

O-010-14

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 2633995
BY BRISTOL LABORATORIES LIMITED
TO REGISTER THE TRADE BRIMISOL IN CLASS 5
AND
OPPOSITION THERETO UNDER NO. 104301
BY BIOFARMA SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE

TRADE MARKS ACT 1994

IN THE MATTER OF Application No. 2633995

by Bristol Laboratories Limited

to register the trade mark BRIMISOL in Class 5

And

OPPOSITION THERETO under No. 104301

by Biofarma Société par actions simplifiée

BACKGROUND

1. On 7 September 2012, Bristol Laboratories Limited applied to register the trade mark BRIMISOL in Class 5 for the following goods:

Pharmaceutical compounds; analgesic compounds.

2. The application was published in the Trade Marks Journal on 5 October 2012. On 28 December 2012, Biofarma Société par actions simplifiée filed an opposition based on the following ground:

Section 5(2)(b) because the opposed mark is similar to an earlier mark owned by the opponents, and is sought to be registered in respect of goods that are identical or similar, such that there is a likelihood of confusion.

3. As part of their Statement of Grounds of Opposition the Opponents say the following:

“1. The Opponent is the registered proprietor of the earlier Community Trade Mark Registration No. 10832053 PRIBISOL (“the Registration”)

2. The mark BRIMISOL of Application No. 2633995 (“the Application”) is visually and phonetically highly similar to the mark of the Registration. Each mark has eight letters of which seven are common to each mark and six of which are found in the same order (-RI-ISOL). Even though the initial letters are different, they are phonetically similar in that the letter ‘B’ is the voiced equivalent consonant to the unvoiced ‘P’.

3. The Application is for goods which are identical to the goods of the Opponent’s Registration.”

3. Details of the earlier mark relied upon by the opponents are as follows:

Number: CTM 10832053

Mark: PRIBISOL

Filing date: 24/04/2012

Registration date: 05/09/2012

Class: 5

Specification: Pharmaceutical and veterinary preparations; Sanitary preparations for medical purposes; Dietetic food and substances adapted for medical or veterinary use, food for babies; Dietary supplements for humans and animals; Plasters, materials for dressings; Material for stopping teeth, dental wax; Disinfectants; Preparations for destroying vermin; Fungicides, herbicides; Bath preparations, medicated; Chemical preparations for medical or pharmaceutical purposes; Herbs for medicinal purposes; Herbal tea; Antiparasitic preparations; Alloys of precious metals for dental purposes.

4. The applicants filed a Counterstatement in which they say:

“It is commonly accepted that when comparing trademarks, a greater degree of significant (sic) should be placed on any similarities or differences between the first part of word marks, rather than to their suffixes (see for example Tripcastroid TM (London Lubricant) (1925) 42 R.P.C. 264)

It is submitted that that approach is especially appropriate in the present case since the suffix – SOL, and to a lesser but still very significant extent, the suffix – ISOL is extremely common (sic) both on the register in class 5 and in use in the pharmaceutical field. Consequently, the suffix of the two trademarks to be compared is of relatively low significant (sic) in terms of the distinctive character of the trademarks as compared to the opening prefixes PRIB - and BRIM -.

In other words, as far as both trademarks are concerned there is a dominant contribution towards distinctive character provided by the respective prefixes than by the respective suffixes, which are common in the field.

There is no realistic sense in which the prefixes PRIB – and BRIM – could be considered to be visually or phonetically similar.

Even if the marks are considered as a whole with no special emphasis being placed on the beginning of the marks there is still a lack of visual of (sic) phonetic similarity. The Opponent’s attempts to suggest otherwise amount to convenient selection of certain letters from each trademark which it says are identical in each case and that of course is true, but the artificial nature of that selection fails to recognise the visual and phonetic differences between the marks when considered as a whole and, in particular, the beginnings of the trademarks, to which more weight should be given in the assessment given bearing in mind the ubiquitous nature of the suffix in the pharmaceutical field.

