

BL O/578/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3576649

BY

MICURX PHARMACEUTICALS, INC

TO REGISTER THE FOLLOWING TRADE MARK:

MICURX

AND

OPPOSITION NO. 424824 THERETO

BY

4D PHARMA RESEARCH LIMITED

Background and pleadings

1. On 8 January 2021, MicuRX Pharmaceuticals, Inc. (the “Applicant”) applied to register the trade mark MICURX. The contested trade mark application was accepted and published for opposition purposes in the Trade Marks Journal on 5 March 2021. Registration of the mark is sought in respect of the following goods:

Class 5 *Pharmaceutical preparations, namely, antibiotics.*

2. On 7 June 2021, 4D Pharma Research Limited (the “Opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), on the basis of its earlier United Kingdom Trade Mark (UKTM):

MicroRx

UKTM no. 3207389

Filing date: 18 January 2017

Registration date 7 April 2017

3. For the purposes of this opposition, the Opponent relied upon the entire list of services for which the earlier mark is registered, i.e.:

Class 42 *Scientific research and development; microbiology research and development into live biotherapeutics.*

4. Since its filing date predates that of the contested application, the Opponent’s mark is an “earlier mark” in accordance with section 6 of the Act. However, as it had not been registered for five years or more before the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon any or all of the services for which the earlier mark is registered without having to show that it has used the mark at all.

5. In its notice of opposition, the Opponent identified that it was opposing all of the contested goods on the basis that they are highly similar to the Class 42 services of the earlier mark. The Opponent specified that the contested *pharmaceutical*

preparations are related and complementary to the earlier mark's *scientific development*, insofar as one is as a direct result of the other.

6. The Opponent contended the similarity of the marks in the following terms:

“The Applicant’s mark MICURX is almost identical to the Opponent’s mark MICRORX. Both are three syllable marks starting with the prefix MIC and ending in the suffix RX. The only difference between the two marks is the Applicant’s use of ‘CU’ rather than ‘CRO’ in the second syllable of its mark... Given the above, there exists a likelihood of confusion between the marks. That confusion would either be that the goods sold by the Applicant originate from the Opponent, or that they are an alternative product or sub-brand or are licensed by the Opponent.”

7. On 24 September 2021, the Applicant filed its counterstatement. The Applicant submitted that the earlier mark consists of the plain word MicroRx, which is divisible into two parts: the words ‘Micro’ and ‘Rx’. The Applicant contended that the earlier mark will be pronounced with the four syllables MI-CRO-R-X, which is contrary to the Opponent’s submission that each mark contains three syllables. The Applicant argued that there is no natural interpretation of the contested mark that would automatically lead to it being broken down as MICU and RX, and on the contrary it would be pronounced as MI-CURX.

8. In relation to the contested goods, the Applicant argued that they are not highly similar to the services of the earlier mark, as they can be readily distinguished in terms of their respective uses, users, nature and channels of trade. The Applicant further argued that one is neither indispensable nor necessary in relation to the other.

9. On 29 December 2021, the Opponent filed evidence and submissions. The Opponent argued that the earlier mark is an invented term and is highly distinctive. The Opponent reiterated its position that both marks consist of three syllables: MI-CRO-RX against MI-CU-RX, with the only difference being the second syllable. The Opponent submitted that five out of the six letters of the contested mark are shared in the same sequence with the earlier mark. The Opponent argued that the use of the unusual and distinctive suffix ‘RX’ in the contested mark compounds the similarity

between the marks. The Opponent argued that overall the marks are aurally, visually and conceptually highly similar.

10. In relation to the respective specifications, the Opponent argued that professionals in pharmaceutical companies would be well-aware of the most recent scientific research pertinent to their therapeutic areas, and most (if not all) pharmaceutical companies have their own in-house research and development teams. According to the Opponent, live biotherapeutics (LBPs) contain a live microorganism that has been recognised as a new class of medicines. The Opponent argued it is therefore clear that *development into live biotherapeutics* is highly similar to the development of pharmaceutical preparations in general.

