

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

between

STEPHEN KAVANAGH (Proprietor)

and

MERCK CONSUMER HEALTHCARE LIMITED (Applicant for Invalidity)

concerning Trade Mark No. 248819

The registered trade mark

1. STEPHEN KAVANAGH, of Beechgrove, Ferrybank, Arklow, Co. Wicklow, Ireland is the registered proprietor of the Trade Mark PulsePro (“the said mark”), which is registered in class 5 in respect of ‘*Amino acids for medical purposes; vitamin preparations*’.

The application for registration of the mark was filed on 19 April, 2013 and, by virtue of Section 45(3) of the Act, the mark is registered as of that date. The application was published for opposition purposes in Journal No. 2231 dated 19 June, 2013 and the registration of the trade mark was published in Journal No. 2242 on 20 November, 2013.

Application for declaration of invalidity

2. On 23 December, 2013, MERCK CONSUMER HEALTHCARE LIMITED of Hedon Road, Marfleet, Hull, HU9 5NJ, United Kingdom made an application under Section 52 of the Trade Marks Act, 1996 (“the Act”) for a Declaration of Invalidity of the said mark and included with the application a statement of the grounds on which it was made. On 11 April, 2014 the Proprietor filed a Counter Statement and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
3. Both parties filed written submissions in lieu of attending a hearing in the matter and both parties filed submissions in reply to the other party’s written submissions. Acting for the Controller, I decided to grant the application for invalidity on the grounds that the registration of the said mark offended against Section 10 of the Act. The parties were informed of my decision by way of letter dated 7 December, 2015. I now state the grounds of my decision and

the materials used in arriving thereat in response to a request by the Applicant in that regard pursuant to Rule 27(2) of the Trade Mark Rules 1996, filed on 4 January, 2016.

Grounds of the Application

4. The Applicant grounds its application on the provisions of Sections 8 and 10 of the Act and on the claim that the registration of the said mark is contrary to Council Directive No. 89/104 to approximate the laws of the Members States relating to trade marks. As regards Section 8, the Applicant claims the said mark should be declared invalid to the extent that its use is prohibited in the State by an enactment or rule of law or by a provision of Community law including any rule of law protecting an unregistered trade mark; though the Applicant fails to identify what specific enactment or rule of law the registration of the said mark offends against. The Applicant also fails to particularise why the registration of the said mark is contrary to Council Directive No. 89/104. Accordingly, and without further ado, I must reject the application on these grounds.

5. In reality the grounds upon which the application is based are centred on Section 10 of the Act and fundamentally relate to the Applicant’s proprietorship of the following Trade Mark Registrations, all consisting solely of the single word PULSE, and the existence of a likelihood of confusion as between these marks and the said mark:

Registration	Effective Date of Registration	Class & Goods
Irish Registration No. 127085	12 January 1988	Class 5: Infants' and invalids' foods; pharmaceutical preparations; food supplements included in Class 5.
Irish Registration No. 127086	12 January 1988	Class 29: Fish oils and derivatives thereof, all included in Class 29.
Community Trade Mark No. 3927704	12 July 2004	Class 5: Pharmaceutical and medicinal preparations and substances; nutritional supplements; vitamins; minerals and mineral salts; preparations consisting of vitamins and/or minerals; medicinal herbs; herbal preparations; fish oils and derivatives thereof for use as dietary supplements and for pharmaceutical and medical purposes; cod liver oil. Class 29: Nutritional supplements; edible oils and edible fats; foodstuffs containing oils or fats.

Notice of Opposition

6. In its Notice of Opposition the Proprietor denies all the claims made by the Applicant in the Statement of Grounds. The Proprietor also denies that the Applicant’s PULSE trade marks

have acquired any distinctiveness through use in that PULSE is arbitrary and is a common word which is used in a meaningless context, whereas his mark is an inherently distinctive trade mark as it comprises an entirely invented or fanciful sign. The Proprietor claims that the word PULSE by virtue of being arbitrary cannot possibly distinguish anything from another thing and claims that there are many registrations for the word PULSE in many different Classes, all arbitrary, the use of the word in each case giving no indication of the goods or services involved.

