

O-444-14

TRADE MARKS ACT 1994

TRADE MARK APPLICATIONS 3027442 & 3030549

BY AMBE LIMITED AMBE MEDICAL GROUP

TO REGISTER THE MARKS FERROUS-S AND FERROUS-F IN CLASS 5

AND

OPPOSITIONS 401723 & 401732

BY PENLAN HEALTHCARE LIMITED

Background and pleadings

1. Ambe Limited Ambe Medical Group, applied on 23 October and 14 November 2013, respectively (“the relevant dates”), to register the trade marks FERROUS-S and FERROUS-F. The marks are proposed to be registered for:

Pharmaceutical preparations; vitamin and mineral supplements for humans

2. Penlan Healthcare Limited opposes the applications on the basis of sections 3(1)(b) and (c) and 3(3)(b) of the Trade Marks Act 1994 (“the Act”). It claims that the marks describe a characteristic of the goods at issue; namely, in the case of FERROUS-S, products containing ferrous sulphur or sulphate, and in the case of FERROUS-F, products containing ferrous fluorine or ferrous fumarate.

3. In this connection the opponent points out that:

- Ferrous means containing iron in the divalent state;
- Ferrous is widely used in the pharmaceutical industry to indicate the use of iron in a compound or supplement;
- The “S” element of the mark FERROUS-S is likely to be understood by doctors, pharmacists and the like as standing for sulphur;
- Ferrous sulphate is widely used as a supplement for humans;
- FERROUS-S is therefore likely to be as a description of a characteristic of the goods covered by the application and, if the goods do not contain ferrous sulphur/sulphate, the mark would be deceptive;
- The “F” element of the mark FERROUS-F is likely to be understood by doctors, pharmacists and the like as standing for ferrous fluorine or ferrous fumarate;
- Ferrous fumarate is widely used as a supplement for humans;
- FERROUS-F is therefore likely to be as a description of a characteristic of the goods covered by the application and, if the goods do not contain ferrous fluorine or ferrous fumarate, the mark would be deceptive.

4. The applicant filed counterstatements admitting that “ferrous” may have a descriptive meaning for the goods at issue, but making no admission as to the prevalence of the use of that word in the pharmaceutical industry. The applicant denies that FERROUS-S and FERROUS-F would be understood as abbreviations for ferrous sulphur/sulphate or ferrous fluorine or ferrous fumarate.

5. The oppositions were consolidated.

The evidence

6. Only the opponent filed evidence in these proceedings. This takes the form of a witness statement by Anthony Xavier Gallafent. Mr Gallafent is a trade mark attorney with Gallafents LLP, which represents the opponent in these proceedings.

7. Mr Gallafent provides some internet search results¹, which he says show that ferrous sulphate and ferrous fumarate are often used in relation to vitamins and supplements. I accept that the evidence establishes that this was the case at the date the internet searches were conducted in June 2014. Further, as these are not new substances or new products, I doubt that the position would have been any different at the relevant dates.

8. Mr Gallafent also provides² extracts from Wikipedia which show that ‘S’ and ‘F’ are the chemical symbols for sulphur and fluorine, respectively. He also provides³ an extract from the national curriculum from 2007 showing that chemical elements and the periodic table were covered in science at key stage 3, i.e. taught to all 11-14 year olds in England. He uses this as support for the opponent’s claim that, in the context of the applicant’s marks, the meaning of ‘S’ and ‘F’ would be apparent to average consumers of vitamins and supplements.

9. No hearing was requested and neither side filed written submissions in lieu of a hearing. I am therefore left to make this decision following a careful perusal of the pleadings and the evidence.

The Law

10. Section 3(1) of the Act is as follows:

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

¹ See exhibits AXG-2 and AXG-3

² As exhibit AXG-4 and AXG-5

³ As exhibit AXG-6

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

11. Section 3(3)(b) is as follows:

“(3) A trade mark shall not be registered if it is-

(a) -

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

12. It is convenient to start by examining the opposition under s.3(1)(c). The case law under section 3(1)(c) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal

set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

Decision

13. The evidence establishes that ferrous sulphate and ferrous fumarate are common components of supplements for humans. According to the case law, it is irrelevant there are other signs, besides the marks at issue, which may also be used to designate that the goods covered by the application include ferrous sulphate or ferrous fumarate.

14. Although these are relatively technical terms, and therefore likely to be better known to medical professionals, pharmacists and chemists, the evidence shows that they are used in the marketing of supplements to the general public. In this

connection, I note that in *Exalation v OHIM*⁴, the General Court confirmed that, at least where technical terms are concerned, it is appropriate to take account of meanings known to those in the trade. The court stated that:

“38. In paragraph 18 of the contested decision, the Board of Appeal stated that the applicant had not submitted any substantiated evidence to invalidate the examiner’s observations to the effect that the element ‘lycopin’ (lycopene) designated a carotenoid with antioxidant properties.

39 For the first time at the hearing, the applicant challenged the Board of Appeal’s assessment that the term ‘lycopin’ is descriptive. The Court observes that the applicant has not given any details to support its claims and there is thus no need to consider whether such an argument may be raised at this stage in the proceedings. In particular, the applicant has put forward no argument capable of calling into question the meaning attributed to the term ‘lycopin’ by the Board of Appeal. In those circumstances, the Court must find that the applicant has not succeeded in challenging the meaning attributed to the element ‘lycopin’ by the examiner and by the Board of Appeal.

40 First, that technical term designates a food supplement necessarily known by some of the relevant public, in particular professionals dealing with dietetic, pharmaceutical and veterinary preparations.

