O/0829/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003800392
BY BRILLIANT SONNERGIE GMBH
TO REGISTER THE FOLLOWING TRADE MARK:

Aprotek

IN CLASSES 3, 5 AND 10

AND

AN OPPOSITION THERETO UNDER NUMBER 437930
BY SANOFI

BACKGROUND AND PLEADINGS

1. On 17 June 2022, Brilliant Sonnergie GmbH ("the applicant") applied to register "Aprotek" as a trade mark in the UK ("the contested mark"). The application was accepted and published for opposition purposes on 9 September 2022 and registration is sought for the following goods:

Class 3: *Cosmetics; Perfume; Non-medicated toiletries.*

Class 5: *Pharmaceuticals; Materials for dressings.*

Class 10: *Medical testing instruments.*

2. On 8 December 2022, SANOFI ("the opponent") opposed the application, in respect of its Class 5 goods, based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").[1] Under sections 5(2)(b) and 5(3), the opponent relies upon the following two registered trade marks (collectively, "the earlier marks"):

i. Trade mark number UK00900627612[2] ("the earlier word mark")
Representation: APROVEL
Filing date: 2 September 1997
Registration date: 8 January 1999
Specification relied upon: *Pharmaceutical products for the prevention and for the treatment of hypertension and heart insufficiency, issued only under medical prescription* in Class 5.

[1] The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

[2] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EU trade mark ("EUTM"). As a result of the opponent having an EUTM protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retails its original filing date.

ii. Trade mark number UK00918142354[3] ("the earlier stylised mark")

Representation: 

Filing date: 24 October 2019

Registration date: 22 May 2020

Specification relied upon: *Pharmaceutical preparations for the prevention and treatment of hypertension and heart failure* in Class 5.

3. The marks relied upon by the opponent are considered earlier marks in accordance with section 6(1)(a) of the Act given that they were filed for registration earlier than the date of application for the contested mark.

4. The earlier stylised mark had not been registered for five years at the date of application for the contested mark and so, in accordance with section 6A of the Act, the mark is not subject to proof of use; the opponent may rely upon all the goods identified for this opposition. The earlier word mark, however, is subject to proof of use; the opponent made a statement of use in relation to all the goods relied upon.

5. Under section 5(2)(b), the opponent claims that the earlier marks are highly similar to the contested mark and that the parties' respective goods are highly similar, resulting in a likelihood of confusion, including a likelihood of association.

6. Under section 5(3), the opponent claims that its earlier marks have a reputation in the UK and that use of the contested mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

7. Under section 5(4)(a), the opponent relies upon two unregistered signs, which are identical to the earlier marks relied upon under sections 5(2)(b) and 5(3). I will, hereafter, refer to these signs as the unregistered word mark and the unregistered stylised mark (collectively, "the unregistered marks"). The opponent claims to have used the unregistered word mark throughout the UK since September 1997 in relation

[3] See [2].

to *pharmaceutical products for the prevention and for the treatment of hypertension and heart insufficiency.* The opponent claims to have used the unregistered stylised mark throughout the UK since October 2019 in relation to *pharmaceutical preparations for the prevention and treatment of hypertension and heart failure.* The opponent claims to have generated a substantial goodwill in the unregistered marks for the aforementioned goods and claims that use of the contested mark for its Class 5 goods would constitute a misrepresentation to the public that would damage the opponent's goodwill. Therefore, use of the mark would be contrary to the law of passing off.

8. The applicant filed a defence and counterstatement essentially denying each ground of opposition, save for a concession at paragraph 13 of the counterstatement that the applicant's *pharmaceuticals* are similar to the opponent's goods. The applicant requested proof of use of the earlier word mark and proof of reputation and goodwill in the earlier marks and the unregistered marks, respectively.

9. Only the opponent filed evidence in these proceedings. Neither party requested a hearing and only the opponent filed written submissions in lieu. The opponent is represented by Mishcon de Reya LLP and the applicant by Handsome I.P. Ltd. Given that no hearing took place, this decision is made following a careful consideration of all the papers before me.

