

O/0127/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003727290
BY PRINCIPIA BIOPHARMA INC. TO REGISTER THE FOLLOWING TRADE
MARK:**

SUVOGIC

IN CLASS 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 431124 BY NOVARTIS AG**

Background and Pleadings

1. On 30 November 2021, Principia Biopharma Inc. ('the Applicant'), filed an application to register the following trade mark:

SUVOGIC

2. The application was published for opposition purposes in the Trade Marks Journal on 17 December 2021. The mark has a priority date of 21 June 2021, the priority country being the United States of America. Registration is sought in respect of the following goods in Class 5:

Pharmaceutical preparations for the prevention and treatment of immune-mediated, autoimmune, inflammatory, respiratory, and rare diseases and disorders; pharmaceutical preparations for preventing and treating diseases and disorders of the skin and blood; pharmaceutical preparations for preventing and treating lesions and tumors.

3. On 17 February 2022, the application was opposed by Novartis AG ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The Opponent relies on the following earlier registration:

International registration: WO0000001575497

ZUVOKOM

Date of protection of the International registration in UK: 24 June 2021

Designation date: 1 December 2020

International registration date: 1 December 2020

Office of Origin: Switzerland

Priority date: 27 November 2020

Priority Country: Switzerland

Registered for the following class 5 goods: *Pharmaceutical preparations*

4. The Opponent claims that:
 - the parties' goods are identical;
 - that the parties' marks are highly similar;
 - and
 - that there is therefore a likelihood of confusion between the parties' marks.

5. The Applicant filed a Defence and Counterstatement in which it:
 - denies that the parties' marks are visually or aurally highly similar;
 - neither accepts nor denies that the parties' goods are identical and puts the Opponent to proof in respect of this claim;¹
 - and
 - that there is no likelihood of confusion between the parties' marks.

6. The Opponent is represented by Abel & Imray; the Applicant is represented by Mishcon de Reya LLP.

7. Both parties have filed evidence. A hearing was neither requested nor thought necessary. Both parties filed written submissions in lieu of a hearing.

8. The following decision has been made after careful consideration of the papers before me.

Opponent's evidence

9. The Opponent's evidence comes from Rebecca Atkins, Chartered Trade Mark Attorney and Senior Associate at Abel & Imray, the Opponent's legal representative. Ms Atkins' Witness Statement is dated 11 July 2022. There are 4 Exhibits: RA1 – RA4.

10. Exhibit RA1 and RA2 – comprise, respectively, the results of searches of the UK Trade Mark register for marks with the prefixes 'ZUVO' and 'SUVO' registered for goods in class 5. Two results are shown with the prefix 'ZUVO': 'ZUVOGEN' and

¹¹ The Applicant subsequently conceded that the parties' goods are identical in its written submissions in lieu of a hearing, at paragraph 2.4.6.

the Opponent's mark 'ZUVOKOM'. Three results are shown with the prefix 'SUVO': 'SUVOGEN', 'SUVOREXANT' and the Applicant's mark 'SUVOGIC'. The Opponent has submitted that 'this is an unusual prefix in the English language and is inherently highly distinctive for pharmaceutical products'.^{2,3} While this is noted, the paucity of marks on the register prefixed by the elements 'ZUVO' or 'SUVO' does not necessarily entail that those prefixes are inherently highly distinctive; merely that the marks have been deemed to have sufficient distinctive character to be admitted on to the register.

11. Exhibit RA3 – comprises a screenshot of the results of a 'Pharma in Use' search in the United Kingdom for ZUVO* and SUVO*.⁴ No information is given about what 'Pharma in Use' is, but it is presumed to be some sort of database or register of pharmaceuticals currently in use. The results appear to indicate that:

- as of 14 April 2022, there was one pharmaceutical product in use whose name included 'ZUVO' and two products in use whose name included 'SUVO';
and
- as of 11 July 2022, there were two pharmaceutical products in use whose names included 'ZUVO' and three products in use whose name included 'SUVO'.

12. Exhibit RA4 – comprises 'Drug search results' via the website 'MIMS' using the search terms 'ZUVO*' and 'SUVO*', showing that no drugs were found for either of these terms. The text 'This site is intended for UK healthcare professionals' appears at the head of the page.

13. While Exhibits RA3 and RA4 are noted, the paucity of pharmaceuticals whose names include the elements 'ZUVO' or 'SUVO' does not necessarily indicate that either party's mark enjoys a high level of inherent distinctive character.

² Opponent's written submissions in lieu of a hearing, at paragraph 10.

³ The Opponent includes the following at paragraph 5 of its Counterstatement: "[...] the prefix ZUVO/SUVO is inherently highly distinctive for pharmaceutical products; a search of the UK Trade Marks Register reveals only one other mark with this prefix in Class 5".