41 Secondly, the Board of Appeal established in the contested decision that the meaning of the term ‘lycopin’ was easily accessible to consumers of all the goods covered by the application for registration. The meaning of the term ‘lycopin’ does in fact appear in dictionaries and on web sites. It is probable therefore that the substance designated by that term is also known by some of the consumers of all the goods listed in paragraph 3 above.

42 Thirdly, consumers of pharmaceutical, veterinary, dietetic and sanitary preparations for medical use who are not aware of the meaning of the term ‘lycopin’ will often tend to seek advice from the informed section of the relevant public, namely doctors, pharmacists, dieticians and other traders in the goods concerned. Thus, by means of the advice received from those who prescribe it or through information from various media, the less well informed section of the relevant public is likely to become aware of the meaning of the term ‘lycopin’.

43 The relevant public must therefore be regarded as being aware of the meaning of the term ‘lycopin’, or at least it is reasonable to envisage that the relevant public will become aware of it in the future (see paragraphs 25 and 26 above).”

15. I am satisfied that the terms ‘ferrous sulphate’ and ‘ferrous fumarate’ would be understood by relevant average consumers as descriptive of a characteristic of supplements, i.e. supplements containing iron in those forms. There is no evidence that ferrous fluorine is used, or could be used, in food supplements.

⁴ Case T-85/08

16. The next issue is whether the marks FERROUS-S and FERROUS-F would be understood by relevant average consumers of supplements as having the same meaning as ferrous sulphate and ferrous fumarate. The fact that the letter 'S' is the chemical symbol for sulphur makes it more likely that the '-S' in the first mark will be understood as standing for sulphate. I find that FERROUS-S is likely to be understood by relevant average consumers, being both health professionals and the general public, as an indication that the goods contain ferrous sulphate.

17. Although the letter 'F' is the chemical symbol for fluorine, I find that it is unlikely to be given this meaning in the mark FERROUS-F in circumstances where ferrous fluorine is not associated with the goods at issue.

18. However, I do not consider that the fact that the letter 'F' is not a chemical symbol for fumarate means that it could not be understood as having that meaning in the context of the mark FERROUS-F.

19. The Court of Justice of the European Union ("CJEU") has been prepared to accept that letters can be given a descriptive meaning if used in a context that invites such an understanding, even where the letters are not recognised symbols or abbreviations for words. In *Alfred Strigl v Deutsches Patent- und Markenamt and Securvita Gesellschaft zur Entwicklung alternativer Versicherungskonzepte mbH v Öko-Invest Verlagsgesellschaft mbH*⁵, the CJEU stated that:

"Article 3(1)(b) and (c) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that it is applicable to a word mark which consists of the juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself, if the relevant public perceives that sequence as being an abbreviation of that word combination by reason of the fact that it reproduces the first letter of each word of that combination, and that the mark in question, considered as a whole, can thus be understood as a combination of descriptive indications or abbreviations which is therefore devoid of distinctive character."

20. Given that:

- ferrous fumarate is descriptive of an important component of iron supplements;
- the relevant public are aware of that fact;
- the 'F' in FERROUS-F is used in the same position as the word 'fumarate' would appear in a conventional word description;

⁵ Cases C-90/11 & C-91/11

- That letter 'F' has no other apparent conceptual significance;

I find that FERROUS-F is likely to be understood by relevant average consumers, being both health professionals and the general public, as an indication that the goods contain ferrous fumarate.

21. This means that the oppositions under s.3(1)(c) must succeed at least for vitamin and mineral supplements for humans. However, it seems to me that the same logic applies to any medicated products containing ferrous sulphate or ferrous fumarate. I therefore find that the s.3(1)(c) grounds succeed for all the goods covered by the applications.

22. In case I am found to be wrong about the s.3(1)(c) grounds, I will also consider the grounds under s.3(1)(b). The principles to be applied under art.7(1)(b) of the CTM Regulation (equivalent to s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*⁶ as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67).”

23. Even if the marks FERROUS-S and FERROUS-F are not understood by relevant average consumers as indicating the presence of ferrous sulphate or ferrous fumarate, it seems plain to me that ‘ferrous’ will be recognised as meaning ‘iron’. In

⁶ Case C-265/09 P

the context of vitamins and mineral supplements, it seems very unlikely that hyphenating the word 'ferrous' with the letters 'S' and 'F' would alter the public's perception that the marks indicate only the presence of iron in the products. This is because the word 'ferrous' is such an obvious indication that the goods at issue contain iron that the additional letter is likely to be understood as part of a description that the product contains an iron compound, even if the user does not know specifically what the letters 'S' or 'F' stand for. Therefore *prima facie* the marks will not serve to identify the products in respect of which registration is applied for as originating from a particular undertaking. Consequently, the opposition also succeeds under s.3(1)(b).

24. The opposition having succeeded under s.3(1)(b) and (c), there is no need to deal with the further ground of opposition under s.3(3)(b).

Costs

25. The opponent has been successful and is entitled to a contribution towards its costs. I order Ambe Limited Ambe Medical Group to pay Penlan Healthcare Limited the sum of £1000 as a contribution towards the cost of these proceedings. The sum is calculated as follows:

£800 to cover the cost of filing the notices of opposition (including recovery of the £400 paid in official fees) and considering the counterstatements;
£200 to cover the cost of filing evidence.

26. Subject to any decision on appeal, the above sum should be paid within seven days of the expiry of the appeal period or, if there is an appeal, within seven days of that appeal being concluded.

Dated this 14th day of October 2014

**Allan James
For the Registrar**