

**O/0845/24**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3825125**

**BY ORIN SLOVAKIA**

**AND**

**OPPOSITION No. 438105**

**BY ORION CORPORATION**

## BACKGROUND AND PLEADINGS

1. This is an opposition by the Orion Corporation of Finland (“the opponent”) to an application filed on 31<sup>st</sup> August 2022 (“the relevant date”) by ORIN Slovakia (“the applicant”) to register the trade mark shown below:




2. The application covers a wide range of preparations and articles in class 5 for medical and health purposes. Some of the goods are relatively low cost widely available products, such as *skin care oils [medicated]* and *vitamin and mineral preparations*. However, the specification also includes specialist medical products unlikely to be available for the general public, such as *live organs and tissues for surgical purpose*, or only available to the public from a medical professional, such as *oral vaccine preparations*. The class 5 specification also includes descriptions that are so general as to potentially cover relatively low cost, widely available products, as well as more specialised goods, e.g. *bacterial preparations for medical and veterinary use* and *medical preparations*. The full list of class 5 goods is shown at Annex A.

3. The application also covers the following goods in class 10:

Physical therapy equipment; Medical and veterinary apparatus and instruments; Mobility aids; Medical furniture and bedding, equipment for moving patients; Hearing protection devices.

4. The opponent is the proprietor of the earlier trade marks shown below:

Trade Mark	Goods relied on
No.911546215  ORION	Class 5: Chemical preparations for medical use; pharmaceutical, veterinary and sanitary products; diagnostic preparations for medical use.

	Class 10: Medical apparatus and instruments, particularly electronic apparatus for medical diagnosis, medical apparatus and instruments for testing bodily fluids.
No. 903763653  	Class 5: Pharmaceutical and veterinary preparations, diagnostic preparations for medical purposes.

5. The opponent's grounds of opposition are that:

- (i) The earlier trade marks are similar to the contested trade mark and cover identical or similar goods;
- (ii) The earlier trade marks have a reputation in the UK in relation to the goods relied on for the purposes of this opposition, and have acquired an enhanced degree of distinctiveness through extensive use;
- (iii) Use of the contested mark would create a likelihood of confusion amongst the public, including the likelihood of association;
- (iv) Use of the contested mark would also take unfair advantage of, and/or be detrimental to, the reputation and distinctive character of the earlier marks;
- (v) Registration of the contested mark would be contrary to sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act").

6. The applicant filed a counterstatement denying the opponent's claims. I note the applicant:

- required the opponent to provide proof of use of its earlier trade marks;
- accepted that the goods at issue are identical or similar;

- accepted that the contested mark is visually similar to the earlier marks to a medium degree;
- accepted that the contested mark is aurally similar to the earlier marks to a low-to-medium degree;
- relied on the conceptual identity of ORION, and the absence of any conceptual meaning of ORIN, as a factor that will help to prevent the public from confusing the marks, or making a link between them.

7. Both sides seek an award of costs.

## **REPRESENTATION**

8. The applicant is represented by Christopher Robertson of Robertson IP. The opponent is represented by Bristows LLP. Neither party requested a hearing. Consequently, this decision is based on the written evidence, the opponent's written submissions and, of course, the law.

## **EVIDENCE**

9. Only the opponent filed evidence. This consists of two witness statements (with 14 exhibits) by Ian Wariner of Orion Pharma (UK) Limited, which is the opponent's UK subsidiary.

10. The main purpose of Mr Wariner's statements is to provide evidence of use of the earlier trade marks by his company, with the opponent's consent, in relation to various human pharmaceutical products, and to show how the earlier marks are used in relation to those goods. He also provides information about the use of the earlier marks by a division of the opponent itself, called Orion Pharma Animal Health, in relation to pharmaceutical veterinary products.

## **STATUS OF EU CASE LAW**

11. 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 includes references to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **PROOF OF USE**

12. The earlier marks were registered in 2013 (the '215 mark) and 2005 (the '653 mark). Consequently, reliance on the marks for the purposes of these opposition proceedings is subject to section 6A of the Act, which is as follows:

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

*(1) This section applies where—*

*(a) an application for registration of a trade mark has been published,*

*(b) there is an earlier trade mark 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 trademark 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.”*

13. Section 100 of the Act is also relevant. It states:

*“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.”*

14. The relevant five-year period in these proceedings is 1<sup>st</sup> September 2017 to 31<sup>st</sup> August 2022.

15. As the earlier trade marks are ‘comparable’ marks cloned from EU-wide registrations when the UK left the EU, use of the marks anywhere in the EU prior to 31<sup>st</sup> December 2020 counts as use of the marks in the UK.<sup>1</sup>

16. In *easyGroup Ltd v Nuclei Ltd & Ors*,<sup>2</sup> Arnold LJ summarised the law relating to genuine use 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.

