

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for the registration of Trade Mark No. 250032 and in the matter of an Opposition thereto.

YouMedical B.V.

Applicant

Wartner Europe B.V.

Opponent

The Application

1. On 5 November, 2013 YouMedical B.V. (hereinafter YouMedical), of Rijnsburgstraat 9-11, 8th Floor, 1059 AT Amsterdam, The Netherlands made application (No. 2013/02057) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register WARTIE as a trade mark in respect of “*Cosmetic preparations for body and skin care; disinfectant soaps*” in Class 3, and “*Pharmaceutical preparations for body and skin care; including pharmaceutical products for dermatological use, also intended for treatment of external swelling of the skin, including warts, disinfectants for hygienic use*” in Class 5.
2. The Applicant claimed and was granted a priority date on foot of an earlier Benelux application No. 1268592 dated 21 May, 2013. Accordingly, this earlier date is the relevant date for the purposes of these proceedings.
3. Notice of Opposition to the registration of the mark, pursuant to Section 43 of the Act, was filed on 26 May, 2014 by Wartner Europe B.V. (hereinafter Wartner) of Keileweg 8, NL-3029 BS Rotterdam, The Netherlands. The Applicant filed a counter-statement on 22 August, 2014 and evidence was then filed under Rules 20, 21 and 22 of the Trade Mark Rules, 1996 (“the Rules”). Both parties attended a Hearing of the matter on 16 February, 2016.
4. Acting for the Controller, I decided to uphold the opposition and to refuse to allow the application to proceed to registration in respect of all goods. The parties were informed of my decision by way of letter dated 1 March, 2016. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) of the Rules.

Grounds of the Opposition

5. In its Notice of Opposition the Opponent identifies itself as a producer, for many years, of pharmaceutical preparations, including anti-wart products. The Opponent offers wart, verruca, corn and nail fungus products and related goods under the name WARTNER, and is considered to be the number one anti-wart brand in the world. The Opponent is the Proprietor of International Trade Mark Registration No. 0944700 WARTNER which designates Ireland and European Union Trade Mark Registration No. 006380661 WARTNER, both of which are registered in respect of goods in Classes 3, 5, 8 and 10, as detailed in the table below.

<p>International Registration 0944700</p>	<p>Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; teeth filling material, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.</p> <p>Class 8: Hand tools and implements (hand-operated); cutlery; side arms, other than firearms; razors.</p> <p>Class 10: Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.</p>
<p>European Union Trade Mark Registration 006380661</p>	<p>Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants.</p> <p>Class 8: Hand tools and implements (hand operated); cutlery; side arms; razors.</p> <p>Class 10: Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.</p>

6. The Opponent then raises objection to the present application under Sections 8 and 10 of the Act, which I shall summarise as follows:

Section 8(3)(b) – *the mark is of such a nature as to deceive the public;*

Section 8(4)(a) – *use of mark is prohibited by enactment or rule of law;*

Section 10(2)(b) – *likelihood of confusion on the part of the public, and likelihood of association with the Opponent’s WARTNER earlier mark;*

Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s mark;*

Section 10(4)(a) – *use of the mark is liable to be prevented by virtue of the law of passing off;*

Counter Statement

7. In its Counter Statement the Applicant denied all the grounds of opposition and calls on the Opponent to provide proof of genuine use of the two marks, the existence of which the Opponent claims would cause a likelihood of confusion in the marketplace. The Applicant also claims the Notice of Opposition filed by the Opponent is vexatious.

Rule 20 Evidence

8. Evidence filed by the Opponent under Rule 20 consists of a Statutory Declaration of Christoph Staeuble, Director of Wartner, and ten exhibits labelled “1” to “10”. At Exhibit “1” Mr. Staeuble provides details of his Company’s three earlier trade marks WARTNER – two of which were mentioned in the Notice of Opposition, the third being European Union Trade Mark No. 012560496. The latter is registered in respect of goods and services in Classes 3, 37 and 40; all of which are specified as being in respect of the treatment of laundry, fabrics and textiles, and related services.
9. He says his Company has a very significant reputation worldwide and that it is the No.1 anti-wart brand in the world. He attaches at Exhibit “2” figures from IMS which he claims show that in 2013 the WARTNER brand had the biggest market share in the wart/corn removal sector. At Exhibit “3” he attaches a letter from IMS Health to Omega Pharma NV, informing the addressee that “*IMS is pleased to grant you permission to use the data for the purpose specified – namely mention the claim ‘No. 1 anti-wart brand in the world’ on all packs of Wartner/Cryopharma within the Omega Pharma territory*”.
10. Mr. Staeuble says the trade mark WARTNER has been used since circa 1998. His company is an affiliate of the worldwide pharmaceutical company Omega Pharma NV