Consequently, the marks are not similar and the Applicant requests refusal of the opposition, acceptance of the application, and an award of costs in its favour.”

5. Only the Opponents filed evidence, a summary of the relevant parts is given below.

6. Neither party requested to be heard. The Opponents did, however provide written submissions in support of their case in lieu of attending a hearing. After a careful study of the papers and submissions I now go on to give my decision.

The Evidence

7. This consists of a Witness Statement dated 22 May 2013 made by Matthew Peter Smith, a Senior Associate and trade mark attorney employed by Abel & Imray, the Opponent's representatives in these proceedings.

8. Mr Smith begins by referring to the Counterstatement in which the Applicants say that "...the suffix – ISOL ...is extremely (sic) common (common?) both on the register in class 5 and in use in the pharmaceutical field" and refers to the "...ubiquitous nature of the suffix in the pharmaceutical field." He says that in light of these claims, an investigation was carried out using a combination of the Catamaran trade mark search system, the Monthly Index of Medical Specialities (MIMS) and a search of the internet, the results of which are shown as exhibits. Mr Smith says that this revealed a number of marks with the ISOL suffix on the UK, CTM and Madrid International registers with only four; "GRISOL and GRISOL AF", "HIBISOL", "GENISOL" and "CLINISOL SOLN RRG" having "any indicium of use, either now or in the past.

9. Further details of three of these marks are shown as Exhibits MPS1 to MPS3 which consist of details from MIMS for "GRISOL AF (P)", an athlete's foot treatment, a liquid hand scrub sold as "HIBISOL", and a shampoo called "GENISOL" from Farmacile.com. Mr Smith suggests that the last two ceased to be in active use back in 2008. He says that no evidence was found that the CLINISOL mark had ever been used in the UK at the time of filing of the opposed trade mark, adding that the registration expired in 2010.

10. Exhibits MPS4 and MPS5 he describes as "full and complete lists of all pharmaceutical products available in the UK in September 2012, the month of filing of the opposed application, as listed in the MIMS print catalogue and online database. Mr Smith draws attention to the fact that of the four previously mentioned only the GRISOL AF mark is listed.

11. Mr Smith concludes saying that based on this evidence it would appear that there is no active use in the UK of any three syllable mark with the suffix –ISOL for a pharmaceutical product at the date of filing.

DECISION

12. The opposition is founded under Section 5(2)(b) of the Act, which reads 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.”

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

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community 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.”

14. For the record the earlier trade mark is not subject to proof of use as per Section 6A of the Trade Marks Act 1994 as it had not been registered for five years at the time of the publication of the Opposed trade mark application.

Section 5(2)(b) – case law

15. As proposed by the Opponents, the standard authorities are those as set out in the decision of Mr Geoffrey Hobbs QC in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), which are (by reference to the CJEU cases mentioned) as indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

The principles

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

16. For the record, I have no evidence that the opponents have made any use of their earlier mark, let alone that they have done so to the extent that I should take the existence of a reputation into account when assessing their distinctive character as part of the global consideration of the likelihood of confusion.

Comparison of the respective goods

17. In assessing the similarity of the respective goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the goods in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the judgment:

‘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 and their

method of use and whether they are in competition with each other or are complementary.’

18. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

19. Although I have cited the relevant case law, for the reason I shall give I do not see that this is a question of whether the goods are similar. The applicants seek registration in Class 5 for “Pharmaceutical compounds. The Opponent’s earlier trade mark is registered in the same class, and for goods including “Pharmaceutical preparations”, so both cover “pharmaceuticals” differing only in the description of their form. Self-evidently these goods are identical.

