

**O-627-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3171730  
IN THE NAME OF AWY GLOBAL RESOURCES LIMITED  
FOR THE MARK**

**NUPLEN**

**IN CLASS 5  
AND  
OPPOSITION THERETO UNDER NO. 408074  
BY BOEHRINGER INGELHEIM INTERNATIONAL GMBH**

## BACKGROUND

1. On 28 June 2016 AWY Global Resources Limited (“the applicant”) applied to register the mark shown on the cover page of this decision for the following goods:

**Class 5:** Pharmaceuticals; veterinary preparations; sanitary preparations for medical purposes; dietetic food preparations adapted for medical use; dietetic food adapted for veterinary use; food for babies; dietary supplements for humans; dietary supplements for animals; plasters, materials for dressings; material for stopping teeth; dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides.

2. The application was published for opposition purposes on 16 September 2016. It is opposed by Boehringer Ingelheim International GmbH (“the opponent”). The opposition, which is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) is directed against all of the goods in the application. The opponent relies upon its International Trade Mark Registration (“IR(EU) No. 1288840 for the mark NUPLADA, which has a date of designation of the EU of 25 November 2015, claims a priority date of 12 June 2015 (from Germany) and was granted protection in the EU on 20 December 2016. The opponent relies upon the goods for which its mark is registered, namely:

**Class 5:** Pharmaceutical and veterinary preparations.

3. The opponent argues that the respective marks are similar and that, with the exception of *herbicides* (in relation to which, it admits, that the goods are dissimilar), the respective goods are identical or similar.

4. The applicant filed a counterstatement in which it denied the grounds of opposition.

5. A hearing was neither requested nor considered necessary. Only the opponent filed evidence and written submissions during the evidence rounds. Both parties also filed written submissions in lieu of attendance at a hearing. I will refer to these submissions

as necessary. In these proceedings, the opponent has been represented by Urquhart-Dykes & Lord LLP. The applicant is not professionally represented.

## **DECISION**

6. Section 5(2)(b) of the Act states:

“5(2) A trade mark shall not be registered if because-

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

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

7. An earlier trade mark is defined in Section 6 of the Act, 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 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.

8. Given the priority date of its IR(EU), the opponent’s mark is an earlier mark in accordance with Section 6 of the Act. As the opponent’s IR(EU) had not been granted protection in the EU (including the UK) for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. Therefore, the earlier mark can be relied upon without having to prove use. The consequence of this is that the opponent may rely upon the full breadth of goods listed in its specification.

## **The opponent's evidence**

9. This comes from Anna Teresa Szpek, a Chartered Trade Mark Attorney at the opponent's representative. Ms Szpek's evidence is aimed at supporting the opponent's claim that the contested *baby food* and *dietary supplements* are similar to *pharmaceutical preparations*.

10. ATS3 and ATS4 includes copies of pages from Boots, Superdrug and Lloyds Pharmacy's websites showing a number of baby food products, food supplements and multivitamins available for sale. Ms Szpek refers to Boots, Superdrug and Lloyds Pharmacy as UK high street pharmacies or chemist shop chains; this concords with my own experience of the UK pharmacy market.

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

11. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("the CJEU") in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97 ("*Canon*"), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

## **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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of goods**

12. In the judgment of the CJEU in *Canon*, the Court 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”.

13. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“the GC”) stated:

“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 trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

14. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;

- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. I also bear in mind the decision in *Boston Scientific Ltd v OHIM*, Case T-325/06, where the GC stated that “complementary” means:

“...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”.

16. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“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.”

Whilst on the other hand:

“.....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.

17. The goods to be compared are as follows:

Applied for goods	Opponent’s goods
<p><b>Class 5:</b> Pharmaceuticals; veterinary preparations; sanitary preparations for medical purposes; dietetic food preparations adapted for medical use; dietetic food adapted for veterinary use; food for babies; dietary supplements for humans; dietary supplements for animals; plasters, materials for dressings; material for stopping teeth; dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides.</p>	<p><b>Class 5:</b> Pharmaceutical and veterinary preparations.</p>

18. The applicant’s position as to the similarity of the respective goods is far from clear. It states:

“Although, the category of ‘pharmaceuticals’ and ‘veterinary preparations’ is sufficiently broad for it to be possible to identify within its various sub-categories capable of being viewed independently (Case T-483/04 *Armour Pharmaceutical v OHIM – Teva Pharmaceutical Industries* (GALZIN) [2006], the subject mark’s specification goes beyond this broad categorisation. For example, ‘food for babies’ and ‘dietary supplements for humans’ and should be treated as dissimilar.

