002, citing a document which appears to have been internally produced and further claims that the mark has been used continuously since that date (although there is no evidence that the mark has been continuously used in the UK).

4. The Opponent submits unsubstantiated sales figures of the SPIRIVA product throughout the EU, claiming that the SPIRIVA product is "one of its most valuable brands". The financial figures at exhibit MK3 of the witness statement are provided according to regions which include Europe, but not the UK specifically.

5. Overall there is no independent evidence that can verify that the SPIRIVA product has ever been used in the UK let alone extensively."

14. In its submissions dated 28 May 2012 the opponent states:

"7. The evidence of turnover relates to several EU member States, including UK, German, Spain and France and shows over the period in question and over the EU as a whole total sales of some 5.6 BILLION Euros. Bearing in mind that genuine use need only be confined to one Member State and need not necessarily be quantitatively significant, these are nevertheless impressive figures for sales. The use of the mark is supported by extracts from the Opponent's official Annual Reports for several of the relevant years which show photographs of the product bearing the trade mark. The Annual Reports also point out the major significance of the mark SPIRIVA to the Opponent and its business...The fact that such a document is not 'independent' is irrelevant as it is produced by the Opponent under stringent legal, financial and company compliance laws and regulations and so the Opponent has legal and regulatory obligations and duties to provide accurate and truthful information regarding its business...It is further submitted that this information is in the public domain and available for consultation by any interested party.

8. It is submitted, therefore, that the evidence supplied by the Opponent is more than adequate to demonstrate genuine use of its mark in the European Union in relation to pharmaceutical products, that the registration is not subject to revocation and so can be relied on in these Opposition proceedings."

Proof of use

15. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use.

16. The requirements for "genuine use" have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed Person in O-371-09 *SANT AMBROEUS*:

"42. The hearing officer set out most of the key extracts from Ansul and La Mer in his decision, so I shall not reproduce them here. Instead, I try to

summarise the "legal learning" that flows from them, adding in references to Silberquelle where relevant:

> *(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: Ansul, [35] and [37].*
>
> *(2) The use must be more than merely "token", which means in this context that it must not serve solely to preserve the rights conferred by the registration: Ansul, [36].*
>
> *(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: Ansul, [36]; Silberquelle, [17].*
>
> *(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: Ansul, [37]-[38]; Silberquelle, [18].*
>
> > *(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: Ansul, [37].*
> >
> > *(b) Examples that do not meet this criterion: (i) internal use by the proprietor: Ansul, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle, [20]-[21].*
>
> *(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: Ansul, [38] and [39]; La Mer, [22] - [23].*
>
> *(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: Ansul, [39]; La Mer, [21], [24] and [25]."*

17. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

> "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."

18. The comments of Mr Justice Jacob in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

> "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 pernickety 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 threeholed 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."

19. The comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

> "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 subcategories to which the goods or services for which the trade mark has actually been used 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."

20. First, I have to identify, as a matter of fact, the goods on which the opponent has actually used its SPIRIVA trade mark and, having reached a conclusion on that point, I must then go on and decide what, from the perspective of the average consumer of the goods, constitutes a fair specification. In these proceedings the opponent relies upon the following goods in class 5:

'Pharmaceutical preparations'

21. The opponent's evidence consists of a page taken from Boehringer Ingelheim's Annual Report from 2010 (exhibit MK1), what appears to be an internal document which provides

details of first use of the SPIRIVA mark in a number of countries and which is undated (exhibit MK2) and Annual Reports for the years 2005 to 2009 (exhibit MK3). With the exception of the internal document provided as exhibit MK2, it is clear from the exhibits which Annual Report each of the pages has been taken from and therefore provides the relevant year in each case. The extracts clearly show the word SPIRIVA presented in both title case and upper case the latter being the form in which it is registered.

22. The mark is shown on items of packaging which include boxes and blister packs and also on the devices which deliver the medication. The evidence also provides several examples of how the product is used to treat respiratory disease, in particular Chronic Pulmonary Obstructive Disorder.

23. In all of the annual report extracts provided by the opponent, the SPIRIVA brand is shown as the top product in the category 'Prescription Medicines'.

24. In his witness statement, Mr Kammler states that total sales of the SPIRIVA brand across the EU amounts to 5.6 Billion Euros. He also provides a breakdown of turnover in respect of the SPIRIVA brand in the UK which I have reproduced at paragraph 8.

25. It is clear from these figures that the SPIRIVA brand has been used in the UK as well as a number of other EU countries during the relevant period.