who acquired the mark WARTNER from Wartner. He attaches at Exhibit “4” a CE Certificate, dated 14 May 1998, which shows that the WARTNER product for the treatment of warts meets the requirements of the applicable EU directives.

11. He says his Company has used the trade mark WARTNER in Ireland since circa 2006. The goods sold in Ireland are WARTNER Cryotherapy and WARTNER Wart Pen. He attaches at Exhibit “5” a copy of packaging used on a WARTNER product in Ireland. The packaging shows the product was manufactured by Omega Teknika for its Irish affiliate company, Chefaro Limited, and that the product expiry date is September 2007.
12. He attaches at Exhibit “6” the CE Certificate for Ireland, which was issued to Omega Teknika in respect of WARTNER for the treatment of warts and verrucae. The certificate is dated 7 February 2008. At Exhibit “7” he attaches screenshots from an internet archive website showing pages from the WARTNER website dating back to April 2007 that mention Ireland as a country where WARTNER products are sold.
13. Mr. Staeuble says his Company also supplies WARTNER products to United Drug, based in Dublin. United Drug supply the products to wholesalers who then sell them to retailers. At Exhibit “8” he attaches a packaging list, dated 21 August 2009, detailing products sent to United Drug. The list shows an order for 5,031 WARTNER Classic products and 5,086 WARTNER Foot products.
14. He attaches at Exhibit “9” a copy of a leaflet providing answers to frequently asked questions and details on how to use the WARTNER product. The leaflet also shows details of Chefaro Ireland Limited, the Irish affiliate of Omega Pharma NV.
15. He concludes his evidence by stating that turnover figures are confidential but he provides, at Exhibit “10”, copies of some invoices dated between 2013 and 2014, which are so heavily redacted they are of little or no probative value.

Rule 21 Evidence

16. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration dated 15 July 2015 and two accompanying exhibits marked “JHW1” and “JHW2”, of Johannes Hendricus Witte, Chief Operating Officer of YouMedical; a Statutory

Declaration dated 3 July 2015 and four exhibits marked “EM1” to “EM4”, of Eoin McAtamney, Sales and Business Development Manager UK and Ireland, of Pharmed Holdings Limited; and a Statutory Declaration dated 24 June 2015 and two exhibits marked “SS1” and “SS2”, of Shane Smyth, Trade Mark Attorney of FRKelly.

17. For his part Mr. Witte states that since 2011 he has been the Innovation Director at YouMedical and was responsible for the development and launch of a number of new brands, including WARTIE. He says he is involved in the promotion and marketing of, among others, the following products: WARTIE, FOOTNER, NAILNER, PURANOX, DEXEM/DERMALEX, HEMOCLIN, POXCLIN and SPOTNER. He notes that the names of all the products he works with on a daily basis reference the ailment to which they relate, usually as a prefix in the brand names. He says this is very common in the context of pharmaceutical products for the treatment of common ailments. He explains the rationale behind this is that common ailments are prone to self-care by consumers, meaning the treatment is purchased without a prescription from a doctor or without intervention from a pharmacist. Consumers are able to buy all the products he works with over the counter.
18. Mr. Witte produces, at Exhibit “JHW1”, a list of products for different ailments whose prefixes are used to indicate to consumers what the product is for or what it is to be used on. The list includes the prefixes “Ear” and “Audi” for ear ailments; the prefix “Wind” for stomach or bowel complaints; the prefix “Derma” for skin products; and the prefixes “Clear” and “Skin” for spot treatments and the like.
19. He says many of these products are available in the same retail outlets, for instance Boots and Superdrug, and are sold off the shelf. At Exhibit “JHW2” he attaches a series of photographs taken at a Boots’ pharmacy showing a number of wart removal products, including Bazuka Sub-Zero, Boots own brand, WARTNER, Scholl FREEZE, EndWarts and WARTIE on a shelf adjacent to one another. He states it is vital that consumers know what they are buying and that the correct product is purchased for a particular ailment or condition. He says the various brands listed in “JHW1”, all of which are owned by different proprietors, contain prefixes associated with the ailments they treat. All have co-existed in the market for a number of years without instances of confusion on the part of