EVIDENCE

10. The opponent filed evidence in the form of the witness statement of Caroline Casalonga dated 31 July 2023 and its corresponding 14 exhibits (CC1 – CC14). Ms Casalonga is Managing Partner of Casalonga, a law firm in France. Ms Casalonga explains that she has been the opponent's Trade Mark Attorney since 2011 and that Casalonga instructed Mishcon de Reya to act for the opponent in the UK. Ms Casalonga's witness statement provides information on the history and business of the opponent; it also acts as a vehicle for introducing the exhibits, intending to show: (i) use of the earlier word mark; (ii) reputation in the earlier marks; and (iii) goodwill in the unregistered marks.

11. I have taken the entirety of the evidence into account in reaching this decision and will refer to it below where necessary.

DECISION

Proof of use

12. I will begin by assessing whether there has been genuine use of the earlier word mark. The relevant statutory provisions are as follows:

> "6A (1) This section applies where
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if –
>
> (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13. As the earlier word mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union."

14. Section 100 of the Act is also relevant, which states that:

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

15. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market*

(Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an

outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

16. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier word mark is the five-year period ending with the filing date of the contested application, i.e., 18 June 2017 to 17 June 2022.

17. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the earlier word mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK (or the EU, prior to IP completion day) during the relevant period. In making the assessment, I am required to consider all relevant factors, including:

(i) The scale and frequency of the use shown;
(ii) The nature of the use shown;
(iii) The goods for which use has been shown;
(iv) The nature of those goods and the market(s) for them; and
(v) The geographical extent of the use shown.

Evidence of use

18. The APROVEL mark is said to be used by the opponent exclusively for its prescription-only medicine for the prevention and treatment of hypertension and heart insufficiency.[4] The APROVEL medicine was granted market authorisation by the European Medicines Agency ("EMA") in 1997, which is when it was first marketed in the EU (including the UK).[5] Following the UK's withdrawal from the EU, marketing authorisations issued by the EMA were automatically converted to UK marketing authorisations from 1 January 2021.[6] The opponent company is headquartered in France, but its products are available worldwide;[7] the UK is listed, on the opponent's website, as a territory in which it operates.[8] APROVEL is listed on the opponent's website under 'prescription products' and appears on associated 'summary of product characteristics' documents and patient information leaflets, alongside the opponent's name.[9] Patient information leaflets describe APROVEL tablets as being used to treat high blood pressure and to protect the kidneys in patients with high blood pressure,

[4] See the witness statement of Caroline Casalonga at [1.14].
[5] See the witness statement of Caroline Casalonga at [1.15] and Exhibit CC4.
[6] See the witness statement of Caroline Casalonga at [1.15].
[7] See the witness statement of Caroline Casalonga at [1.12].
[8] Exhibit CC3.
[9] Exhibit CC6 and CC7.

type 2 diabetes, and impaired kidney function.[10] Ms Casalonga gives the following EU and UK sales figures for products sold under the APROVEL mark:[11]

Year	EU Revenue (€)	UK Revenue (€)
2017	115,000,000	Not provided
2018	108,000,000	317,305
2019	113,000,000	236,107
2020	100,000,000	289,422
2021	Not provided	173,899
2022	Not provided	179,044
Total	436,000,000[12]	1,195,777

19. The sales figures are supported by (i) the opponent's financial reports, which list APROVEL products under the heading 'diabetes & cardiovascular'[13] and (ii) invoices listing 'APROVEL tabs' and delivered to pharmacies across the UK between May 2018 and January 2022; the supplier's name on the invoices is listed as "Aventis Pharma trading as Sanofi [the opponent]".[14] Ms Casalonga's witness statement[15] and Exhibit CC10 explain that Aventis Pharma Limited is part of the Sanofi group of companies.

20. There are no figures on marketing spend and very few examples of advertising. However, as explained by Ms Casalonga, the advertising of prescription-only medicines to the general public is prohibited in the UK; advertisements for such medicines are acceptable only on websites whose nature and content are directed solely at healthcare professionals.[16] Examples of APROVEL medicines detailed on websites directed at healthcare professionals are provided at Exhibit CC13.

