

O/0403/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS.

UK00003505978 & UK00003505983

BY PODS GROUP LIMITED

TO REGISTER:

POD

AND



AS TRADE MARKS IN CLASSES 5, 10 AND 44

AND

IN THE MATTER OF OPPOSITIONS THERETO

UNDER NOS. OP000422919 & OP000422923

BY IMPEL NEUROPHARMA, INC.

Background and pleadings

1. On 29 June 2020, Pods Group Limited (“the applicant”) applied to register the trade marks shown below – Nos. UK00003505978 and UK00003505983 – and the applications were published for opposition purposes on 23 October 2020.

POD



2. The registrations are sought for the following goods and services:

Class 5 Pharmaceuticals; sanitary preparations and articles; anti-bacterial preparations; anti-bacterial sprays, wipes and cleansers; disinfectants; disinfectants for medical use; disinfectants for medical apparatus and instruments; sanitising preparations; hand-sanitising preparations; alcohol for medical use; wipes and tissues for medical use; washes (disinfectant) [other than soap]; antiseptics; alcohol based antibacterial skin sanitiser gels; antiviral preparations; medicated handwash; sterilising solutions and preparations.

Class 10 Medical, surgical and veterinary apparatus and instruments; diagnostic, examination and monitoring equipment; medical devices; medical instruments; medical masks; surgical masks; masks and equipment for artificial respiration; protective face masks for medical and surgical purposes; face masks for medical and surgical use for antibacterial protection; medical

gloves; surgical gloves; disposable gloves for medical and surgical purposes; medical gowns; surgical gowns; sterile clothing for medical and surgical use; sterile surgical sheets; isolation gowns; surgical caps; shoe covers for medical and surgical purposes; eye shields for medical and surgical use; face shields for medical and surgical use; scanners for medical use; thermometers for medical purposes; temperature scanners for medical use; infrared apparatus for medical purposes; infrared thermometers for medical use; medical ventilators; lamps for medical and surgical purposes; ultraviolet lamps for medical purposes; parts and fittings for the aforesaid goods.

Class 44 Health care; health advice and information services; health assessment surveys; health centres; health clinics; health screening; managed health care services; preparation of reports relating to health care matters; provision of health care information by telephone; nursing services; medical and dental services; medical screening; health screening services; advisory and consultancy services relating to all of the above.

3. Impel NuroPhrama, Inc. ("the opponent") opposes the trade marks on the basis of sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The oppositions (no. OP000422919 – the lead case – and no. OP000422923 – the second case) are directed against all of the goods and services in the applications and are reliant upon the trade mark and the goods detailed below.
4. International registration no. WO0000001361766 which has a date of protection in the UK of 23 November 2017. It has an international registration date of 23 June 2017, a designation date of 23 June 2017, and a priority date of 3 January 2017.

POD

Class 10 Drug delivery systems; dosing aids and apparatus for medicines, namely, drug delivery and dispensing devices and systems; dosing aids and apparatus for medicines, in particular for medicines in liquid and granulated form, namely, machines for dispensing pre-determined dosages of medication; nasal, respiratory, and sinus drug delivery devices and parts therefor.

The consolidated proceedings

5. In its two separate Form TM7s and accompanying statements of grounds, the opponent argues that the applicant's marks are identical in the lead case and identical or at least highly similar overall in the second case, and that the competing goods and services are identical or highly similar.
6. The applicant filed two separate Form TM8s and counterstatements denying the claims made.
7. On 20 January 2022 the lead and second cases were joined together in consolidated proceedings.
8. Both parties filed written submissions. The opponent also filed evidence, detailed below. The opponent is represented by Lane IP Limited and the applicant is represented by Varun Kunwar Singh.
9. This decision is taken after careful consideration of the papers.

Evidence

10. The opponent filed a witness statement from Robert Snell, an employee of Lane IP Limited, the opponent's representatives, 21 March 2022.

11. Along with the witness statement, there are three exhibits, RS1 to RS3.

DECISION

12. Although the UK has left the EU, section 6(3)(a) of the European (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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

13. Sections 5(1) to 5(2) of the Act read as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.”

14. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(1) In this Act an “earlier trade mark” means—

(a) a registered trade mark, international trade mark (UK) a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.


(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

15. Given its filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark as defined above.

Comparison of the marks

16. The marks in these consolidated proceedings are shown below.

The opponent’s trade mark in both the lead case and the second case	The applicant’s trade mark in the lead case
POD	POD

	<p>The applicant's trade mark in the second case</p>
	

17. I first analyse the respective marks in the lead case.

18. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ('CJEU') held that:

“54 ... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

19. The opponent's mark is listed on the WIPO database as a word mark and hence is the plain word “POD”. The applicant's mark is the plain word “POD”. While the fonts used for the two marks are slightly different, I bear in mind the *Groupement Des Cartes Bancaires* case and conclude that the respective marks are identical.

