

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2120952 IN THE NAME OF  
GENERICUS (UK) LIMITED**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 47095 IN THE NAME OF  
NORTON HEALTHCARE LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF application No 2120952 in the name of  
Generics (UK) Limited**

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**and**

**IN THE MATTER OF opposition thereto under No 47095  
in the name of Norton Healthcare Limited**

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**Background**

15 On 15 January 1997, Generics (UK) Limited of Station Close, Potters Bar, Hertfordshire, applied to register the trade marks BECLOGEN in Class 5 in respect of “Pharmaceutical preparations and substances; all for human use”.

20 On 25 June 1997, Norton Healthcare Limited filed notice of opposition to this application. They say that they are the registered proprietors of registered trade mark number 1511853, the exclusive licensee and sole user of registered trade mark number 1440496, both of which they say they have used extensively in the United Kingdom, and the applicants for Community Trade Mark number 219972. The grounds of opposition are as follows:

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1. **Under Section 3(1)** Registration or use of the mark BECLOGEN applied for would be contrary to the provisions of Section 3 of the Act. Without prejudice to the generality of the foregoing, registration or use of the mark BECLOGEN would be contrary to the provisions of Section 3(1) in that the mark applied for is devoid of any distinctive character and/or that it consists exclusively of signs or indications which may serve in the trade to designate the kind, quality or other characteristics of the goods and/or that it consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.
  2. **Under Section 3(6)** Because the application is made in bad faith in view of the opponents’ use and reputation in their trade marks BECLAZONE and CROMOGEN.
  3. **Under Section 5** Because registration of the mark applied for would be contrary to the provisions of Section 5 of the Act. Without prejudice to the generality of the foregoing the opponent contends that the distinctive BECLA- prefix of the opponents’ mark BECLAZONE is phonetically and visually virtually identical to the prefix of the applicants’ mark BECLOGEN. The suffix of the applicants’ mark is not distinctive and the applicants’ mark is sufficiently similar to the opponents’ mark that the applicants’ mark cannot serve to

distinguish their goods. Use of the mark applied for would lead to a likelihood of confusion on the part of the public and/or to a likelihood of association with the opponent.

5 The opponents say that the products available under the marks BECLAZONE and CROMOGEN contain different active substances. Use by the applicants of the mark BECLOGEN may lead to confusion of the public familiar with these two established brand and would obstruct or prejudice the legitimate conduct of the opponents' business. They ask that the mark be refused in the exercise of the Registrar's judgement and discretion and that costs awarded in their favour.

10 The opponents say that prior to filing the opposition they had drawn the applicant's attention to their objections

Details of the marks referred to above are as follows:

15	Number	Mark	Class	Specification
20	1511853	BECLAZONE	5	Pharmaceutical, veterinary and sanitary preparations and substances; all included in Class 5.
25	1440496	CROMOGEN	5	Pharmaceutical, veterinary and sanitary substances, all containing sodium cromoglycate; all included in Class 5
30	219972 (OHIM)	CROMOGEN	5 10	Pharmaceutical preparations and substances. Inhalation devices for medical use and parts and components therefor.

35 The applicants filed a Counterstatement in which they admit that the opponents are the proprietors of trade mark number 1511853 and the applicants for Community trade mark number 219972, but deny any knowledge of the use claimed in respect of these marks, or the nature of the opponents' use of trade mark number 1440496. They admit that the suffix GEN lacks distinctive character and have established that it is a common element of trade marks registered in Class 5, although deny all other grounds mentioned. They also say that the applicants' agent is not aware that the opponents made their objections known to the applicants. The applicants ask that the opposition be dismissed and that costs be awarded in their favour.

45 Both sides have filed evidence in these proceedings although neither party has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision

## Opponents' evidence

5 This consists of a Statutory Declaration dated 16 April 1998, and made by Ewan Livesey, the company solicitor for Norton Healthcare Limited, although does not say how long he has held this position. He confirms that he has full access to the company records and is authorised to make this Declaration on behalf of the opponents.

10 Mr Livesey begins by confirming his responsibility within the opponents' company and his knowledge in relation to the use of trade marks in the United Kingdom pharmaceuticals industry. He says that BECLAZONE and CROMOGEN are two trade marks the opponents use in the United Kingdom in connection with different drugs for the treatment of asthma, and gives details of the active ingredients used in each of these products. He says that the products are available as inhalation aerosols under the trade marks BECLAZONE EASI-BREATHE and CROMOGEN EASI-BREATHE, and as nebulisers under the trade mark STERI-NEBS. Mr Livesey says that  
15 on becoming aware of the application to register BECLOGEN he made a connection with his company's trade marks and concluded that there was a risk of association and danger of confusion.

