

O/0260/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3639870
BY ECO ANIMAL HEALTH LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:**

ECOVAXXIN

IN CLASS 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 427829
BY BHARAT BIOTECH INTERNATIONAL LIMITED**

Background and pleadings

1. On 11 May 2021, Eco Animal Health Limited (“the applicant”) applied to register the trade mark **ECOVAXXIN** in the UK, under number 3639870 (“the contested mark”). Details of the application were published for opposition purposes on 30 July 2021. Registration is sought for ‘*vaccines for poultry and swine*’ in class 5.

2. On 29 October 2021, Bharat Biotech International Limited (“the opponent”) opposed the application under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). In respect of both claims, the opponent relies upon its UK trade mark number 3594294. The registration consists of a series of two trade marks: **COVAXIN** and **Covaxin**. As the only difference between them is the use of capitalisation, I will refer to them in the singular (i.e. “the earlier mark”) unless it becomes necessary to distinguish between them. The earlier mark was filed on 11 February 2021 and became registered on 27 August 2021 in respect of ‘*vaccine for human use*’ in class 5.

3. The opponent’s trade mark qualifies as an earlier mark in accordance with section 6 of the Act. As it had not completed its registration process more than five years before the filing date of the contested mark, it is not subject to the use provisions specified in section 6A of the Act. Consequently, the opponent is entitled to rely upon earlier mark for the purposes of section 5(2)(b) without having used its mark at all.

4. Under section 5(2)(b), the opponent argues that the competing marks are similar and that the parties’ respective goods are similar. On this basis, the opponent submits that there is a likelihood of confusion.

5. As for its claim under section 5(3), the opponent claims that the earlier mark has a reputation in connection with the goods for which it is registered. The opponent submits that this reputation is such that use of the contested mark would give the applicant an unfair commercial advantage, exploiting the opponent’s marketing efforts without paying compensation. It also contends that use of the contested mark may tarnish the reputation of the earlier mark, since it would not accord with the opponent’s brand guidelines or meet its standards and quality. Finally, the opponent claims that the distinctive character of the earlier mark will be diluted as the presence of a similar

mark on the market would reduce the capacity for it to create an immediate association with the opponent.

6. The applicant filed a counterstatement denying the grounds of opposition. The applicant denies each of the opponent's claims. It also put the opponent to proof of its alleged reputation.

7. Both parties are professionally represented; the opponent by Potter Clarkson LLP and the applicant by Withers & Rogers LLP. Both parties filed evidence. Neither party requested a hearing, but both filed written submissions in lieu of attendance. This decision is taken following a careful perusal of all the papers before me.

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

Evidence and submissions

9. The opponent's evidence is given in the witness statement of V Krishna Mohan, dated 9 June 2022, and fourteen exhibits. Dr Mohan is Executive Director of the opponent, a position they have held since 2011. They give evidence as to the background of the company as well as its use of the earlier mark.

10. The applicant's evidence consists of the witness statement of David Hallas, dated 15 August 2022, together with eleven exhibits (DCH1 to DCH11). Mr Hallas is Director and Chief Executive Officer of the applicant, a position he has held since April 2022. The purpose of his statement is to give evidence as to the background and activities of the company, details of its other trade mark registrations and dictionary definitions for the prefixes "eco-" and "co-".

11. As noted above, both parties also filed written submissions in lieu of a hearing.

12. I have read all of the evidence and submissions and will return to them to the extent I consider necessary in the course of this decision.

Preliminary remarks

13. Mr Hallas gives evidence as to the history and background of the applicant and its intended use of the contested mark. Much of Mr Hallas' statement also describes perceived differences between the actual goods that are, or will be, provided by the parties. For reasons I will now explain, these matters will have no material bearing on the outcome of this opposition, nor can they in law.

14. A trade mark registration is essentially a claim to a piece of legal property. Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods if there is a likelihood of confusion. Once a trade mark has been registered for five years, section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods for which it is registered.