26. In *Pago International GmbH v Tirol Milch registrierte Genossenschaft mbH* - Case C-302/07, the European Court of Justice (now the CJEU) considered the requirements for establishing a reputation in respect of a Community trade mark. It said:

> *"30 The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community."*

27. It would be anomalous if reputation in one member state were enough to satisfy the requirements of Article 9(1)(c) but could not satisfy the use requirement.

28. When considered as a totality, the opponent's evidence clearly demonstrates that in the relevant period it made genuine use of the word SPIRIVA in (at least) the United Kingdom in respect of treatments for respiratory diseases. Having established use, I need to go on to consider whether 'pharmaceutical preparations' is a fair specification for the goods given such a finding and if not, to establish what does constitute a fair specification.

29. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

> *"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services*

they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

30. The GC has considered appropriate specifications for pharmaceutical products on a number of occasions. In *GlaxoSmithKline SpA and others v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Cases T-493/07, T-26/08, T-27/08 the GC stated:

"37 In addition, the criterion of the purpose or intended use of the product or service in question is of fundamental importance in the definition of a sub-category of goods or services, and the purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication (RESPICUR, paragraphs 29 and 30)."

31. In *Kureha Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-487/08 the GC stated:

"61 By contrast, the sub-category of goods identified by the Opposition Division and confirmed by the Board of Appeal, that is 'pharmaceutical preparations for the treatment of the heart', must be approved insofar as, first, it is based on the therapeutic indication of the goods at issue and, second, it is sufficiently broad not to undermine the intervener's legitimate interest in being able, in future, to extend its range of goods or services while enjoying the protection which registration of that trade mark confers on it."

32. The evidence set out in paragraph 8 (Annual Reports) describes the opponent's goods as being for the treatment of COPD. COPD is an umbrella term for various respiratory diseases and, in my view, this is how the average consumer would describe the goods: 'pharmaceutical preparations all for use in the treatment of respiratory diseases'. For the reasons indicated above that, in my view, represents a fair specification (which is neither too broad nor too pernickety) and is the basis on which I intend to proceed.

Section 5(2)(b) case law

33. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

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; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives 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.”

The average consumer and the nature of the purchasing act

34. In accordance with the above cited case law, I must determine who the average consumer is and also the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to

vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

35. The opponent submits:

> *"12. The relevant public for the respective goods will be medical specialists such as doctors and consultants, pharmacists who will dispense the goods, and the patient or member of the public who will require to use the goods for the treatment of their specific condition."*

36. The applicant submits:

> *"The nature of purchases and acquisitions of pharmaceuticals preparations will be well considered by the relevant consumer which includes both the end users of pharmaceuticals and intermediaries such as healthcare professionals."*

37. In *Mundipharma AG v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-256/04, the Court of First Instance (CFI) stated:

> *"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 healthcare professionals, the end consumers."*

38. The evidence shows that the goods of the earlier mark are all prescription pharmaceuticals and they are described as such in the Annual Reports. The average consumer of such goods will be primarily a medical professional and to some extent the patient, who is the end user. There is no evidence before me to indicate the nature of the purchasing act in respect of medical professionals. I anticipate that such an average consumer would be aware of these products from articles in medical journals, approaches from medical sales representatives and additional literature such as medical catalogues.

39. The applicant's goods are human pharmaceuticals at large which would include prescription medication and over the counter or self-selected goods. The average consumer for such goods would include the medical professionals, discussed above, and members of the general public. In the case of pharmaceutical preparations administered in hospital, the relevant public is more likely to be the physician and hospital pharmacist. When a member of the general public purchases over the counter or off the shelf medication the purchase may be made visually from a shelf or website, or, aurally, when requesting advice from a pharmacist.

40. In either case, whether the goods are prescription medicines or medicines available over the counter or off the shelf, I cannot conclude that either the visual or aural elements play a more significant role in the purchasing act and will give both equal weight.