consumers. The naming of the Applicant's wart product WARTIE follows the same logic and naming convention as that demonstrated in other common, self-care categories.

20. Mr. Witte concludes his declaration by stating that YouMedical is of a size that he would be made aware of consumer complaints, including complaints relating to products other than YouMedical's own products, which have been mistakenly sent to YouMedical. He says he is not aware of any instances of a complaint from consumers in relation to confusion between WARTNER and WARTIE products, or indeed any other WART prefixed wart product.
21. In his Statutory Declaration Mr. McAtamney states that his company is the authorised distributor for goods sold under the mark WARTIE in Ireland. He attaches at Exhibit EM1 samples of the packaging showing use of the mark on products for the treatment of warts and verrucae, which his company has been distributing in Ireland since November 2013.
22. Mr. McAtamney says the total value of goods sold in Ireland under the mark WARTIE from November 2013 to April 2015 is €24,034. He attaches at Exhibit EM2 two invoices, both dated 28 May 2015 and both showing sales of 6 units of WARTIE wart and verruca remover.
23. He says his company has spent in the region of €3,000 on advertising the product in Ireland, though he states it is difficult to calculate the specific spend as this is included in the over-the-counter category spend. He states all of the advertisements appear on Facebook and he attaches at Exhibit EM3 a sample of such advertising.
24. He concludes his declaration by stating that goods bearing the trade mark WARTIE are available and have been sold in a large number of retail outlets in Ireland and he attaches, at Exhibit EM4, a list containing approximately 160 named outlets in which he states WARTIE is sold.
25. For his part Mr. Shane Smyth states that his firm carried out a search of the Irish and Community Trade Mark Registers on 8 May 2015 in Classes 3 and 5 for trade marks containing the prefix WART. He produces at Exhibit SS1 the results of that search which show the following marks: WARTS 'N' ALL, WARTNER (two separate registrations), WARTIEPEN, WARTREM, WartStop, WARTAWAY, NAILEXPert BY WARTNER, FORWARDTS and WART OFF.

26. He says his firm also carried out a search of the internet on 18 May 2015, for wart removing products being offered for sale in Ireland. He produces at Exhibit SS2 the results of that search, which identified three products WARTNER, EndWarts and WARTIE.

Rule 22 Evidence

27. Evidence filed under Rule 22 consists of a second Statutory Declaration, dated 6 October 2015, of Christoph Staeuble and two exhibits marked “CS1” and “CS2”. He says that, contrary to what Mr. Witte claims, it is not true to say the naming convention of products to treat common ailments is such that brand names often make reference to the ailment they treat. Mr. Staeuble states that most pharmaceutical products do not refer to the common ailment. He attaches at Exhibit “CS1” an extract from Wikipedia showing the 100 largest selling pharmaceutical products, the majority of which he claims do not make reference to the ailment they treat. The exhibit also contains an extract from the website *drugs.com* which lists treatments associated with warts and shows the vast majority of the products listed do not include the element WART or any reference to warts.

28. Mr. Staeuble states the naming convention for products for other treatments is not relevant and should be disregarded. He says the fact that some companies are willing to allow the marks of competitor’s to co-exist in their fields is also irrelevant to these proceedings. As regards the photograph adduced in evidence of wart treatment products in a Boots pharmacy, he says there are no products with the prefix WART except his company’s product and the Applicant’s product. He also points out the photograph has a sign beneath the Applicant’s product which identifies it as a “new” product. In any event he says this evidence should be disregarded as the photograph was taken after the relevant date and after the date the Notice of Opposition was filed.