[10] Exhibit CC7, pages 3-4.
[11] See the witness statement of Caroline Casalonga at [1.20] and [1.22].
[12] Not provided, but calculated myself.
[13] Exhibit CC8.
[14] Exhibit CC9.
[15] At [1.23.2].
[16] Corroborated by guidance on 'Advertising and Promotion of Medicines in the UK' by the Medicines & Healthcare products Regulatory Agency, dated November 2020, at Exhibit CC12.

21. There are examples of media coverage of the opponent and its APROVEL medicines.[17] One example is an article from 'The Pharma Letter' dated 5 February 1998, which details the launch of APROVEL in France and confirms its availability in other European countries and the USA.[18] The remaining four examples are dated August 2021 and relate to the recall of batches of medicine, including APROVEL.[19]

Assessment

22. It is clear from the evidence that the opponent has used its earlier word mark in the EU and across the UK throughout the relevant period. Whilst the UK revenue is significantly lower than that of the EU, the EU is the relevant territory for a significant part of the relevant period and, in any case, there remains evidence of use and sales in the UK after IP completion day. The evidence demonstrates that the medicines sold under the APROVEL mark are used for cardiovascular conditions and, in particular, hypertension (also known as high blood pressure). Consequently, the goods for which the mark is registered adequately accord with the use shown.

23. I am satisfied that there has been genuine use of the earlier word mark for the goods relied upon:

Class 5 *Pharmaceutical products for the prevention and for the treatment of hypertension and heart insufficiency, issued only under medical prescription.*

Section 5(2)(b)

24. Section 5(2)(b) of the Act is as follows:

> "5. […]
>
> (2) A trade mark shall not be registered if because –

[17] Exhibit CC14.
[18] Exhibit CC14, pages 1-2.
[19] Exhibit CC14, pages 3-13.

(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."

Relevant law

25. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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.

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 marks

26. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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."

27. 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 trade 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.

28. The trade marks to be compared are as follows:

The earlier marks	**The contested mark**
(i) APROVEL (ii) APROVEL	Aprotek

29. The earlier word mark comprises a single component, in which the overall impression solely resides. The earlier stylised mark comprises the word APROVEL, in which the letter 'V' is represented by a tick device, and a slightly curved line above the textual element. The text is written in upper case letters, in blue, save for the letter

'V'/tick device, which is presented in pink, as is the curved line. The dominant and distinctive element of the mark is the word APROVEL, encompassing the tick device. The pink, curved line is merely decorative. The contested mark comprises a single component, in which the overall impression solely resides.

30. I will compare the contested mark to each of the earlier marks, separately.

(i) APROVEL

31. Visually, the marks coincide in the letters 'APRO-E-', which constitute five of the marks' seven letters. The fifth and seventh letters differ: 'V' and 'L' in the earlier mark and 'T' and 'K' in the contested mark: the differing letters are not visually similar. Overall, I find the marks to be visually highly similar.

32. The contested mark will be pronounced as 'APP-ROH-TEK' with emphasis given to the first syllable. The earlier mark will be pronounced in one of two ways: 'APP-ROH-VEL' with emphasis given to the first syllable, or 'APP-ROO-VUHL' with emphasis given to the second syllable, similarly to the ordinary dictionary word 'approval' – I say this because of the earlier mark's high visual similarity with the ordinary dictionary word 'approval' and because of the average consumer's tendency to break marks down into verbal elements which resemble familiar words.[20] In circumstances where the average consumer pronounces the earlier mark as 'APP-ROH-VEL' the marks are aurally similar to between a medium and high degree. Where consumers pronounce the earlier mark as 'APP-ROO-VUHL' the marks are aurally similar to between a low and medium degree.

33. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court ("GC") and the CJEU including *Ruiz Picasso v OHIM*.[21] The assessment must be made from the point of view of the average consumer.

