

O-161-15

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 2648993
STANDING IN THE NAME OF
MEDIATECH INC.**

AND

**IN THE MATTER OF A REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER No.500348
BY CELLGENIX GMBH**

BACKGROUND

1) The following trade mark is registered in the name of Mediatech, Inc. (hereinafter MI):

Mark	Number	Filing & registration date	Class	Specification
CELLGRO	2648993	23.01.13 05.07.13	1	Cell culture media for research and scientific purposes.
			5	Cell culture media for medical and veterinary purposes.

2) By an application dated 27 March 2014 Cellgenix GmbH (hereinafter CG) applied for a declaration of invalidity in respect of this registration. The grounds are, in summary, that CG is the registered proprietor of the following mark:

Mark	Number	Filing & registration date	Class	Specification
CellGro	CTM 011252798	26.09.12 21.02.13	1	Products for cultivating cell lines for scientific and medical purposes, media for the cultivation of human and animal cells.

a) CG contends that the marks, and goods, are identical or similar such that there is a likelihood of confusion and that the mark in suit therefore offends against section 5(2)(b) of the Act.

3) MI provided a counterstatement, dated 9 June 2014, in which it denies the above grounds and also denies that CTM 11252798 is a valid registration. No reasons for either statement are provided.

4) Neither side filed evidence. Both sides ask for an award of costs. Neither side wished to be heard. Only CG provided written submissions which I shall refer to as and when necessary in my decision.

DECISION

5) The only ground of invalidity is based on section 5(2)(b) which reads:

5.-(2) A trade mark shall not be registered if because -

- (a)
- (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.”

6) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

7) CG is relying upon its trade mark listed in paragraph 2 above which is clearly an earlier trade mark. As CG’s earlier trade mark had not been registered for five years at the point at which the application for a declaration of invalidity was filed, it is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

8) When considering the issue under section 5(2)(b) I take into account the following principles which 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

9) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

10) Both parties' specifications cover cell culture media. As neither party has commented on this issue I must use my own knowledge. I regard such goods as being highly specialised which would be purchased by companies, hospitals or educational establishments conducting research. I imagine that such purchases would be very carefully considered as the correct media will be required depending on the type of cell to be cultivated. The purchasing process will include brochures, on-line and face to face discussions with sales representatives as well as telephone orders.

Comparison of goods

11) In the judgment of the 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”.

12) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

13) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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 that the responsibility for those goods lies with the same undertaking”.

14) In *Sanco SA v OHIM*, Case T-249/11, the General Court 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.”

15) Whilst 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.

16) For ease of reference the specifications of both parties are reproduced below:

MI's specification	CG's specification
In Class 1: Cell culture media for research and scientific purposes.	In Class 1: Products for cultivating cell lines for scientific and medical purposes, media for the cultivation of human and animal cells.
In Class 5: Cell culture media for medical and veterinary purposes.	

17) It would appear that in terms of *Treat*, the goods would be identical in terms of users, nature and trade channels, and would be in competition with each other. The class 1 goods of the two parties must be regarded as identical, whilst it would appear that MI's class 5 goods are highly similar to CG's class 1 goods. MI has not provided any submissions on the matter.

Comparison of trade marks

18) The two marks are CELLGRO and CellGro. Whilst the first consists of upper case letters and the second is a mixture of upper and lower case, it is accepted that letters in either case must be regarded as identical. I therefore regard the marks as being identical.

Distinctive character of the earlier trade mark

19) 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).”

20) In relation to the goods for which it is registered in class 1 the earlier mark is only of average inherent distinctiveness as the mark CellGro clearly alludes to the fact that the goods are for growing cell cultures. As the opponent has not filed evidence of any use it has made of its earlier trade mark in the UK it cannot benefit from enhanced distinctiveness through use.

Likelihood of confusion

21) In determining whether there is a likelihood of confusion, 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 and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a specialised company, hospital or educational establishment who will select the goods by both visual and aural means and who will pay a high level of attention when doing so;
- the goods in class 1 of the two parties are identical, whilst CG's goods in class 1 are highly similar to MI's class 5 goods;
- the marks are identical;
- the opponent's earlier trade mark is possessed of a average degree of inherent distinctive character, but does not benefit from an enhanced distinctiveness by the use made of it in the UK.

22) In view of the above and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that MI's goods in class 1 and 5 are those of CG or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in full.**

CONCLUSION

23) The invalidity action under Section 5(2)(b) was successful. The registration will be deemed to have never been made.

COSTS

24) As CG has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Submissions	£300
Expenses	£200
TOTAL	£800

25) I order Mediatech Inc. to pay the sum of £800 to Cellgenix GmbH. This sum 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 13th day of April 2015

**G W Salthouse
For the Registrar
the Comptroller-General**