20. I now move on to analyse the respective marks in the second case.

21. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 Case C-591/12P, *Bimbo SA v OHIM*, 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 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.”

22. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.
23. The opponent's mark consists of the plain word “POD”. This is the only thing that forms the overall impression of this mark.
24. The applicant's mark consists of the word “pod” in blue text in a stylised intertwined form. The stylistic elements have a visual impact, although to a lesser extent than the word “pod” which is the dominant and distinctive element of the mark.
25. Visually, the words in the marks are identical, albeit the applicant's mark is in all lower case. The applicant's mark also has blue, stylised text by comparison with the opponent's plain word mark. Overall, I find these marks to be highly similar visually.
26. Aurally, the comparison is between “POD” and “pod”. The marks are aurally identical.
27. Conceptually, both marks share the concept derived from the word “POD”/ “pod” – that of a seed container (the Collins online dictionary definition of

“pod” being “a seed container that grows on plants such as peas or beans”¹). The marks are conceptually identical.

28. It is a pre-requisite of sections 5(1) and 5(2)(a) of the Act that the trade marks are identical. The marks are identical in the lead case and so the opponent’s section 5(1) and 5(2)(a) claims in the lead case can move forward to the goods and services analysis. Given that the respective marks in the second case are not identical, the opponent’s section 5(1) and 5(2)(a) claims in the second case fall away.

Comparison of the goods and services

29. As the applications share identical specifications, the following comparison will apply to both of the applicant’s specifications. The competing goods and services are set out as follows:

The opponent’s goods	The applicant’s goods and services
	<u>Class 5</u> Pharmaceuticals; sanitary preparations and articles; anti-bacterial preparations; anti-bacterial sprays, wipes and cleansers; disinfectants; disinfectants for medical use; disinfectants for medical apparatus and instruments; sanitising preparations; hand-sanitising preparations; alcohol for medical use; wipes and tissues for medical use; washes (disinfectant) [other than soap]; antiseptics;

¹ www.collinsdictionary.com/dictionary/english/pod

	alcohol based antibacterial skin sanitiser gels; antiviral preparations; medicated handwash; sterilising solutions and preparations.
<p><u>Class 10</u></p> <p>Drug delivery systems; dosing aids and apparatus for medicines, namely, drug delivery and dispensing devices and systems; dosing aids and apparatus for medicines, in particular for medicines in liquid and granulated form, namely, machines for dispensing pre-determined dosages of medication; nasal, respiratory, and sinus drug delivery devices and parts therefor.</p>	<p><u>Class 10</u></p> <p>Medical, surgical and veterinary apparatus and instruments; diagnostic, examination and monitoring equipment; medical devices; medical instruments; medical masks; surgical masks; masks and equipment for artificial respiration; protective face masks for medical and surgical purposes; face masks for medical and surgical use for antibacterial protection; medical gloves; surgical gloves; disposable gloves for medical and surgical purposes; medical gowns; surgical gowns; sterile clothing for medical and surgical use; sterile surgical sheets; isolation gowns; surgical caps; shoe covers for medical and surgical purposes; eye shields for medical and surgical use; face shields for medical and surgical use; scanners for medical use; thermometers for medical purposes; temperature scanners for medical use; infrared apparatus for medical purposes; infrared thermometers for medical use;</p>

	medical ventilators; lamps for medical and surgical purposes; ultraviolet lamps for medical purposes; parts and fittings for the aforesaid goods.
	<u>Class 44</u> Health care; health advice and information services; health assessment surveys; health centres; health clinics; health screening; managed health care services; preparation of reports relating to health care matters; provision of health care information by telephone; nursing services; medical and dental services; medical screening; health screening services; advisory and consultancy services relating to all of the above.

30. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

31. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

32. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved

a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

33. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

34. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-

388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

35. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the GC stated that “complementary” means:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking.”

36. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

While on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

37. Robert Snell’s witness statement and supporting exhibits are of limited value. Exhibit 1 consists of printouts from the opponent’s websites and Exhibit 2 consists of printouts from the websites of third-party pharmaceutical companies. Both of these exhibits show real-world activity in the marketplace, and I must make a notional assessment of the goods and services. Exhibit 3 is of some assistance, being a third-party article on what a drug delivery system is.