(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.

---

<sup>1</sup> Paragraph 7(3) of Schedule 1A of the Act

<sup>2</sup> [2023] EWCA Civ 1247

(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. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality.

(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. Internal use by the proprietor does not suffice. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter.

(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.

(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.

(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.

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

17. Mr Wariner's evidence is that Orion Pharma (UK) Limited opened in the UK in 1996. It supplies the opponent's (human pharmaceutical) products to the UK market. The earlier marks have been used in the UK since at least 1997. Orion is the opponent's house mark and, he says, it is used on all its products. According to Mr Wariner, the opponent's products are:

*“Medicines, pharmaceuticals and self-care products; active pharmaceutical ingredients; medical apparatus; and veterinary medicines and animal well-being products.”*

18. Mr Wariner's evidence is that during the period April 2017 to April 2022, his company supplied pharmaceutical products in the UK under various product marks. The main therapy areas for these products were pain management, cancer diseases, respiratory diseases, neurological diseases and women's health. Orion is shown as the manufacturer of these products, including on the accompanying Patient Information Leaflets. Mr Wariner exhibits the packaging of some of his company's goods sold under the product names Salevo, Sandrena, Tridestra and Indivina. This shows the earlier '653 ORION logo mark appears prominently on the front of the packaging of the products.<sup>3</sup> He continues:

*“Even where the Marks do not feature on the front of the packaging, such as for the EASYHALER products, customers (being in particular distributors, pharmacies and pharmaceutical wholesalers) will be aware that EASYHALER products are Orion's products, not least because the Word Mark and/or Logo Mark will appear elsewhere on the packaging, on the [summary of product characteristics] and/or on the [patient Information Leaflet]. Nearly 1.5 million*

---

<sup>3</sup> See exhibit IW-5

*units of EASYHALER inhalers were put on the UK market in 2022. Indeed, healthcare professionals, patients and customers looking for medical information about the product or wanting to contact the maker of EASYHALER (or any medicine put on the market in the UK by Orion) will find contact details for Orion Pharma UK Limited on the back or side panels of the packaging, patient information leaflet and [summary of product characteristics].”*

19. Exhibit IW-6 to Mr Wariner’s statement consists of a breakdown of UK sales of each of the opponent’s products for the period of 2017 to the end of April 2022. The opponent requested an order denying the public access to this exhibit. Given the different ways in which the opponent’s earlier marks are applied to the various products, I was concerned that such an order might make it difficult for the decision maker to give publicly accessible reasons as to why the opponent’s case that the earlier marks had (1) been put to genuine use, and (2) had acquired enhanced distinctiveness and a reputation through use, had been accepted or rejected. I therefore directed that the contents of IW-6 be kept confidential from the public on condition that:

*“The opponent provide a publicly open written document setting what proportion of the total sales set out in exhibit 6 relate to prominent use of the earlier mark on the packaging of the goods (as per exhibit 5) and what proportion relate to the use of the mark in smaller font (only) as the name of the manufacturer.”*

20. Mr Wariner provided a second witness statement in which he stated:

*“I have been asked to provide this witness statement to explain what proportion of the total sales set out in [Confidential] Exhibit IW-6 to my First Statement relate to prominent use of the earlier marks on the packaging of the goods (as per Exhibit IW-5 of my First Statement) and what proportion relate to the use of the earlier mark in smaller font (only) as the name of the manufacturer.*

*The Logo Mark has appeared prominently on the packaging for all products listed in [Confidential] Exhibit IW-6 to my First Statement throughout the period of 2017 to April 2022, with the sole exception of NUBEQA. That is because Orion is the manufacturer of NUBEQA, but is not the [Marketing Authorisation]*

*holder, and so is listed as the manufacturer for NUBEQA but this appears in smaller font.”*