11. Accompanying the Opponent's submissions was the witness statement of Mr Jonathan Mathew Day, Partner at Carpmaels & Ransford LLP. Mr Day referred to examples of the Applicant's use of the contested mark, which purportedly indicate that it consists of two distinctive elements and should be read Micu-Rx (Exhibit JMD1). Mr Day argued that in view of this "*...the Applicant should be estopped from relying on the claim that its mark could be perceived as MI-CURX when this is not in line with the Applicant's own use of its mark.*" Mr Day confirmed the previous submission that LBPs are recognised as a new class of medicines that contain live microorganisms, and attached at Exhibit JMD2 documentation to support the position.

12. The Applicant did not file evidence or submissions when invited to do so. However, on 27 April 2022 it opted to file written submissions in lieu of a hearing.

13. The Applicant submitted that the contested goods will be utilised by both the general public (e.g., an individual seeking treatment for an infection), and healthcare professionals (e.g., a medical professional and pharmacist who will prescribe and dispense the contested goods to the individual). The Applicant argued that the relevant consumer of the earlier mark's services, however, would be a member of the professional public, who deals in a very niche, experimental area of scientific research. The Applicant submitted that the goods and services at issue fundamentally differ in their characteristics, including nature, method of use, purpose and users, due largely to the fact that the contested goods are tangible whilst the services of the earlier mark are not. The Applicant provided further submissions in relation to the differences

between the respective goods and services, which shall not be summarised here, rather they shall be introduced later into the decision wherever I consider it appropriate to do so.

14. The Applicant responded to the Opponent's submission regarding the Applicant's use of the contested mark by arguing that the marks at issue must be compared in the form in which they are registered or applied for. The Applicant argued that the actual or possible use of the contested mark is irrelevant for the purposes of assessing whether it is liable to be refused registration. The Applicant revisited and reiterated previous submissions, and submitted that the marks at issue are conceptually different insofar as the earlier mark is dominated by the English word 'Micro', being very small, whilst the contested mark has no readily discernible meaning.

15. At this point it is worth indicating my position on the issue of the Applicant's alleged use of their mark, especially in light of the Opponent's request for estoppel. Put plainly, the form of mark to be assessed for any potential likelihood of confusion with the earlier mark is that in which the contested mark was applied for. The form in which it may or may not actually be used, either currently or in the future, is not the concern of these current proceedings. It is worth remembering that the application is not subject to proof of use, which is where the question of use in a form differing from that which is registered would ordinarily need to be assessed (in which case use in a different form can be considered as an acceptable variant).¹ It is also worth remembering that the Court of Justice of the European Union (CJEU) has considered the notion of avoiding strict conformity to the applied for form in prospective future use, in order to better allow commercial exploitation, adapted to particular marketing and promotional requirements.² In addition, it is established in case law that the protection offered by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic or stylistic characteristics which that mark might possess.³ The contested mark will therefore be considered to consist of the word MICURX or micurx.

¹ See for example *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22; *Hyphen GmbH v EU IPO*, T-146/15; *Menelaus BV v EUIPO*, T-361/13; *Austria Tabak GmbH c EUIPO*, T-800/19; *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19; *Adidas AG v EUIPO* T-307/17.

² *Specsavers International Healthcare Ltd v. Asda Sores Ltd*, C-252/12, paragraph 29.

³ *Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom)*, T-254/06, paragraph 43.

16. Both parties are professionally represented. The Applicant is represented by AA Thornton IP LLP, and the Opponent is represented by Carpmaels & Ransford LLP.

17. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Decision

Section 5(2)(b)

18. Section 5(2)(b) of the Act is 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, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

19. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *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.

(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.

20. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Comparison of goods and services

21. Both parties provided submissions as to the comparison of the respective goods and services. Whilst the parties' comments are noted, the degree of similarity or identity of the specifications, as the case may be, is something which fundamentally contributes to whether there is a likelihood of confusion. I must therefore conduct my own full analysis of the goods and services at issue.