7. The Proprietor states that he is a Marine Scientist and can verify that, contrary to the Applicant's claims, there is absolutely no similarity between the goods involved in these proceedings. The Applicant's goods are fish oil gelatine capsules for human consumption, whereas the Proprietor's goods are an amino acid which is dissolved in water and taken as a drink. He states there is no possibility of confusion between the two.
8. The Proprietor closes his Counter Statement by disagreeing with the Applicant's contention that the registration be declared invalid and that costs should be awarded to the Applicant. The Proprietor states that he and the Patents Office at all times followed the correct protocol and the Applicant had ample opportunity to object to the Proprietor's application when it was advertised in the Journal and that there were never any attempts by the Proprietor to withhold or deny the Applicant a chance to object.

Rule 20 evidence

9. Evidence submitted by the Applicant under Rule 20 of the Rules consists of a joint Statutory Declaration, dated 13 October 2014, of Sabine Felloussi and Diana Schmerier, authorised representatives of the Applicant, and evidence by way of five exhibits (marked "Exhibit 1" to "Exhibit 5").
10. They say the Applicant's PULSE trade marks (registered details of which were attached at Exhibit 1) has been used by the Applicant in Ireland since 2004 in relation to a food supplement containing fish oils. They attach at "Exhibit 2" sample packaging for the full range of products sold under the PULSE brand which include:

PULSE OMEGA-3 CAPSULES 60's
PULSE OMEGA-3 CAPSULES 120's
PULSE ADVANCED OMEGA-3 CAPSULES 60's
PULSE ADVANCED OMEGA-3 CAPSULES 120's

11. They state their company’s PULSE trade mark has been used throughout the State and products bearing the mark are available in a number of supermarket chains, including Tesco’s, and numerous pharmacy chains, including Boots, Sam McCauley’s and McNally’s. They attach at “Exhibit 3” references, by way of printouts from the named stockists’ websites, to the Applicant’s PULSE branded products and a single purchase order from the Applicant’s distributor (United Drug Distributors) which contained, amongst other items, a total of 4,200 PULSE branded products with a value of over €35,000.
12. Ms. Felloussi and Ms. Schmerier state that sales under the PULSE trade mark are substantial and provide turnover figures, totalling €1,901,327, for goods sold under the mark in Ireland between 2008 and 2013 as set out below.

Year	Amount
2008	€ 452,525
2009	€ 391,382
2010	€ 332,110
2011	€ 302,698
2012	€ 265,516
2013	€ 156,096

13. They say the PULSE trade mark is widely promoted and advertised throughout the State in numerous publications, billboard advertising, out-of-home posters and online. They attach at “Exhibit 4” three advertising posters displaying the PULSE trade mark in respect of fish oils. They also say the Applicant advertises its PULSE mark through its www.seven-seas.com website and provide, at “Exhibit 5”, printouts of such advertising.

Rule 21 evidence

14. Evidence submitted by the Proprietor under Rule 21 of the Rules consisted of a Statutory Declaration, dated 21 April 2014, of Stephen Kavanagh, and 6 accompanying exhibits marked “Display number 1” to “Display number 6”.
15. In his evidence the Proprietor identifies himself as a scientist engaged since 1992 in research and development of supplemental functional food ingredients and food products. He states he is the beneficiary of the PulsePro trade mark (he attaches details of its registration at “Display number 1”) and that the product PulsePro is the culmination of over 20 years working in the field of human health and nutrition. The product was originally made by Fish Out Of Water Limited, a company owned by him and established in 2000. He states that another company –

Gaia Biotechnology Ltd. – was incorporated by him in 2007 with the intention of manufacturing and marketing his supplement products. He attaches at “Display number 3” a quotation for an “Orange Drink Compound” and a pro forma invoice in respect of 60kgs of an “Orange Drink Base”, both addressed to Fish Out Of Water Ltd. He also attaches an invoice in respect of 100kgs of “L-Arginnie” and an invoice from a freight company in respect of a consignment of 3 items of “L-Arginnie Base”, both made out to Gaia Biotechnology Ltd. There are also two certificates of analysis in respect of products named “L-Arginnie” and “L-Citrulline” and e-mail correspondence that relates to an online order placed by info@fishoutofwater.ie for Vitamin D3 Veggie Caps, L-Citrulline Capsules and L-Arginnie Powder. However, none of the materials attached at “Display number 3” contains any mention of the PulsePro trade mark.