15. The mark relied upon by the opponent had not been registered for five years at the date on which the application was filed. Consequently, the opponent is not required to prove its use of it. The earlier trade mark is entitled to protection against a likelihood of confusion with the contested mark based on the 'notional' use of that earlier mark for the goods listed in the register.

16. The concept of notional use was explained by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark

uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place”.

17. So far as the applicant's claimed, or intended, use of the contested mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark might be used if it were registered. As a result, even though the applicant has suggested the ways in which the mark will be used, and the goods for which it will be used, my assessment later in this decision must take into account only the contested mark – and its specification – and any potential conflict with the earlier mark. Any differences between the actual goods provided by the parties, or differences in their actual customers, are not relevant unless those differences are apparent from the applied-for and registered marks. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

18. I note that Mr Hallas also refers to other trade mark registrations of which the applicant is the proprietor. It suffices to say that these other trade marks are not relevant. None is the subject of these proceedings, and their existence will have no bearing on whether, for instance, there is a likelihood of confusion between the contested mark and the earlier mark.

19. Finally, Mr Hallas provides letters from the EUIPO concerning the registration process of another trade mark owned by the applicant. I reiterate that other trade marks are not relevant to the matters to be determined; the mark referred to does not form the subject of these proceedings. Moreover, it is well-established that decisions of the EUIPO are not binding on the Registrar; whether the mark was accepted for registration by the EUIPO on the basis of acquired distinctiveness will have no bearing on the outcome of these proceedings.

Section 5(2)(b)

The law

20. Sections 5(2)(b) and 5A of the Act read 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.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

21. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

22. In *Canon*, the CJEU stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] 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”.

23. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

24. In its written submissions in lieu, the applicant has referred to two prior decisions of the Registrar (Cases BL O/156/09 and BL O/302/06). Whilst I note the contents and findings of those decisions, I am not bound by them and will proceed to conduct a full comparison, having regard to the case law above and all the relevant factors.

25. To my mind, the general nature and intended purpose of *'vaccines for poultry and swine'* overlaps with *'vaccine for human use'* in that they are both vaccines which are used for protection against infectious diseases. Broadly speaking, the method of use of the respective goods also overlaps; they are both delivered to the recipient in the form of, for example, an injection. However, the respective goods clearly differ as one is for animals, whereas the other is for humans. The applicant's goods will be purchased by veterinary professionals and agricultural business owners, while the opponent's goods will be purchased by medical professionals. As such, the respective goods generally have different users, though I accept that there may be a limited overlap insofar as animal-owning members of the general public may be users of both. It is my view that the respective goods are unlikely to share manufacturers or distribution channels. In the absence of any evidence to the contrary, I do not consider it commonplace for undertakings which produce and distribute vaccines for animals to also offer vaccines for humans. Mr Hallas has provided an example of an undertaking which produces both animal and human vaccines.¹ However, these appear to be

¹ Exhibit DCH10

offered through separate divisions of the company. Even if it did show that both animal and human vaccines were made available side-by-side, I do not consider one example to be indicative of what is typical in trade. As the applicant's goods are not for use by humans, there is no competition between them; animal vaccines are not typically administered to humans, nor vice versa. As the goods are not indispensable or important for the use of one another,² they are not complementary. Overall, I find that the respective goods are similar to between a low and medium degree.

The average consumer and the nature of the purchasing act

26. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

27. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.³

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

² *Boston Scientific Ltd v OHIM*, Case T-325/06

³ *Lloyd Schuhfabrik Meyer*

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

40. Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, *TOLPOSAN*, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).

[...]

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

29. As explained above, the goods at issue in these proceedings will, generally, have different user bases; the applicant's goods will be purchased by veterinary professionals and agricultural business owners, whereas the opponent's goods will be purchased by medical professionals. Where goods are purchased by distinct consumer groups, the circumstances in which confusion could occur would not arise, since such consumers would not encounter both trade marks. However, there may be circumstances where both parties' goods are purchased by the same users, namely, animal-owning members of the general public. Although I consider it unlikely that these circumstances would materialise (as members of the general public do not typically purchase vaccines for themselves), there is potential for such consumers to be prone to the effects of confusion. Therefore, I will proceed to consider it anyway. The assessment which follows will be limited to this group.