20. The remaining part of the Applicant’s specification covers “analgesic compounds”. The Online Collins English Dictionary refers to “analgesic” as “a substance that produces analgesia” and “analgesia” as “the relief of pain”. Although not specifically mentioned in the specification of the Opponent’s earlier mark, I am mindful of the decision in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05* in which the General Court said:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

21. Collins gives a definition of “pharmaceutical” as “of or relating to drugs or pharmacy”, and on the principles outlined in *Meric* is a general description of a category of goods that would include “analgesic compounds”. That being the case these must also be identical goods.

The average consumer and nature of the purchasing decision

22. In determining the average consumer I am mindful of the decision in *Mundipharma AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-256/04* in which the Court stated:

“44 Second, it has not been disputed in the present case that the relevant public for the goods covered by the mark applied for, namely therapeutic preparations for respiratory illnesses, is made up of patients in their capacity as end consumers, on the one hand, and health care professionals, on the other.

45 As to the goods for which the earlier mark is deemed to have been registered, it is apparent from the parties’ written submissions and from their

answers to the questions put at the hearing that some therapeutic preparations for respiratory illnesses are available only on prescription whilst others are available over the counter. Since some of those goods may be purchased by patients without a medical prescription, the Court finds that the relevant public for those goods includes, in addition to health care professionals, the end consumers.”

23. The Opponents refer me to the decision of the Registrar’s Hearing Officer in decision BL 0-148-06 in which it was concluded that in circumstances such as in this case “there is no single homogenous group of consumers”; I have no argument with this. That the goods of the earlier mark are not limited means that they would include both those only available on prescription and those available for purchase over the counter or via self-selection from a supermarket shelf. The relevant public for prescription-only pharmaceuticals is both the prescriber and the patient, although in the case of pharmaceuticals administered in hospital the relevant public is more likely to be the physician and hospital pharmacist. For goods available over-the-counter or by self-selection the average consumer is the general public.

24. The level of attention in relation to pharmaceuticals will vary according to their nature and use. In *Armour Pharmaceutical Co v OHIM*, Case T-483/04, the CFI stated:

“79 The Court finds that the level of attention of the average consumer of pharmaceutical preparations must be determined on a case-by-case basis, according to the facts in the case-file, especially the therapeutic indications of the goods in question. Likewise, the Court finds that, in the case of medicinal products subject to medical prescription such as those being considered in the present case, that level of attention will generally be higher, given that they are prescribed by a physician and subsequently checked by a pharmacist who delivers them to the consumers.”

25. Further in *Aventis Pharma SA v OHIM*, Case T-95/07, the CFI stated:

“29 First, as noted in the case-law, medical professionals display a high degree of attention when prescribing medicinal products. Second, with regard to end-consumers, it can be assumed, where pharmaceutical products are sold without prescription, that the consumers interested in those products are reasonably well informed, observant and circumspect, since those products affect their state of health, and that they are less likely to confuse different versions of such products (see, to that effect, Case T-202/04 *Madaus v OHIM – Optima Healthcare (ECHINAID)* [2006] ECR II-1115, paragraph 33). Furthermore, even supposing a medical prescription to be mandatory, consumers are likely to display a high degree of attention when the products in question are prescribed, having regard to the fact that they are pharmaceutical products (*ATURION*, paragraph 27).”

26. The medical professional is likely to display a high degree of attention in relation to prescribing pharmaceutical goods, but the general public also displays a high degree of attention when given a prescribed medicament.

27. For products sold without prescription, even those of low cost, the general public will be reasonably well informed, observant and circumspect and will pay a

reasonable level of attention to the selection of a product. They do not have the benefit of a prescription from the medical professional to guide them and will take care to ensure that the medicament matches the need arising from the ailment. The consumer is more likely to be subject to the effects of imperfect recollection than the medical professional whose level of attention and expertise will be greater than those of a member of the general public.

Comparison of trade marks

28. In making a comparison between the marks, I must consider their visual, aural and conceptual similarities with reference to the overall impression that they create. Whilst there cannot be any artificial dissection of the trade marks, it is necessary to take account of any distinctive and dominant components.