According to Kureha, ‘the criterion of the purpose or intended use of the product is of fundamental importance in the definition of a sub-category of goods’. From a commercial perspective, the purpose of these products in the subject mark is



to provide nutrition to humans. It is unlikely that the manufacturer of pharmaceuticals would also produce food for babies and dietary supplements for humans, as there is no 'medicinal' value to these products. Similarly the distribution channels for supplying food for babies would not be the same as the 'pharmaceuticals', or 'veterinary preparations' of the earlier mark. Therefore the subject mark's specifications with regards to 'food for babies' and 'dietary supplements for humans' should be treated as dissimilar."

19. The applicant only denies that *food for babies* and *dietary supplements for humans* in the application are similar to the opponent's goods. That said, the applicant did not explicitly admit that there is any similarity in respect of the remaining goods in the application and, moreover, has plainly requested that the opposition is dismissed in its entirety. I will proceed therefore on the basis that the matter cannot be determined on the basis that the applicant have conceded any identity or similarity of goods.

20. The contested *pharmaceuticals* and *veterinary preparations* are self-evidently identical to *pharmaceutical* and *veterinary preparations* of the earlier mark.

21. *Sanitary preparations for medical purposes* are special hygienic substances that serve a medical purpose: these goods go beyond sanitary preparations used as toiletries (which are classified in Class 3) and cover products such as disinfectant washes and antiseptic lotions. The opponent considers that these goods are similar to a high degree to its *pharmaceutical preparations*, because, it states, the goods have a similar purpose, share the same distribution channels, target the same public and are produced by the same manufacturers. Although these goods are not necessarily pharmaceutical preparations, I agree with the opponent that the end user is the same, namely a person who has a health problem requiring treatment. *Sanitary preparations for medical purposes* could, in fact, be used to complement pharmaceutical preparations in certain treatments or even as alternative treatments, e.g. a medicated body washes for treating skin diseases. There is, therefore, a similarity in term of purpose. Further, the goods are competitive and might be complementary in the sense that one is indispensable or important for the use of the other and customers may think that the responsibility for those goods lies with the same undertaking. The methods of use may also be the same as for *pharmaceutical preparations*, for example, the

product may be applied externally on the skin. The goods are sold in the same establishments, namely pharmacies and drugstores, as well as supermarkets, as the latter often sell pharmaceuticals. Overall, I agree with the opponent that these goods are similar to a high degree to the opponent's *pharmaceutical preparations*.

22. *Dietetic food preparations adapted for medical use* are food preparations for special nutritional requirements that serve a medical purpose. These goods are not intended to serve as ordinary food preparations but, instead, are consumed to assist in the management of the dietary aspects of a medical condition. According to the opponent, these goods are similar to the *pharmaceutical preparations* covered by the earlier mark since they have a similar purpose, share the same distribution channels and target the same public. I agree with the opponent that the purpose of these goods is similar to that of the *pharmaceutical preparations* covered by the earlier mark since the goods could have a therapeutic effect and are, broadly speaking, intended to improve health. The end user for these products is likely to be the same, e.g. someone seeking treatment for a health problem, and both categories of goods are ingestible medical products. The goods can be used together to treat or manage the same medical condition, albeit probably with different expectations as to the benefits of the respective products. Consequently, though the goods are not competitive, they may be complementary in the sense that one is indispensable or important for the use of the other and the relevant public may believe that the responsibility for the goods lies with the same undertaking. The goods may be available through the same trade channels, namely pharmacies and supermarkets. Overall, I agree with the opponent that these goods are similar to a medium degree to the opponent's *pharmaceutical preparations*<sup>1</sup>.

23. *Dietetic food adapted for veterinary use*. For similar reasons to those already outlined above, I find that these goods are similar to a medium degree the opponent's *veterinary preparations*.