16. The Proprietor states that Gaia Biotechnology Ltd. was dissolved and the product and trade mark are currently in use in the State and internationally through selected professional persons and online commerce by Marine Healthfoods Ltd., a company owned by the Proprietor that now manufactures the PulsePro product. “Display number 6” contains two extracts from that company’s website showing the PulsePro product on offer. He attaches at “Display number 4” a Material Safety Data Sheet in respect of the PulsePro product and a Certificate of Analysis of the PulsePro product, which is signed by the Proprietor.
17. He states that sales of the product have been significant and reached in excess of €60,000 in the financial years 2011, 2012 and 2013 compared with sales of under €1,000 four years earlier during the development phase. He says the PulsePro mark is widely promoted through a network of professionals in the healthcare industry and through a cardio vascular screening programme in the State operated by Marine Healthfoods Ltd. He attaches at “Display number 5” details of the screening programme, which in fact does not mention PulsePro but refers to a “BPro” branded monitoring device worn on the wrist.
18. The Proprietor goes on to claim the Applicant misled the Controller in certain statements made in its Statutory Declaration. The Proprietor claimed the PULSE trade mark was not used by the Applicant since 2004 as prior to 2005 the mark was in the proprietorship of Seven Seas Limited and that the Applicant is asserting the mark at issue is PULSEPRO when in fact it is PulsePro. He also claims that as the Rule 20 deponents are employed by Merck KGaA they need to provide authorisation from Merck Consumer Healthcare Ltd. and back up same

with minutes from the EGM where the authorisation was granted by a majority decision of the board.

19. The Proprietor also claims the Applicant should have made its declaration under the Trade Marks Act, 1963 as it is under this Act that the Applicant's mark is registered. Thus, he claims, the declaration is flawed and the claim invalid.
20. The remainder of the Proprietor's declaration is mostly comprised of opinion regarding the construct and distinctiveness of the respective marks, the likelihood of confusion as between the marks, the differences between the actual products sold under the respective trade marks, the packaging used by each party and the respective trade channels.

Rule 22 evidence

21. The Proprietor filed evidence in reply under Rule 22, which consisted of a Statutory Declaration, dated 16 June 2015, of Carol Gormley, Partner and Trade Mark Attorney of FRKelly and a single exhibit marked "Exhibit CJG1".
22. In her evidence Ms. Gormley addresses the specific claims made by the Proprietor that I have detailed at paragraphs 18-19 above. She confirms Sabine Felloussi and Diana Schmerier are authorised to make their declaration on behalf of Merck Consumer Healthcare Ltd. and signed a Statutory Declaration to that effect. She confirms that Seven Seas Ltd. is identified as a Merck KGaA (a KGaA being a "Kommanditgesellschaft auf Aktien", which designates a German corporate partnership limited by shares) and attaches at "Exhibit CJG1" a printout from www.seven-seas.com which shows this to be the case.

The Written Submissions

23. In the opening pages of its written submissions the Applicant critiques the evidence submitted by the Proprietor under Rule 21. The Applicant submits the Proprietor has failed to adduce any evidence to substantiate its claim that the product it produces is the result of 20-years work in the field of human health nutrition. Many of the exhibits do not refer to the trade mark PulsePro but refer to other brands, for example 'BPro' in respect of the claimed cardio vascular screening programme.
24. There is no evidence of when any of the three companies mentioned by the Proprietor first manufactured the product bearing the PulsePro mark. There is no evidence to suggest the

PulsePro trade mark has a market presence in Ireland. The claimed sales figures are unsupported and there is no evidence to show even a single sale of a product PulsePro in Ireland. The invoices that are submitted do not refer to the trade mark PulsePro. The evidence put forward as a sample of current product packaging is no more than a graphical “mock-up” of packaging as opposed to actual packaging or a photograph of real packaging.