29. The opponent's earlier mark consists of the single word PRIBISOL presented in plain block capitals. The mark applied for also consists of a single word in plain block capitals, in this case BRIMISOL. The Opponents assert that these are visually and phonetically highly similar because each has eight letters, seven of which are common to each mark of which six are found in the same order (-RI-ISOL), and that the initial letters "B" and "P" are phonetically similar.

30. The applicants in turn argue that the beginnings of word trade marks are usually taken to be more important or dominant than the ends. Connected to this they argue that the suffix "SOL" and to a lesser but still significant extent, the suffix "ISOL" is extremely "column" (sic) which I take to be a mistyping of common, both on the trade marks register in class 5, and in use in the pharmaceutical field. Consequently they invite me to give the suffix a relatively low significance in terms of the distinctive character as compared to the opening prefixes "PRIB" and "BRIM".

31. The Applicant's then refer me to the Tripcastroid case which they say set in place a general rule of thumb relating to "..... the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and in my judgment, the first syllable of a word is, as a rule, far the most important for the purpose of distinction". This is not dealing with a point of law as such but a matter of human behaviour, that is to say how the public approaches words. Although a case under the preceding law this principle set down in Tripcastroid has become a standard that has continued to be used with approval in decisions such as joined cases T-183/02 and T184/0276 - El Corte Inglés, SA v OHIM - González Cabello, SA al d Iberia Líneas Aéreas de España, (MUNDICOR) [2004] ECR II – 965, paragraph 81.

32. However, cases such as "INADINE and ANADIN" ([1992] RPC 421), "VICROM and EYE-CROM" ([1994] FSR 745) and OROPRAM and SEROPRAM (BL 0-208-02), show that differences in the initial elements of word marks do not necessarily lead to a dissociation in the perceptions and recollections of 'consumers' of 'pharmaceutical preparations' at large. What is clear is that each case must be decided on its merits considering the marks as wholes.

33. When looking to read a word it is natural to start from the beginning. With the straight backbone and the looped front there is a certain visual similarity between the letters P and B although each is readily discernible to the eye. That these letters are both followed by the letters "RI" adds to their visual similarity but the very different

appearance of the following letters “B” and “M” significantly detracts from this. The remaining parts of the marks may be identical and the mark as a whole may also share features such as the number and sequencing of letters, but to my mind does not draw the attention away from the earlier differences. These are words with a low degree of visual similarity.

34. If enunciated clearly there is limited aural similarity between a letter P and a letter B. The similarity increases when the P or B is followed by a consonant (and particularly the same consonant) which will have the effect of softening their contribution to the sound. The next vowel and consonant have a significant contribution to the first syllable. Here, both have the letter “I” as the vowel but then a letter “B” in the case of the Opponent’s marks and a letter “M” in the mark applied for. The Opponents refer to the letters “B” and “M” as a “small point of difference” that does not counteract the overall phonetic similarity; I do not agree. The letter “B” creates quite a hard sound that defines the first syllable whereas the “M” is softer and performs more of a smooth bridging sound to the next syllable. The remaining parts of the words may be identical, but their sound when spoken will again be affected by the jump-off from the harder B or the softer M, and the tendency to be less precise or lazy in enunciating the endings of words. So whilst the words may as a whole share features, including the number and sequencing of letters, I do not consider the words PRIBISOL and BRIMISOL to have more than a moderate level of aural similarity.

35. As far as I am aware, and there is no evidence or argument otherwise, PRIBISOL and BRIMISOL are not words extracted from language. The Opponent’s say that “...the common –ISOL suffix (by common I take this to mean common to both marks) might “suggest or allude to dissolving which would bring the marks closer together. In the OROPRAM case (0/208/02) to which the Opponent’s refer me, Professor Annand stated at paragraph 24:

“In the applicant’s own admission the prefix of OROPRAM suggests oral delivery. That coupled with the degree of similarity in the marks, the identity of the goods and the high distinctiveness of SEROPRAM, leads me to conclude that the average consumer is likely to consider that “medicine and medicinal products intended for human therapy” offered under the mark OROPRAM originate from the opponents or an undertaking economically linked to the opponents in the sense that they are different products in the same range (Wagamama Ltd v. City Centre Restaurants plc [1995]FSR 713).”

