

O-794-18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3233720
BY PULSIN LTD
TO REGISTER THE FOLLOWING TRADE MARK**

PULSIN

IN CLASSES 5, 25, 29, 30 AND 32

AND

**OPPOSITION THERETO UNDER NO. 410193
BY MERCK CONSUMER HEALTHCARE LIMITED**

Background and pleadings

1. On 26 May 2017, Pulsin Ltd (“the applicant”) filed trade mark application number 3233720, for the mark PULSIN, for the following goods:

Class 5: Food supplements; vitamins; mineral and vitamin supplements; dietary foodstuffs; supplements and additives.

Class 25: Clothing; footwear; headgear.

Class 29: Soups, salads, meat, fish, poultry and game; meat products, fish products; preserved, dried, cooked, canned and frozen fruits and vegetables; jellies, jams and compotes; eggs, milk and milk products; yoghurt; edible oils and fats; prepared meals; snack foods; nuts, seeds.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, porridge, muesli, bread and bakery products; brownies, snack bars and cakes; pastries, sandwiches and filled bread rolls; pastry and confectionary; ices, honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice; ice cream; prepared meals and snack foods.

Class 32: Energy drinks.

2. The application was accepted and published for opposition purposes on 09 June 2017. Merck Consumer Healthcare Limited (“the opponent”) partially opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon UK Trade marks (“UKTM”) 1308302 and 1308303, the pertinent details of which are as follows:

1308302

Mark: PULSE

Filing date: 25 April 1987

Date of registration: 09 March 1990

Goods: Class 5: Fish oils and derivatives thereof, all included in Class 5

1308303

Mark: PULSE

Filing date: 25 April 1987

Date of registration: 18 August 1989

Goods: Class 29: Fish oils and derivatives thereof, all included in Class 29

3. The goods opposed by the opponent are 'food supplements; vitamins; mineral and vitamin supplements; dietary foodstuffs; supplements and additives' in class 5 and 'fish products; edible oils and fats' in class 29.

4. By virtue of having filing dates that predate the filing date of the contested mark, the opponent's UKTMs qualify, under section 6 of the Act, as earlier marks for the purposes of these proceedings. As the earlier marks completed their registration procedure more than five years prior to the publication date of the applicant's mark, they are subject to the proof of use conditions, as per section 6A of the Act. The applicant, in its counterstatement, requested the opponent provide proof of use of the earlier registered mark upon which it relies. The relevant period in the current case is 10 June 2012 to 09 June 2017.

5. The opponent claims that the applied for mark is highly similar to its earlier marks and the goods applied for are identical or similar, leading to a likelihood of confusion.

6. The applicant filed a counterstatement in which it denies that the marks are similar and that the goods are identical. It further denies that there exists a likelihood of confusion.

7. The opponent filed evidence and written submissions in lieu of a hearing. The applicant did not file evidence or written submissions. Neither party chose to be heard. The opponent is represented by A.A. Thornton & Co. and the applicant is represented by Marshall Law.

Preliminary issue

8. The two marks relied upon by the opponent are identical and registered for identical goods. Therefore, for the sake of procedural economy, I will refer to them collectively as the 'earlier mark' throughout this decision.

Evidence summary

9. The opponent's evidence takes the form of a witness statement and four exhibits from James Binnington, UK & Ireland Sales Director of Merck Consumer Health of Seven Seas Limited, a wholly owned subsidiary of the opponent. Some of this evidence is dated outside the relevant period (Exhibit 1 and part of Exhibit 2). Consequently, I will only summarise the relevant evidence.

Witness statement

10. Mr Binnington's witness statement is dated 22 May 2018, in which he gives the following evidence:

- Merck Consumer Health of Seven Seas Limited ("the Company") is a leading manufacturer of branded vitamins, minerals and supplements in the UK;
- The Company was formed over 75 years ago and has, since then, expanded from a small, local co-operative to a company recognised the world over;
- Seven Seas branded products are sold in more than 100 countries worldwide;
- The Company has used the mark PULSE under licence in the UK since at least 2005;
- The mark PULSE is used in relation to fish oil capsules including Omega-3;
- The mark PULSE has been used on goods offered for sale nationwide in major retailers including Boots, Superdrug, Wilkinsons, Asda, Morrisons and Tesco.