24. *Dietary supplements for humans* are intended to be ingested to supplement the nutritional value of the normal diet of individuals or to redress imbalances of vital

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<sup>1</sup> See by analogy Case T-262/14, *Bionecs v OHIM*

constituents that may be caused by certain health conditions. They are substances such as vitamins, fatty acids and mineral salts. The opponent submits that these goods are similar to its *pharmaceutical preparations* since they have a similar purpose, share the same distribution channels and target the same public. As these goods are intended to have a health benefit and help to manage certain health conditions, I agree that, on a general level, there is a similarity in term of purpose. The goods can have some therapeutic impacts and although are not competitive, they could potentially be used in conjunction with *pharmaceutical preparations*. This would create a degree of complementarity, in the sense that the relevant public may believe that the responsibility for the respective goods lies with the same undertaking. The goods are normally supplied in the form of tablets, capsules or packets so the methods of use are also similar. I am aware that the goods can be purchased via the same channels, i.e. pharmacies and supermarkets, a fact which is confirmed by the evidence produced. The applicant argues that *dietary supplements for humans* are not made by the same companies who make *pharmaceutical preparations*. However, it has provided no reason why this would be so nor any evidence to support its assertion. Further, there is some tension between this submission and the fact that the applicant's own application, which includes a statement of use (or proposed use) of the mark in relation to the goods listed, covers both *pharmaceutical preparations* and *dietary supplements for humans*. Overall, I find that these goods are similar to a medium degree to the opponent's *pharmaceutical preparations*.

25. *Dietary supplements for animals*. For similar reasons to those already outlined above, I find that these goods are similar to a medium degree the opponent's *veterinary preparations*.

26. *Disinfectants* are chemicals that destroy bacteria used especially on surfaces. The opponent claims that these goods are similar to the *pharmaceutical preparations* covered by the earlier mark because the goods have a similar purpose, share the same distribution channels, target the same public and are produced by the same manufacturers. *Disinfectants* may contain the same chemical substances used in the production of the opponent's *pharmaceutical preparations*; further, the opponent's goods include antiseptic medicines that are applied to the skin to treat or prevent infections: though the nature and methods of use are different, there is a similarity of

purpose as both set of goods destroy microorganisms that cause diseases. In terms of complementarity, I find that although the administration of the opponent's *pharmaceutical preparations* usually requires a high standard of hygiene and a sterile environment and may be complemented by the applied for *disinfectants*, this does not create a complementary relationship in the sense described by the case law. Finally, though the goods may be available through the same trade channels, i.e. pharmacies and supermarkets, they are likely to be found in different parts of the store. I find that these goods are similar to the opponent's *pharmaceutical preparations* to a low degree.

27. *Plasters and materials for dressings* are goods used for the treatment of wounds. According to the opponent these goods are similar to the *pharmaceutical preparations* covered by the earlier mark because the goods have a similar purpose, share the same distribution channels and target the same public. I find that *plasters and materials for dressings* have the same nature as of *pharmaceutical preparations* since they belong to the same general category of healthcare products and have the same intended purpose, being intended for use in medical treatment or in surgical operations. Further, as the goods are not limited in any way, they include medicated and surgical plasters and materials for dressing, which routinely incorporate some form of medication. That being the case, I consider that there might be a degree of competition and that the goods could be produced by the same manufacturers. The goods are aimed at the same public, namely healthcare professionals and end consumers. Overall, I find that these goods are similar to a low to medium degree to the opponent's *pharmaceutical preparations*.

28. The opponent submits that *material for stopping teeth* and *dental wax* are similar to a low degree to the *pharmaceutical preparations* covered by the earlier mark because the goods have a similar purpose, share the same distribution channels and target the same public. *Materials for stopping teeth* are materials used to fill holes in decayed teeth. *Dental wax* is used to make braces less abrasive when fitted to teeth. These goods are products used for dental treatments directed at the professional public, i.e. dentistry professionals<sup>2</sup> and available through orthodontic suppliers. The

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<sup>2</sup> See by analogy Case T 366/11, *Bial-Portela v OHIM* of 3 March 2015 paragraph 30

*pharmaceutical preparations* of the earlier mark would include products for oral and dental care, including anaesthetic used in dental procedures. Consequently the two set of goods could have the same intended purpose (treat the same part of the body) and share users (dentists) and trade channels. However, the nature of the goods and their methods of use are different and I cannot detect any degree of complementarity or competition. Overall, I agree that these goods are similar to a low degree to the opponent's *pharmaceutical preparations*.