25. The Applicant argues that the Proprietor’s claims that there is no possibility of confusion because the respective products are sold in different forms (one in capsule format while the other is power form that must be dissolved), they come in different packaging, they use different labelling and the respective distribution channels are different, must be rejected. These are not relevant and the matter at issue must be decided on a comparison of the word marks PULSE and PulsePro.
26. The Applicant refutes the Proprietor’s claim that the Applicant’s PULSE trade mark does not fulfil the requirements for registration as laid out in Section 6 of the Act, whereas the Proprietor’s PulsePro mark does. The Applicant points out that adding the common abbreviation “Pro” to the end of the term Pulse does not create a trade mark that looks, sounds or means anything different to the term Pulse.
27. The Applicant explains that it did not oppose the registration when it was open to opposition because it was unaware of its publication, but nonetheless acted as soon as it became aware of the existence of the Proprietor’s mark.
28. Turning its attention to the Section 10 based ground of invalidity the Applicant conducts a comparison of the respective marks and submits the distinctive and dominant elements of both marks is the term Pulse. The remaining element of the said mark is the term Pro, which is entirely lacking in distinctive character. The term Pro is merely an abbreviation of the word professional and will be seen as meaning “advanced”. The said mark therefore suggests that there is a range of products traded under the mark Pulse with the term Pro being added to signify an advanced or higher intensity product within the Pulse range. The use of capital P in the term Pro reinforces the suggestion that the brand is Pulse with the Pro element being used as a secondary descriptor.
29. The Applicant conducts a visual, phonetic and conceptual comparison of the respective marks and concludes they are visually and phonetically highly similar, and that they are highly similar if not identical from a conceptual perspective.

30. When comparing the respective goods the Applicant submits both sets of goods include pharmaceutical / medicinal preparations / vitamins, they are in competition with one another and are complimentary, and the nature and purpose of the Applicant's goods are identical to the nature and purpose of the Proprietor's goods. The Applicant argues it is clear, therefore, that the contested goods are identical to the goods covered under the Applicant's earlier PULSE marks. As the respective marks and goods are identical or highly similar, the criteria for constituting a likelihood of confusion have been established.
31. The Applicant cites a number of Community Trade Marks cases and decisions of the Court of Justice of the European Union in support of its arguments and concludes the Controller must find that there is a likelihood of confusion and, therefore, the registration of the mark must be invalidated.
32. In his written submissions the Proprietor argues that there can be no possibility of confusion as the products sold under the respective marks are entirely different in nature. The Applicant's mark is used on a fish-oil in gelatine capsule format, whereas the Proprietor's mark is used on a vitamin and amino acid preparation taken as a drink. He repeats what he said in his Statutory Declaration regarding the differences in trade channels and target market, and submits the Applicant's arguments about confusion are akin to saying a bicycle and an airplane are the same thing when the similarity between the two is limited to the fact they are both modes of transport.
33. The Proprietor then turns to the distinctiveness of the respective marks, arguing that his mark is a neologism that is fanciful and has merit based on intellectual originality, whereas the Applicant's mark is an everyday word used in a seemingly meaningless context. He challenges the Applicant's moral and ethical right to monopolise the word PULSE, as he argues it comprises a word that is widely used in relation to the benefits derived from the consumption of fish oils, specifically that they have a beneficial effect on the pulse rate and cardio vascular health. The word is the essence of life itself and monopolising it could seriously limit the willingness of researchers to engage in work that could benefit mankind if they were to believe that using everyday words in literature relating to their discoveries could lead to litigation from multi-national corporations. He submits that should a researcher in the future be in a position as a result of their endeavours to make a direct medical claim in relation to some new fish oil and the human and/or animal pulse, they may be prevented from

sharing such medical breakthrough by virtue of this attempted monopolisation by the Applicant.