21. On the basis of the volume of sales of the various products listed in IW-6, Mr Wariner gave evidence that *“the proportion of total sales relating to goods whose packaging prominently used the Logo Mark [i.e. the earlier ‘653 mark] is 99.41% (being all sales except for NUBEQA), representing £95,852,000 in sales out of a total of £96,420,000.”*

22. Given that Mr Wariner has given evidence that the earlier marks do not appear on the front of the packaging of its EASYHALER products (its biggest selling product range), I take Mr Wariner’s clarificatory evidence to mean the ‘653 mark appears in ways he considers to be ‘prominent’ *“elsewhere on the packaging”* of these products. The only evidence showing the ‘653 mark appearing prominently on the front of the packaging of specific products marketed by Mr Wariner’s company relates to the Salevo, Sandrena, Tridestra and Indivina products.

23. I consider Mr Wariner’s evidence sufficient to establish that the ‘653 mark was put to genuine use during the relevant period in relation to pharmaceutical preparations for human use. As well as the use of the mark on the packaging of pharmaceutical products and accompanying patient information leaflets, the ‘653 mark also appears on invoices to UK customers.<sup>4</sup> The ‘653 mark includes the word ORION. Use of a registered trade mark as part of another mark counts as use of the registered mark, if when used in that way the mark continues to be perceived as indicative of the trade origin of the products at issue.<sup>5</sup> I am satisfied that use of the word ORION as part of the ‘653 logo mark counts as use of the ‘215 word mark too. The opponent can also rely on the use of the word ORION, as such, on patient information leaflets etc. I am, therefore, satisfied that the ‘215 mark was also put to genuine use during the relevant period in relation to pharmaceutical preparations for human use.

---

<sup>4</sup> See exhibit IW-13

<sup>5</sup> See *Colloseum Holdings AG v Levi Strauss & Co.*, CJEU, Case C-12/12

24. Mr Wariner gives evidence that:

*“Orion Pharma Animal Health is a division of [the opponent], generating 7% of its net global sales. It operates in the field of veterinary medicines and health care. [The opponent] operates through partners in the UK market to offer veterinary products to UK consumers by reference to the Marks.”*

25. Mr Wariner provides evidence showing that the opponent holds the marketing authorisations necessary to market veterinary pharmaceuticals in the UK under ten different product marks.<sup>6</sup> He goes on to explain how the earlier marks are also applied to the packaging of these products and the accompanying summary of product characteristics.

26. Exhibit IW-11 consists of screenshots from the websites of VioVet, Hyperdrug and VetUK, who are retailers of veterinary medicines. These screenshots appear to have been downloaded around the time of Mr Wariner’s first statement dated 23<sup>rd</sup> May 2023. They show a selection of the ten products for which the opponent holds UK marketing authorisations. All but one of the selection (Antisedan) shows the ‘653 mark on the packaging of the products.

27. Mr Wariner explains that:

*“I do not have a breakdown of the UK sales of Orion’s veterinary products available to me, but I can confirm that each of the veterinary products listed below have held UK MA’s at times after April 2017 and prior to April 2022.”*

28. This statement indicates to me that Orion Pharma (UK) Limited (i.e. Mr Wariner’s company) does not market veterinary products on the opponent’s behalf. Rather, such products were, at the time of Mr Wariner’s first statement, marketed in the UK by the ‘partners’ to which he earlier refers. This is borne out by the historical screenshots from the website of Mr Wariner’s company (orionpharma.co.uk) and copy invoices to UK customers, none of which mention veterinary products.<sup>7</sup>

---

<sup>6</sup> See exhibit IW-9, which is a list of Marketing Authorisations for veterinary products “currently” held by the Orion Corporation. which was downloaded from the website the UK’s Veterinary Medicines Directorate on 19<sup>th</sup> May 2023.

<sup>7</sup> See exhibits IW-2 and IW-13

29. Holding marketing authorisations does not establish actual use of the trade marks for the purposes of creating or maintaining a market under the marks during the relevant period. Showing retailers marketing some of the products in the UK, but well after the end of the relevant period, does not do so either.

30. I note that the opponent has a dotcom website. Mr Wariner provides historical screenshots from this website showing how it looked during the relevant period. I note that a webpage from early 2022 includes a title proclaiming that “*Demand for veterinary medicines is growing - Orion also builds well-being for animals.*” However, the website provides no information about any of the opponent’s specific veterinary products. This is because the main focus of the website is on the opponent’s corporate profile. Consequently, apart from the content being in English, there is nothing to suggest that it was targeted at the UK or EU consumers of veterinary products. I find the opponent has not discharged the burden of showing that it used the earlier marks in relation to veterinary products in the UK (or the EU) during the relevant period.