20 Mr Livesey sets out the details of the registrations for BECLAZONE (No. 1511853) and CROMOGEN (No. 1440496) and confirms the assignment of CROMOGEN to Fisons Plc under an agreement whereby the opponents were granted an exclusive licence to use the mark. He goes on to set out details of the sales of pharmaceutical products under the BECLAZONE trade mark since its launch in May 1993, which are as follows:

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<b>Year</b>	<b>Turnover by value (Million £)</b>	<b>Turnover by units (Million units)</b>
1993	2.90	0.417
1994	10.21	1.462
1995	15.44	2.26
1996	19.20	10.99
30 1997	15.81	2.58

35 Mr Livesey continues saying that BECLAZONE was first launched in May 1993 as the BECLAZONE inhaler, and in March 1995 as the BECLAZONE EASI-BREATHE inhaler. He says that the mark has been applied to the goods, packaging, labels, display and promotional materials, and has been publicised in the press, and at exhibitions and conferences. He says that the BECLAZONE products are supplied through wholesalers, dispensing doctors, retail pharmacies and hospitals. Mr Livesey next gives the advertising and publicity costs relating to the mark EASI-BREATHE for the years 1992 through to 1997.

40 He goes on to set out details of the sales of the CROMOGEN pharmaceutical product since its launch in 1992, which are as follows:

Year	Turnover by value (Million £)	Turnover by units (Million units)
1992	0.213	0.018
1993	0.926	0.089
1994	1.89	0.176
1995	1.34	0.29
1996	1.45	0.34
1997	1.35	1.02

Mr Livesey next says that unit dose vials of nebulising solution were launched under the mark CROMOGEN STERI-NEBS. Pressurised metered dose inhalers were launched in May 1992 under the mark CROMOGEN in June 1992, and breath operated pressurised metered dose inhalers were first marketed under the mark CROMOGEN EASI-BREATH in November 1996. All three products are for the control of the symptoms of asthma and were available on prescription. He gives details of the use made of the mark, and the channels through which it is sold, both of which are the same as that given for BECLAZONE, and he goes on to give the advertising and publicity costs relating to the mark EASI-BREATHE for the years 1992 through to 1997. Although Mr Livesey does not say so, it seems reasonable to assume that the figures now referred to relate to CROMOGEN EASI-BREATHE, and those referred to earlier, to BECLAZONE EASI-BREATHE.

Mr Livesey says that the BECLAZONE and CROMOGEN marks were regularly advertised in named medical publications, and refers to exhibit EL1 which he describes as the advertising schedules for the EASI-BREATHE and STERI-NEB product for 1997, and excerpts from 1 May 1997 edition of Doctor which contains an advertisement for BECLAZONE EASI-BREATHE. The advertising schedule sets out by month details of the publications in which advertisements for EASI-BREATHE were placed, but does not mention any other trade marks or give any indication of the year to which it relates. The advertisement in the issue of Doctor mentions BECLAZONE and BECLAZONE EASI-BREATHE indicating that these are trade marks of the opponents, although being dated after the relevant date can be given little if any weight.

Mr Livesey next refers to exhibit EL2 which consists of various items of promotional material, apparently directed at the medical profession and promoting a pharmaceutical for the control of asthma under various names including BECLAZONE,, BECLAZONE EASI-BREATHE, CROMOGEN, CROMOGEN EASI-BREATHE, CROMOGEN STERI-NEB and CROMOGEN INHALER, most dating from before the date of application.

Mr Livesey gives his opinion saying that use of the trade mark BECLOGEN in respect of the relevant goods would damage the opponents' business and the goodwill gained by the use of BECLAZONE and CROMOGEN. He says that pharmacists and especially patients who are not fully conversant with the trade marks used for pharmaceuticals would be likely to confuse BECLAZONE and BECLOGEN, paying most attention to the prefix BECL, particularly as the suffix GEN lacks distinctive character. He says that the risk of confusion would be increased if

the customer was familiar with CROMOGEN which is used for treatment of similar conditions. Mr Livesey concludes saying that he wrote to Jackie Gregory of the applicants on 13 May 1997 drawing her attention to his company's intention to oppose the application.

5 **Applicants' evidence**

10 This consists of a Statutory Declaration dated 21 January 1999, and comes from Jacqueline Jean Gregory, Marketing Director of Generics (UK) Limited, a position she has held since August 1996. Ms Gregory says that she has been involved in the pharmaceuticals industry for approximately 10 years having previously held the positions of Group Marketing Manager of Norton Healthcare Limited from 1988 to 1995, and New Product Development Director of Ashbourne Pharmaceuticals Limited from January 1996 to July 1996.