22. The parties' respective specifications are:

Earlier mark	Application
<i>Class 42: Scientific research and development; microbiology research and development into live biotherapeutics.</i>	<i>Class 5: Pharmaceutical preparations, namely, antibiotics</i>

23. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

24. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services 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 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.

25. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, 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 the responsibility for those goods lies with the same undertaking.”

26. The Opponent provided submissions to argue that the *development into live biotherapeutics* is highly similar to (or a subset of) the development of *pharmaceutical preparations*. Conversely, the Applicant argued that the goods and services at issue are different, as the contested goods are an end product, a treatment, a tangible consumable, whilst the earlier mark’s services involve specialists carrying out assessments of data in order to gather knowledge.

27. It is clear from the wording of the application's specification that the contested goods are antibiotics. Generally speaking, antibiotics are prescribed to the end user/patient by a medical or pharmaceutical professional, rather than being chosen directly by the end user/patient, as they are designed to fight a particular bacteria identified by said medical professional.⁴ The services of the earlier mark include scientific research and development at large, but appear more specifically honed for *research and development into live biotherapeutics*. It is these more specified services which the Opponent tends to focus on in its submissions. In its submissions, the Opponent explained that live biotherapeutics (LBPs) "... *are products that contain a live microorganism applied to the prevention, treatment, or cure of human diseases*". The Applicant meanwhile referred to the fact that the earlier mark's services focus on the *development* of live biotherapeutics, and subsequently argued that the Opponent is involved with creating a hypothetical product, rather than an actual current product such as the applied for goods.

28. The witness statement of Mr Day referred to Exhibit JMD 2, which set out to establish the definition of live biotherapeutics. Based on the information before me, it would appear that live biotherapeutic products are primarily centred on, and/or derived from, the microbiome/microbiota of human gut, which is a particularly specific origin for potential therapeutics. The information also indicates that the registration of LBPs as pharmaceutical drugs is "rather rare".⁵ This could be construed to support the Applicant's implication that the development of live biotherapeutics is in its infancy.

29. Without being an expert in the science of live biotherapeutics, and also without having a unanimous or concrete position provided by the parties as to how the contested goods and services do or do not interact, it is left to me to assess the degree of similarity of the goods and services at issue, or otherwise the lack thereof, using the well-established principles of case law in *Canon*, *Treat* and *Kurt Hesse*. In order to do so, I find it logical to evaluate the respective goods and services based on the most literal interpretation of their wording, with the contested goods consisting of *antibiotics* (as a finished article product) and the services of the earlier mark consisting of

⁴ Topical antibiotics can be bought over the counter without prescriptions, although this is small fraction of antibiotic-type goods.

⁵ See *General Conclusion* of extract from eurjmedres.biomedcentral.com.

scientific research and development at large, but with an apparent focus on how microbiome/microbiota can be used to develop therapeutics.

30. In light of this interpretation, it appears to me to be relatively clear that the respective uses, physical nature and trade channels of the goods and services at issue are different. In addition, their nature and method of use are different. Furthermore, the goods and services at issue are not in competition. There may be a degree of overlap as regards the consumer in those infrequent scenarios where the person who prescribes and dispenses the antibiotic was also involved in the research and development of the live biotherapeutic. However, there would not be overlap when the ultimate end-user consumer of the antibiotic is the patient/person ingesting it. It therefore appears to me that the goods and services at issue are dissimilar.

31. In case I am found to be wrong that the goods and services are dissimilar, I am prepared to accept the alternative view that it is possible for the goods and services at issue to be considered by a certain and specific consumer to be complementary, insofar as the research or development of a live biotherapeutic could be assumed to be indispensable or important to, and eventually result in, the end product of an antibiotic.