[20] *Usinor SA v OHIM* Case T-189/05 at [62].
[21] [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

34. Where consumers see the earlier mark as a misspelling of the ordinary dictionary word ‘approval’, the concept associated with the mark will be the definition of that ordinary word, i.e., a noun referring to a statement that something is acceptable. Where consumers see the earlier mark as an invented word, it offers no immediate concept. For the contested mark, whilst consumers may see the letters ‘TEK’ as a misspelling of ‘tech’ – a common abbreviation for ‘technology’ – when absorbed in the mark as a whole, I am not satisfied that such a concept will be immediately grasped. The marks are either conceptually not similar (where consumers see the earlier mark as ‘approval’) or conceptually neutral (where consumers see both marks as invented words with no clear concept).

(ii) 

35. Visually, the marks coincide in the letters ‘APRO-E-’, which constitute five of the marks’ seven letters. The fifth and seventh letters differ: ‘V’ (represented as a tick device) and ‘L’ in the earlier mark and ‘T’ and ‘K’ in the contested mark: the differing letters/device are not visually similar. The curved line and the font colour also differentiate the marks. Overall, I find the marks to be visually similar to a medium degree.

36. The aural and conceptual comparisons of the contested mark and the earlier word mark, as discussed at paragraphs 32 and 34, apply equally to the earlier stylised mark. However, given that the tick device in the earlier stylised mark reinforces the concept of the word ‘approval’, the possibility of consumers grasping that concept and pronouncing the mark as the word ‘approval’ is more likely, though this does not materially affect my findings.

37. Having compared the contested mark with the two earlier marks, it is my view that the earlier word mark is the opponent’s best case for a finding of a likelihood of confusion. This is on the basis that it is visually more similar to the contested mark than the earlier stylised mark, but is equally aurally and conceptually similar. Further, the specifications for the earlier marks are almost identical and so the earlier stylised mark would have no advantage in this respect over the earlier word mark. I will proceed

with my decision under section 5(2)(b) on the basis of the earlier word mark, APROVEL. If there is no likelihood of confusion with this mark, the earlier stylised mark does not improve the opponent's case. As will become apparent, the distinctive character of the earlier marks does not affect this approach.

Distinctive character of the earlier mark

38. In *Lloyd Schuhfabrik Meyer* 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 *WindsurfingChiemsee 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)."

39. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

40. I will begin by addressing the inherent distinctiveness of the earlier word mark. Whether consumers see APROVEL as an invented word or a misspelling of the word 'approval', it is not an English dictionary word and, as a result, is afforded a high degree of inherent distinctive character: it neither describes, nor alludes to, the goods for which it is registered.

41. Turning now to consider whether the distinctiveness of the earlier word mark has been enhanced through use, I refer to the opponent's evidence of use, summarised earlier in this decision. For this assessment it is the perception of the relevant public in the UK that is important. Whilst the evidence satisfies me that the earlier word mark has been put to genuine use, there are deficiencies in the evidence that render a finding of an enhanced distinctive character more difficult. The opponent has provided no evidence of the market share it holds in the UK for its APROVEL goods. I have no evidence of the size of the relevant market in the UK but, to my mind, it would not be unreasonable to estimate the pharmaceutical industry's worth to be in the region of billions of pounds every year. The opponent's annual UK revenue between 2018 and 2022 ranges from 173,899 to 317,305 euros, which is far from significant given the relevant industry. The evidence shows that use of the mark has been geographically widespread, but it does not show what I would describe as use that has been especially extensive or longstanding. There is no evidence of the amount spent on marketing, though I accept there are restrictions in this regard for the relevant goods. In terms of media coverage, aside from a 1998 article referring to the APROVEL launch, the only reporting of the APROVEL goods that is shown in evidence relates to one incident in August 2021: the recall of its goods due to health concerns. Taking the evidence as a whole, I am not satisfied that the earlier word mark has an enhanced distinctive character as a result of the use that has been made of it.

42. For the avoidance of doubt, the earlier stylised mark does not put the opponent in a better position: it has the same high degree of inherent distinctive character as the earlier word mark, which has not been enhanced through use.

Comparison of goods

43. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

> "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."

44. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281 for assessing similarity between goods/services also include an assessment of the users and channels of trade of the respective goods/services.

45. Further, in *Kurt Hesse v OHIM*,[22] the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,[23] the GC stated that "complementary" means:

> "…there is 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."

