

O-027-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos. 2636233 & 2636234
BY VENAXIS INC.
TO REGISTER THE TRADE MARKS
APPY1 and APPYREADER
IN CLASS 10
AND
IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER Nos. 104394 AND 104396 BY
BIOMÉRIEUX**

BACKGROUND

1) On 27 September 2012, AspenBio Pharma Inc. applied to register the trade mark **APPY1** in respect of the following goods in Class 10: In vitro diagnostic test kits for appendicitis diagnosis, appendicitis evaluation and abdominal pain triage evaluation. On the same date it also applied to register the trade mark **APPYREADER** in respect of the following goods in Class 10: Diagnostic testing instruments for use in immunoassay procedures for the detection of appendicitis.

2) The applications were examined and accepted, and subsequently published for opposition purposes on 26 October 2012 in Trade Marks Journal No.6963. On 30 September 2013 AspenBio Pharma Inc. changed its name to Venaxis Inc. and is hereinafter referred to as the applicant.

3) On 24 January 2013 Biomérieux (hereinafter the opponent) filed notices of opposition. The grounds of the oppositions are in summary:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Date of application / registration	Class	Specification
API	CTM 7294655	07.10.08 05.08.10	1	Chemicals used in industry and science, reagents and media for checking and detecting contaminants in industrial, farming, cosmetic and pharmaceutical preparations.
			5	Reagents and media for medical and veterinary diagnostics.
			9	Scientific apparatus and instruments for checking and detecting contaminants in industrial, farming, cosmetic and pharmaceutical preparations.
			10	Medical diagnostic and veterinary diagnostic apparatus and instruments.
APIWEB	CTM 10485944	12.12.11 09.05.12	9	Computer software in the field of clinical in vitro diagnostics; Computer software in the field of industrial in vitro diagnosis.
			35	Collection and computer processing of technical data and documentation in the field of clinical and/or industrial in vitro diagnostics, updating and correction of technical

				data and documentation in the field of clinical and/or industrial in vitro diagnostics.
			38	Transmission of information and data, All the aforesaid services being in the field of clinical and/or industrial in vitro diagnostics.
			42	Surveys (expert reports), Development, Design, The installation, Maintenance and updating of computer software, In the field of clinical and/or industrial in vitro diagnostics.

b) The opponent contends that the marks applied for are similar to its registered marks as they share the first two letters, AP, and the numeral “1” at the end of the applicant’s first mark is similar to the letter “l” in its marks. They also state that the initial part of the applicant’s mark “APPY” is similar to its mark /initial part of its mark “API”. They contend that they are visually similar and phonetically similar. They state that the extensive use made of its marks in the UK in addition to the use of the unregistered mark MINI-API gives it a family of marks. They also contend that the goods are similar. With regard to the word “READER” which forms part of the applicant’s second mark it is contended that this does not hang together with the initial part of the mark and will be seen as a separate word which has meaning in relation to the goods for which registration is sought. The mark in suit therefore offends against Section 5(2)(b) of the Act.

c) The opponent also contends that it has made extensive use of the mark API in the UK since 1970 in respect of medical diagnostic goods. It states that it has gained a reputation in the mark in these goods and enjoys considerable goodwill. Use of the applicant’s marks is likely to lead consumers to believe that the goods of the applicant originate from the opponent. It also points out that it has used a family of marks (API, APIWEB and MINI API) and has goodwill and reputation in these marks such that use of the applicant’s marks will cause misrepresentation. They contend that the marks in suit offend against Section 5(4)(a) of the Act.

4) On 8 April 2013 the applicant filed a counterstatement denying that the marks opposed were similar. The applicant accepts that part of the opponent’s specification (Class 10: Medical diagnostic and veterinary diagnostic apparatus and instruments; Class 5: Reagents and media for medical and veterinary diagnostics) is similar to the goods it has applied for. However, it denies that the rest of the opponent’s specification is similar to the specification for which it has applied.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard although both sides provided written submissions which I shall take into account as and when they are relevant.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 30 July 2013, by Laurant Cavcal the Corporate IP Director, a position he has held since 1 May 2013. He states that he has access to the opponent's records and that he is fully conversant in the English language. He states that the API mark was first used in the UK in 1970 in relation to a biochemical testing product for use in antimicrobial testing, and has been in continuous use in the UK since this date. He states that at the time of its introduction the product was pioneering and there have been many references to API products in UK scientific journals. Mr Cavcal states that the API mark has been "habitually combined with numerical and "quasi-descriptive elements in order to differentiate between specific products in the range, for example API 20 E, API 10 S, API Coryne, API Campy etc" (exhibit BM2 refers).