29. The opponent submits that *fungicides* are similar to the *pharmaceutical and veterinary preparations* covered by the earlier mark because the goods share a similar purpose, are offered through the same distribution channels and are complementary. As *fungicides* would cover medications used to treat human or animal infections<sup>3</sup>, it is curious that the opponent does not claim that these goods are identical to *pharmaceutical and veterinary preparations*. Without making a better case for the opponent than it does for itself, I find that the purpose, nature, methods of use, users and trade channels are similar to a high degree to the opponent's *pharmaceutical and veterinary preparations*.

30. The opponent submits that *preparations for destroying vermin* are similar to the *pharmaceutical and veterinary preparations* covered by the earlier mark because the goods share a similar purpose, are offered through the same distribution channels and are complementary. *Preparations for destroying vermin* are substances used to destroy animal species and insects that are believed to be harmful to human or domestic animals and which may carry diseases. Consequently, it is possible that some preparations for destroying vermin may be used in order to prevent the risks to human or animal health. The nature, purpose and methods of use are not particularly similar and I cannot detect any degree of competition or complementarity. However, the users might be the same, since *preparations for destroying vermin* are used to prevent ailments caused, directly or indirectly, by the presence of those animal species or contact with them, whilst *pharmaceutical and veterinary preparations* are used to treat the same ailments once they have occurred. Further, the goods share the same channels as some *preparations for destroying vermin*, such as, for example,

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<sup>3</sup> Case T 470/09

insecticides, may be sold in pharmacies<sup>4</sup>. In my view, these goods are similar to a low degree to the opponent's *pharmaceutical and veterinary preparations*.

31. This leaves *food for babies*. The opponent's claim that these goods are similar to the *pharmaceutical preparations* covered by the earlier mark because the goods have a similar purpose, share the same distribution channels and target the same public. The applicant disagrees on the basis that, it claims, the goods are manufactured by different producers and do not share the same trade channels. In this connection, the opponent's evidence that *food for babies* are sold in pharmacies concords with my own experience, and the applicant has not challenged this evidence. In *Ferring BV v OHIM*, Case T-169/14, the GC considered, inter alia, the question of the similarity between *food for babies* and *pharmaceutical preparations*. It stated:

55 In the third place, it should be noted that food for babies covers a large spectrum of goods, the majority of which are everyday consumer goods and which, as OHIM states, do not have a medical purpose or properties.

56 That said, those goods are nevertheless defined as food which, from a medical point of view, is suitable for consumption by babies who, because of their physiology or for other medical reasons, are not yet able to consume all types of normal food. As the applicant states, they are therefore goods which are specially composed in order to safeguard the health of infants and young children. Moreover, as the applicant also observes, it cannot be ruled out that some foods for babies might be complementary to medicines which are administered to them, particularly within the context of the treatment of nutritional deficiencies of young children, in the sense that one is indispensable or important for the use of the other.

57 Lastly, contrary to what OHIM suggests, the fact that some foods for babies are sold in pharmacies cannot generally be considered to be insignificant. In accordance with the case-law referred to in paragraph 41 above, the distribution channels of the goods concerned may constitute a relevant factor for the purpose of the comparison of those goods.

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<sup>4</sup> Case T-169/14

58 Consequently, in the light of a certain connection between some foods for babies and pharmaceutical products and substances in respect of their intended purpose, their method of use and their distribution channels, it must be held that there is a low degree of similarity between those goods (see, to that effect, judgment in *METABIOMAX*, cited in paragraph 47 above, EU:T:2014:436, paragraph 43).

32. I see no reason, in the circumstances of the case, to adopt a different approach. Accordingly, I find that the contested *food for babies* and similar to a low degree to the opponent's *pharmaceutical preparations*.