29. As regards Mr. Witte’s claim that no instances of confusion have arisen, Mr. Staeuble states that as there has been minimal use of the Applicant’s new product that instances of confusion may not have been reported.

30. Mr. Staeuble states that of the 10 trade marks identified in Exhibit “SS1” attached to Mr. Shane Smyth’s evidence, 2 are owned by the Opponent (or its affiliates), 2 have been

abandoned, 2 are in respect of entirely different goods and 1 has “Wart” as a suffix. He says the results of this search do not show a co-existence of trade mark registrations containing the prefix “WART”.

31. As regards the list of wart treatment products available in Ireland contained in Exhibit “SS2”, Mr. Staeuble states there are only three items mentioned - the Opponent’s, the Applicant’s and the EndWarts product which does not contain “WART” as a prefix. The earliest dated item in the list dates from November 2014, which is after the relevant date. Mr. Staeuble then attaches his own list, at Exhibit “CS2”, containing the results of a search of the website *boots.ie* for “wart” products. There are no products listed with a prefix “WART” apart from the Opponent’s and the Applicant’s products.
32. Mr. Staeuble then addresses the sales and advertising expenditure figures and the list of WARTIE outlets produced by the Opponent. He states that all the materials relating to these elements of the Applicant’s evidence post-date the relevant date and should not be taken into consideration. He also says that there is no independent third party proof of use of the Applicant’s mark.

The Hearing

33. At the Hearing the Opponent was represented by Simon Gray, Trade Mark Attorney of Tomkins & Co. and the Applicant by Paul Kelly, Trade Mark Attorney of FRKelly.
34. Of the grounds of opposition cited in the Notice of Opposition filed on behalf of the Opponent, only those under Section 10 subsections (2)(b), (3) and (4) were canvassed at the hearing. While Mr. Gray did not abandon the other grounds cited in the Notice of Opposition, I am satisfied that my consideration of the opposition may be confined to these in respect of Section 10.

Section 10(2)(b) – likelihood of confusion

35. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:
- (2) *A trade mark shall not be registered if because –*
- (a)
- (b) *it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.

36. The principles of interpretation to be applied in determining an objection under Section 10(2)(b) of the Act are not in dispute. They have been set out in detail in several decisions of the Court of Justice of the European Union (CJEU)¹ and their applicability in an Irish context has been affirmed by the High Court (Finlay Geoghegan J) in *Cofresco Frischalteprodukte GmbH & Co. KG –v- The Controller of Patents, Designs and Trade Marks and Reynolds Metals Company*². In summary, the principles are:

- (i) the likelihood of confusion must be appreciated globally, having regard to all of the relevant factors, including the degree of similarity between the marks and between the goods, the likelihood that the public will make an association between the earlier mark and the mark seeking registration, and the distinctiveness of the earlier mark;
- (ii) the similarity between the marks must be determined by reference to the degree of visual, aural and conceptual similarity between them and the importance to be attached to each of these elements must be assessed by reference to the category of goods and the circumstances in which they are marketed;
- (iii) the assessment must be made from the perspective of the average consumer of the goods in question, who must be deemed to be reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely, instead, on the imperfect picture of them that he keeps in his mind;
- (iv) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components, because the average consumer normally perceives a mark as a whole and does not analyse its various details;

¹ including Case No. C-251/95, *Sabel BV v Puma AG and Rudolf Dassler Sport*, Case No. C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* and Case No. C-342/97, *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel BV*

² Unreported decision dated 14 June, 2007

- (v) the higher the distinctiveness of the earlier mark, whether inherent or acquired through use, the greater the protection granted to it, and vice versa.

37. There are four basic requirements which must be met in order for an objection under Section 10(2)(b) to succeed. The first of these conditions is there must be an earlier mark. The Opponent's Irish Trade Mark Registration No. 944700 and its European Union Trade Mark No. 006380661 share a registration date of 24 October, 2007. By virtue of Section 11(1)(b) of the Act, they are earlier trade marks as against the present applications for the purposes of Section 10.