15 Ms Gregory says that she is responsible for the applicants' marketing activities and trade mark rights. She confirms that she is aware of most of the companies engaged in the pharmaceutical industry in the United Kingdom, and many of their branded products, and that she monitors new products and development through various named medical and trade publications. She says that investigations were carried out prior to filing the application and list various trade mark registrations for marks having the prefix BECLO, and which have been registered in Class 5 by different companies for, inter alia, pharmaceutical products. Ms Gregory says that the investigations also showed the suffix/word GEN is a common element of marks applied for or registered in Class 5 and confirmed the applicants' impression that neither the prefix BECL/BECLO nor the suffix GEN is exclusive to any one particular trade mark or proprietor.

25 Ms Gregory continues saying that at the time of filing, the applicants were aware of the various Beclomethasone nasal spray products, including BECONASE, and two others sold under the names BECLO-AQUA and BECLOMIST. She says that the applicants intended to use BECLOGEN in relation to a Beclomethasone Dipropionate based nasal spray for the treatment of allergic rhinitis (not yet launched) for sale over the counter and not by prescription, although 30 may develop other products for sale under the mark.

35 Ms Gregory goes on to comment on the Statutory Declaration executed by Ewan Livesey in support of the opposition, noting that in paragraph 1 he does not say what his responsibilities for the opponents' trade mark matters entail, nor why, and in what respects as a company solicitor he is aware of trade marks used in the United Kingdom pharmaceuticals industry, or whether he is referring to his own company's trade marks. She also notes that Mr Livesey does not say whether the facts in his Declaration have been extracted from the company records or are from his personal knowledge, or that they are true and correct.

40 Ms Gregory next refers to paragraph 3 saying that Mr Livsey does not mention that both of the opponents BECLAZONE and CROMOGEN products are prescription only medicines, or that the opponents market their own Beclomethasone nasal spray under the trade mark NASOBEC, noting that this is reminiscent of another trade mark and questioning why they had not used their BECLAZONE trade mark for this product. She moves on to question Mr Livseys' conclusions 45 in paragraph 4 in which he gives his views on the likelihood and consequences of confusion with his company's trade marks. Ms Gregory reiterates her statement that the prefix BECL is not exclusive to the opponents trade marks, and refers to exhibit JJG1 which consists of details of

trade mark registrations taken from the Marquesa system on 20 November 1998. This shows that five different proprietors (including the opponents) own trade marks with the prefix BECL or BECLO, in respect of, inter alia, pharmaceutical preparations in Class 5, and Ms Gregory notes that a number pre-date the opponents' registrations.

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She goes on to say that the pharmaceuticals market shows a similar situation, and refers to exhibit JJG2, which consists of an extract taken from the January 1999 edition of the Chemist & Druggist monthly price list. This shows that a number of different proprietors use names having the prefix BECL or BECLO in respect of pharmaceuticals for delivery by inhaler or nasal spray, and in all but one case the product is shown as containing Beclomethasone Dipropionate.

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Ms Gregory next compares the marks BECLOGEN and CROMOGEN, noting that the only similarity is the suffix GEN which is non distinctive in relation to pharmaceutical products, and refers to exhibit JJG3 which contains details of trade marks in Class 5 having the GEN suffix taken from the Marquesa system.

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Ms Gregory contrasts the applicants' intended use of the BECLOGEN mark saying that it will initially be used in relation to products sold over the counter by retail pharmacies and at which any advertising would be directed, whereas the opponents BECLAZONE and CROMOGEN products are prescription only medicines, and consequently, any advertising will be directed at general practitioners. She comments that the respective goods reach the market through different routes, one over the counter, the other by prescription.

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Ms Gregory next refers to the mark EASI BREATHE and comments on the advertising and publicity figures set out in paragraphs 14, 15, and 16 of Mr Livseys' Declaration. She refers to exhibit EL2 to that Declaration saying that this confirms that the opponents' BECLAZONE and CROMOGEN products are prescription only medicines. Ms Gregory refutes the claims made by Mr Livsey in paragraph 19 of his Declaration in which he gives his opinion on the likelihood of confusion, and the consequences for his company's business and their goodwill in the BECLAZONE and CROMOGEN trade marks should the applicants use the mark BECLOGEN for the relevant goods. She says that there are differences in the marks and that doctors and pharmacists are professionals with a duty of care, noting that common prefixes are used by different companies, and that the BECL/BECLO prefix is a case in point.

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Ms Gregory concludes by referring to Mr Livseys' statement that he had notified her of the intention to oppose the application in a letter sent on 13 May 1997, confirming that she did receive a letter by facsimile transmission.