31. The ‘215 mark is also registered in relation to:

Class 5: Chemical preparations for medical use; sanitary products; diagnostic preparations for medical use.

Class 10: Medical apparatus and instruments, particularly electronic apparatus for medical diagnosis, medical apparatus and instruments for testing bodily fluids.

32. The ‘653 mark is also registered in relation to:

Class 5: Diagnostic preparations for medical purposes.

33. Except, possibly, for *chemical preparations for medical use*, there is no evidence of use of the earlier marks in relation to any of these products, Mr Wariner gives evidence that:

*“Levosimendan is the active ingredient of Orion’s medicine SIMDAX, that is used for chronic heart failure. Orion does not have a UK MA for SIMDAX, so it*

*is only sold in the UK as an unlicensed drug where it is requested for compassionate use.”*

34. Levosimendan could be a *chemical preparations for medical use*. However, none of the invoices provided by Mr Wariner show sales of Levosimendan, or Simdax for that matter. Similarly, the figures for annual sales volumes provided in exhibit IW-7 do not include either product. By contrast, exhibit IW-6 records a small-but-not-trivial income from annual UK sales of Levosimendan during the relevant period. There is no evidence as to how the earlier marks were used in relation to Levosimendan, being an ingredient in the unlicensed drug Simdax. Consequently, I find the opponent has not discharged the burden of showing that it made genuine use of the earlier marks in relation to Levosimendan in the UK (or the EU) during the relevant period. The net effect of these findings is that the opponent can rely on the earlier marks in relation to *pharmaceutical preparations for human use* in class 5, but not otherwise.

## **THE SECTION 5(2) GROUNDS**

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

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

*(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.*

### **Comparison of goods**

36. The opponent’s notice of opposition stated that the opponent was relying on all the goods for which the earlier marks are registered. This included goods in class 1 and an additional description of goods in class 5 (as compared to the list shown at paragraph 4 above). In its counterstatement, the applicant accepted that the goods/services covered by the application are identical or similar to those covered by the earlier marks. At the same time, it requested proof of use of the earlier marks in relation to all the goods for which they are registered. The opponent’s subsequent written submissions relied on the applicant’s concession about the identity/similarity of

the respective goods. At the same time the opponent modified the basis of the opposition by relinquishing reliance on the goods in class 1, and on the additional product in class 5. This prompted me to write to the applicant's representative on 5<sup>th</sup> July 2024 to ask if the applicant wished to make submissions on the identity/similarity of the goods in light of the reduced list of goods the opponent now relied on. The applicant replied stating that it did not wish to make further submissions about this matter. Therefore, subject to the outcome of my decision about whether the opponent has proven the earlier marks were put to genuine use, the applicant appears to accept that all the goods covered by the application are identical or similar to the goods the opponent still seeks to rely upon.

37. The opponent has not provided proof of use of the earlier '215 mark in relation to 'sanitary products'. I find that *air deodorising and air purifying preparations* are not similar to the goods for which proof of use has been provided, or if they are similar goods, they are similar to only a low degree. This is because they have different purpose, methods of use, and are not in competition with, or complementary to, *pharmaceutical preparations for human use*. Therefore, if they are similar goods, they are similar to only a low degree.

38. Similarly, the opponent has not provided proof of use of the earlier '215 mark in relation to *medical apparatus and instruments* in class 10. The opponent must therefore rely on the similarity (if any) between the applicant's class 10 goods and *pharmaceutical preparations for human use* in class 5. I accept that *medical and veterinary apparatus and instruments* in class 10 of the application is wide enough to cover complementary goods with a similar purpose to *pharmaceutical preparations for human use*, e.g. needles and other applicators for pharmaceuticals. However, I see no similarity, or at least no more than a low degree of similarity of purpose etc., between *pharmaceutical preparations for human use* and:

Class 10: Physical therapy equipment; Mobility aids; Medical furniture and bedding, equipment for moving patients; Hearing protection devices.

## **Global Assessment of the Likelihood of Confusion**

39. 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.

### *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.

### **Average consumer and the selection process**

40. It is common ground that the average consumer is a member of the general public or a healthcare professional who will pay “*at least*” a medium degree of attention during the selection process.