36. If the -ISOL suffix will be perceived by the consumer in the way that the Opponent’s “suggest”, this to my mind will have the reverse effect than in the OROPRAM case by placing greater significance on the element where the differences are and diminishing rather than increasing the argument for similarity. This aside, I agree with the Opponents when they say that to the relevant consumer, both PRIBISOL and BRIMISOL will be seen as invented words with no descriptive relevance for the goods in question, and thus are neutral in the concept they convey.

37. The Opponent’s refer to a series of cases involving goods in Class 5 where the respective marks were found to be similar, although they do not recite any of the relevant facts. Whilst I can take notice of the information that is in the public domain this may not include everything that would have contributed to the assessment of

similarity. In expressing my views on the relevance of the cited cases, I am mindful that similarity is not just word against word; there is an interdependency with other factors such as the relative distinctiveness and dominance of component parts which are often a matter of perspective and balance. Whilst I do propose to “second-guess” the decisions, it is inevitable that my comments on why I consider them to be relevant or distinct will touch on the basis of the decision, but at the end of the day the decision I must take must be based on the facts and circumstances of this case.

38. The first case referred to is PLENDIL against FELENDIL. Although not mentioned by the Opponent’s this case went to an appeal before Mr Hobbs QC sitting as the Appointed Person (BL O-079-07). In his summary Mr Hobbs noted that the Hearing Officer had made his assessment “...with reference to the particular products for which there had been actual use of the trade marks...” which was taken as “...a litmus test for the contested specification as a whole.” The Hearing Officer had said:

“43. I have found this to be a finely balanced decision. Not without hesitation I find that the effect of the above considerations points to a likelihood of confusion. Even if the different first elements to the marks was sufficient to overcome direct confusion I consider that sequential rather than concurrent acquaintance with the marks (particularly by non professionals) coupled with the fact that the goods are of the same composition and directed at the same clinical need points at the very least to an association in the sense that the public would wrongly believe that the respective goods came from the same or economically linked undertakings or that one product was a development or revised formulation of the other. The opposition succeeds under Section 5(2)(b).”

39. Mr Hobbs QC further summarised the Hearing Officer’s view expressed in Paragraph 25 of his decision that “audible compression” and “normal intonation on audible enunciation” would in each case result in emphasis being placed on the elements which the words PLENDIL and F(E)LENDIL have in common. For the reasons I have given I do not consider that to be the position in respect of PRIBISOL and BRIMISOL.

40. The next case concerned EVONISE and EVARISE which also went on appeal to the Appointed Person, in this case Professor Ruth Annand . In her summary of the decision Professor Annand referred to these being seven-letter invented words, sharing the first element “EV” and terminating element “ISE”. In my view, that the difference resides solely in the middle imposes less visual and aural impact than the differences in the marks at issue here.

41. In the case of REMICADE and HUMICADE the Registrar’s Hearing Officer found there to be “...little likelihood of direct confusion between the marks given the overall differences between them.” He concluded that the “HU” prefix would be recognised by prospective customers, in this case, medical professionals, as being semi-descriptive that the applicant’s goods are made from **h**uman proteins, leaving the remainder of the mark the same as the middle and end of REMICADE. The Hearing Officer placed weight on the failure to explain the adoption of the “MICADE” suffix in HUMICADE and that the evidence showed no other products in the market with a “CADE” or “MICADE” suffix for the goods at issue. In the case of PRIBISOL and

BRIMISOL the applicant's assert that "...the suffix – ISOL ...is extremely common both on the register in class 5 and in use in the pharmaceutical field". There is limited evidence of other traders having adopted, if not used the suffix for their trade marks but little can be made of this. Nevertheless, it is possible to distinguish the REMICADE case from the position here.