Similarity of the goods

38. The second requirement is there must be similarity between the goods. Looking at the specification of goods in Classes 3 and 5 in respect of both party's marks it is apparent the goods are either similar or identical. The parties do not take a contrary position on this and, at the Hearing, Mr. Kelly was quick to declare his acceptance that that is the case in respect of goods in Classes 3 and 5.

Similarity of the marks

39. Turning now to the third requirement: the mark applied for must be similar to the earlier mark. I have compared the respective marks on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods for which the Applicant seeks registration. Notwithstanding the detailed comparisons I make below I am mindful that the CJEU has noted in *Sabel*³ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. Having acknowledged that, the marks at issue are not complex and neither contains any specific points of detail that are likely to go unnoticed by the average consumer.

40. In their respective oral submissions, Mr. Gray and Mr. Kelly conducted an assessment of the marks and reached different conclusions. Mr. Gray argued the marks share a high degree of visual similarity because of the presence of the common prefix WART, while

³ *Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*

Mr. Kelly maintained that, because of the different suffixes the marks were visually sufficiently distinguishable. Also Mr. Kelly argued that, while the Opponent's earlier mark is only one letter longer than the contested mark, it appears longer.

41. The Applicant's and Opponent's marks comprise nothing other than single words which are both of medium length – they consist of 6 and 7 letters respectively. They are both depicted in uppercase characters using the same unremarkable typeface. In my opinion, from a visual perspective, the marks are far more similar than dissimilar and I would rate the level of similarity as high.
42. Aurally the marks differ somewhat in that, while both consist of two syllables, the end syllables are different. Both marks open with the syllable WART, which is slightly longer than the “NER” and “IE” syllables that follow. Again, I find from an aural point of view, the marks are far more similar than dissimilar. I would assess the degree of aural similarity as medium high to high. Furthermore, the fact that the shared visual and aural similarities are found at the start of the marks and, being mindful that consumers tend to place greater emphasis on the beginning of pure verbal marks than to their endings, this would reinforce the high level of similarity.
43. Both marks are invented words but this does not mean they are devoid of conceptual meaning. Both begin with the letters W-A-R-T which would be recognised as a reference to an undesirable growth on the skin. However, the whole of the Opponent's mark WARTNER does not, in my opinion, convey an obvious message that it is something to do with such ailments. Also, I do not believe consumers would make a direct connection between warts and the goods in Classes 3, 8 or 10 for which the Opponent's mark is registered. Nor would it be in the Opponent's interest to have goods in these classes associated with warts, particularly “*soaps; perfumery, essential oils, cosmetics and hair lotions*”. In my opinion, use of the trade mark WARTNER on goods in these classes is more likely to be seen as use of a purely fanciful word or of a family name. However, when used on products for the treatment of warts (and this is the only type of good for which the Opponent provided evidence of use) consumers would make a conceptual connection between WARTNER and warts. So the conceptual message conveyed to

consumers by the Opponent's mark is likely to be different depending on the type of good it is placed on.

44. On the other hand the Applicant's mark WARTIE is immediately recognised as an alternative spelling of the word *warty* which describes someone that has or is covered in warts. Also, all of the goods for which the Applicant has sought registration can be associated with skin care, in particular, the treatment of skin disorders. I find the marks share a degree of conceptual similarity which is most pronounced when the marks are placed on preparations for the treatment of warts, which is the precise business in which the parties are competitors. I would rate the level of conceptual similarity as medium high for these goods.

45. Having completed a global comparison of the marks I am satisfied the marks are far more similar than they are dissimilar. Overall, I find the marks share a high level of similarity.

Likelihood of confusion

46. The basic ingredients of an objection under Section 10(2)(b) of the Act – *earlier similar trade and similar goods* – are all present in this case and the issue now rests on whether, as a consequence, there is a likelihood of confusion on the part of the purchasing public. The criteria against which the question should be answered has been enunciated in a number of decisions of the CJEU⁴ in this area and include the following:

- i. A lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa;
- ii. The more distinctive the earlier mark, the greater will be the likelihood of confusion;
- iii. In determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings;
- iv. In making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as

originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations;

- v. A global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the category of goods and the way in which they are marketed;
- vi. The assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind;
- vii. The likelihood of confusion must be appreciated globally, taking into account all of the factors relevant to the circumstances of the case.