41. There are a number of obvious distinctions to be made within this area of general agreement. Firstly, where the goods are likely to be selected and used by healthcare professionals, such as *biological tissue cultures for medical purposes*, they will comprise the relevant public. Secondly, consumers of goods such as this are likely to pay a high degree of attention during the selection process so as to ensure the products satisfy the medical, safety and cost requirements.

42. The goods are likely to be selected primarily by visual means from product information material, on-line information, and advertisements. However, word-of-mouth recommendations/requests are also likely to play a part in the selection process. Therefore, the way the marks look is of particular importance, but the way they sound must also be taken into account.

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

43. In *Lloyd Schuhfabrik Meyer* the CJEU provided the following guidance about the assessment of distinctive character (with references to earlier cases removed):

*“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.*

*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.”*



44. The opponent submits that the earlier marks have a high degree of inherent distinctiveness because they have no meaning in relation to the goods. Descriptive marks cannot be registered without proof of acquired distinctiveness through use. It follows that the majority of the marks on the register are not descriptive of the goods/services for which they are registered. By definition, they cannot all be of ‘above average’ distinctiveness. The word Orion is in common use to designate a particular

stellar constellation. It is not an invented, unusual, or rarely used word. In my view, it has a 'normal' or medium degree of inherent distinctive character in relation to pharmaceuticals.

45. The opponent claims that the distinctive character of the earlier marks has been enhanced through use. However, although there is little doubt that the marks have been used over a long period, and on a substantial scale, in relation to pharmaceutical products, it is not easy to assess from the evidence just how visible the marks would have been, especially to the general public who are less likely to notice relatively small words and signs on the back or sides of product packaging, or somewhere in patient information leaflets. The opponent has provided no figures for the amount spent promoting goods under the marks. Further, apart from operating a couple of websites without any product specific information, no evidence has been provided showing how the marks have been promoted, if they have. Consequently, I am not satisfied that the evidence shows that the marks have acquired a high degree of distinctive character through use so far as the general public is concerned. I accept that healthcare professionals are more likely to have noticed, or otherwise have become aware, of the opponent's marks as the marks of the manufacturer of, and/or the marketing authorisation holder for, a range of pharmaceutical products for human use. I therefore accept that the earlier marks had acquired an above average degree of distinctive character through use by the relevant date, to a significant proportion of healthcare professionals. Even among this group, I do not consider the evidence establishes that the earlier marks were in the highest category of factually distinctive marks.

## Comparison of marks

46. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
	

47. The earlier '215 mark consists of the word ORION alone. The earlier '653 mark consists of a logo which will be perceived as a stylised form of the word 'Orion'. The contested mark is the stylised word 'Orin' in lower case. The stylisation consists of the horizontal lines beneath the word, which gives the impression of underlining the word element.

48. The dominant and distinctive elements of the earlier '653 mark, and the contested mark, are the words ORION and ORIN, respectively. However, the stylisation of these marks is not so negligible as to be completely overlooked by consumers/end users. Therefore, the stylisation must be taken into account. Registration of a word in capital letters covers use of the mark in any normal font, as well as in upper and lower case letters. Therefore, the fact that the contested mark portrays the word 'orin' in lower case letters is not a material point of distinction from the '215 mark.

49. The opponent points out that ORIN consists of four of the five letters of the word ORION, and that those letters appear in the same order. According to the opponent, this results in a high level of visual similarity between the earlier marks and the contested mark.

50. The applicant does not dispute the marks are visually similar, but argues that the degree of similarity between them is medium, rather than high.

51. A difference of one letter generally has more visual impact in short words than in longer words.<sup>8</sup> That remains true even when the common letters follow the same order. On the other hand, the omission of a letter in the middle of a word is less likely to be noticed than when at the beginning (or even at the end) of the word. That remains true, albeit to a lesser degree, where the words are relatively short words like ORION and ORIN. In my view, the contested mark is highly visually similar to the '215 mark. It is a little less visually similar to the '653 mark because of the different stylisation.

52. The opponent accepts that the contested mark has two syllables, whereas the earlier marks have three syllables, but submits "*the different syllable is not a prominent phonetic sound and it is highly likely someone pronouncing O-RIN will be perceived as sounding very similar to O-RI-ON.*" Therefore, according to the opponent, the earlier marks are highly aurally similar to the contested marks. I see some force in this submission. Nevertheless, the difference between a two syllable word and a three syllable word introduces a noticeable difference in sound, particularly to those likely to be paying a high degree of attention. I find the marks are aurally similar to a medium-to-high degree.