42. I have already mentioned the OROPRAM case which in my view can be distinguished because the prefix was taken to suggest oral delivery, leaving the significant remainder of the mark identical to SEROPRAM, and to a conclusion by the average consumer that the mark OROPRAM originate from the opponents or an undertaking economically linked. In the case of PRIBISOL and BRIMISOL the similarity is far less marked and the differences cannot be dispensed with in the same way as the prefix in OROPRAM.

43. In respect of MELISANA and VERISANA the OHIM The decision mentions that the marks coincide in the letters "- E * ISANA ", differing only in respect of the initial and third letter, and on this basis are visually similar, although not the degree of this similarity. Whilst this sequencing matches the position in PRIBISOL and BRIMISOL, in my view the effect of the differences is to endow these two words with similarity to a moderate degree. When looking at the aural similarities of MELISANA and VERISANA the decision acknowledged that although there would be differences in the pronunciation of the respective first and third letters, the respective last two syllables "SA -NA" and the sound of the letter "E" and "I" on the second and fourth position matched. There is no comment on the degree of impact of the different letters. In the case of PRIBISOL and BRIMISOL I would say that the impact would be of a similar level, but in the fourth letter this would be a significantly higher than the third letter difference in the cited case, and the overall impact. From a conceptual standpoint the decision acknowledged that whilst neither mark in its entirety had a meaning, "SANA" would be associated by a substantial part of the relevant public with health-related products and in this respect, the characters are conceptually similar. Notwithstanding the Opponents mention of a suggested or allusive descriptiveness in the "-SOL" or "-ISOL" suffix (which is not established) there is a neutral position conceptually in the case of PRIBISOL and BRIMISOL, and as a whole the position here can be distinguished.

44. In the opposition by the owners of FEMOSEAL to registration of HEMOSEAL the Fourth Board of Appeal found the signs to be visually "highly similar" because they differed only in their initial letters differences in the first letter which "cannot neutralize the similarities arising from the common letter sequence". The difference between PRIBISOL and BRIMISOL is much more than just the initial letter. The Board of Appeal also found there to be at least an average degree of aural similarity which I would have to say is higher than the marks under consideration here. In common with PRIBISOL and BRIMISOL the marks were found to be conceptually neutral.

45. I have not been able to find a decision for CINACRYL and SILACRYL. The OHIM website shows two applications to register SILACRYL with an opposition being filed against one (CTM Number 617977) but recording that the opposition was withdrawn without a decision being made.

46. The assessment of the Opposition Division in respect of RHIZOVIT and RHODOVIT is very brief with little in the way of reasoning in their finding of similarity. However, the visual difference between PRIBISOL and BRIMISOL is more prominent than letters in the body of the words, and the aural impact created by these differences more profound. Taking account that PRIBISOL and BRIMISOL are also conceptually neutral the circumstances that lead to a finding of similarity in the case in question can be distinguished.

47. Although the decision in SILCOSIL and ZIRCOSIL is not available in English, I can see why there may have been a finding of similarity. The letters S and a Z have a certain visual similarity, and when both are followed by the letter I and the suffix COSIL, there is a reasonable possibility of the different use of the letters L and R being overlooked. In the context in which they are used the letters S and Z also have aural similarities created by the following letter I. The fourth position in each word is a letter C. This contributes a hard sound that softens the impact of the preceding letter, which, combined with the identity in the remaining letters creates a strong aural similarity. Both marks are conceptually neutral. This is a different situation to PRIBISOL and BRIMISOL where the visual and aural differences in the initial letters and particularly the first syllable, is more evident and lessen the significance of endings.