34. The Proprietor argues he followed the correct protocol in applying for his mark. The Applicant had ample time to object, but through its negligence failed to do so. By waiting until the mark was registered before taking action the Applicant ensured he incurred costs in respect of branding, marketing and PR for his mark. He should not be expected to forego these efforts and expenses.

35. He then repeats his claims that the Applicant misled the Controller and concluded his submission by arguing the mark should remain on the register and that an award of costs be made in his favour.

Written submissions in reply

36. In its reply to the Proprietor's written submissions the Applicant reiterates what was contained in its written submissions and evidence. The Applicant questions a number of statements made by the Proprietor but adds little of probative value to what was already submitted.

37. Similarly the Proprietor repeats much of what he has already said in evidence or in his written submissions. However, he does offer an explanation for the absence of sales and customer information, by declaring this information "*valuable and confidential customer data*", which he is not in the habit of sharing with third parties "*who may be in a position to use that data to market their own entirely different products to those customers*".

38. The Proprietor argues that the legal authorities cited by the Applicant are not relevant as they are concerned with matters entirely different to the case at hand.

Non-substantive issues

39. Before considering the substantive issue I must address three other matters that were raised during the course of these proceedings. The Applicant was critical of the lack of supporting evidence adduced by the Proprietor in defence of the registration, particularly in terms of claimed use of the mark at issue. While much of what was claimed by the Proprietor was unsupported by evidence, the question of use of the mark is a moot point as there is no requirement to submit evidence of use in order to successfully defend a registration against an application for a Declaration of Invalidity.

40. The Proprietor claimed the application should be rejected because the Applicant failed to act during the period in which an opposition can be lodged. In his view the delay was evidence that the Applicant's application for invalidity was vexatious. While the initiation of opposition proceedings is the most appropriate mechanism in which to challenge an application and while the Proprietor is certainly likely to be more inconvenienced by an application for invalidity after registration than by an opposition beforehand, there is no legal requirement to use that channel. Nonetheless the timing of an attack can be a factor in determining whether the attack is vexatious. The Applicant did not oppose the registration of the mark, but it did submit an application for a Declaration of Invalidity just 3 days after the publication of the registration of the mark. The Applicant explained that it was unaware of the publication of the application, but nonetheless acted immediately on discovery of the registration of the mark. I have no reason to doubt the Applicant and I am completely satisfied the Applicant acted as soon as it became aware of the existence of the Proprietor's mark. Therefore, without hesitation, I dismiss the Proprietor's charge that the Applicant's motives were vexatious in nature.
41. The Proprietor also claimed the application should be dismissed as it was filed under the wrong legislation, namely the Trade Marks Act of 1996, because as the Applicant's earlier mark was registered under the Trade Marks Act of 1963 the application should have been made under the old act. The Proprietor is incorrect. The effective legislation for these proceedings is the Act under which the mark under attack is registered not the Act under which the earlier mark is registered.

Decision

Section 10(2)

42. 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.

43. As is evident from the wording of Section 10(2), the four basic requirements that must be met in order for an objection under it to succeed are that, (i) there must be “an earlier trade mark”, (ii) the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, (iii) the mark applied for must be similar to that earlier trade mark, and, (iv) there must be a resultant likelihood of confusion on the part of the public.
44. The first two of these conditions are clearly fulfilled in this case. The Applicant’s two Irish Registered Trade Marks were filed at this Office on 12th January 1988 and its Registered Community Trade Mark was filed at the Office for Harmonisation in the Internal Market on 12th July 2004, both dates being prior to 19rd April 2013 (the relevant date) and by virtue of Section 11(1)(a) of the Act, are earlier trade marks as against the Proprietor’s mark for the purposes of Section 10.
45. In his evidence and written submissions the Proprietor emphasised the difference between the party’s products that bear the respective marks that are currently on the market and argues that these goods are completely different. The Proprietor also questioned the validity of the Applicant’s mark as, in his opinion, the word PULSE is the essence of life itself and no one undertaking should not be granted a monopoly for its use. While the Proprietor must be commended for conducting a robust defence of his trade mark registration these two lines of argument demonstrate he does not fully understand the relevant provisions of trade mark law. The actual goods upon which the respective marks are currently used are not a factor that I can take into account in adjudicating on this matter. These proceedings are concerned with the goods for which the respective marks are registered, not the goods that currently bear the marks. In the absence of a formal application for a Declaration of Invalidity or Revocation of the Applicant’s PULSE trade mark, the registration of that mark cannot be called into question. Therefore, these proceeding are concerned solely with the validity of the Proprietor’s PulsePro mark.
46. The specifications of goods of the Proprietor’s mark consists of ‘*Amino acids for medical purposes*’ which must be considered a subset of the Applicant’s ‘*medicinal preparations and substances*’; and ‘*vitamin preparations*’ which must be considered identical to the