32. It is unlikely that the ultimate end user consumer/patient of the antibiotic would be aware of the research and development service being provided earlier in the process, and therefore such a consumer would not wonder as to any potential complementarity. The consumer for whom there may be a question of complementarity is the medical and pharmaceutical professional who prescribes and dispenses the antibiotic. This consumer may think that the responsibility for the antibiotic lies with the undertaking conducting the research and development into live biotherapeutics. As there exists a potential scenario whereby the professional consumer believes there is complementarity between the goods and services at issue, it is prudent to continue with my assessment of the opposition case with this particular consumer in mind, but strictly and only this medical and pharmaceutical professional consumer.

Comparison of marks

33. 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 the marks, 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.”

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

35. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
MicroRx	MICURX

36. Despite the Opponent referring to the earlier mark in the different from MICRORX in its submissions, the protection of the registration actually applies to the form of the word as registered, i.e., MicroRx. As discussed in paragraph 15, the use of a mark may change between upper and lower case for the purposes of commercial exploitation, however, the protection of a registration does not extend to a form which

alters its distinctive character. In *Present-Services Ullrich GmbH & Co.KG v. OHIM*, T-66/11, the General Court commented:

“Firstly, it should be noted that, given that the earlier trade mark and the mark applied for are word marks, the fact that the former is represented in capital letters, whereas the latter is represented in lower-case letters, is irrelevant for the purposes of a visual comparison of those marks. According to case-law, a word mark is a mark consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element (Case T-211/03 Faber Chimica v OHIM – Nabersa (Faber) [2005] ECR II-1297, paragraph 33, and judgment of 13 February 2007 in Case T-353/04 Ontex v OHIM – Curon Medical (CURON), not published in the ECR, paragraph 74). The protection offered by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic or stylistic characteristics which that mark might possess (judgment of 22 May 2008 in Case T-254/06 Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom), not published in the ECR, paragraph 43).

37. I interpret this judgment, in conjunction with the findings in *Specsavers International Healthcare Ltd* as cited at paragraph 15 of this decision, to indicate that the protection of a word extends to a version that is either *entirely* uppercase or *entirely* lowercase. I do not interpret the case law to indicate that a registered word can be used in a mixture of both upper and lower cases at random junctures, even for the purposes of commercial exploitation. In my opinion, the same applies vice versa.

38. Whilst it may appear minor, the presence of the uppercase ‘R’ in the earlier mark has a significant impact insofar as it effectively separates the word into Micro + Rx. It seems to me that changing MicroRx to MICRORX would go beyond a simple variation to better adapt to marketing or promotion requirements. Rather, I consider it to be the creation of a new word which differs as to the distinctive character of the earlier mark. The comparison of the marks at issue shall therefore be undertaken on the basis that the earlier mark is MicroRx and the contested mark is MICURX.

39. With the above in mind, the earlier mark consists of the two conjoined elements ‘Micro’ and ‘Rx’. The word ‘Micro’ is an English language word which means extremely

small. The combination of letters 'Rx' has no apparent meaning in the English language, and neither party have offered a meaning. The word 'Micro' is frequently used as a prefix, in which case the earlier mark could be perceived as referring to an extremely small version of 'Rx'. The earlier mark is presented in a standard typeface, with neither element appearing more dominant or distinctive. The overall impression of the mark lies in the perception of the combination 'Micro' plus 'Rx'.

40. The contested mark consists of the combination of letters 'MICURX'. The combination of letters is not an apparent initialism, acronym or abbreviation, and neither party has provided submissions as to any potential meaning. The combination does not have any obvious natural break. The contested mark is presented in a standard typeface, and all letters are of the same size. The overall impression lies in the mark as a whole.

Visual similarity

41. The marks are visually similar insofar as they both start with the combination of letters M-i-c/M-I-C, and end with the combination of letters Rx/RX. The marks differ visually due to the earlier mark containing the middle combination of letters r-o (which serves to create the word 'Micro'), and the contested mark containing the letter U. From a visual perspective, the earlier mark appears to consist of a combination of terms 'Micro' plus 'Rx', whilst the contested mark appears to be a random collection of letters. The Opponent's submission that the marks coincide in five letters is correct. The marks are therefore found to be visually similar to at least a medium degree.