46. In *Gérard Meric v OHIM,* the GC confirmed that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):[24]

[22] Case C-50/15 P.
[23] Case T-325/06.
[24] Case T-133/05.

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur 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."

47. The competing goods are shown in the table below:

The opponent's goods (under the earlier word mark)	**The applicant's contested goods**
Class 5: *Pharmaceutical products for the prevention and for the treatment of hypertension and heart insufficiency, issued only under medical prescription.*	Class 5: *Pharmaceuticals; Materials for dressings.*

Pharmaceuticals

48. Regardless of the applicant's concession that there is similarity between its *pharmaceuticals* and the opponent's goods, it is necessary to establish the degree of similarity, as it is directly relevant to the likelihood of confusion. The applicant's term *pharmaceuticals* is broad. Whilst the opponent's pharmaceuticals products have a specific purpose, i.e., they are for specific health concerns, they are, at large, pharmaceuticals. As such, the opponent's goods are included in the applicant's more general category of pharmaceuticals. In accordance with *Meric*, these goods are identical.

Materials for dressings

49. The opponent submits that material dressings are similar to its pharmaceutical products on the basis that they are both pharmaceutical preparations designed to treat health problems and are used by, or under the supervision of, a professional, and that

this reasoning would apply in respect of the applicant's *materials for dressings*.[25] The opponent attests to these goods having the same nature (pharmaceutical products), purpose (treatment of human health problems), consumers (professionals and patients) and distribution channels (pharmacies and hospitals) and suggests they are identical or highly similar.[26]

50. The idea that materials for dressings and prescription pharmaceutical products for the prevention and treatment of hypertension and heart insufficiency could be identical, or even highly similar, is illogical. They have entirely different physical natures and core purposes. As the opponent pointed out in its submissions,[27] dressings are used for wounds whereas its pharmaceutical products are used for the treatment of specific health problems, i.e., those listed in the specification. The mere fact that these goods might be found in hospitals and pharmacies (which offer a wide range of goods in the pharmaceutical field) and that they would be used by the general public as well as professionals treating a vast range of health concerns, is not a convincing basis for a finding of similarity. Other than an overlap in trade channels and users at a very general level, there are no similarities between these goods, and they are neither complementary nor in competition with one another. I bear in mind the comments of Mr Iain Purvis KC, sitting as a deputy High Court judge in *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)*.[28] He reiterated that the overall purpose of considering similarity between goods is to identify similarities which might be relevant to the likelihood of confusion, and that the greater the level of generality at which some similarity can be found the less relevant it could be. That is the case here; any similarity is at such a general level that I do not consider it could be relevant to the likelihood of confusion. I find no similarity between these goods.

51. In accordance with *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, if there is no similarity between goods, there is no likelihood of confusion to be considered. Consequently, the opposition has failed in relation to the following goods, which may proceed to registration:

[25] See the opponent's written submissions in lieu, dated 5 January 2024 at [2.22] and [2.23].
[26] See the opponent's written submissions in lieu, dated 5 January 2024 at [2.23].
[27] See the opponent's written submissions in lieu, dated 5 January 2024 at [2.23].
[28] [2024] EWHC 1098 (Ch).

Class 5: *Materials for dressings.*

The average consumer and the purchasing act

52. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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. (as he then was) 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

53. The relevant goods are those for which I have found similarity. Whilst the average consumer of pharmaceuticals at large is either a member of the general public or a medical professional, the consumer of the opponent's goods – being prescription-only pharmaceuticals – is the medical professional (though the end users will include members of the general public). The relevant group of consumers for considering the likelihood of confusion is the group who is common to both parties' goods and so I will consider the position from the perspective of the medical professional. The perspective of the general public is not relevant here since they are not the average consumer of the opponent's goods, relied upon for this opposition. The opponent suggests that it is "the group with the lower level of attention, namely general end consumers" who must be taken into account in the assessment of the likelihood of confusion, but does not expand on this argument or clarify what degree of attention is paid.[29] Since the goods

[29] See the opponent's written submissions in lieu, dated 5 January 2024 at [2.28].

are medicinal in nature, the average consumer will pay a high degree of attention because of the impact that the goods may have on the health of the end user; the suitability of the pharmaceuticals and their ingredients will be carefully considered. Whilst *pharmaceuticals* encompass a vast range of medicines, there is nothing before me to suggest that goods of this nature would attract a lower level of attention. I consider that a high degree of attention will be paid during the purchasing process.