Applicant's '*nutritional supplements; vitamins; preparations consisting of vitamins and/or minerals*'. I am completely satisfied the Proprietor's specification of goods is contained within, and is therefore identical to, the specification of the Applicant's goods.

Comparison of the marks

47. I have compared the respective marks of the parties 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 protected by the marks. Notwithstanding the detailed comparisons I make below I am mindful that the European Court of Justice has noted (*Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*)¹ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

Visual and aural comparison of the marks

48. Visually and aurally the marks are highly similar. The Applicant's mark consists entirely of the common word PULSE and the Proprietor's mark differs only in that the word PRO is added as a suffix.

49. The Proprietor argued made much of the fact that in his mark it is only the P's that are upper case whereas the entire of the Applicant's mark is depicted in uppercase. Nothing turns on this as the marks will be seen and spoken as "PULSE" and "PULSEPRO" irrespective of the case used. The Proprietor also argued that his mark is a neologism which is fanciful and has merit based on intellectual originality, whereas the Applicant's mark is an everyday word used in a seemingly meaningless context. I disagree. The Proprietor's mark contains the well-known English word "Pulse" to which he has merely added the commonly-used abbreviation for professional - "Pro". There are hundreds of registered trade marks protected in Ireland that end in "Pro". In that regard the Proprietor's mark is not particularly meritorious in terms of intellectual originality, as it was created using a well-established formula.

¹ Paragraph 23 of decision dated 11 November, 1997

Conceptual comparison of the marks

50. While the word pulse has a number of meanings (e.g. heart-beat, rhythm, to beat, edible seeds of certain plants) the clear message conveyed by the word when used in association with the goods for which both party's marks are registered centres on the human heart-beat. In my opinion, the addition of the suffix "Pro" in the Proprietor's mark does no more than suggest a stronger or better quality heart-beat. Therefore, I find the respective marks share a high degree of conceptual similarity.

51. Having completed a global assessment I have come, unsurprisingly, to the conclusion that the overall impression given by the respective marks is that they are highly similar.

Likelihood of confusion

52. The question is whether that similarity is sufficient to come within the meaning of Section 10(2)(b) of the Act? The criteria against which that assessment should be made have been enunciated in a number of decisions of the European Court of Justice² in this area and they include the following:

- the likelihood of confusion must be appreciated globally, taking into account all of the relevant factors,
- a global assessment of likelihood of confusion implies some interdependence between the relevant factors and, in particular, between the extent of the similarity of the respective marks and that of the respective services,
- a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective services, and vice versa,
- the more distinctive the earlier mark, the greater will be the likelihood of confusion resulting from the use of a similar mark,
- in determining the distinctive character of the earlier mark, an overall assessment must be made as to its capacity to identify the relevant services and distinguish them from those having a different origin,
- in making that assessment, account must be taken of the inherent characteristics of the mark and also of the distinctiveness it may have acquired through use,

² 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

- the global appreciation of the likelihood of confusion must, as regards the visual, aural or conceptual similarities of the respective marks, be based on the overall impression likely to be created by them in the mind of the average consumer having regard to their distinctive and dominant components,
- for the purposes of that assessment, the average consumer of the services is deemed to be reasonably observant and circumspect but account must be taken of the fact that the average consumer rarely has the chance to make a direct comparison of the respective marks and must rely on his imperfect recollection of them.