47. In applying those criteria to the facts of the present case, I have reached the following conclusions:

- (a) The Opponent's mark has an obvious capacity to identify the goods for which it is registered as being those of a particular undertaking and thus to distinguish those goods from those of other undertakings;
- (b) The Opponent's mark is known in the State for over 10 years. Evidence adduced by the Opponent suggests it is the world's No. 1 wart and verruca treatment product, though it is not known for any other goods;
- (c) The contested goods may be purchased over-the-counter in pharmacies and the average consumer for present purposes is the ordinary citizen;
- (d) The overall impression created by the marks in question is that they are similar. Visually, verbally and conceptually they share an overall high level of similarity.

48. The kind of confusion that Section 10(2)(b) seeks to avoid is concerned solely with the commercial origin of goods, whereby the average consumer, being familiar with goods sold under the earlier mark and, because of the similarity in the respective marks, attributes to the goods offered under the disputed mark the qualities and characteristics

⁴ Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445; Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) [1999] 1 CMLR 77; Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343

that he associates through experience with the goods offered under the earlier mark. The question is whether the average person, who knows of products sold under the Opponent's trade mark WARTNER and who then encounters the Applicant's similar or identical products for sale under the trade mark WARTIE, would assume that the latter goods were connected with the former in the sense that they were both put on the market by the same undertaking or by commercially related undertakings.

49. I am required to make an overall assessment of the likelihood of confusion that may exist. The confusion in question may be direct confusion, whereby the Applicant's goods are mistaken for those of the Opponent, or indirect confusion, whereby the Applicant's goods are associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. I must look at the question of likelihood of confusion from a practical perspective in the context of the marketplace for the goods in question and put myself in the shoes of the average consumer.
50. Both parties put much emphasis on the use of their respective marks on skincare products, especially the treatment of warts, which is a subgroup of the "*pharmaceutical preparations*" goods for which the Opponent's mark is registered and for which the Applicant seeks registration. All of their respective evidence and most of their submissions related specifically to that niche area of trade and their respective positions regarding the norms associated with that business. Therefore, I think it is appropriate to deal with the likelihood of confusion question in two parts; one in respect of "*pharmaceutical preparations*" used solely for the treatment of warts and verrucae; the other in respect of all the remaining goods, including other pharmaceutical preparations.
51. Looking firstly at the non-wart and verruca goods. The respective marks do not in any way describe the goods or any characteristics of the goods mentioned in the respective specifications of the non-wart and verruca related category of goods. The respective goods are highly similar if not identical. Neither party identified the average consumer of these types of goods or the typical purchasing scenario, so I must assume the average consumer is the general public and that there is nothing unusual about the manner in which the goods are purchased. The marks are very similar but not identical. Both marks contain one word. They are similar in length. Each starts with the letters W-A-R-T and both have an 'E' as their sixth letter.

52. In *Canon*⁵ the CJEU ruled the global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services. Accordingly, the court found 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. I have conducted an in-depth assessment of the similarity between the respective goods, and it is clear there is identity in respect of some goods and a high degree of similarity with respect to the remainder. I find the differences between the Opponent's WARTNER mark and the Applicant's WARTIE mark are not sufficiently striking and obvious to offset the level of identity and similarity that exists between the respective goods.
53. In light of all the foregoing I am satisfied the average consumer would be likely to be confused as to the origin of goods, other than "*pharmaceutical preparations [for the treatment of warts and verrucae]*", bearing the WARTIE mark or to believe that such goods were produced by an undertaking associated with the proprietor of the WARTNER mark. Therefore, I uphold the opposition based on Section 10(2)(b) of the Act in respect of all goods which do not fall within the category of "*pharmaceutical preparations [for the treatment of warts and verrucae]*".
54. Turning now to "*pharmaceutical preparations*" and the particular subgroup of that category concerned with the treatment of warts and verrucae. As already mentioned, the Applicant made much play of the fact that brand names for medical products often contain a reference to the ailment they treat, though the Opponent suggests that the practice is not as widespread as the Applicant claims. I am satisfied that some trade marks, used on some medical products, refer to the ailment they target and that enough evidence was adduced by the Applicant to conclude that this practice has, in some incidences, been followed in respect of products for the treatment of warts and verrucae. Nonetheless, this practice does not mean there is a free-for-all in respect of the registration of trade marks containing the word WART for products used to treat warts and verrucae. Nor does it mean the prohibition on the registration of trade marks because of a likelihood of confusion resulting from the similarity between the marks and the goods must be set aside or relaxed.