30. Vaccines are unlikely to be particularly frequent purchases, whether they are purchased by the general public for themselves or their pets. The purchasing of the goods is likely to be mediated by a medical or veterinary professional. The cost of vaccines for humans and animals may vary considerably, though, overall, they are likely to be relatively inexpensive. I would expect the level of attention of the general public to vary depending on the nature of the vaccine, the severity of the condition it is intended to prevent and the reasons why it is sought. However, the purchasing process is likely to be more careful than casual. Further, it is unlikely to be an unassisted purchase. Vaccines will affect the state of the recipient's health and, therefore, the general public will wish to choose the correct product for themselves or their pet and ensure the product is suitable for their needs. Moreover, the general public may consider ingredients and any potential side effects during the selection process. In light of all of this, and consistent with the case law cited above, it is my view that, overall, the general public will demonstrate a relatively high level of attention. The goods are likely to be obtained by the general public from professionals such as hospitals, general practitioners or veterinary practices. The goods will be selected after consulting information in brochures or websites. However, it is likely that the general public will also discuss vaccines with a healthcare professional or veterinarian prior to it being administered. Accordingly, it is my view that the purchasing process will be by a combination of visual and aural means.

Distinctive character of the earlier mark

31. 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 *WindsurfingChiemsee*, paragraph 51).”

32. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

33. The earlier mark is in word-only format and consists of the word 'COVAXIN'. As it is the only element of the mark, its distinctive character lies in the word itself. The word 'COVAXIN' appears to be an invented word. Mr Hallas has provided a dictionary definition for the prefix 'co-',⁴ which indicates that the prefix is used to form nouns that refer to people who share a job or task with someone else. However, for a concept to be relevant it must be capable of immediate grasp by the relevant consumer.⁵ It is my view that the letters 'CO' do not combine with the remainder of the mark in this way. As the mark would make little sense in this regard, I consider it unlikely that the average consumer would perceive the letters in this sense and attribute the meaning of the prefix to them. In its written submissions, the applicant has contended that the letters 'CO' would be perceived as reflecting the beginning of 'Covid-19' and, as such, it has a connection to the goods. Whilst I accept that Covid-19, being an infectious disease, has a clear connection to vaccines, there is no evidence demonstrating that the average consumer would perceive the beginning of the earlier mark in this manner, merely because the words share two letters. I consider it more likely that the beginning of the earlier mark will simply be perceived as the letters 'CO'. It has been established that consumers tend to break down trade marks into elements which suggest a meaning or resemble known words.⁶ Given the resemblance of 'VAXIN' to the word 'vaccine', it is my view that the earlier mark as a whole will be perceived as alluding to the goods for which it is registered. Overall, I find that the earlier mark possesses between a medium and level of inherent distinctive character.

34. Evidence has been filed by the opponent and I am now required to assess whether it has demonstrated that, at the relevant date of 11 May 2021, the earlier mark had an enhanced level of distinctive character by virtue of its use in the marketplace.

35. Dr Mohan gives evidence that the opponent is a multinational biotechnology company which specialises in the manufacture of, *inter alia*, vaccines.⁷ They say that the opponent has developed many vaccines, including for use in relation to Hepatitis-B, the Zika virus, polio and influenza. The opponent has delivered over 4 billion doses

⁴ Exhibit DCH11

⁵ *The Picasso Estate v OHIM*, Case C-361/04 P

⁶ *Usinor SA v OHIM*, Case T-189/05

⁷ Witness statement of V Krishna Mohan, §4

of vaccines worldwide.⁸ The opponent's products have reached individuals in over 123 countries and its manufacturing facilities are approved by, *inter alia*, the World Health Organisation ("WHO").⁹ The opponent received numerous awards and accolades between 1998 and 2021 for its activities in the industry.¹⁰ From the information provided, these appear to predominantly relate to India and Asia.