11. Mr Binnington provides figures for the approximate sales revenue of PULSE branded goods throughout the UK as follows:

2013: £245,542

2014: £211,002

2015: £209,590

2016: £165,458 (figures only available for April – December 2016)

2017: £197,874

12. The market share of PULSE goods from 2016 to 2018 is set out by Mr Binnington as 1.28% for the year ending April 2016, 1.29% for the year ending April 2017 and 1.09% for the year ending April 2018.

Exhibits

13. Exhibit JB2 contains invoices issued to customers who purchased PULSE goods between 2012 and 2016. The exhibit consists of seven invoices dated within the relevant period and addressed to West Midlands, Lancashire, Hertfordshire, Nottinghamshire, Hampshire and London. The invoices total £109,347.41, however, the individual cost of the PULSE goods has been redacted. Each invoice shows a description of goods either labelled PULSE FISH OIL CAPSULES or PULSE ADVANCED OMEGA 3.

14. Exhibit JB3 contains images of the packaging design of PULSE goods, namely omega-3 fish oil capsules. Pages 1-12 show plans for the packaging between 2010 and 2017. Pages 13-20 show images of the assembled packaging on product information leaflets dated June 2013. Mr Binnington explains that these leaflets were used by sales representatives to inform pharmacists across the UK of the products. Throughout the exhibit, the plain word PULSE is used in both upper and lower case.

15. Evidence of PULSE omega-3 fish oil capsules available for sale online is contained within Exhibit JB4. Pages 1-4 relate to the goods' availability at Amazon.co.uk. The product shown is a box of 120 omega-3 fish oil capsules at a purchase price of £17.35. The PULSE mark is displayed centrally and prominently on the front of the product and is in a relatively large white font of a standard typeface. Page 2 of the exhibit shows that the product was first available on Amazon on 2 February 2008 and pages 3 and 4 contain reviews from verified purchasers of the product dated between

February 2012 and November 2017. Pages 5-7 show the product available on the Boots website. The product shown is the same as that available on Amazon but for a purchase price of £17.49. These pages are not dated; however, it seems reasonable to conclude that they would have been printed at the same time as the Amazon printouts (being 15 May 2018). Two reviews from the Boots website are shown to have been posted '3 years ago' and '4 years ago', consequently appearing to fall within the relevant period.

16. As the applicant filed no evidence, that concludes my summary of the evidence, insofar as I consider it necessary.

Decision

Proof of use

17. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use condition in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

18. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

19. The relevant period, as identified in paragraph 3 above, is 10 June 2012 to 09 June 2017.

20. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. In *London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*¹, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use.* In *In Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria”

¹ [2016] EWCH 52

(Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with

the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

21. It is clear at the outset that the earlier mark relied upon by the opponent is a plain word mark. Use of a mark registered as a plain word includes use in upper or lower

case, as per Professor Ruth Annand's comments, sitting as the Appointed Person in *Bentley Motors Limited v Bentley 1962 Limited*²:

“16. A word trade mark registration protects the word itself (here BENTLEY) written in any normal font and irrespective of capitalisation and, or highlighting in bold (see e.g. Case T-66/11, *Present-Service Ullrich GmbH & Co. KG v. OHIM*, EU:T:2013:48, para. 57 and the cases referred to therein, BL O/281/14,).”

22. The invoices at Exhibit JB2 show sales to a number of locations across the UK and support the turnover figures recorded in the witness statement. Whilst the images of PULSE goods' packaging at Exhibit JB3 do not prove use of the mark for goods that are currently being marketed, it must be noted that the correct approach to assessing the evidence is to view the picture as a whole, including whether individual exhibits corroborate each other³. I bear in mind that Exhibit JB4 does show that the goods (as packaged in Exhibit JB3) were available to the public online during the relevant period, supporting the evidence at Exhibit JB3 and supporting Mr Binnington's witness statement.