Class 5

38. I compare the applicant’s “pharmaceuticals” with the opponent’s “drug delivery systems”. Pharmaceuticals being a synonym for drugs, the former is the content that is delivered by the latter’s systems. While they differ in nature and method of use, their purposes are closely aligned. Both would be used by medical professionals, albeit pharmaceuticals would also be used by the general public. In terms of trade channels, these would differ in that pharmaceuticals would be sold through chemists or procured through a separate channel by medical professionals than the channel through which they would purchase medical hardware (except where the drug delivery systems came pre-loaded with the relevant drugs). The goods are not in competition, but they are complementary. It is perfectly possible for drugs and drug delivery systems to be provided by the same company, or at least by the same corporate grouping. As such, the relevant public, medical professionals, are liable to believe that responsibility for the goods lies with the same undertaking or with economically connected undertakings. I find the respective goods to be of low similarity.

39. The applicant's "sanitary preparations and articles", "anti-bacterial preparations", "anti-bacterial sprays, wipes and cleansers", "disinfectants", "disinfectants for medical use", "disinfectants for medical apparatus and instruments", "sanitising preparations", "hand-sanitising preparations", "alcohol for medical use", "wipes and tissues for medical use", "washes (disinfectant) [other than soap]", "antiseptics", "alcohol based antibacterial skin sanitiser gels", "antiviral preparations", "medicated handwash" and "sterilising solutions and preparations" are all means of sanitising medical equipment, surfaces, or the body. As such, they differ in nature, purpose and method of use from the opponent's "drug delivery systems". While the competing goods are all used by medical professionals (albeit many of the applicant's goods can also be used by the general public), that is not a sufficient basis for a finding of similarity. The goods will typically be purchased through different trade channels, those of the suppliers of sanitisers and so on to hospitals and doctors' surgeries (but also supermarkets and chemists), and those of the suppliers of medical hardware. The respective goods are neither in competition, nor are they complementary. I find the respective goods to be dissimilar.

Class 10

40. The applicant's "medical, surgical and veterinary apparatus and instruments" are *Merix* identical to the opponent's "... apparatus for medicines ..." in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.

41. I compare the applicant's "diagnostic, examination and monitoring equipment" as well as its "masks and equipment for artificial respiration", "scanners for medical use", "infrared apparatus for medical purposes" and "medical ventilators" with the opponent's "drug delivery systems". While the respective goods have specific purposes, they have something in common in terms of their nature and methods of use. All such goods are mechanical, some coming with attachments and tubing, and will typically have circuitry and

monitors (drug delivery systems generally incorporating a means of monitoring the dosage). All are used directly on, or in close proximity to, a patient's body by medical professionals. In terms of trade channels, all the respective goods are forms of medical hardware that would be purchased for a hospital ward or operating theatre and hence they will share trade channels. They would only be in competition to a limited degree in relation to the applicant's monitoring equipment were the consumer to face a choice between a drug delivery system requiring the purchase of separate monitoring equipment and that which came with integrated monitoring equipment. The goods are not complementary. I find the respective goods to be of medium similarity.

42. Given that I have found the applicant's "masks and equipment for artificial respiration" to be of medium similarity to the opponent's goods, the opponent's broad term "medical masks" is also caught by this finding.

43. The applicant's "medical devices" are *Merix* identical to the opponent's "nasal, respiratory, and sinus drug delivery devices and parts therefor" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.

44. I compare the applicant's "medical instruments", along with its "thermometers for medical purposes", "temperature scanners for medical use", and "infrared thermometers for medical use" with the opponent's "drug delivery systems". The former are medical "tools of the trade" which are made from metal or plastic, and they are hand-held. The latter are mechanical, often with tubes that are attached to the patient, but sometimes they are hand-held. The respective goods are all used by medical professionals. They would be purchased through the same trade channels, albeit they would be categorised differently. They are neither in competition, nor are they complementary. I find these goods to be of low similarity.

45. While the applicant's "lamps for medical and surgical purposes" and "ultraviolet lamps for medical purposes" do not come into contact with the

patient like the opponent's "drug delivery systems", the respective goods are all forms of medical hardware that would be used by medical professionals. They would all be purchased through the same trade channels, although they would be categorised differently and therefore this will have a limiting effect on the overlap of the trade channels. They are neither in competition, nor are they complementary. I find these goods to be of very low similarity.