54. Pharmaceutical goods are purchased in several ways. Medical professionals, being the average consumer, will select the goods by perusing specialist websites or catalogues, or by making orders by telephone. They will also discuss the goods with pharmaceutical representatives. Therefore, visual and aural considerations will be relevant during the purchasing process.

Likelihood of confusion

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while 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 down to the responsible undertakings being the same or related. 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. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, 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 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.

56. I have found the earlier word mark and the contested mark to be visually highly similar. I have found those marks to be aurally similar to either a low to medium degree,

or a medium to high degree, depending on the consumer's pronunciation of the earlier word mark. Depending on the consumer's impression of the earlier word mark, I have found the marks to either have no conceptual similarity or to be conceptually neutral. I have found the earlier word mark to have a high degree of inherent distinctive character. I have found the goods to be identical. I have identified the average consumer to be a medical professional who, paying a high degree of attention, will select the goods visually and orally.

57. The opponent has drawn my attention to several decisions of other courts, including the Court of Appeal, to support a finding of a likelihood of confusion. I have considered those decisions; however, assessing the likelihood of confusion is multifactorial and must take account of all the circumstances relevant to the individual case. Where the facts in the cases referenced by the opponent differ to the facts in the case before me, the findings simply cannot be applied equally.

58. The opponent attests to a likelihood of both direct and indirect confusion. The difference between the two was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc:*[30]

> "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 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 recognised 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'.

[30] BL O/375/10.

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)."

59. The marks share the first four of their seven letters, as well as having their sixth letter in common. For me to be satisfied that there is a likelihood of direct confusion requires me to find that the average consumer will misremember the letter 'V' for the letter 'T' and/or the letter 'L' for the letter 'K', or vice versa. In coming to my decision, I have given thought to the opponent's submission that consumers pay greater attention to the beginning of marks.[31] However, that is a general rule of thumb and not always applicable. In the case before me, the endings of the marks are quite visually and aurally different – 'VEL' versus 'TEK'. Despite the goods being identical, and even accounting for the interdependency principle, when considering that the average consumer selects such goods with a high degree of attention, to my mind, the endings of the marks will not be misremembered or recalled as one another. Whilst the marks

[31] See the opponent's written submissions in lieu, dated 5 January 2024 at [2.8]. See the opponent's cited case: Case T-133/05 (*Gerard Meric v OHIM (PAM-PIM's BABY-PROP)).* See also *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

share their first four letters and, as a result, their first syllable, the marks are not so significant in length that the two differing letters will become invisible to the average consumer. Taking everything into consideration, I do not find there to be a likelihood of direct confusion.

60. I turn now to indirect confusion. The examples given by Mr Purvis in *L.A. Sugar* are not exhaustive. Rather, they were intended to be illustrative of the general approach.[32]

61. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC, sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] 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". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

62. Despite the opponent's submission that the consumer may believe the marks come from the same undertaking as a result of the shared 'APRO' element,[33] I cannot see any logic in this argument. Whilst the earlier word mark has a high degree of inherent distinctive character, that lies in the mark as a whole. The 'APRO' element within the mark is not so distinctive that consumers would assume that the use of those four letters in any trade mark indicates only one undertaking, or related undertakings. Further, the letters 'VEL' in the earlier mark and 'TEK' in the contested mark are not non-distinctive additions; the replacement of one with the other is not consistent with a brand extension, rebranding or a sub-brand, for example. I do not envisage a scenario, either falling into one of the categories suggested by Mr Purvis, or otherwise, whereby consumers, who will notice the marks are not the same, assume the undertakings responsible for each mark are the same or related. There is no likelihood of indirect confusion.

[32] See *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17 at paragraphs [81] to [82].
[33] See the opponent's written submissions in lieu, dated 5 January 2024 at [2.33].