23. Overall, the evidence shows genuine use of the mark which identifies the origin of the goods (being the goods for which the mark is registered) and creates or preserves an outlet for these goods. Putting all the evidence together provides me with a picture which is sufficient to establish that the opponent has used its mark, for all the goods for which it is registered, in the relevant period.

24. The opponent may rely upon its earlier mark and all the goods within its specification ('fish oils and derivatives thereof' in class 5 and class 29) for the purposes of this opposition.

² BL O/158/17

³ See the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Brandconcern BV v Scooters India Limited* [2014] WL 517611

Section 5(2)(b)

25. Section 5(2)(b) of the Act states that:

“5 (2) A trade mark shall not be registered is 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 confusion with the earlier trade mark.”

The principles

26. The following principles are gleaned from the judgments 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 C3/03, *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 the 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.

Comparison of goods

27. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*⁴, that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier trade mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für 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.”

28. The goods to be compared are as follows:

Earlier marks	Applied for mark (as opposed)
Class 5: Fish oils and derivatives thereof	Class 5: Food supplements; vitamins; mineral and vitamin supplements; dietary foodstuffs; supplements and additives
Class 29: Fish oils and derivatives thereof	Class 29: Fish products; edible oils and fats

29. Given that the opponent’s fish oils and derivatives thereof in class 5 are dietary supplements intended to supplement a normal diet or to have health benefits, I find that they are included within the scope of the applicant’s food supplements; vitamins; mineral and vitamin supplements; dietary foodstuffs; supplements and additives. The parties’ class 5 goods are identical.

⁴ Case T-133/05

30. The opponent's fish oils in class 29 are clearly both fish products and edible oils and fats, meaning they are included within the scope of the applicant's class 29 goods. These goods are identical.

The average consumer and the nature of the purchasing act

31. It is necessary for me to determine who the average consumer is for the respective parties' services. 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*⁵, 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.”

32. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*⁶.

33. I am of the view that the average consumer of the parties' goods is a member of the general public. The goods will be self-selected from, for example, the shelves of supermarkets or retail outlets specialising in such goods or from the websites of such undertakings. Therefore, visual considerations are likely to dominate the selection process. However, as such goods may also be the subject of oral recommendations/advice, aural considerations will also play a part, albeit, to a lesser extent than visual considerations. The goods at issue are intended to supplement a normal diet or provide specific health benefits and so the average consumer will

⁵ [2014] EWHC 439 (Ch)

⁶ Case C-342/97

consider factors such as the ingredients and the health benefits, for example. However, the goods are likely to be purchased on a fairly regular basis and are, on the whole, inexpensive. As such, I am of the view that the average consumer will pay an average degree of attention to their selection.

Comparison of marks

34. It is clear from *Sabel BV v Puma AG* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to their overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

35. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

36. The marks to be compared are as follows:

Earlier mark	Applied for mark
PULSE	PULSIN

Overall impression

37. The opponent's earlier mark consists solely of the word PULSE, the overall impression of which rests in the word itself.

38. The applicant's mark consists of the plain word PULSIN, again, the overall impression of which rests in the word itself.

Visual comparison

39. Visually, the similarity rests in the first four letters of the marks: PULS. The differences are that the earlier mark is a five letter word ending in -E and the applied for mark is a six letter word ending in -IN. Taking everything into consideration I find there to be a medium degree of visual similarity between the marks.

Aural comparison

40. The opponent submits the following:

"The Earlier Mark and Contested Mark are phonetically highly similar. [...] The dominant sound of the mark PULSIN is "PULSE" which is at the beginning of the mark; the additional letters 'IN' of the Contested Mark would be pronounced but they occupy a phonetically weak position at the end of the mark and the speaker would not emphasise these letters."

41. The applicant denies that the marks are phonetically highly similar and submits the following:

"It is admitted that the earlier Mark would be pronounced as the single syllable PULSE. The contested Mark would be pronounced as two syllables PUL-SIN or PULS-IN, both versions being phonetically very different to PULSE."