⁴ Witness Statement of Rebecca Atkins, paragraph 5.

Applicant's evidence

14. The Applicant's evidence comes from Daniela Antonina Zavera, of Mishcon de Reya LLP, the Applicant's legal representative. Ms Zavera's Witness Statement is dated 9 September 2022. There are 7 Exhibits: DZ1 – DZ7.
15. Exhibits DZ1 and DZ2 comprise pages from the website 'thefreedictionary.com' providing information on the pronunciation of the letter 'S' according to which 'S' is: almost always pronounced 'ESS' when it is the first letter of a word; and only produces the 'Z' sound when it appears in the middle or at the end of words.
16. Exhibit DZ3 comprises a 'Wikipedia' entry, accessed 22 August 2022, on the pronunciation of 'Hard and soft G'. The Applicant has adduced this to seek to demonstrate that the consonant 'G' preceding the vowels 'i', 'e' or 'y' is pronounced as a 'soft' 'G'.
17. Exhibit DZ4 comprises a 'Wiktionary' entry, accessed 22 August 2022, listing examples of words where the 'G' is pronounced as a 'Hard "g" where soft "g" expected'.
18. Exhibit DZ5 appears to be an extract from the platform 'Twitter' on the pronunciation of the letter 'K'.
19. While Exhibits DZ1 – DZ5 are noted, it is my view that this evidence is unnecessary. I consider that a Hearing Officer is equipped to make an assessment of the pronunciation of the letters 'S', 'Z', 'G' and 'K' in the parties' marks by the average consumer, without recourse to the information provided.
20. Exhibits DZ6 and DZ7 comprise search results of online dictionaries for, respectively, 'SUVOGIC' and 'ZUVOKOM', and show that neither word can be found.

Decision

Section 5(2)(b) of the Act and related case law

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

“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.”

22. In accordance with section 6 of the Act, the Opponent’s mark is an earlier mark because the date from which it claims priority (27 November 2020) fell before the date from which the Applicant claims priority for its applied-for mark (21 June 2021).

23. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is not engaged because the date from which the Opponent claims priority for its earlier mark fell less than 5 years prior to the date from which the Applicant claims priority for its applied-for mark. The Opponent is therefore entitled to rely upon all of the goods that it seeks to rely upon.

24. The following principles are derived from the decisions of the Court of Justice of the European Union⁵ (“CJEU”) in:

⁵ Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

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 C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P

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 be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of goods

25. The Applicant has conceded that the parties' goods are identical.⁶

Average consumer and the purchasing act

26. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word "average" denotes that the person is typical. 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*, Case C-342/97.

⁶ Applicant's written submissions in lieu of a hearing, at paragraph 2.4.6.

27. I bear in mind the following:

In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, EU:T:2021:41, the General Court considered the average consumer for and level of attention which would be paid in the selection of pharmaceutical and medical products in class 5. It said:

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

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

41 [...]

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

28. The parties’ goods, in my view, will cover both specialised medicines available only as directed by medical professionals, as well as over-the-counter items (e.g. some ointments for skin disorders). These goods would, therefore, be purchased by both the professional public, i.e. medical professionals, and the general public. For the professional purchaser, the purchasing act will, in my view, entail consulting catalogues and/or databases of pharmaceutical products, such materials being aimed at medical professionals. The purchasing act will therefore be primarily visual. I find that a high degree of attentiveness will be paid. Factors influencing the purchasing process will likely include, *inter alia*: ensuring that the correct product is ordered for the particular disease/condition to be treated. For members of the general public, the purchasing act will, in some cases, be primarily visual e.g. where an over-the-counter product is seen on a shelf or display in a pharmacy. In other cases, there will be an aural aspect to the purchasing process where consumers make requests to staff and recommendations are made (e.g. ‘what do you have for ‘so-and-so ailment’?’). The general public will also, in my view, pay a high level of attention when purchasing the relevant goods. Factors considered may include, *inter alia*: the ingredients in the products; contraindications with other medicines; side effects.

Comparison of the marks

Opponent’s (earlier) mark	Applicant’s (contested) mark
ZUVOKOM	SUVOGIC

29. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

30. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks, and to give due weight to any other features which are not negligible and, therefore, contribute to the overall impressions created by the marks.

31. The Opponent’s mark is a word mark⁷ consisting of the single word element ‘Zuvokom’ rendered in a plain sans serif typeface. The overall impression of the mark resides in the mark in its entirety.

⁷ In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

‘[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).’

32. The Applicant's mark is also a word mark. It consists of the single word element 'Suvogic' rendered in a plain sans serif typeface. The overall impression of the mark resides in the mark in its entirety.

Visual comparison

33. Both marks are seven characters in length and share the string 'UVO' for the third, fourth and fifth characters. Points of difference are:

- the first character of the Opponent's mark is 'Z' as opposed to the Applicant's mark beginning with 'S';
- the final three characters of the Opponent's mark are 'KOM' as opposed to the Applicant's mark ending in 'GIC'.