Aural similarity

42. Although the earlier mark is conjoined, I believe the mark will be separated into the word 'Micro' followed by the enunciation of the single letters 'R' and 'x' when it is pronounced. The combination 'Rx' has no obvious sound, and I do not believe it exists as a combination in any word in the English language. As a result, the letters will be pronounced individually. The contested mark is not an English word and it does not appear to contain an obvious natural break between letters, which could have assisted in identifying an established pronunciation for a specific collection of letters in the form of a pre-existing word. Therefore, I find it likely that each letter in the contested mark

will be enunciated individually, i.e., M-I-C-U-R-X. In such an instance, the collection of letters 'R-x/RX' in each mark will be pronounced identically. In the alternative, it is possible, although in my opinion unlikely, that a certain number of consumers may attempt to pronounce the contested mark as one word, and thereby pronounce the combination of letters 'MIC' as in the word 'MIC-ROPHONE', and pronounce the combination 'URX' as the phonetic equivalent 'ERKS'.

43. Both parties have provided submissions as to the number of syllables in each mark. In my opinion, the earlier mark consists of four syllables Mic-ro-R-x, whilst the contested mark consists either of six syllables (if pronouncing each letter separately), or three syllables Mic-erk-s.

44. In either scenario the marks are aurally similar to no more than a low degree.

Conceptual similarity

45. Due to the structure of the earlier mark, it will be perceived as a combination of 'Micro' plus 'Rx'. Based on the word 'Micro' frequently being used as a prefix to indicate something that is very small, the conceptual meaning of the earlier mark is a very small unidentified thing called 'Rx'.

46. The entirety of the letter combination in the contested mark has no conceptual meaning.

47. Due to the fact that the contested mark has no obvious conceptual meaning, there can be no conceptual comparison.

Average consumer and the purchasing act

48. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

49. 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.”

50. In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, EU:T:2021:41, the GC considered the average consumer for and level of attention which would be paid in the selection of pharmaceutical and medical products in class 5. It said:

“39 Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis v OHIM – Sanochemia Pharmazeutika (TOLPOSAN)*, T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma v EUIPO – Ipsen Pharma (COLINEB)*, T-36/17, not published, EU:T:2017:690, paragraph 49).

40 Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued

on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, *TOLPOSAN*, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).

41 ...

42 In the present case, having regard to the nature of the goods concerned, namely medical or pharmaceutical products in Class 5, the Board of Appeal acted correctly in finding in paragraphs 18 to 21 of the contested decision – which, moreover, is not disputed by the applicant – that, in essence, the relevant public was made up of medical professionals and pharmacists and consumers belonging to the general public with a higher than average degree of attentiveness.”.

51. The contested goods are *antibiotics*. I have previously identified that generally speaking antibiotics are prescribed by medical or pharmaceutical professionals. According to *Olimp Laboratories*, medical professionals display a high degree of attentiveness when prescribing medicinal products, which would certainly include antibiotics. The level of attention of the average consumer of the goods at issue is therefore considered to be high. I have previously intended to make clear that due to the specific goods and services at issue in these proceedings, the only relevant consumer is the medical and pharmaceutical professional (see paragraph 32). However, for the sake of completeness at this opportune moment, I shall briefly refer to the other consumer, i.e. the end user/patient. The judgment in *Olimp Laboratories* also established that even a patient is “*less likely to confuse different versions of such goods*” when the medicinal goods are either prescribed by a medical professional or when they are sold without prescription, i.e., when they are bought over-the-counter. It is quite apparent that whether the consumer is the end user/patient or is the medical and pharmaceutical professional, the level of attention in relation to medicinal and pharmaceutical products is higher than it would be for everyday consumer items.

52. As for the services of the earlier mark, which include microbiology and live biotherapeutic research, the relevant consumer is only ever expected to be a

specialist. A specialist in a field has a level of attention that is particularly attuned to the specialist subject, and therefore is considered to have a higher than average degree of attention.