41. In *Armour Pharmaceutical Co v OHIM*, Case T-483/04, the CFI stated:

> *"79. The Court finds that the level of attention of the average consumer of pharmaceutical preparations must be determined on a case-by-case basis, according to the facts in the case-file, especially the therapeutic indications of the goods in question. Likewise, the Court finds that, in the case of medicinal products subject to medical prescription such as those being considered in the present case, that level of attention will generally be higher, given that they are prescribed by a physician and subsequently checked by a pharmacist who delivers them to the consumers."*

42. Further in *Aventis Pharma SA v OHIM*, Case T-95/07, the CFI stated:

> "29. First, as noted in the case-law, medical professionals display a high degree of attention when prescribing medicinal products. Second, with regard to end-consumers, it can be assumed, where pharmaceutical products are sold without prescription, that the consumers interested in those products are reasonably well informed, observant and circumspect, since those products affect their state of health, and that they are less likely to confuse different versions of such products (see, to that effect, Case T-202/04 Madaus v OHIM – Optima Healthcare (ECHINAID) [2006] ECR II-1115, paragraph 33). Furthermore, even supposing a medical prescription to be mandatory, consumers are likely to display a high degree of attention when the products in question are prescribed, having regard to the fact that they are pharmaceutical products (ATURION, paragraph 27)."

43. For pharmaceutical products sold without prescription, even those of low cost, the general public will be reasonably well informed, observant and circumspect and will pay a reasonable level of attention to the selection of the product, taking into account the ingredients, side effects and condition for which treatment is required. A medical professional is likely to pay a high degree of attention when prescribing medication, as is the patient for whom it is being prescribed. Both have knowledge of the patient's medical history and an interest in the patient's prognosis. The consumer who is a member of the general public is more likely to be subject to the effects of imperfect recollection than the medical professional whose level of attention and expertise will be greater than those of a member of the general public.

Comparison of goods

44. As a consequence of my finding above, the goods to be compared are as follows:

The opponent's goods	**The applicant's goods**
Class 5: Pharmaceutical preparations all for use in the treatment of respiratory diseases	**Class 5:** Human pharmaceuticals

45. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM,* Case T-133/05:

> *"29. …goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark*

application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

46. Based upon its broader specification, the opponent submitted that the goods of both parties are identical. Having found that the fair specification of the opponent's goods is *'Pharmaceutical preparations all for use in the treatment of respiratory diseases',* and basing the comparison on this specification, I agree, these goods are identical as they are included within the broader category *'human pharmaceuticals'* in the application.

Comparison of marks

47. The marks to be compared are:

Opponent's mark	**Applicant's mark**
SPIRIVA	ABIRIBA

48. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

Dominant and distinctive components

49. The opponent's mark consists of the word SPIRIVA presented in upper case. The applicant's mark consists of the word ABIRIBA presented in upper case. Neither of the competing trade marks has a distinctive or dominant element, the distinctiveness of both trade marks lie in their totalities.

Visual similarities

50. In its submissions the opponent states:

"14. The respective marks are also similar. These are ABIRIBA v SPIRIVA. They also each contain the identical sequence of vowels, -I-I-A. The second part of each mark, i.e. –IRIBA and –IRIVA are virtually identical with the exception of the letters "B" and "V".

51. In its submissions the applicant states:

"Visually, comparing the marks, it is immediately apparent that the marks are fundamentally different from one another to the extent that the relevant consumer would notice the differences immediately and without the need for further reflection…Consumers generally tend to focus on the first elements of signs when confronted with trade marks. This is justified by the fact that consumers tend to read from left to right which makes the initial part on the left of the mark the one that first catches the attention of the relevant consumer. Consequently, the elements SPI and

ABI, are clearly distinguishable from one another. The fact that both marks contain the string –IRI-A is not, in itself, sufficient for a finding of similarity."

52. Any visual similarity between the marks rests in the middle three letters 'IRI' and the fact that both marks end in the letter 'A'. They are both presented in block capital letters. The fact that both marks contain the same letters in the same order in the middle does not mean that they are necessarily similar in their totality.

53. The applicant's mark begins with the letters 'ABI' while the opponent's begins with the letters 'SPI'. It is clear from decisions such as those in joined cases T-183/02 and T-184/02[3] that the first parts of words catch the attention of consumers and, in my view, this is the case here. The beginnings of the competing marks are completely different.

54. Taking all of these factors into account I find there to be a very low degree of visual similarity between the marks.

Aural similarities

55. The opponent submits:

"14. The letter 'B' in the middle of a word is often not emphasised or stressed and can, therefore, sound approximate to the letter 'V'."

56. The applicant submits:

"There are clear aural differences between the marks to the extent that there is no likelihood of confusion. The relevant consumer would pronounce the opponent's mark SPIRIVA using three syllables as SPI-RI-VA, (phonetically SPY-REE-VAR) opposed to the four syllables of ABIRIBA as A-BI-RI-BA (phonetically, ABBEY-REE-BER). Any similarity between the marks is therefore confined to the second syllable of the earlier mark and third syllable of the contested mark, namely 'RI'. All of the remaining elements, including the prefixes, SPI and ABI, which are the most important elements (where the overwhelming influence is placed) are very different. These differences would be immediately noticeable when spoken."