⁵ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*, (Case C-39/97 paragraph 17)

55. The Opponent also argued that many different WART named brands coexist in the marketplace without their proprietors suffering adversely or finding it necessary to take some action. The Opponent pointed out that it always protects its WARTNER brand and the position adopted by third parties in relation to their brands is irrelevant. I agree with the Opponent. These proceedings cannot be decided on the basis that what is good enough for some must be good enough for all. The determination of whether a trade mark is registrable cannot be influenced by the brand protection strategies adopted by traders that are not party to the proceedings. Such strategies are irrelevant and must be ignored.
56. The Opponent claims that all of the evidence submitted by the Applicant post-dates the relevant date. The Applicant's evidence clearly states that goods bearing the WARTIE mark were first placed on the Irish market in November 2013. There is no evidence to point to any advertising or marketing prior to the product appearing on the shop shelves. The only evidence of advertising, which is not dated, points to the Applicant having a Facebook page, which by its nature cannot be deemed to be advertising targeted specifically at Irish consumers or the general Irish public, many of which are not users of Facebook or who do not use Facebook as a shopping site.
57. The Opponent is correct that the Applicant's evidence all post-dates the relevant (priority) date, but that is not fatal to the Applicant's case. I must decide the matter based on what would have been the position on 21 May 2013 if both marks were used in a fair and normal manner. The fact that no use whatsoever was being made of the mark on the relevant date does not help the Applicant's cause and, in light of the non-use, claiming a priority date for an application which is likely to be subsequently opposed may be viewed as being of more harm than good to its case.
58. The Applicant claims that as it has not been made aware of any incidents of confusion that confusion has not occurred and is therefore unlikely to occur in the future, while the Opponent argues that due to the extremely limited use by the Applicant of its WARTIE mark that incidents of confusion may not have been reported, but are likely to arise in the future. There was no use of the Applicant's mark in the State at the relevant (priority) date of 21 May 2013. In fact the evidence submitted by the Applicant does not allow me to determine the date, or even an approximation of the date, on which the Applicant first used its mark in Ireland. The only materials submitted in evidence by the Applicant which are dated are two invoices dated 28 May 2015 and the results of two searches carried out

in May 2015. These dates not only postdate the relevant date, they fall after the Notice of Opposition was filed and also after the Opponent submitted its evidence under Rule 20. Therefore, the evidence submitted by the Applicant does not allow me to conclude that its mark was being used in Ireland since November 2013. In light of the absence of evidence of simultaneous use in the marketplace of the parties' respective marks prior to the initiation of these opposition proceedings it is not surprising that no incidents of confusion have been reported.

59. In any event, in my opinion, a lack of actual incidents of reported confusion is not sufficient to conclude that confusion is unlikely to arise. The goods upon which both parties' marks are used are inexpensive and purchased infrequently. A consumer who purchases a WARTIE product in the mistaken belief that it is a WARTNER product is highly unlikely to complain, unless the WARTIE product does not do the job for which the consumer made the purchase. There is nothing to suggest the Applicant's WARTIE product is not a very good treatment for the treatment of warts and verrucae. Therefore, it is simply not likely that a consumer would be so disgruntled that, having used a product that worked, but then subsequently discovered s/he picked up one branded product thinking it to be something else, that s/he would actually contact the Applicant, or indeed the Opponent, to complain that s/he was confused. Nor is it likely that a consumer would purchase a WARTIE branded product and, on discovering prior to using it that it was not the WARTNER product s/he thought s/he was purchasing, return it unused to the retailer and make a formal complaint regarding being confused.