53. It is common ground that ORION has a conceptual meaning whereas ORIN does not. Therefore, there is no conceptual similarity between the marks.

### **Likelihood of confusion**

54. The opponent submits there is a likelihood of direct and indirect confusion. I will start by considering the likelihood of direct confusion.

55. The issue the parties disagree about most strongly about is the impact of the conceptual meaning of ORION and the absence of any meaning of ORIN. In *The*

---

<sup>8</sup> I refer to the finding of Mr Iain Purvis KC, acting as the Appointed Person in BL O/277/12, who stated: "*In considering visual similarity, it was clearly right to take into account the shortness of the marks, since a change of one letter in a mark which is only 4 letters long is clearly more significant than such a change in a longer mark.*"

*Picasso Estate v OHIM*<sup>9</sup> the CJEU upheld a decision of the EU's Court of First Instance (now called the General Court) holding that:

*“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”*

56. There are limits to this so-called counteraction theory. The fact that one of the marks has a clear conceptual identity, whereas the other mark does not, or may even have a different conceptual identity, may be insufficient to counter pronounced visual and aural similarities between the marks. This is particularly possible where other factors weigh in favour of a likelihood of confusion, e.g. the identity of the goods. In *Nokia Oyj v OHIM*<sup>10</sup> the Court of First Instance upheld a decision of the EU's Trade Mark Office to refuse to register LIFE BLOG as an EU mark in the face of opposition by the holder of an earlier German national mark consisting of the English word LIFE. In doing so the court stated that:

*“..... it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established.... .“*

57. Similarly, in the UK case reported at BL O/566/19, Mr Geoffrey Hobbs KC, as the Appointed Person, upheld an opposition brought by the proprietor of the trade mark PIMKIE against an application to register PINKIES for similar goods in class 14. Mr Hobbs found that the degree of visual and aural similarity between the marks was such that, when combined with other factors, there was a likelihood of confusion, notwithstanding the clear conceptual meaning of PINKIES.

58. Each case must be assessed on its own merits.

---

<sup>9</sup> Case C-361/04 P

<sup>10</sup> Case T 460/07

59. I find that where the goods are the same, or similar to more than a low degree, a person with the deemed attributes of an average consumer or end user, paying a normal degree of attention, is liable to mis-read or mis-hear the word ORIN in the applied-for mark as ORION. In my view, neither the conceptual meaning of ORION, nor the figurative elements in the applied-for mark and the earlier '653 mark, are sufficient to avoid such confusion. I accept there may be many instances where such confusion will not occur, or will not persist through the selection process. However, I am satisfied that in the circumstances I have described, there is a likelihood of sufficient direct confusion amongst a significant proportion of the relevant public to engage section 5(2)(b) of the Act.<sup>11</sup>

60. As noted above, some of the goods in class 5 are likely to be selected and used by healthcare professionals paying a high degree of attention. In these circumstances, I consider that ORIN is unlikely to be mis-read or mis-heard as ORION. Consequently, I find there is no likelihood of direct confusion in relation to the following goods:

Class 5: Live organs and tissues for surgical purpose; Arsenic detoxification agents for medical purposes; Benzol detoxification agents for medical purposes; Biological tissue cultures for medical purposes; Reagents for medical use; Haemoglobin; Injectable dermal fillers; Isotopes for medical purposes; Stem cells for medical purposes; Collodion for pharmaceutical purposes; Cellular function activating agents for medical purposes; Oxygen baths; Oral vaccine preparations; Radioactive substances for medical purposes; Reconstituted cells for clinical treatments for skin care; Reconstituted cells for medical treatments for skin care; Radioactive elements for medical use; Diagnostic radiopharmaceutical preparations; Radiotherapeutic hormones; Nucleic acid sequences for medical and veterinary purposes.

61. Additionally, I find there is no likelihood of direct confusion if the contested mark is used in relation to *air deodorising and air purifying preparations* in class 5 and *physical therapy equipment, mobility aids, medical furniture and bedding, equipment for moving*

---

<sup>11</sup> See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at paragraph 34(v)

*patients and hearing protection devices in class 10, none of which are similar to pharmaceutical preparations for human use to more than a low degree.*

62. Consequently, I find there is no likelihood of direct confusion if the contested mark is used in relation to these goods.