7) Mr Cavcal states that the mark MINI API was first used in the UK in 1996 in relation to an automated reading device for the API range. He also states that the APIWEB mark has been used in the UK since 2007 in relation to an online identification system for use in conjunction with the API system. He contends that the marks API and APIWEB are consistently used in the same product literature due to the complementary nature of the products. He also contends that the marks API range, MINI API and APIWEB form a complementary group of products known collectively as "the API system". He states that the API range and APIWEB products are sold in the UK to customers, particularly in the medical, pharmaceutical and food and drink industries. He provides the following annual sales figures for goods (unspecified) sold under the API and APIWEB marks in the UK:

Year	UK revenues €	UK quantity of kits
2008	2,608,702	50,202
2009	2,316,743	48,811
2010	2,196,311	43,438
2011	2,127,439	42,311
2012	2,184,694	40,215

8) Mr Cavcal states that his company has over 800 UK clients for its API and APIWEB products. Of these 226 are hospital laboratories, 127 are in the pharmaceutical industry and 136 are in the food industry. He states that his company sends brochures relating to the API and APIWEB products to potential customers in the UK. In addition the opponent attends conferences, some in the UK. He also provides the following exhibits:

- BM1: Articles from scientific journals which mention API products. These are dated 2000 (The Pathological Society of GB); February 2005 (Journal of Clinical Microbiology); 2006 (Journal of Medical Microbiology) which states that it is printed in the UK; November 2006 (Journal of Antimicrobial Chemotherapy) published by Oxford University Press; and a letter to the Journal of Antimicrobial

Chemotherapy) dated February 2010. All refer to using API testing kits during the course of their research.

- BM2: Extracts from product literature, dated 1990, 1996, 2006 and 2011, showing the API range: these are said to be the more detailed brochures which would be given to potential clients at meetings and conferences. These show that the company has “developed a range of systems for bacteriological identification, associating miniaturised biochemical strips with specially adapted data bases: Ready-to-use, easy-to-use comprehensive systems allow accurate identification of almost all organisms encountered”. All the items have the prefix “API” and then numbers and/ or shortened versions of words such as STAPH (staphylococci), STREP (streptococci) and CORYNE (coryneform). It also shows use of API in relation to a database, obtainable via a web based product called “apiweb”. The term API is often used with a device element similar to the top of a finger where the nail is in white and the flesh in black.
- BM3: A copy of an article, dated 2001, titled “Instrumentation in antimicrobial susceptibility testing” published in the Journal of Antimicrobial Chemotherapy which makes a reference to the MINI API.
- BM4: A copy of an APIWEB brochure, dated 2005, which shows both API and APIWEB marks used alongside examples of the API range of products, all concerned with identifying species of bacteria and yeasts. The term API is often used with a device element similar to the top of a finger where the nail is in white and the flesh in black. I note that in his written statement Mr Cavcal states that APIWEB mark was first used in the UK in 2007.
- BM5: Copies of eleven invoices dated February 2010- July 2012 showing sales of APIWEB products worth £702.68 to various customers in the UK. Also included is a copy of one invoice dated 24 November 2010 which shows sales of products with an API prefix worth £535.95
- BM6: A copy of a general type brochure dated 2012. This shows use of the mark “apiweb” with a device element similar to the top of a finger where the nail is in white and the flesh in black. The wording of the brochure cannot be read as it is so poorly photocopied.
- BM7: An extract from the ESCMID (European Society of Clinical Microbiology and Infectious Diseases) website which shows that conferences about infections and other medical issues take place in the UK.
- BM8: A copy of the brochure for the 31 March 2012 ESCMID conference held in the UK, which was attended by the opponent.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

10) The first ground of opposition is based on section 5(2)(b) which reads:

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,

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

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

12) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. Given the interplay between the date on which the application was published and the dates on which the opponent’s marks were granted protection in the EU, they are not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

13) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice to 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). In the case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below, by reference to the CJEU cases, which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; 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;

(e) 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

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

(i) 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;

(j) 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 process

14) I must now determine the average consumer for the goods of the parties. Both parties, broadly speaking, make diagnostic kits for the medical and scientific industries. Clearly, such professionals will take reasonable care in selecting the testing kit that is relative to the work they are carrying out. Medical professionals are used to differentiating between words which look and sound very similar but which have very different meanings e.g. hypertension/hypotension. I would expect such items to be selected from a catalogue or on-line and the relevant consumer will self select, although they could also be purchased via the telephone or indeed face to face with a salesperson. Whilst aural considerations must not be overlooked it is the visual aspect of the competing trade marks that will dominate the selection process.

Comparison of goods

15) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

16) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed in *Canon*. In that case the factors to be taken into account were:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods reach the market;
- e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be found on the same or different shelves;
- f) The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

17) I also bear in mind the following guidance of the GC in *Gérard Meric v OHIM*, T-133/05:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

18) Finally, in terms of understanding what a "complementary" relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 where it was stated:

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Segio Rossi v OHIM - Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseno original Juan Bolanos) [2007] ECR I-0000, paragraph 48)."

19) However, in the cases *Sandra Amalia Mary Elliott v LRC Products Limited* (and cross opposition) [BL O-255-13] in respect of the marks LUV and LOVE respectively Mr Alexander Q.C. acting as the Appointed Person said:

“15 A formulation of the law by the same Hearing Officer in very similar terms was accepted without criticism by either party or by Floyd J (as he then was) *Youview TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) and the Hearing Officer's statement of the law cannot be faulted.

16 However, because of the particular grounds of appeal in this case, which did not arise in the *Youview* case, it is necessary to make three observations about that summary as it applies to the present case.

17 First, the starting point for the analysis of similarity is the wording of the Act and the Directive. These require the tribunal to determine whether or not the respective goods are “identical or similar” but they do not specify the criteria by reference to which similarity is to be assessed. In the well-established guidance from the Court of Justice on this issue originating in *Canon*, to which the Hearing Officer referred, the Court has not suggested that every case requires assessment of whether the respective goods or services are complementary. To the contrary, the Court has regularly made it clear that all relevant factors relating to the goods or services

themselves should be taken into account, of which complementarity is but one (see e.g. in Boston).

18 Second, the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in Boston as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense — but it does not follow that wine and glassware are similar goods for trade mark purposes.

19 Third, the Hearing Officer said at [32]:

As stated above, the legal definition of ‘complementary’, as per Boston , is that the goods must be “indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”. It is not sufficient that the goods “can” be used together; nor is it sufficient that they are sold together.

20 In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston .

21 Moreover, it is necessary to view the quotation from Boston in the context of the facts of that case where the dispute over similarity turned in part on whether the goods were used together for a rather specific medical procedure. The Court of First Instance said at [77]-[87]:

Similarity between the products

77 According to consistent case-law, in order to assess the similarity of the products or services concerned, all the relevant features of the relationship that might exist between those products or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*Sunrider v OHIM* , paragraph 27 above, paragraph 85; judgment of 15 March 2006 in Case T-31/04 Eurodrive

Services and Distribution v OHIM — Gómez Frías (euroMASTER) , paragraph 31).

78 As regards the assessment of the similarity of the goods at issue, the Board of Appeal found, in paragraphs 22 to 24 of the contested decision, that, owing to their functional differences, apparatus for placing a suture, on the one hand, and hollow fibre oxygenators with detachable hard-shell reservoir, on the other hand, have a different method of use, are not in competition with each other and are not interchangeable. However, the Board found, in essence, that the goods at issue were closely linked to the goods of the intervener in so far as they had a certain complementary character, since they could be used simultaneously in the field of medicine, for example during surgery. They might also be purchased through the same distribution channels and be found in the same points of sale, so that the relevant public could be led to believe that they came from the same undertaking.

79 Those findings must be upheld.

80 In this respect, it must be noted that the goods bearing the earlier trade mark and those covered by the mark applied for both concern the medical field and are therefore intended to be used in the context of a therapeutic treatment.