60. I have considered all the relevant factors in this case, including the accepted naming conventions in the area under examination. The Applicant pointed to a number of registered trade marks containing the word WART and argued that consumers are familiar with such practices and have not been confused by the introduction of the Applicant's trade mark WARTIE. On the other hand, the Opponent contended that the evidence produced by the Applicant, that relates purely to use in Ireland, shows only two marks side-by-side on a retail shelf with "WART" as a prefix, these being the Opponent's and the Applicant's marks.

61. While the Opponent did not provide details of its turnover or sales figures in relation to its WARTNER products, copies of two orders were submitted, each in respect of amounts of

more than 5,000 WARTNER branded units. This demonstrates significant market penetration when compared to the two invoices in respect of 6 units each that were adduced by the Applicant. The evidence submitted shows the Opponent has built up a significant reputation in Ireland for wart and verruca treatment products, dating back to 2006. The evidence, by way of an approval from IMS, substantiates the Opponent's claim to be the world's leading anti-wart brand. While the trade mark WARTNER possesses a less than average degree of inherent distinctiveness in respect of wart and verruca treatment products, the level of distinctiveness attached to the mark has been enhanced as a result of the use made of it.

62. In the context of conducting the necessary assessment of the respective mark in terms of a likelihood of confusion as regards products for the treatment of warts and verrucae, I am completely satisfied the same conclusions must be drawn as those I reached regarding all other categories of goods. That is, that if the respective marks were fairly used on wart and verruca treatments, there is a likelihood of confusion on the part of the typical consumer. The only question now is whether the naming convention, which the Applicant claims is common in the business, would have an effect on the relevant class of consumers so as to make them more attentive, more observant and more circumspect than usual, and therefore diminish the possibility of confusion arising to such an extent that confusion would be unlikely.

63. In my opinion, the answer to that question must be that that scenario is most unlikely to be played out. I say that for two reasons. Firstly, consumers do not, on encountering trade marks that contain a direct reference to the intended purpose of the goods on which the mark is placed, make a determined and conscious effort to retain more information or detail about the trade mark than they do for trade marks placed on other products which they purchase in the same manner. The goods at issue are relatively inexpensive and can be selected by consumers off the shelf. The typical purchasing scenario would see the consumer entering a pharmacy, going to the relevant section and selecting a product that they think might work get rid of the unwanted wart or verruca. If they had cause to purchase such a product in the past they are likely to be guided by their previous experience. If not, it is likely they might think that any one of the products on offer is as good as the next and they may simply select one and hope for the best.

64. Secondly, in my opinion, wart and verruca treatment products are not purchased frequently and are not typically one-use-only treatments. Consumers can expect to treat a number of unwanted growths with the same purchase. In my opinion, they are more likely to be purchased once every couple of years or even less frequently.
65. On the basis of the typical purchasing pattern and the level of attention paid by the average consumer of these goods, I am satisfied consumers would not feel they need to consciously remember all the finer details of a particular brand. It is not unlikely that they would only recall that, in the past, they purchased a product beginning with the word WART. The evidence adduced by the Applicant itself shows that there are only two wart treatment products on sale in the Irish market which begin with the prefix WART – the Applicant’s and the Opponent’s, thereby further weakening the Applicant’s contention that Irish consumers are used to seeing and discerning between marks that begin with WART. I find, on the basis of the facts of this case, that the naming convention which at times comes into play for medicinal products does not have any bearing on the likelihood of confusion. Therefore, I must refuse the application in respect of wart and verruca treatments.

Decision

66. Having dealt with all the goods, I am satisfied that there is every likelihood that a consumer, having purchased a product bearing the Opponent’s WARTNER mark who then encounters the Applicant’s WARTIE mark on identical or highly similar goods, would be confused as to the origin of those goods. That confusion would be such that the consumer would be likely to think the products emanate from a single source or from economically linked sources. Accordingly, I have decided to refuse the application in respect of all the goods for which registration was sought as it offends against Section 10(2)(b) of the Act.
67. Having refused the application under Section 10(2)(b) I need not consider the other grounds of opposition.

Dermot Doyle

Acting for the Controller

9 August, 2016