42. The entire PULSE mark and the first syllable of PULSIN ('PULS') will, in my view, be pronounced identically. However, the second syllable in the applied for mark, which

will be pronounced as 'IN', does not have a counterpart in the earlier mark. Overall, I consider there to be a medium degree of aural similarity between the marks.

Conceptual comparison

43. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgements of the GC and the CJEU including *Ruiz Picasso v OHIM*⁷. The assessment must be made from the point of view of the average consumer.

44. The opponent submits the following:

“[T]he Earlier Mark will be understood by the relevant consumer either as a noun, meaning a rhythmical beat (e.g. of the flow of blood through veins / arteries or a musical beat), or as a verb meaning to throb rhythmically. The Contested Mark does not have a dictionary meaning, however, the mark is visually and phonetically highly similar to the word PULSING and is likely to be viewed as an abbreviation of the word ‘Pulsing’ and therefore will be conceptually associated, at least by some consumers, with the word PULSING which is either a noun or an adjective based on the verb PULSE. [...] We further note that when the application was filed, the Applicant’s name was in fact Pulsin’ Ltd with an apostrophe at the end. Although the Applicant has since amended its name to remove the apostrophe, we believe that this supports our argument that PULSIN is in fact an abbreviation of PULSING.”

45. The applicant submits the following:

“It is denied that the contested word is highly similar to the word PULSING [...] There is therefore no conceptual similarity between the respective Marks.”

46. I am of the view that the concept of the earlier mark will be immediately grasped by the average consumer. Pulse is an ordinary dictionary word which will be known to

⁷ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

the average consumer to mean a rhythmical throbbing or beating. However, I do not find that PULSIN will be considered to be an abbreviation of the dictionary word PULSING. Whether the company name of the applicant was previously Pulsin' Ltd does not alter my view on this point since company names are not relevant to trade mark proceedings and, in any case, I must consider the mark applied for. I am of the view that PULSIN will be seen by the average consumer as an invented word with no specific meaning or concept. Therefore, I find the marks to have no conceptual similarity.

Distinctive character of the earlier mark

47. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). In *Lloyd Schuhfabrik* 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).”

48. I have not been provided with sufficient evidence on market share or the amount that has been invested in promoting the earlier mark to find that its distinctive character has been enhanced through use. Consequently, I have only the inherent distinctiveness of the mark to consider. The earlier mark consists solely of the word PULSE, which is an ordinary dictionary word. However, it does not appear to be descriptive or allusive of the goods at issue. I find the earlier mark to possess an average degree of inherent distinctive character.

Likelihood of confusion

49. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. There are two types of confusion that I must consider. The difference between them was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*⁸:

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

50. I also bear in mind *The Picasso Estate v OHIM*⁹, where the CJEU found that:

⁸ BL O/375/10

⁹ Case C-361/04 P

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applied in the present case, the Court of First Instance did not in any way err in law.”

51. In the case before me, the earlier mark has a clear concept that will be immediately grasped by the average consumer, whereas the applied for mark will be seen as an invented word. Taking all the relevant factors into account including the clear conceptual differences, I find that there would be no direct or indirect confusion. The nature of the respective marks is such that the average consumer would not directly confuse them. A finding of indirect confusion requires the likelihood of the average consumer making a connection between the marks and assuming that the goods are from the same or economically linked undertakings. Given the lack of any conceptual similarity, I consider that the average consumer would not make such an assumption.

Outcome

52. The opposition fails under section 5(2)(b) as there is no likelihood of confusion. The applied for mark may proceed to registration in respect of all the goods in its specification.

Costs

53. As the applicant has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide I award costs to the applicant on the following basis:

Preparing a statement and
considering the other side’s statement: £200

Considering the other side's evidence: £200¹⁰

Total: £400

54. I order Merck Consumer Healthcare Limited to pay Pulsin Ltd the sum of **£400**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of December 2018

**Emily Venables
For the Registrar,
The Comptroller-General**

¹⁰ This amount is below the scale minima due to the applicant not preparing evidence or commenting on the opponent's evidence