48. The marks PROMOXIN and POLMOXIN were found to be visually similar because they both have eight letters, predominantly the same in form and sequence, and a letter "O" of the first parts of the marks in common, albeit in different positions. They were also considered to coincide in the sound of the last two syllables, and although differing in the sound of the first syllable "PRO" against "POL", the sound of the letters "P" and "O" is the same. It seems that significant weight has been placed on the impact of the first letter and the termination OMOXIN. To me this seems reasonable, particularly from an aural standpoint where PRO and POLO both have an "O" sound with a significant contribution being made by OMOXIN. Although PRIBISOL and BRIMISOL have the letters –RI-SOL in common, to my mind the difference created by the first letter and particularly in the fourth letter is more pronounced and the impact greater.

49. In the opposition by the owners of WINTANYL to the registration of VICTANYL the decision refers to the words being the same length, coinciding in the letters "I-TANYL". In the visual assessment they say that the first letters (W vs V) are also similar in the sense that the latter constitutes a duplicate of the first, and as a whole there is a high degree of visual similarity. To that extent this coincides with the situation in PRIBISOL and BRIMISOL albeit there is less similarity in the look of a letter P and B. In the cited case the remaining difference is in the ending of the first syllable, where, having two letters lessens the visual impact of difference in the letters (N as opposed to C). In PRIBISOL and BRIMISOL the letter at the end of the first syllable stands alone making the difference clearer to the eye. In a finding of a high degree of aural similarity between WINTANYL and VICTANYL the decision mentions them differing only in respect of the first of their three syllables, and that having the same number of syllables creates a similar rhythm and intonation. Whilst the number of syllables is clearly relevant, to focus on this overlooks the contribution of each letter and syllable to the sound, in particular, the beginning of the words which as I have already mentioned will be enunciated more clearly. When spoken in isolation there is a strong aural similarity between a letter P and a B, but the

following letters that form the first syllables of PRIBISOL and BRIMISOL change so that they have reasonably distinct sound. The fourth letters (B and M) have particular impact, creating a sound that in each case is quite distinct, reducing the degree of aural similarity of the words than to below that in cited case. The conceptual consideration is not influence the assessment of similarity of any of the signs.

50. The assessment of the similarity between RISPOVAL and REPROVAL refers to the words being similar in length, coinciding in the letters “R” and “P_OVAL”. The decision acknowledged that a certain difference exists at the beginnings which do not share the letters “E” and “R” and that the position of the letter “P” varies. Although not specifically mentioned, there is also a difference in the use of the letter “S”. Based on the common letters the words were considered to be visually similar to a certain degree, which must also be the position with PRIBISOL and BRIMISOL. However, in PRIBISOL and BRIMISOL the letter at the end of the first syllable stands alone making the difference clearer to the eye than in the cited case. When considering aural similarity the decision referred to the marks coinciding in the sound of the letters “R-P-OVAL”, and to that extent are aurally similar. It is not clear what if any relevance was placed on different pronunciation in different parts of the relevant territory (EU) for having said that this was not material the decision went on to say that “It has to be considered that in many countries of the European Union “E” and “I” or “RI” and “RE” are not pronounced in a clearly different way, but sound rather similar.” Nevertheless, the finding was that the similar vowel structure and the partially identical consonant structure there was average phonetic similarity. As I have already said, the first syllables of PRIBISOL and BRIMISOL have reasonably distinct sounds particularly caused by the differing fourth letters, such that any aural similarity is on the lower side of average. Again, the conceptual consideration did not influence the assessment of similarity of any of the signs.

51. The penultimate case mentioned involved the opposition to the registration of TOPENTRA relying on the earlier mark LOSENTRA. The finding of a “medium degree of visual similarity” was based on the marks coinciding in the second letter O and the string of letters ENTRA. With the difference being in the first letter and the ending of the first syllable this coincides with the situation in PRIBISOL and BRIMISOL. When looking at how the respective marks will sound, the decision broke the marks into syllables when considered “in Spanish”, stating they coincide in the third syllable TRA, and share similarities in the first and second syllables “LO/TO” and “SEN/PEN”. The decision said that the accent will be on the similar syllable SEN/PEN, and given the commonality in the use of certain letters, the rhythm and the intonation will be similar. To my mind this is not how the words will be considered by the English speaking consumer, where the aural structure will be formed by each letter, and be governed by the letters that precede and follow. In the case of PRIBISOL and BRIMISOL the enunciation will be “PRIB”, “BIS” and “SOL” and “BRIM”, “MIS” and “SOL”, with most emphasis on the first syllable.