53. The purchase process of the goods at issue is likely to be dominated by the visual aspect. When the consumer is the medical professional, it is essential that they pay a high degree of attention to the product they are prescribing, and so will closely read the terms. Similarly, when the consumer is the patient buying the goods themselves in a pharmacy, they too will pay close attention and read the terms (see *Olimp Laboratories* paragraph 40). I am aware that prescriptions and pharmaceutical preparations are often requested orally in a pharmacy, and so I do not discount the possibility that there may be an aural element to the purchase process. In relation to the services of the earlier mark, I believe the purchase process will also be dominated by the visual aspect as research includes the discovery of information. However, I do not discount the possibility of an aural element due to the undoubted verbal exchange of information.

Distinctive character of the earlier trade mark

54. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. 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).

23. 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).”

55. Although the Opponent claimed to be a market leader in the field of live biotherapeutic products, this has not been substantiated or borne out of the evidence. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

56. In terms of its inherent distinctiveness, the earlier mark has no obvious descriptive or allusive meaning in respect of the goods or services at issue, and is therefore found to possess a medium degree of inherent distinctive character.

Likelihood of Confusion

57. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

58. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The factors include 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 services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the Opponent’s trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

59. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

“50 ...Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

60. The earlier mark consists of the combination MicroRx, whilst the contested mark consists of the apparently random collection of letters MICURX. I have previously acknowledged that based purely on a visual aspect the marks are similar to at least a medium degree. I have also previously identified that the purchasing process of the goods and services at issue will be predominantly visual, and the relevant consumer (both types) will pay a high degree of attention. However, a high degree of attention does not necessarily assist in a finding of a likelihood of confusion. In *Claude Ruiz-Picasso*, C-261/04 P, the CJEU found:

40 ““Where it is established in fact that the objective characteristics of a given product mean that the average consumer purchases it only after a particularly careful examination, it is important in law to take into account that such a fact may reduce the likelihood of confusion between the marks relating to such goods at the crucial moment when the choice between those goods and marks is made”.

61. It is well established in case law that an assessment on any apparent likelihood of confusion is based on a global comparison of the marks at issue, not only on one of their aspects. It is therefore imperative to consider not only the visual degree of similarity, but to also keep firmly in mind both the aural and conceptual degrees of similarity, or lack thereof. With this in mind, I have found the marks at issue to be aurally similar to no more than a low degree. I have also identified that there is no conceptual comparison to be made.

62. It appears to me to be self-evident that the aural differences alone prevent a finding of direct confusion. In addition, the fact that only one of the marks at issue has any concept means that the marks are unlikely to be directly confused. In my opinion, these findings, coupled with the reality that the relevant attentive consumers would notice differences (see *Claude Ruiz-Picasso*), prevents a finding of direct confusion.

63. Having found there to be no likelihood of direct confusion, I shall now consider the possibility of indirect confusion. It should be borne in mind that a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.⁶ Further, there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.⁷

64. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are

⁶ In *Liverpool Gin Distillery Limited v Sazerac Brands LLC [2021] EWCH Civ 2017*, paragraph 13, Arnold LJ approved this “consolation prize statement” as made by James Mellor QC’s (sitting as the Appointed Person) statement in *Cheeky Italian Ltd v Sutaria (O/219/16)* paragraph 16.

⁷ *Ibid*, Arnold LJ’s words at paragraph 13.

very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

65. I feel it is important at this stage to reiterate the finding that the earlier mark is the combination of two elements Micro + Rx, whilst the contested mark is the collection of letters MICURX. From a visual, aural and conceptual standpoint, the earlier mark clearly contains the known English language word ‘Micro’, which is not present in the contested mark. Although the marks share the collection of letters MIC--RX, I do not consider that this could be classified as sharing an element. In my opinion, in order to

share an element the contested mark would also need to contain the word 'Micro', which it does not. The marks at issue do not, therefore, share a common element which is so strikingly distinctive that no-one else but the brand owner would be assumed to use it. Further, the clear differences in the composition of letters in each mark would not, in my opinion, constitute the addition of a non-distinctive element which one would expect to find in a sub-brand. Furthermore, the differences between the marks are not entirely logical or consistent with a brand extension. For example, if the protection of the earlier mark lies in 'Micro' + 'Rx', it would not appear to me logical to do away with the first word 'Micro' when creating a brand extension.