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

Degree of similarity between the marks and between the goods: For the reasons set out above I regard the marks in question as having a high level of similarity.

Inherent distinctiveness of the earlier marks: I regard the Applicant's marks as having a low degree of inherent distinctiveness, as the goods for which it is registered can all be classified as health-related products and the word PULSE is in common usage in connection with medical or health matters, though it does not actually directly designate any specific characteristic of the goods. Therefore, it has the 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.

Additional distinctiveness acquired through use: The Applicant's marks have been in use in the State since 2008, but the evidence submitted by the Applicant does not suggest to me that a significant proportion of the relevant public would identify the Applicant's goods by reference only to the PULSE trade mark. Little by way of evidence was adduced to support claims of wide-spread promotion and sales of PULSE branded products throughout Ireland. Notwithstanding the Applicant claimed (though the claim was not supported by hard evidence) that turnover for the six-year period from 2008-2013 was €1,901,327 (an approximate annual average of €317,000) this, in my opinion, is a minuscule share of the overall Irish market for all the goods for which the Applicant's marks are registered. Therefore, I am not satisfied that it has acquired any significant additional distinctiveness through use and promotion to justify it being afforded an increased level of protection.

Overall impression created by the marks: The overall impression created by the marks in question is that they are very similar. They look and sound highly similar and the concept is very similar.

The average consumer: In his written submissions Proprietor expressed his uncertainty of what or who the average consumer is, and suggested that his customers are not average consumers. He identified his customer's as naturopathic doctors and therapists. I understand the Proprietor sees this class of professional as different from the average customer who might buy health products in a supermarket. However, once again I am not concerned with what products the specific parties are actually selling or who buys those products. For the purposes of these proceedings I must identify the average consumer i.e. the typical retailer, purchaser or end-user of the goods specified in the respective lists of goods. The goods listed are readily available in the State (albeit that some classes of these goods are available on prescription only) and purchased frequently. The "average consumer" of these goods must, therefore, be deemed to be the general public.

54. The goods covered by the Applicant's and the Proprietor's marks are identical. The marks are highly similar. In determining whether the degree of identity and similarity is sufficient to be likely to cause confusion I must put myself in the shoes of the average consumer of the goods in question. In essence I must judge the matter of the assessment of likelihood of confusion in accordance with ECJ guidance to decision-makers, which can be summarised as follows: *Imagine a typical purchasing scenario involving the average person who already knows the product sold under the earlier trade mark and ask yourself whether it is likely that he will select and purchase a product bearing the said mark in the mistaken belief that it is the product he knows by the earlier mark (direct confusion) or that it is related to that product (indirect confusion by association).* It is not necessary to find that every consumer would be confused, nor is it sufficient to find that some consumers might be confused in order to invalidate the registration of a trade mark by reason of Section 10(2)(b). The question is whether it is likely or unlikely that the average person would be confused in the course of the typical purchasing scenario.

55. In my opinion there is no doubt that a consumer who having purchased either a 'medicinal preparation or medicinal substance' or a 'vitamin preparations' under the PULSE trade mark

and then encounters '*Amino acids for medical purposes*' or '*nutritional supplements; vitamins or preparations consisting of vitamins and/or minerals*' under the PulsePro trade mark is likely to think the PulsePro branded product is an improved or stronger (in the sense that the active ingredients are more concentrated or faster-acting) version of the earlier PULSE product that emanates from the same undertaking or from an undertaking that is connected or associated in trade with the undertaking that is responsible for the PULSE brand. Therefore the continued presence of the PulsePro trade mark is likely to cause the confusion that Section 10(2)(b) seeks to avoid. Accordingly, I find that the registration of the PulsePro mark is invalid and I grant the application for a Declaration of Invalidity.

Dermot Doyle

Acting for the Controller

1st February, 2016