81. In addition, as the Board of Appeal rightly pointed out, all the goods covered by the mark applied for have a certain complementary relationship with those bearing the earlier trade mark.

82. It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM — Sissi Rossi (SISSI ROSSI) [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057 ; Case T-364/05 Saint-Gobain Pam v OHIM — Propamsa (PAM PLUVIAL) [2007] ECR II-757 , paragraph 94; and Case T-443/05 El Corte Inglés v OHIM — Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48).

83. It is also true that, as OHIM moreover acknowledged, apparatus for placing a suture cannot be considered to be indispensable or important for the use of hollow fibre oxygenators with detachable hard-shell reservoir.

84. However, it is clear that apparatus for placing a suture and hollow fiber oxygenators with detachable hard-shell reservoir can be considered to be complementary where, in surgery which has required an incision and during

which an oxygenator has been used, the surgeon uses apparatus for placing a suture. Thus, in the course of a single, very specific procedure, namely a surgical operation, two apparatus, namely an oxygenator and apparatus for placing a suture, might be used, one bearing the trade mark CAPIOX and the other the trade mark CAPIO.

85. It follows that, even though the applicant claims that the goods at issue cannot be considered to be similar simply because they are both used in the field of medicine, which, according to the applicant, is the case of nearly all goods of significance, the goods at issue are similar because they are in fact in a certain complementary relationship and specifically target certain professionals in the medical sector. In addition, in the present case, contrary to what the applicant claims, the goods at issue are not similar solely because they are used in the field of medicine, but because they could be used in the same, very specific surgical operation, namely open-heart surgery.

86. Finally, the products at issue can in fact be found in the same distribution channels, such a criterion being relevant for the purposes of the assessment of the similarity of the goods (PiraÑAM diseño original Juan Bolaños, paragraph 82 above, paragraph 37; see also, to that effect, SISSI ROSSI , paragraph 82 above, paragraph 65; and PAM PLUVIAL , paragraph 82 above, paragraph 95).

87. Accordingly, given the close link between the products in question as regards their end users, the fact that they are to some extent complementary and the fact that they may be distributed via the same distribution channels, the Board of Appeal was right to find that the applicant's goods and those of the intervener were similar (see, to that effect, *Case T-388/00 Institut für Lernsysteme v OHIM — Educational Services (ELS)* [2002] ECR II-4301 , paragraph 56).

22 The Court of First Instance was not attributing decisive importance to the question of whether the goods in that case were complementary in determining the overall question of whether they were similar.

20) For ease of reference I reproduce the specifications of both parties. In its submissions the opponent has commented upon the similarity of its goods in classes 5 and 10 of its CTM 7294655 with both the marks applied for and also the services in class 35 of its CTM 10485944 with both marks. It would appear that the opponent has deemed that these goods and services are its strongest cases and decided not to comment on the other goods and services for which its marks are registered.

Applicant's specifications	Opponent's specification
2636233: Class 10: In vitro diagnostic test kits	7294655: Class 5: Reagents and media for medical and veterinary

<p>for appendicitis diagnosis, appendicitis evaluation and abdominal pain triage evaluation.</p>	<p>diagnostics. Class 10: Medical diagnostic and veterinary diagnostic apparatus and instruments. 10485944: Class 35: Collection and computer processing of technical data and documentation in the field of clinical and/or industrial in vitro diagnostics, updating and correction of technical data and documentation in the field of clinical and/or industrial in vitro diagnostics.</p>
<p>2636234: Class 10: Diagnostic testing instruments for use in immunoassay procedures for the detection of appendicitis.</p>	<p>7294655: Class 5: Reagents and media for medical and veterinary diagnostics. Class 10: Medical diagnostic and veterinary diagnostic apparatus and instruments. 10485944: Class 35: Collection and computer processing of technical data and documentation in the field of clinical and/or industrial in vitro diagnostics, updating and correction of technical data and documentation in the field of clinical and/or industrial in vitro diagnostics.</p>

21) The opponent contends that the applicant’s specifications are both for diagnosing a medical condition, whereas its class 5 specifications “reagents” are to aid medical diagnostics by facilitating a chemical reaction and its “media” support the growth of microorganisms or cells for the purpose of medical diagnostics. They state that the applicant’s “test kits” may include reagents or media and that the goods are similar or complementary and they would be used by the same end users and distributed through the same trade channels. The opponent also points out that its class 10 goods are diagnostic kits which are very similar to the applicant’s goods. To my mind the opponent’s goods in class 10 must be regarded as highly similar to the class 10 goods in both the applicant’s specifications. I also regard the class 5 goods of the opponent to be reasonably similar to the class 10 goods of both of the applicant’s specifications.