46. The applicant's "surgical masks", "protective face masks for medical and surgical purposes", "face masks for medical and surgical use for antibacterial protection", "medical gloves", "surgical gloves", "disposable gloves for medical and surgical purposes", "medical gowns", "surgical gowns", "sterile clothing for medical and surgical use", "isolation gowns", "surgical caps", "shoe covers for medical and surgical purposes", "eye shields for medical and surgical use" and "face shields for medical and surgical use" are all forms of protection worn on the body. They are made of paper, cloth or plastic, and are only worn once before being disposed of or sterilised. As such, they differ in nature, purpose and method of use from the opponent's "drug delivery systems". While the competing goods are all used by medical professionals, that is not a sufficient basis for a finding of similarity. The goods will typically be purchased through different trade channels, those of the suppliers of single use clothing and those of the suppliers of medical hardware. The respective goods are neither in competition, nor are they complementary. I find the respective goods to be dissimilar.

47. I make the same finding of dissimilarity for the applicant's "sterile surgical sheets" as I have in the preceding paragraph.

Class 44

48. Services and goods are necessarily different in nature, but the applicant's "health care", "health centres", "health clinics", "managed health care services", "nursing services" and "medical and dental services" are packaged services that would include the deployment of the opponent's goods - "drug

delivery systems". While the nature of the goods and services differs, both share the broad purpose of ameliorating the health of patients. The trade channels will ordinarily usually diverge, the services being primarily aimed at the general public, while the goods are aimed at medical professionals. The services and the goods are not in meaningful competition. While it is difficult to conceive of the opponent's goods being used other than via the applicant's services, and hence they are indispensable to the opponent's goods, they are not strictly speaking complementary because the relevant public are not liable to believe that responsibility for the services and goods lies with the same undertaking or with economically connected undertakings. I find the respective services and goods to be of very low similarity.

49. I compare the applicant's "health screening", "medical screening" and "health screening services" to the opponent's "drug delivery systems". Health screening is a separate process from administering drugs and I find the services and goods to be different in nature, method of use, and trade channels. They are neither in competition, nor are they complementary. While the respective services and goods share the broad aim of improving the health of patients, I do not consider that alone to be a sufficient basis for similarity and I find these services and goods to be dissimilar.

50. I make the same finding – that of dissimilarity – for "health advice and information services", "health assessment surveys", "preparation of reports relating to health care matters" and "provision of health care information by telephone" which are services that do not involve the physical delivery of healthcare. These services are an even further remove from the opponent's "drug delivery systems" than those services discussed in the previous paragraph.

51. As some degree of similarity between the goods and services is required for there to be a likelihood of confusion², the opposition fails in respect of the following goods and services:

² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

- Class 5 Sanitary preparations and articles; anti-bacterial preparations; anti-bacterial sprays, wipes and cleansers; disinfectants; disinfectants for medical use; disinfectants for medical apparatus and instruments; sanitising preparations; hand-sanitising preparations; alcohol for medical use; wipes and tissues for medical use; washes (disinfectant) [other than soap]; antiseptics; alcohol based antibacterial skin sanitiser gels; antiviral preparations; medicated handwash; sterilising solutions and preparations.
- Class 10 Surgical masks; protective face masks for medical and surgical purposes; face masks for medical and surgical use for antibacterial protection; medical gloves; surgical gloves; disposable gloves for medical and surgical purposes; medical gowns; surgical gowns; sterile clothing for medical and surgical use; sterile surgical sheets; isolation gowns; surgical caps; shoe covers for medical and surgical purposes; eye shields for medical and surgical use; face shields for medical and surgical use; parts and fittings for the aforesaid goods.
- Class 44 Health advice and information services; health assessment surveys; health screening; preparation of reports relating to health care matters; provision of health care information by telephone; medical screening; health screening services; advisory and consultancy services relating to all of the above.

52. A requirement of a successful opposition based on section 5(1) of the Act is that the goods and services are identical. I have found the applicant's "medical, surgical and veterinary apparatus and instruments" and its "medical devices" to be identical to the opponent's goods. The opponent's section 5(1) claim in the lead case therefore succeeds for those identical goods.

Case law

53. 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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Distinctive character of the earlier mark

54. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

55. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

56. The word “POD” is not particularly suggestive of the goods for which the mark is registered. It is a dictionary word with a well-known meaning. I find the mark to be inherently distinctive to a medium degree.

The average consumer and the nature of the purchasing act

57. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J 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.”

58. The competing goods and services are pharmaceuticals, medical equipment (including drug delivery systems), and healthcare services. For individual purchasers of health goods and services, the types of purchase would vary considerably, from routine care to the treatment of potentially life-threatening conditions, and so the extent of the scrutiny of the services and the cost would differ accordingly. Nevertheless, the level of attention paid would, on average, be medium. Collective purchasers of health goods and services would often need to draw up contracts, and patient safety would be paramount, so a high level of attention would be required. Overall, the level of attention paid would be medium to high.