I find the parties' marks to have a level of visual similarity no more than between low and medium.

Aural comparison

34. The Opponent's mark will, to my mind, be articulated as 'ZOO-VOE-COM' or 'ZOO-VUH-COM'. I consider that the Applicant's mark will be articulated as 'SOO-VOE-JIC' or 'SOO-VUH-JIC'. Both marks are three syllables in length. The first syllable of each mark shares the 'OO' sound and the second syllable of each mark shares the 'OE' or 'UH' sound. Points of difference are:

- the 'S' at the beginning of the Opponent's mark as opposed to the 'Z' sound at the beginning of the Applicant's mark;
- the 'COM' sound of the final syllable of the Opponent's mark as opposed to the 'JIC' sound in the Applicant's mark.

I find the parties' marks to have, at best, a medium level of aural similarity.

Conceptual comparison

35. Neither 'zuvokom' nor 'suvogic' are words in the English language. The average consumer will, in my view, perceive both marks as invented words to which no concept will attach. I find the marks to be conceptually neutral.

Distinctive character of the earlier mark

36. *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).”

37. Registered trade marks possess varying degrees of inherent distinctive character: perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities.

38. 'ZUVOKOM' does not appear in the English dictionary and will, in my view, be perceived by the average consumer as an invented word. It neither describes nor alludes to the goods in respect of which it is registered. Consequently, the mark is inherently distinctive to a high degree.

39. The Opponent has not adduced material to demonstrate: the market share held by the marks; the geographical spread of sales in the UK; marketing spend or annual turnover figures. The totality of evidence available is not sufficient for me to find that the level of distinctiveness of the mark can be raised above the finding that I have made for the mark's inherent distinctive character i.e. that of a high degree.

40. On the evidence available to me, I am unable to form a view as to whether the Opponent's mark enjoys an enhanced level of inherent distinctive character.

Likelihood of confusion

41. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v Back Beat Inc*⁸. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*⁹, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or an economically linked undertaking.

⁸ Case BL O/375/10 at [16].

⁹ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

42. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [24]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.
43. In my view, despite the identity between the parties’ goods, the net effect of the visual and aural differences is, in my view, sufficient to prevent the average consumer from mistaking one party’s mark for the other. Despite both parties’ marks comprising seven characters and three syllables, and sharing the string ‘UVO’, I find that the average consumer will notice the visual and aural distinctions that I have noted. Both marks will be seen as invented words, neither conveying any concept for the mind to fix upon. There is therefore no conceptual nexus between the marks. The average consumer, whether a member of the professional or general public, will display a high level of attentiveness when purchasing the parties’ goods, a factor which further points away from a likelihood of direct confusion. The high degree of inherent distinctive character enjoyed by the earlier mark derives from the perception of the mark as an invented word. The applied-for mark will, for the same reason, also have a high level of inherent distinctive character. However, the visual and aural differences that I have identified, are, in my view, sufficiently marked to prevent one mark being confused for the other by imperfect recollection. I find that there is no likelihood of direct confusion.
44. I now consider whether there is a likelihood of indirect confusion. I note that in the recent case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

45. I consider that the average consumer will notice the above-mentioned differences between 'SUVOGIC' and 'ZUVOKOM'. I can see no reason why the average consumer would presume that the same or economically linked undertaking is responsible for the relevant goods. The instant case does not fall within any of the categories identified in *L.A. Sugar Limited v By Back Beat Inc*¹⁰ Mr Iain Purvis Q. C., as the Appointed Person, explained that [my words in parentheses]:

17. Instances where one may expect the average consumer to reach such a conclusion [i.e. to conclude that marks relate to the same or economically linked undertakings] tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

Whilst I accept that these categories are not exhaustive, I can see no other mental process by which the average consumer would arrive at a conclusion indicative of indirect confusion. I can therefore find no proper basis on which to conclude that there is a likelihood of indirect confusion.

Conclusion

¹⁰ Case BL O/375/10

46. The Opposition has been unsuccessful. The Application may, subject to a successful appeal, proceed to registration.

COSTS

47. I award the Applicant the sum of **£500** as a contribution towards its costs, calculated as follows¹¹:

Consideration of the Opposition and preparation of Defence and Counterstatement	£200
Preparation of submissions and evidence	£300 ¹²
Total:	£500

48. I therefore order Novartis AG to pay to Novartis AG the sum of £500. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of February 2023

N. R. Morris

**For the Registrar,
the Comptroller-General**

¹¹ Based upon the scale published in Tribunal Practice Notice 2/2016.

¹² I have awarded a sum below the minimum because I consider that the evidence filed was unnecessary and unduly lengthy.