52. The final case referred to by the Opponents is an opposition to the registration of RESVEROL based on the earlier mark LESTEROL. In the decision it was identified that the conflicting marks share six of eight letters with an identical sequence, differing only in the initial letters and in the consonants ‘T’ versus ‘V’ placed in the fourth position. As there are more similarities than differences the marks were deemed to look similar at least to a medium degree. Although factually correct, saying X number of letters are the same and in an identical sequence is to my mind

an analysis that overlooks that consumers view marks as a whole and the contribution made by the first part of words. A different letter at the beginning has a strong visual impact. A sequence of similar letters that is not consecutive will have varying degrees of impact. Here the use of a letter V in place of the T in the body of the word is lessened by the preceding letter also being a consonant, and the letters following it being the same in the both marks. In PRIBISOL and BRIMISOL the initial letter is different and the letter at the end of the first syllable stands alone making the difference here clear to the eye. The commonality in the letters and their sequence was considered to make them sound similar, at least to a medium degree. Little weight seems to have been given what was described as the “minor differences of the letters ‘L’ versus ‘R’ and ‘T’ versus ‘V’”. In my view the phonetic impact of the differences in the first syllables of PRIBISOL and BRIMISOL are not so minor as to take the aural similarity above low. Again, as has consistently been the case, conceptually did not influence the assessment of similarity of the marks.

53. There is nothing in these cases that would lead me to an assessment that on the facts and circumstances, the respective PRIBISOL and BRIMISOL are similar to anything more than a below average extent.

54. Beyond saying that “the beginnings of words are more important” and the disregarded invitation to ignore the suffixes “SOL” and ISOL”, there is little comment on the dominance of any elements of the respective words. In my view this reflects that neither PRIBISOL nor BRIMISOL can readily be divided into separate identifiable components. If there is any dominance this will only be by virtue of its positioning at the beginning of the words.

Likelihood of confusion

55. When looking at the respective goods I have found these to be identical. The specifications are quite wide ranging in their potential scope, specialism and sophistication which will influence whether they will be selected by visual or oral means, and the level of attention when doing so. Whichever is the case, that the goods are identical means that the relevant consumer and circumstances of trade are notionally the same.

56. Earlier in this decision I concluded that whilst the respective marks have similarities, when assessed overall this is at the lower end. I also expressed my view that there is no obvious distinctive element; distinctiveness rests in the respective words as a whole. In terms of dominance, such as it may be this must reside in the initial and different first syllable.

57. I am satisfied that at the material date in these proceedings, the similarities are insufficient to give rise to a likelihood of either direct confusion where one mark is mistaken for the other, or indirect confusion where the average consumer assumes the undertakings are economically linked. Likewise, the average consumer in the UK who, at the material date, was familiar PRIBISOL will not embark on an artificial dissection so as to focus on the similarities in BRIMISOL, and through imperfect recollection assume that this is the name they know.

Conclusion

58. The opposition based upon section 5(2)(b) of the Act fails.

Costs

59. The applicants having been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. With this in mind I award costs on the following basis:

60. The applicant's counterstatement is brief in its response. Minimal evidence was provided which would not have taken much work to assess. I therefore consider that an award of £700 in respect of the work undertaken in considering the opponent's statement of case, preparing the counterstatement and any further assessment of the evidence and the need for an oral hearing.

Total: £700

61. I order Biofarma Société par actions simplifiée to pay Bristol Laboratories Limited the sum of £400. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of January 2014

**Mike Foley
For the Registrar
The Comptroller-General**