59. In the case of the individual consumer for the applicant's pharmaceuticals, visual considerations would play an important role at point of sale, but consultation with a pharmacist might be required at which point verbal

factors would also play a key role. For the remaining goods and services, initial contact would be through websites and brochures where visual considerations would predominate. Verbal factors may come into play as the purchasing process develops, so I do not rule those out.

Likelihood of confusion

60. 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 and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services 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.

61. Earlier in this decision (except where I found the goods and services to be dissimilar), I found the goods and services to be either identical or similar to a medium, low, or very low degree. I have found the earlier mark to be of a medium level of inherent distinctiveness. The average consumer of the parties' goods and services will pay a medium to high level of attention during the purchasing process. In the case of the individual consumer for the applicant's pharmaceuticals, visual considerations would play an important part, but verbal factors would also play a key role. For the remaining

goods and services, visual considerations would predominate, but I do not rule verbal factors.

Lead case: OP000422919

62. In respect of the opponent's section 5(2)(a) claim I find that there would be a likelihood of direct confusion for all those goods and services that I have found to be similar, this finding extending to those goods and services that I have found to be of very low similarity. There is no minimum threshold level of similarity between the services that must be shown as it is sufficient that some similarity exists in order to consider the likelihood of confusion.³

63. I do not need to consider the opponent's section 5(2)(b) claim, the respective marks being identical.

Second case: OP000422923

64. In respect of the section 5(2)(b) claim, I have found the parties' marks to be highly similar visually, and identical aurally and conceptually and I consider it highly likely that the average consumer would mis-recall one mark for the other, the only differences between the marks being those of the application of a different colour and some stylisation to what are identical single words. On that basis, I find that there would be a likelihood of direct confusion for all those goods and services that I have found to be identical or similar, this finding extending to those goods and services that I have found to be of very low similarity.

65. If I am wrong, the average consumer would see the applicant's mark as a brand variation of the opponent's plain word mark and would, therefore, be indirectly confused.

³ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

CONCLUSION

66. Subject to appeal, and in respect of both cases – the lead case OP000422919 and the second case OP000422923 – the oppositions succeed in relation to the following goods and services:

Class 5 Pharmaceuticals.

Class 10 Medical, surgical and veterinary apparatus and instruments; diagnostic, examination and monitoring equipment; medical devices; medical instruments; medical masks; masks and equipment for artificial respiration; scanners for medical use; thermometers for medical purposes; temperature scanners for medical use; infrared apparatus for medical purposes; infrared thermometers for medical use; medical ventilators; lamps for medical and surgical purposes; ultraviolet lamps for medical purposes; parts and fittings for the aforesaid goods.

Class 44 Health care; health centres; health clinics; managed health care services; nursing services; medical and dental services; advisory and consultancy services relating to all of the above.

67. The applications will proceed to registration for the following goods and services:

Class 5 Sanitary preparations and articles; anti-bacterial preparations; anti-bacterial sprays, wipes and cleansers; disinfectants; disinfectants for medical use; disinfectants for medical apparatus and instruments; sanitising preparations; hand-sanitising preparations; alcohol for medical use; wipes and tissues for medical use; washes (disinfectant) [other than soap]; antiseptics; alcohol based antibacterial skin sanitiser gels;

antiviral preparations; medicated handwash; sterilising solutions and preparations.

Class 10 Surgical masks; protective face masks for medical and surgical purposes; face masks for medical and surgical use for antibacterial protection; medical gloves; surgical gloves; disposable gloves for medical and surgical purposes; medical gowns; surgical gowns; sterile clothing for medical and surgical use; sterile surgical sheets; isolation gowns; surgical caps; shoe covers for medical and surgical purposes; eye shields for medical and surgical use; face shields for medical and surgical use; parts and fittings for the aforesaid goods.

Class 44 Health advice and information services; health assessment surveys; health screening; preparation of reports relating to health care matters; provision of health care information by telephone; medical screening; health screening services; advisory and consultancy services relating to all of the above.

COSTS

68. The applicant has been the more successful of the two parties in these consolidated cases. I award proportionate costs accordingly.

69. In line with Annex A of Tribunal Practice Notice 2 of 2016, I award costs to the applicant as below.

Preparing statements and considering the other side's statements:	£150
Considering the other side's evidence:	£225
Preparation of submissions:	£300
Total:	£675

70. I order Impel NuroPhrama, Inc. to pay Pods Group Limited £675. 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 this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of May 2023

JOHN WILLIAMS
For the Registrar