33. The opponent admits that the applied for *herbicides* are dissimilar to the *pharmaceuticals* and *veterinary preparations* covered by its registration.

34. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

35. Accordingly, for a claim under Section 5(2)(b) to succeed, there must be at least a degree of similarity of goods and services. Having concluded that there is no meaningful similarity between the opponent's goods and the applicant's:

#### *Herbicides*

36. I conclude that there is no likelihood of confusion and the opposition to these goods under Section 5(2)(b) fails accordingly.

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

37. As the case law indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods will be selected in the course of trade.

38. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

39. In *Mundipharma AG v OHIM*, Case T-256/04, the GC 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 health care professionals, the end consumers.”



40. The respective *pharmaceuticals* and *pharmaceutical preparations* are not limited to goods only available on prescription; consequently the respective products could be prescription-only or self-selected from a retail shelf or requested over the counter. The average consumer will, therefore, include the public at large as well as medical professionals. The distinction between one part of the relevant public, made up of final consumers and the other part of the relevant public made up of professional users also applies to the remaining goods which may also be available to the general public as well as professionals in the field of human and animal health. Insofar as *material for stopping teeth* and *dental wax* are concerned, these goods are intended solely for dentistry professionals, including orthodontists, who will administer them to the patients in the course of providing their services.

41. As regards the level of attention that is likely to be paid, in *Aventis Pharma SA v OHIM*, Case T-95/07, the GC 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).”

42. Even if some of the contested goods are not pharmaceutical as such, they are still purchased for some health purpose and concern the health of the final consumers or their domestic animals. The level of attention will therefore range from above average for goods such as *veterinary sanitary preparations*, *sanitary preparations for medical purposes*, *dietetic food preparations adapted for medical use*, *dietetic food adapted for veterinary use*, *food for babies*, *dietary supplements for humans*, *dietary*

*supplements for animals, plasters, materials for dressings, material for stopping teeth, dental wax, disinfectants, preparations for destroying vermin and fungicides, to high, for pharmaceuticals.*

43. Prescribers are likely to encounter the marks in medical journals/catalogues and discussions with pharmaceutical sales representatives. The general public are likely to obtain the goods through self-selection from a shelf, over the counter purchases, word of mouth recommendations or by prescription after discussion with a medical professional. Bearing all of this mind, I find that both visual and aural considerations are important in relation to both users.

### **Comparison of marks**

44. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

45. It would be wrong, therefore, artificially to dissect the marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Applicant's mark	Opponent's mark
NUPLEN	NUPLADA

### **Overall impression**

46. Both marks are made up of single words, the distinctive character in each case resides in the whole word.

### **Visual and aural similarity**

47. In terms of visual and aural similarity the marks are of similar length: the earlier mark is 7 letters long and the applicant's mark contains 6 letters. The first 4 letters of each mark are shared, with both marks beginning with the letter NUPL. The last 2 letters (of the applicant's mark) and three letters (of the opponent's mark) differ. Visually and aurally, I consider that the points of similarity outweigh the differences resulting from the contribution made by the different endings. In my view the marks are similar to a medium to high degree.

### **Conceptual similarity**

48. Conceptually, both marks are invented words with no conceptual meaning or allusive reference to the goods. There is therefore neither conceptual similarity nor conceptual difference between the marks. The conceptual position is neutral.

### **Distinctive character of the earlier mark**

49. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular

undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

50. The opponent did not file any evidence aimed to show that the distinctiveness of the earlier mark has been enhanced through use, so I have only the inherent characteristics to consider. The word NUPLADA has no obvious meaning and must be regarded as an invented word. That puts it at the top of the scale, so to speak, of distinctiveness.

### **Likelihood of confusion**

51. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

52. The applicant's argument on confusion is that given that the endings of the marks is different "it is unlikely that a medical practitioner prescribing the medication could mistake both products, even if one has poor handwriting." However, I have already found that, with the exception of *material for stopping teeth* and *dental wax* which are aimed at dentistry professionals, all of the goods in the application may be directed at the general public, including the contested *pharmaceuticals*, since the term encompasses goods available over the counter.