63. This brings me to the opponent's case on indirect confusion. According to the opponent, average consumers of the goods covered by the application who realise the contested mark does not include the word ORION, will nevertheless be caused to believe that the contested mark is economically linked to the undertaking that uses the earlier marks. The opponent's statement of grounds explains the claim like this:

*"In particular, the applicant's Mark might be considered a brand extension of the opponent."*

64. I reject this submission. In the well-known case of *L.A. Sugar Limited v By Back Beat Inc*,<sup>12</sup> Mr Iain Purvis KC, as the Appointed Person, considered the circumstances in which a finding of indirect confusion might be justified. This included:

*"[Where the contested mark] appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."*

65. I see no reason (and none has been advanced) as to why an average consumer or end user of any of the goods at issue would assume that a mark including the word 'Orin' as its distinctive and dominant element, is likely to be a brand extension of marks comprising, or including, the word ORION. On the contrary, changing a dictionary word into a made-up word appears highly illogical and inconsistent with a brand extension. This is because, to those who identify the marks correctly, it substantially changes their distinctive character. I conclude that no "*proper basis*" (or indeed, any basis) has been put forward to justify the opponent's claim of a likelihood of indirect confusion.<sup>13</sup>

66. The net effect of the above findings is that the opposition succeeds on the basis of a likelihood of direct confusion in respect of the majority of the goods listed in class

---

<sup>12</sup> Case BL O/375/10

<sup>13</sup> Per L.J. Arnold's comments in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

5 and *medical and veterinary apparatus and instruments* in class 10, but the opposition under section 5(2)(b) fails in relation to:

Class 5: Air deodorising and air purifying preparations; live organs and tissues for surgical purpose; Arsenic detoxification agents for medical purposes; Benzol detoxification agents for medical purposes; Biological tissue cultures for medical purposes; Reagents for medical use; Haemoglobin; Injectable dermal fillers; Isotopes for medical purposes; Stem cells for medical purposes; Collodion for pharmaceutical purposes; Cellular function activating agents for medical purposes; Oxygen baths; Oral vaccine preparations; Radioactive substances for medical purposes; Reconstituted cells for clinical treatments for skin care; Reconstituted cells for medical treatments for skin care; Radioactive elements for medical use; Diagnostic radiopharmaceutical preparations; Radiotherapeutic hormones; Nucleic acid sequences for medical and veterinary purposes.

Class 10: Physical therapy equipment; Mobility aids; Medical furniture and bedding, equipment for moving patients; Hearing protection devices.

### **THE SECTION 5(3) GROUNDS**

67. Section 5(3) of the Act is as follows:

*“(3) A trade mark which—*

*(a) 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.”*

68. If I am wrong about the (partial) success of the opposition under section 5(2)(b) of the Act, then the case under section 5(3) appears no stronger and would fail too. Therefore, it is only necessary to formally decide this ground in relation to the registration of the contested mark in relation to the goods for which opposition under section 5(2) failed.

69. The relevant case law under section 5(3) 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’Oreal 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; *General 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’Oreal 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'Oreal 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'Oreal 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'Oreal v Bellure*).

## **Reputation**

70. For the reasons given in paragraph 45 above, I find the earlier marks have a qualifying reputation with a significant proportion of healthcare professionals, but not with the general public.

## **Link**

71. My assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

*The degree of similarity between the conflicting marks*

72. This is set out in paragraphs 46 - 53 above.

*The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*

73. It is common ground that some of the parties' goods are identical or similar. Even where the goods are not similar, or are similar to only a low degree, they are all for use in the healthcare sector.

*The strength of the earlier mark's reputation*

74. The earlier marks appear to be well established. However, there is very limited evidence as to how the opponent has promoted the marks, and no information about the amount invested in doing so. Further, the marks do not appear to be highly visible on the packaging of some of the opponent's best-selling products. Therefore, the evidence only establishes that the earlier marks have a moderate reputation, even with healthcare professionals.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

75. This is set out in paragraph 45 above.

*Whether there is a likelihood of confusion*

76. There is no likelihood of confusion between the earlier marks and the contested mark in relation to the goods under consideration.