22) Regarding the class 35 services the opponent contends that its services are “for the purpose of collecting and processing technical data, which may be data such as medical diagnostic test results. As such, the opponent’s services are likely to be used in combination with the applicant’s goods. The goods and services are complementary and are likely to be offered by the same undertakings and used by the same end users”. The opponent has not provided any evidence that the provision of computer services is common amongst companies which provide medical diagnostic kits. Whilst the opponent’s services may be used by those involved in diagnostic testing there is no evidence that they are indispensable or important for the use of the diagnostic kits. I accept that the computer services may be used alongside the diagnostic kits. Despite this, to my mind the services of the opponent in class 35 are not similar to the Class 10 goods sought to be registered by the applicant.

Comparison of trade marks

23) The trade marks to be compared are as follows:

Applicant's marks	Opponent's marks
APPY1	API
APPYREADER	APIWEB

24) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

25) The applicant contends that the letters "API" is an abbreviation of "Application Programming Interface"; the opponent disputes this stating that whilst the term may have stemmed from the term "analytical profile index" it has always been used as API. There is no evidence that the average consumer will be aware of any hidden meaning for the three letters. The opponent states that in relation to its mark APIWEB the "web" part will be seen as "non-distinctive and/or descriptive" as the products for which this mark is registered all relate to computer goods or services. I agree with this reasoning and accept that the distinctive and dominant part of the opponent's mark APIWEB is the initial part API. In relation to the opponent's API mark and both the applicant's marks the goods of parties in Classes 5 & 10 are, broadly speaking, medical diagnostic kits. As such I do not believe that any part of these marks has any meaning in relation to such goods, nor do I accept that the dominant and distinctive aspect of the applicant's marks is the "APPY" aspect. To my mind, the applicant's marks hang together as wholes even if its second mark contains a well known word "reader".

Visual / Aural and Conceptual similarity

26) The opponent contends that all the marks begin with the letters "AP" which makes them visually similar. They also contend that the number "1" at the end of the applicant's mark "APPY1" will be seen as a letter "l" and thus be even more visually similar. Whilst I accept that the marks of both parties begin with the letters "AP" I do not find this a persuasive argument that the marks are therefore similar. The opponent's mark 7294655 consists simply of the three letters API. The applicant's mark 2636233 consists of four letters and a number APPY1. It is generally accepted that differences in short marks, even if at the end of the mark, are likely to stand out more and are less likely to

be overlooked. There are significant visual differences between these marks. When comparing the applicant's mark 2636234 APPYREADER to the opponent's API mark the visual differences are even more pronounced. Moving onto the opponent's mark 10485944 APIWEB although nearer in length to the applicant's mark there are significant visual differences that the average consumer would not overlook. The visual differences far outweigh the fact that they share the first two letters.

27) Moving on to aural similarity, to my mind the applicant's first mark would be most obviously pronounced in the same manner as a guttersnipe would mangle the word "Happy" by dropping the "h", then adding "one" at the end. The second mark would obviously be "appy-reader". The opponent would appear to agree with this view as it contends that its marks will be pronounced "ap-ee" and "ap-ee-web" by the average consumer. I accept that this is one way of pronouncing the marks. However, to my mind the average consumer is far more likely to enunciate a mark consisting of three letters by clearly pronouncing each letter separately "A-P-I" in the same way they would the BBC or IPO. Given the obvious link in the computer services offered under the opponent's other mark I believe that it would be pronounced "A-P-I-web". I accept that there is a degree of aural similarity between the marks, if I accept the opponent's contentions. Other than accepting that the "web" part of its own mark has a meaning neither side has suggested any conceptual meanings for the marks.