36. I note that a Covid-19 vaccine was developed by the opponent under the earlier mark.¹¹ It was one of the first companies in the world to create a vaccine in the pandemic and the first Indian company to develop an indigenous one.¹² Its three-phased clinical trials were approved in India in July 2020; over 25,000 individuals were involved.¹³ Thereafter, in January 2021, the 'COVAXIN' vaccine was approved for emergency use in India.¹⁴ The vaccine was approved for emergency use by the WHO on 3 November 2021, while, in 2022, 'COVAXIN' became the first Covid-19 vaccine in the world to be rolled out for children;¹⁵ however, these milestones occurred after the relevant date.

37. Between 2020 and 2021, 10 million doses of 'COVAXIN' were supplied in India, with a value of approximately £21.3 million, while 700,000 doses were exported to Afghanistan, Australia, Botswana, Cambodia, Iran, Mauritius, Myanmar, Paraguay and Zimbabwe, with a value of approximately £4.6 million.¹⁶ The opponent has also donated 1.65 million doses of 'COVAXIN' to the Indian Government for frontline workers and 200,000 doses to Vietnam.¹⁷ It is said to have invested significant resources in its efforts to provide around 600 million doses of the vaccine.¹⁸ 'COVAXIN' is currently approved for emergency use by 23 governments and organisations, including India, Vietnam and the WHO, and is under registration in 39 other territories, such as Austria, Japan and South Africa.¹⁹ On 8 November 2021, the

⁸ Mohan, §5; Exhibit 1

⁹ Mohan, §6; Exhibit 1

¹⁰ Mohan, §8

¹¹ Mohan, §9; Exhibit 2

¹² Mohan, §9

¹³ Exhibit 2

¹⁴ Mohan, §11

¹⁵ Mohan, §§11 and 23; Exhibits 3 and 9

¹⁶ Mohan, §12

¹⁷ Mohan, §14

¹⁸ Mohan, §14

¹⁹ Mohan, §21; Exhibit 7

UK Government announced that 'COVAXIN' would be recognised in its inbound travel rules, allowing international travellers inoculated with 'COVAXIN' to travel to England without needing to self-isolate.²⁰ However, this was after the relevant date.

38. Dr Mohan says the approval process is a lengthy one with many stages, and that these matters of public interest are widely covered by the global media.²¹ I note that the approval of 'COVAXIN' for emergency use by the Philippines, Vietnam and the WHO was reported by Reuters and Associated Press;²² however, the articles are dated 25 June, 13 July, 3 November and 10 November 2021, i.e. after the relevant date. Business Standard and PharmaTimes reported on the UK Government's aforementioned announcement regarding 'COVAXIN',²³ though the articles are dated 9 November and 22 November 2021, i.e. after the relevant date.

39. According to Dr Mohan, the development and distribution of 'COVAXIN' has also been widely covered by the global media.²⁴ An article from BioSpace, dated 20 May 2020, is in evidence.²⁵ It details the opponent's development of the vaccine in partnership with the Thomas Jefferson University of Philadelphia. It says that, under the licence agreement, the opponent gains exclusive rights to develop, market and deliver the vaccine in, *inter alia*, Europe. However, there is no clear indication that this article targeted UK readers.

40. Examples of coverage of 'COVAXIN' in the UK media have been provided.²⁶ The first is from Reuters and is dated 9 March 2021. It says that a Brazilian company representing the opponent requested that the country's health regulator grant authorisation to use 'COVAXIN'. The second, also from Reuters, says that the opponent was to produce an additional 200 million vaccines per year. However, it is dated 20 May 2021, i.e. after the relevant date. The third is from the BBC. It says that 'COVAXIN' was approved in India for children under 12. It is dated 26 April, with no

²⁰ Exhibits 11 and 12

²¹ Mohan §22

²² Exhibits 8 and 10

²³ Exhibit 12

²⁴ Mohan, §18

²⁵ Exhibit 6

²⁶ Exhibit 13

year given. When read in conjunction with the opponent's other evidence,²⁷ it appears likely to be from 2022, i.e. after the relevant date.