57. In my view the applicant's mark will be pronounced as the applicant submits. The opponent's mark may be pronounced SPI-REE-VA or SPY-REE-VA. There are common aural elements to the marks, namely 'IRI' in the middle of each. (whichever way the average consumer pronounces the word SPIRIVA). However, a finding that there is an element of similarity does not mean that the marks are similar overall. I agree with the applicant that the differences between the marks are immediately noticeable when spoken. Taking these factors into account I find there to be a low degree of aural similarity between the marks.

Conceptual similarities

58. For a conceptual meaning to be relevant it must be one capable of immediate grasp by

[3] *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR) [2004] ECR II – 965, paragraph 81*

the average consumer.[4]

59. The opponent submits that:

> *"15. Neither mark has any obvious conceptual meaning and so each presents as an invented word."*

60. The applicant states:

> *"Since the marks are considered to be conceptually neutral, there can be no finding of similarity."*

61. As far as I am aware, the words ABIRIBA and SPIRIVA have no meaning in relation to the goods at issue. Consequently, I agree with the parties that the competing trade marks are neither conceptually similar nor conceptually different.

Distinctive character

62. I must now assess the distinctive character of the opponent's earlier trade mark. In these proceedings, the distinctive character of the opponent's earlier trade mark must be appraised first, by reference to the goods upon which I have found it has been used 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 used 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.

63. I have to consider whether the Opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it.

64. In its submissions the applicant said:

> *"Despite submitting evidence relating to use of the SPIRIVA mark, which cannot be said with any certainty, to be use in the UK, the Opponent has not claimed that the mark has an enhanced distinctive character or reputation for that matter. Therefore, it can be concluded that the earlier marks are to be taken as having a normal or low degree of distinctive character. The Applicant does not consider the earlier mark to be unusual."*

65. As far as I am aware, the word 'SPIRIVA' is an invented word which is neither descriptive of nor non-distinctive for the goods at issue; consequently, it enjoys a high level of inherent distinctive character.

66. Since the matter of enhanced distinctive character through use is not a pleading point but a matter for the Hearing Officer, I must determine whether the trade mark SPIRIVA has acquired an enhanced distinctive character through the use made of it. In so doing I must

[4] *This is highlighted in numerous judgments of the GC and the CJEU including Ruiz Picasso v OHIMi [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.*

return to the evidence filed by the opponent which I have summarised and commented on above. Having done so, I have no hesitation concluding that the duration and intensity of the opponent's use of its SPIRIVA mark in the UK entitles it to benefit from an enhanced distinctive character.

Likelihood of confusion

67. In assessing the likelihood of confusion I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.[5] I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

68. I have found that the marks share a very low degree of visual similarity, a low degree of aural similarity and are conceptually neutral. I have identified a high level of inherent distinctive character in the opponent's earlier mark which has been further enhanced by the use made of it and have concluded that the parties' goods are identical. I have identified the average consumer, namely a medical practitioner or member of the general public. I have concluded that the purchase may be visual or aural and will involve at least a reasonable degree of care and attention. In the case of a medical professional and/or patient, it is likely to involve a high degree of attention being paid to prescribed medication.

69. The general rule, that the average consumer tends to place most importance on the start of a word,[6] is exactly that - a general rule, which can be mitigated depending on the circumstances of the case.[7] In this case the fact that the first two letters are different, in words which are only seven letters in length, is a significant factor and the endings also differ. In my view, the similarities between the competing marks are more than offset by the differences.

70. Taking all the above factors into account, and considering the marks as a whole, I have no difficulty concluding that there is no likelihood of confusion between the competing marks.

CONCLUSION

The opposition fails.

Costs

[5] *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V. paragraph 27*

[6] *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-336/03*

[7] *Castellani SpA v OHIM, T-149/06 and Spa Monopole, compagnie fermiere de Spa SA/NV v OHIM, T-438/07*

71. The opposition having failed, the applicant is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place, but that submissions were filed in lieu of a hearing. I make the award on the following basis.

Preparing a statement and considering the other side's statement:	£ 200
Considering the other side's evidence:	£ 300
Written submissions (filed during proceedings and in lieu of a hearing):	£400
Total:	**£ 900**

72. I order Boehringer Ingelheim Pharma GmbH & Co. KG to pay Johnson & Johnson 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 27th day of June 2012

Ms Al Skilton
For the Registrar,