*Conclusion on link*

77. In my view, the relevant public will not make any link between the contested mark and the earlier marks, if the former is used in relation to the goods set out in paragraph 66 above.

**Unfair advantage/detriment to reputation or distinctive character**

78. It follows that in the absence of any link between the marks in the minds of the relevant public, use of the contested mark will not take unfair advantage of, or be detrimental to, the reputation or distinctive character of the earlier marks.

79. The opposition under section 5(3) of the Act therefore takes the opponent's case no further than the case advanced under section 5(2)(b).

**OVERALL OUTCOME**

80. The opposition succeeds, except in relation to the goods listed at paragraph 66 above.

**COSTS**

81. The opponent has been more successful than the applicant. It is therefore entitled to a contribution towards its costs. I assess this as follows:

£100 towards the official filing fee for the Form TM7 (Notice of Opposition);

£200 towards the cost of preparing the Notice of Opposition and considering the applicant's counterstatement;

£400 for preparing evidence;

£100 for filing written submissions.

82. I therefore order ORIN Slovakia to pay the Orion Corporation of Finland the sum of £800. This 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 2<sup>nd</sup> day of September 2024**

**Allan James**  
**For the Registrar**

## **ANNEX A**

Class 5: Dietary and nutritional supplements; Dietary supplements and dietetic preparations; Dental preparations and articles, and medicated dentifrices; Sanitary preparations and articles; Pest control preparations and articles; Air deodorising and air purifying preparations; Dental preparations and articles; Hygienic preparations and articles; Diagnostic preparations and materials; Pharmaceuticals and natural remedies; Medical dressings, coverings and applicators; Live organs and tissues for surgical purpose; Alcohol for pharmaceutical purposes; Medicinal alcohol; Amino acid preparations for medical purposes; Antipyretic preparations; Arsenic detoxification agents for medical purposes; Mud for baths; Bacteriological preparations for medical purposes; Bacterial preparations for medical and veterinary use; Benzol detoxification agents for medical purposes; Biochemical preparations for medical use; Biological preparations for medical purposes; Biological tissue cultures for medical purposes; Chemical preparations for medical purposes; Cooling sprays for medical purposes; Chlorine detoxification agents for medical purposes; Baby bottom balms for medical purposes; Menthol vapor bath preparations for babies; Reagents for medical use; Dextrins for pharmaceutical use; Rubbing alcohol; Enzyme preparations for medical purposes; Enzymes for medical purposes; Pheromones; Haemoglobin; Injectable dermal fillers; Isotopes for medical purposes; Cachets for medicinal purposes; Stem cells for medical purposes; Collagen for medical purposes; Collodion for pharmaceutical purposes; Oxygen for medical purposes; Medical preparations; Medicinal mud; Cellular function activating agents for medical purposes; Capsules for medicines; Bath salts for medical purposes; Medicated sunscreen preparations; Skin care oils [medicated]; Medicinal healthcare preparations; Skin relief serum [medicated]; Skin calming serum [medicated]; Lubricants for medical use; Massage gels for medical purposes; Massage candles for therapeutic purposes; Mineral food preparations for medical purposes; Mineral preparations for medical purposes; Mineral waters for medical purposes; Sea water for medicinal bathing; Breath refreshers for medical purposes; Scrubs [preparations] for medical use; Hydrogen peroxide for medical purposes; Bath preparations for medical purposes; Oxygen baths; Oral vaccine preparations; Preparations for use in naturopathy; Preparations for making medicated beverages; Panthenol preparations for medical use; Radioactive substances for medical purposes; Rehydration preparations; Reconstituted cells for

clinical treatments for skin care; Reconstituted cells for medical treatments for skin care; Radioactive elements for medical use; Diagnostic radiopharmaceutical preparations; Radiotherapeutic hormones; Nucleic acid sequences for medical and veterinary purposes; Salts for mineral water baths; Mineral water salts; Oral rehydration salts; Saline solution for sinus and nasal irrigation; Medicated shampoos; Therapeutic preparations for the bath; Thermal water; Medicated toiletry preparations; Ear candles for therapeutic purposes; By-products of the processing of cereals for medical purposes; Vitamin and mineral preparations; Yeast extracts for medical, veterinary or pharmaceutical purposes; Bark extract for medical use; Nutritional supplements for veterinary use; Gelatine for medical purposes; Breath-freshening chewing gum for medicinal purposes.