66. I acknowledge that the marks at issue share the first three letters MIC. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of words tend to have more visual and aural impact than the ends. The court stated:

"81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the

attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

67. The marks at issue in the GC judgment were MUNDICOLOR vs MUNDICOR. The GC made clear that the strong visual similarity was due in part to the marks sharing the “same root”. I do not consider the coincidence of the letters Mic/MIC in the earlier and contested marks to constitute a shared ‘root’ to the same degree as ‘MUNDI’ in the respective marks in the *El Corte Inglés* judgment. In addition, I do not consider the coincidence of the letters Mic/MIC to be on a comparable level as a prefix to MUNDI, which the GC considered MUNDI to be.

68. In coming to its conclusion in the *El Corte Inglés* judgment, the GC also paid particular attention to the fact that the marks at issue shared aural characteristics. I have previously established that the marks at issue in the current proceedings are aurally similar to no more than low degree.

69. I refer to *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, in which Mr James Mellor Q.C., as the Appointed Person stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark, as this would be mere association rather than indirect confusion. In my opinion, the fact that the marks at issue share the letters Mic/MIC (which I have previously argued to not even be considered to be an ‘element’) is not enough, in and of itself, to find indirect confusion.

70. In its submissions, the Opponent referred to the fact that the marks at issue each end with the letters Rx/RX. In *Bristol Global Co Ltd v EUIPO*, T-194/14, the GC held that there was a likelihood of confusion between AEROSTONE (slightly stylised) and STONE if both marks were used by different undertakings in relation to identical goods (land vehicles and automobile tyres). This was despite the fact that the beginnings of the marks were different. The common element STONE was, in that instance, sufficient to create the necessary degree of similarity between the marks as wholes for the opposition before the EUIPO to succeed. In relation to the marks in these proceedings, I do not find the same assessment to be directly applicable. The combination of letters Rx/RX in each mark has no obvious concept (unlike STONE),

not only in relation to the respective goods and services but also in general as a term. The concurrence of the two letters 'Rx/RX at the end of each respective mark does not, in my mind, constitute the degree of similarity as the sharing of an actual word with concept would.

71. Having found there to be no direct confusion, there would need to be a “proper basis” for finding there to be a likelihood of indirect confusion.⁸ Having maintained the correct principles of law firmly in mind, I am of the opinion that upon seeing the contested mark the attentive consumer would not carry out the mental process whereby they either consciously or unconsciously assume it to be a logical extension of the earlier mark based purely on the coincidence of certain shared letters, which have no concept, and which have differing impacts on the overall impression of each mark. This is especially so due to the high level of attention paid by the average medical and pharmaceutical consumer, who is acutely more aware of the differences between marks that are closely scrutinised.

72. It should be remembered that the assessment of a likelihood of confusion was only made for the purposes of absolute completeness, and was arguably not necessary at all as the similarity between the respective goods and services at issue was limited to a possible finding of complementarity at best – though in my mind still rather unlikely. Bearing in mind the interdependency principle, and the gulf in similarity between the goods and services at issue, the marks MicroRx and MICURX would have to be extremely similar in order for any chance of a finding of a likelihood of confusion, which I have made clear they are not.

COSTS

73. As the opposition has failed, the Applicant has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the applicant the sum of £1,100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the statement of grounds

⁸ *Liverpool Gin Distillery Limited v Sazerac Brands LLC [2021] EWCH Civ 2017*, paragraph 13,

and preparing a counterstatement £300

Considering the Opponent's evidence,
and preparing submissions in lieu £800

Total £1,100

74. I therefore order 4D Pharma Research Limited to pay MicuRX Pharmaceuticals, Inc. the sum of £1,100. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 6th day of July 2022

Dafydd Collins

For the Registrar