

ENGLISH

UKIPO, decision of 10 December 2015 in Case O-587/15

Background

The applicant, Glaxo Group Limited, filed a UK trade mark application for EVONTRUS to cover “pharmaceutical and medicinal preparations and substances; vaccines” in class 5. The opponent, Evonik Industries AG, opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 on the grounds of likelihood of confusion with its earlier UK designation for the mark EVONIK, which covers “pharmaceutical, veterinary and sanitary preparations” in class 5.

Decision

The goods were held to be identical or highly similar.

The average consumer was held to consist of medical and healthcare professionals and members of the general public, for whom the level of attention may vary, depending on factors such as the price and purpose of the goods, therapeutic indications, and whether they are sold with or without prescription. It was held that, although members of the general public are in general likely to pay greater attention to the purchase of goods which affect their health, their attention will not normally be as high as that of medical and healthcare professionals, and will vary with the purpose and price of the particular products.

Whilst comparing the marks, the Hearing Officer found that the initial EVON in both marks will catch the consumer’s attention. Having said that, the marks are of different length and their endings are different. In the case of EVONTRUS the ending makes up fifty percent of the mark. The endings make a real contribution to the overall impression of their respective marks. Overall, there is a medium degree of visual similarity. It was held that there is a medium degree of aural similarity and that, since both marks are invented words and neither has any meaning or allusive content for the relevant consumer, there is neither conceptual similarity nor conceptual difference between

them.

Since the earlier mark will be perceived as an invented word, it has a high degree of inherent distinctiveness.

It was held that the average consumer of “vaccines” consists of the medical professionals who select and administer them, and who will have a high level of attentiveness. Therefore, the differences between the marks in this case will be sufficient to offset their similarities in the mind of the average consumer of “vaccines”. Thus, the Hearing Officer found no likelihood of confusion in respect of “vaccines” and the opposition failed for these goods.

With regard to the broader term “pharmaceutical and medicinal preparations and substances”, it was found that these include over-the-counter or self-selected goods, as well as products used exclusively by medical professionals and general prescription medication. Therefore, particularly bearing in mind the principle of imperfect recollection, it was considered that the differences between the marks will not be sufficient to offset their similarities in the mind of members of the general public and that, for these consumers, there is a likelihood of confusion.

Comment

The Hearing Officer invited the applicant to submit a revised specification for the broad term “pharmaceutical and medicinal preparations and substances” which excludes occasion for confusion on the part of consumers who are not medical or healthcare professionals. If this is not achieved, a supplementary decision confirming that the opposition succeeds in respect of the broad term “pharmaceutical and medicinal preparations and substances” will be issued.

This decision provides interesting comment on the comparison of marks and on the likelihood of confusion, taking into account the different types of consumer and the awareness thereof. It serves as a reminder that attention must be paid to the nature of the goods and the consumers thereof, particularly when there is more than one type of pharmaceutical product at issue.



Rachel Conroy

Rachel Conroy is a UK Registered and European Trade Mark Attorney and works at Boulton Wade Tennant in London. She advises clients in the pharmaceutical sector and is a member of the Pharmaceutical Trade Marks Group (PTMG). Rachel has considerable experience in trade mark searching and practices all aspects of trade mark law, including prosecution and contentious matters, both in the UK and European Community.