28) Overall, both of the opponent's marks have very superficial degree of visual similarity, and potentially a degree of aural similarity but these are outweighed by the differences.

FAMILY OF MARKS

29) The opponent contends that it has a family of marks. In the case of *The Infamous Nut Company v Percy Dalton (Holdings) Ltd [2003] RPC 7*, Professor Annand sitting as the Appointed Person said:

"It is impermissible for Section 5(2) (b) collectively to group together several earlier trade marks in the proprietorship of the opponents.

Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by Section 6). This where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately (ENER-CAP trade mark [1999]RPC 362).

In some circumstances it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a "family of marks" in the proprietorship and use of the opponent (AMOR, Decision No 189/1999 of the Opposition Division, OHIM OJ 2/2000 p235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr

Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31.”

30) I also take note of the comments in *Il Ponte Finanziaria SpA v OHIM* Case 234/06P, paragraphs 62-64, reported at [2008] ETMR 13 it was stated:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family or series' of marks.

63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family or series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64. As the Advocate General stated in point 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family or series', the earlier trade marks which are part of that 'family' or series' must be present on the market.”

31) In the instant case the opponent has two registered marks “API” and “APIWEB”. It also contends that it has made use of the mark “MINI API” although the only evidence of this mark comes from an article in a scientific journal dated 2001. It is clear that the opponent adds a number of suffixes to its API mark, but, just as it admitted in relation to its APIWEB mark, the suffixes all tend to have a clear meaning, see exhibit BM2 at paragraph 8 above and the opponent’s written submissions at page 5. Far from having a series of marks with a common element the opponent uses a single mark API with clear descriptors of the product. Even if I were to accept that it had a family of marks the use shown for these marks is so paltry that it does not provide for an enhanced reputation.

Distinctive character of the opponent's earlier trade mark

32) The opponent has provided evidence of use of its marks, however I do not believe that the sales figures shown are sufficient for the opponent to benefit from an enhanced reputation for either of its marks. They have not been put into any kind of context such as market share, and there is a lack of evidence from independent witnesses. However, to my mind the opponent's marks are inherently very distinctive for the goods and services for which they are registered as they have no obvious meaning when used on medical diagnosis kits in Classes 5 and 10, or when used on computer services in class 35.

Likelihood of confusion

33) I must now take all the above into account and consider the matter globally. I need to take into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. The evidence does not allow me to find the opponent to have an enhanced reputation in any goods or services. In the case of the opponent's mark 2636233 API, I found that the goods in Class 5 were reasonably similar to the Class 10 goods applied for under both of the applicant's marks, whilst the opponent's class 10 goods were highly similar to the goods applied for under both of the applicant's marks. However, I find that the opponent's mark is so dissimilar to either of the marks applied for that, even allowing for the concept of imperfect recollection there is no likelihood of the average consumer for such items being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them,

34) Moving onto the opposition under the opponent's mark 2636234 APIWEB I found that the opponent's computer services in class 35 were not similar to the goods applied for in Class 10. I also find that the opponent's mark is so dissimilar to either of the marks applied for that, even allowing for the concept of imperfect recollection there is no likelihood of the average consumer for such items being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails completely.**

35) The opponent has also opposed the marks applied for under Section 5(4) of the Act on the basis of its use of its API mark and the fact that it has also used an unregistered mark MINI API, and that it has used a family of marks, API, APIWEB and MINI API.

36) I have dealt with the question of the family of marks earlier in this decision and have found that the opponent has shown enough use of its API mark, with and without various descriptive suffixes to satisfy the question of goodwill in its API mark for the purposes of section 5(4)(a). A similar situation exists for its APIWEB mark. However, it has not shown any evidence of goodwill in its unregistered mark MINI API. Earlier in this decision I found that use of the marks applied for, actual or on a fair and notional basis would not result in confusion with the opponent's marks. Accordingly, it seems to me

that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act must fail.

CONCLUSION

37) The opponent has failed in its opposition under Section 5(2)(b) and also section 5(4)(a).

COSTS

38) As the applicant has been successful overall it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement x 2	£400
Preparing written submissions	£500
TOTAL	£900

39) I order Biomerieux to pay Venaxis Inc. 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 21st day of January 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**