Outcome

63. There is no likelihood of confusion. The opposition under section 5(2)(b) has failed.

Section 5(3)

64. Section 5(3) states:

> "(3) A trade mark which-
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

65. Section 5(3A) of the Act states:

> "Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

66. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oréal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

> (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors*, paragraph 26*.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63*.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42*.*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68*;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79*.*

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel,* paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oréal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure).*

Reputation

67. In *General Motors,* Case C-375/97, the CJEU held that:

"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

68. As discussed at paragraph 37, above, I found the earlier word mark to represent the opponent's best case under section 5(2)(b). For the same reasons, I consider this also to apply to the section 5(3) ground of opposition and so I will proceed on the same basis.

69. I recall that whilst I made a finding of genuine use,[34] I considered the evidence insufficient to establish that the distinctive character of the earlier word mark has been enhanced through use.[35] The factors that were relevant in that assessment are also the ones that I must consider when deciding whether the mark has a reputation and so the criticisms of the opponent's evidence apply equally here. As a reminder, there is no evidence of the opponent's market share, no evidence of the amount spent on marketing (though this is explained in the witness statement), and minimal instances of media coverage, most of which portray the opponent's goods in a negative light given they were recalled due to health concerns. The opponent's annual UK revenue for the relevant goods is also far from significant when considering the size of the

[34] See paragraphs 22 and 23 of this decision.
[35] See paragraph 41 of this decision.

pharmaceutical industry. The evidence is not sufficient for me to make a finding of reputation for either the earlier word mark or the earlier stylised mark.

70. The section 5(3) ground of opposition is dismissed.

Section 5(4)(a)

71. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> >
> > (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

72. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

Relevant law

73. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy High Court judge, conveniently summarised the essential requirements of the law of passing off as follows:

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.
>
> 56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

Relevant date

74. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (as he then was), as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

> "43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:
>
> > 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether

the position would have been any different at the later date when the application was made.'"

75. The applicant has not filed evidence of use of its mark. Consequently, the relevant date for this opposition is the date of the contested application, i.e., 17 June 2022.

Goodwill

76. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

77. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd.'s Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

78. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

79. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

"62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small.

That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

80. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (as he then was), as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

".. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

81. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

"The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi's witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of "reCUP" ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca's Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

82. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal held that the defendant had passed off its LUMOS nail care

products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, *"very limited",* the claimant's goodwill was found to be sufficient to entitle it to restrain the defendant's trade under LUMOS.

83. The case law above makes it clear that goodwill must be more than trivial in extent, but that a business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill may be small.

84. The particulars of the opponent's claim under section 5(4)(a) are detailed at paragraph 7, above. Bearing in mind my summary and assessment of the evidence earlier in this decision, there are clear deficiencies. However, what is deficient does not exclude the opponent from having a protectable goodwill in relation to the custom that it has shown to have generated. There are clear sales of the goods across the UK for four years leading up to the relevant date, along with a total UK revenue of almost 1.2 million euros for the same period. To my mind, this does not point to a trivial, but a protectable goodwill, albeit a modest one.

Misrepresentation

85. The relevant test was set out by Morritt LJ in In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC at [473]:

> "There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is:

> ‘Is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product].’
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

86. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely, in the light of the Court of Appeal’s decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here. Similar to my finding of no likelihood of confusion, even accounting for the opponent’s modest goodwill, I am not satisfied that what is similar between the marks – the letters ‘APRO’ – is sufficient for a substantial number of members of the public to be deceived. There is no misrepresentation in relation to either the identical goods, or the goods I found to be dissimilar under section 5(2)(b).

87. The section 5(4)(a) ground has failed.

OUTCOME

88. The opposition has failed in its entirety and the application may proceed to registration.

COSTS

89. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I award the applicant the sum of £600, calculated as follows:

Preparing a statement and considering the other side's statement	£350
Considering the other side's evidence	£250[36]
Total	**£600**

90. I therefore order SANOFI to pay Brilliant Sonnergie GmbH the sum of £600. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 28th day of August 2024

MRS E FISHER
For the Registrar

[36] This is below the scale minima due to the applicant not preparing its own evidence but only considering, and not commenting on, the opponent's evidence.