53. I have found a medium to high degree visual and aural similarity between the competing marks, and neither conceptual similarity nor conceptual difference. I have also found various degrees of similarity between the competing goods; the degree of attention deployed during the purchase also varies between the goods sought for protection. Finally, I have found that the earlier trade mark has the look and feel of an invented word and that that puts it at the top of the scale in terms of distinctiveness. The various findings I have arrived at above need now to be factored into an overall assessment of likelihood of confusion, which includes both direct confusion (mark against mark), and indirect confusion (where the marks may not be confused, but the consumer will consider that the respective goods originate from the same or linked undertaking). As the prospects of success bears not only on the marks themselves but also on the other relevant factors, I will assess the matter with respect to the terms (grouping them together where possible) that the applicant seeks to protect.

54. In relation to *pharmaceuticals*, I have no hesitation in finding that given the identity of the goods, the similarity between the marks and the high degree of distinctiveness of the earlier mark, the high level of attentiveness deployed during the selection of the goods cannot reduce the impact of imperfect recollection to the point that it can shift the balance in favour of the applicant. In my view, it is likely that the purchaser of over the counter goods will, notwithstanding the high degree of care and consideration that may be used in the selection process, directly confuse one mark for the other. **There is a likelihood of direct confusion.**

55. The above finding extends to *veterinary preparations*, *sanitary preparations for medical purposes* and *fungicides* given that the goods are identical or highly similar

and the level of attention deployed is above average. **There is a likelihood of direct confusion.**

56. I take the same view in relation to the goods in the application that are similar to a low to medium degree to the opponent's goods, namely *dietetic food preparations adapted for medical use, dietetic food adapted for veterinary use, food for babies, dietary supplements for humans, dietary supplements for animals, plasters, materials for dressings, disinfectants, preparations for destroying vermin*. Here I consider that the differences between the goods will not be sufficient to offset the similarities between the marks in the mind of the average consumer purchasing the goods off-the-shelf in shops or over the internet, when an above average degree of attention is deployed. The closeness of the marks (which could be mistaken for one another) will still indicate to the average consumer that the goods are the responsibility of the same or an economically related undertaking. **There is a likelihood of direct confusion.**

57. Finally, in relation to *material for stopping teeth* and *dental wax* I have found that these goods are aimed exclusively at dentistry professionals who will select and administer them to their patients. Though the goods will be selected with an above average degree of attentiveness, dentistry professionals are experts with specific medical knowledge. They are likely to be less subject to the effects of imperfect recollection than members of the general public and are likely to be able to distinguish between products with small name differences. It is therefore unlikely that they will directly confuse the marks. The opponent has not raised in its submissions indirect confusion and there is no evidence of use of the mark or enhanced distinctiveness. Further there is no evidence that the opponent has used of a family of NUPL- marks to support an argument that the relevant consumer has been educated to pick out that element<sup>5</sup>. I consider that in those circumstances, the differences between the goods and the marks will be sufficient to offset their similarities in the mind of the average consumer of *material for stopping teeth* and *dental wax*. Accordingly, **I find that there is no likelihood of confusion.**

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<sup>5</sup> See by analogy BL-503/16

## CONCLUSION

58. The opposition succeeds in relation to:

Pharmaceuticals; veterinary preparations; sanitary preparations for medical purposes; dietetic food preparations adapted for medical use; dietetic food adapted for veterinary use; food for babies; dietary supplements for humans; dietary supplements for animals; plasters, materials for dressings; disinfectants; preparations for destroying vermin; fungicides.

59. And fails in relation to:

Material for stopping teeth; dental wax; herbicides.

## COSTS

60. Although both parties have achieved a measure of success, as the opponent has been substantially more successful than the applicant, it is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice (TPN) 2 of 2016. Using that TPN as a guide and making a “rough and ready” reduction to reflect the measure of the applicant’s success, I award costs to the opponent on the following basis:

Official fees:	£100
Preparing a statement and considering the applicant’s statement:	£200
Filing evidence and written submissions:	£700
Total	£1,000 (-20%)
	£800

61. I order AWY Global Resources Limited to pay Boehringer Ingelheim International GmbH the sum of £800 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

**Dated this 6<sup>th</sup> day of December 2017**

**Teresa Perks**

**For the Registrar**

**The Comptroller – General**