41. Examples of other press articles, dated between 16 December 2020 and 13 March 2021, are also in evidence.²⁸ Although they are all from before the relevant date, none relates to the UK, nor to the opponent's use of the earlier mark in this territory. Moreover, none appears to target readers in the UK. None appears to be UK based and the articles either relate to other territories (such as, for example, India and Jamaica) or have other indications that they were published in, or intended for, other territories (such as, for example, references to Indian Standard Time).

42. No details have been provided by the opponent to indicate the size of the relevant market. Neither is there any evidence before me to that effect. It is my impression that the market for vaccines would be extremely large, with the potential for entire populations to be targeted. Although the opponent has delivered a significant number of vaccine doses to numerous countries around the world, and its vaccines have been approved for use by numerous governmental bodies, the evidence lacks relevance to the UK. The evidence predominantly relates to the opponent's activities in India, and the other territories mentioned do not include the UK. There is no evidence, for example, that any 'COVAXIN' vaccines have been exported to the UK and no turnover figures relating to the UK have been provided. Whilst I accept that the UK Government announced that 'COVAXIN' would be recognised within its inbound travel rules, this occurred in November 2021. As such, it cannot be relied upon as showing the position at the relevant date. Moreover, no information has been provided as to the sums spent by the opponent on marketing vaccines bearing the earlier mark. There is also a distinct lack of evidence that any such activities were conducted in the UK prior to the relevant date. I do not discount that the earlier mark has been referred to in numerous media publications, but the majority of the media coverage is either not relevant to the UK or is from after the relevant date. Moreover, much of the media coverage does not appear to target readers in the UK. I acknowledge the article published by Reuters that is dated before the relevant date. However, although it is my understanding that

²⁷ In particular, see Mohan, §11, and Exhibit 3

²⁸ Exhibit 14

Reuters is a large news outlet, no circulation figures have been provided; there is nothing which would enable me to ascertain how many individuals in the UK would have been exposed to the earlier mark through reading this particular article. Further, the subject of the article is the potential use of ‘COVAXIN’ in Brazil, not the UK. In any event, reference to the earlier mark in one article is clearly not sufficient to establish that the earlier mark was known to the average consumer in the UK at the relevant date. Whether the earlier mark is known to consumers in other territories – such as, for example, India – is not relevant to assessing how strongly the earlier mark indicates to consumers in the UK that the goods originate from the opponent. Nor is there any evidence from which it could safely be inferred that average UK consumers would have become familiar with the earlier mark as a result of its use or publicity in such territories. The details of other trade mark registrations do not assist the opponent;²⁹ the mere fact that the opponent is the owner of a number of registrations does not establish that the marks are in use or that consumers in the UK would be aware of them. Taking all of the above into account, the evidence before me does not support a finding that the distinctiveness of the earlier mark had been enhanced above its inherent characteristics at the relevant date. Even accounting for the public’s increased awareness of vaccines during the global pandemic, it is my view that the evidence falls a long way short for this purpose.

Comparison of trade marks

43. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *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 relative weight

²⁹ Mohan, §§15 to 17; Exhibits 4 and 5

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.”

44. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

45. The competing trade marks are as follows:

The earlier mark	The contested mark
COVAXIN Covaxin	ECOVAXXIN

Overall impressions

46. The competing marks are in word-only format and consist of the words ‘COVAXIN’/‘Covaxin’ and ‘ECOVAXXIN’. As these words are the only element in the marks, they dominate their respective overall impressions

Visual comparison

47. The competing marks are visually similar in that the seven letters which comprise the earlier mark appear in the contested mark in the same order. The difference in letter case between the contested mark and the second mark in the opponent’s series is not significant, since the registration of word-only marks provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case.³⁰ The competing marks are visually different insofar as the contested mark contains two additional letters, i.e. ‘E’ and ‘X’. The former appears at the beginning of

³⁰ *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

the contested mark, a position which is generally considered to have more impact.³¹ The repeated letter 'X' in the contested mark is also fairly striking from a visual perspective. Further, due to the additional letters, the contested mark is longer than the earlier mark. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

Aural comparison

48. It is my view that the repeated letter 'X' in the contested mark will have no material impact on the way in which the mark is pronounced. As such, the competing marks are likely to be articulated as "CO-VAX-IN" and "EE-CO-VAX-IN", respectively. Clearly, they are aurally similar because the three syllables present in the earlier mark appear in the contested mark in the same order. The additional syllable at the beginning of the contested mark creates a point of significant aural difference. Overall, I find that there is between a medium and high degree of aural similarity between the competing marks.

Conceptual comparison

49. As explained previously, whilst the earlier mark is an invented word, it is likely to be understood as alluding to the word 'vaccine'. The contested mark is also an invented word. However, in the context of the applied-for goods, I am of the view that the 'VAXXIN' part of the word will also be perceived as evocative of the word 'vaccine'. The average consumer will be familiar with the prefix 'eco-' from common usage and will, therefore, understand the letters 'ECO' in the mark to be denoting ecology, ecological or environmental. Mr Hallas has provided a dictionary definition which confirms, rather than contradicts, my impression of how the prefix would be understood.³² As a whole, the contested mark is likely to be understood as alluding to vaccines which are environmentally friendly or produced in such a manner. The competing marks conceptually overlap to the extent that they both allude to vaccines but differ in that the contested mark conveys an additional meaning. Taking all of the

³¹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

³² Exhibit DCH11

above into account, I find that there is a medium degree of conceptual similarity between the competing marks.

Likelihood of confusion

50. 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. One such factor 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 mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier 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 they have retained in their mind.

51. 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.

52. Earlier in this decision, I concluded that:

- The parties' goods are similar to between a low and medium degree;
- The average consumer (relevant to my assessment) is an animal-owning member of the general public, who will demonstrate a relatively high level of attention;
- The goods will be selected by a combination of visual and aural means;

- The earlier mark possesses between a medium and high level of inherent distinctive character;
- The overall impression of the competing marks lies in the words 'COVAXIN'/'Covaxin' and 'ECOVAXXIN', respectively, being the only elements of the marks;
- The competing marks are visually and conceptually similar to a medium degree, and aurally similar to between a medium and high degree.

53. I acknowledge that the letters which constitute the earlier mark are all reproduced in the contested mark in the same order and that the earlier mark enjoys an above average level of distinctive character. I also accept that the competing marks are both technically invented words. Nevertheless, there are differences between them which are not negligible. The contested mark contains two additional letters which are not present in the earlier mark. One of those letters creates a difference at the beginning of the competing marks, a position which, as noted above, is generally considered to have more impact. The other produces a rather unusual double letter 'X' in the middle of the contested mark, and this feature has no counterpart in the earlier mark. For these reasons, the additional letters will not be overlooked by the average consumer. Although the repeated letter 'X' in the contested mark does not create any aural variance between the competing marks, the contested mark also has an additional syllable at its beginning. Moreover, whilst there is an element of conceptual overlap between the competing marks, this stems from a meaning which describes the goods at issue in these proceedings. It is not, therefore, a distinctive similarity. The contested mark also conveys a concept relating to ecology and the environment which is not shared by the earlier mark. Taking all the above factors into account, as well as the relatively low level of similarity between the parties' goods, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer – paying a relatively high level of attention – to distinguish between them and avoid mistaking one for the other. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion.

54. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

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

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

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

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

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

55. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.³³ However, indirect confusion has its limits. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.³⁴ The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.³⁵

56. Applying these principles, I do not believe that the average consumer, having noticed the differences between the competing marks, will assume that the opponent and the applicant are economically linked undertakings. I am not convinced that the average consumer would assume a commercial association or licensing agreement between the parties, or sponsorship on the part of the opponent, merely because of the shared letters. The earlier mark is not so strikingly distinctive that the average consumer would assume that only the opponent would be using the constituent letters in a trade mark. In any event, the average consumer would have no reason to separate these letters from the contested mark when perceiving it as a whole. Further, the differences between the competing marks are not simply adding or removing non-distinctive elements. Nor are the differences consistent with any logical brand extensions with which consumers would be familiar. I can see no reason why an undertaking would add an additional letter to the beginning of a mark, resulting in a prefix with a known meaning and, thus, altering the impression it conveys. Neither is there any obvious reason why an undertaking would add an additional letter ‘X’ to the middle of a mark, creating an unusual feature that was not previously present. Although the competing marks conceptually overlap, this stems from a meaning which describes the goods. Whilst indirect confusion is not limited to the categories outlined

³³ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

³⁴ *Duebros Limited v Heirler Cenovis GmbH*, Case BL O/547/17

³⁵ *Liverpool Gin Distillery*

in *L.A. Sugar*, to my mind, there is no other basis for concluding that the average consumer would assume an economic connection between the parties. Rather, it is my view that the average consumer – paying a relatively high level of attention – would attribute the similarities between the competing marks to coincidence, particularly given there are relatively low levels of similarity between the parties’ goods. Taking all of the above factors into account, I do not consider there to be a likelihood of indirect confusion.

Conclusion

57. The opposition based on section 5(2)(b) is dismissed.

Section 5(3)

The law

58. Sections 5(3) and 5(3A) of the Act state:

“(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.

(3A) 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.”

59. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oréal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora* and

Case C383/12P, *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-Salomon, 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) 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*.

(g) 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*.

(h) 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*.

(i) 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*).

60. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its earlier mark is similar to the contested mark.³⁶ Secondly, the opponent must show that the mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the contested mark. Fourthly, assuming the foregoing conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is not necessary for the purposes of section 5(3) that the goods are similar,

³⁶ Given my findings at paragraphs 47 to 49, this condition has clearly been satisfied.

although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

61. The relevant date for the assessment under this ground is the filing date of the contested application, that being 11 May 2021.

Reputation

62. 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.”

63. The opponent’s evidence has already been assessed above. Although I do not doubt that the opponent was commercially active prior to the relevant date, there is a distinct lack of evidence relating to the UK. There is very little, if any, evidence to establish that the earlier mark would have become known to consumers in the UK. For the same reasons given at paragraph 42, I am unable to conclude that the earlier mark

had a qualifying reputation in the UK at the relevant date. Therefore, the opponent's claim under this ground must fail.

64. Even if I were to conclude that the opponent had demonstrated a qualifying reputation, for the same reasons given at paragraphs 53 and 56, I consider it unlikely that the earlier mark would be brought to mind by the contested mark. If any link was made, it is my view that this would be too fleeting to result in any damage arising; given that the evidence could only, at best, support a finding of a weak reputation and the respective goods are for use by animals and humans, respectively, there would be no material change in economic behaviour.

Conclusion

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

Overall outcomes

66. The opposition under sections 5(2)(b) and 5(3) has failed. Subject to any successful appeal, the application will proceed to registration in the UK.

Costs

67. As the applicant has been successful, it 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 **£1,200** as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Considering the opponent's statement and preparing a counterstatement	£300
Preparing evidence and considering the opponent's evidence	£500
Preparing written submissions	£400
Total	£1,200

68. I hereby order Bharat Biotech International Limited to pay Eco Animal Health Limited the sum of **£1,200**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 9th day of March 2023

James Hopkins
For the Registrar