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That concludes my review of the evidence insofar as it is relevant to these proceedings.

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### **Decision**

With the exception of Section 3(6), the notice of opposition does not give the sub-sections of the Act under which the grounds are founded. The wording used suggests that these would fall under Section 3(1)(b),(c) or (d) and Section 5(2)(b), although the inclusion of the text "without prejudice to the generality of the foregoing" makes this very unclear. It is possible to exclude

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grounds by the facts, for example, the only earlier rights claimed by the opponents are earlier registrations or applications covering identical goods, and therefore Section 5(3) and Section 5(4)(b) cannot be an issue. However, I find having to identify the issues by a process of elimination and guesswork to be a situation with which I am less than comfortable. I note the remarks of Geoffrey Hobbs QC sitting as the Appointed Person in the Wild Child case, (1998) RPC 455, when referring to the scope of the opposition said:

“In the interests of justice and fairness it is plainly necessary for an objection to registration under Section 5(4) to be framed in terms which: (i) specify whether the objection is raised under sub-section 4(a) or sub-section 4(b); (ii) identify the matters which are said to justify the conclusion that use of the relevant trade mark in the United Kingdom is liable to be prevented by virtue of an “earlier right” entitled to recognition and protection under the relevant sub-section; and (iii) state whether the objection is raised in respect to all or only some (and if so, which) of the goods....”

I see no reason why the interests of justice and fairness should not extend to other grounds on which opposition proceedings may be based. I do not consider, therefore, that it would either be just or fair for me to put in place arguments against or in defence of an application which are not clearly set out in the notice of opposition or counterstatement, and which are not supported by the evidence, and I dismiss all grounds other than Section 3(6), Section 3(1)(b)(c) & (d) and Section 5(2)(b) which I believe have been stated, at least in substance.

I will turn first to consider the objection founded under Section 3(1), the relevant parts read as follows:

**3.(1)** The following shall not be registered -

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

Section 1(1) in turn reads:

**1-(1)** In this Act “trade mark” means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.



A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

5 The opponents say that the mark is devoid of any distinctive character which is the language of sub-section (b) of Section 3(1) although they have not given any indication as to why they believe this to be so. I can therefore only conclude that their objection is linked and dependant upon establishing their claim that the mark consists exclusively of signs or indications which serve in the trade to designate a characteristic of the relevant goods, or which have become customary in the language or practices of the trade.

10 I begin by looking at how the law stands. In the *British Sugar Plc v James Robertson & Sons Ltd (TREAT)* trade mark case, (1996) RPC 9, Mr Justice Jacob said:

15 “...I begin by considering the “not a trade mark” point. Section 1(1) has two parts, *sign*, and *capable of distinguishing*. *Sign* is not an issue: a word is plainly included within the meaning of *sign* as the remainder of Section 1 indicates. But what about *capable of distinguishing*? Does this add any requirement beyond that found in section 3(1)? Section 3(1)(b) bars the registration of a mark which is *devoid of any distinctive character* unless it has *in fact acquired a distinctive character*. I cannot see that the closing words of the first sentence of section 1(1) add anything to this. If a mark on its face is non-distinctive (an ordinary descriptive and laudatory words fall into this class) but is shown to have a distinctive character in fact then it must be *capable of distinguishing*. Under section 10 of the old Act, for a mark to be registerable in Part B, it also had to be *capable of distinguishing*. But the Pickwickian position was that some marks, even though 100% distinctive in fact, were not regarded as *capable of distinguishing* within the meaning of that provision. I do not think the Directive and the 1994 Act takes a more limited meaning over.

20 Thus, *capable of distinguishing* means whether the mark can in fact do the job of distinguishing. So the phrase in Section 1(1) adds nothing to section 3(1) at least in relation to any sign within sections 3(1)(b)-(d). The scheme is that if a man tenders for registration a sign of this sort without any evidence of distinctiveness then he cannot have it registered unless he can prove it has a distinctive character. That is all. There is no pre-set bar saying no matter how well it is proved that a mark has become a trade mark, it cannot be registered. That is not to say that there are some signs which cannot in practice be registered. But the reason is simply that the applicant will be unable to prove the mark has become a trade mark in practice - “Soap” for “Soap” is an example. The bar (no pun intended) will be factual not legal.

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40 Both sides accept that the suffix GEN is commonly used in relation to pharmaceuticals and is devoid of distinctive character, although I have no persuasive evidence to this effect. They have opposing views on the distinctiveness or otherwise of the prefix BECL and BECLO, but the evidence shows that the opponents along with a number of other companies in the pharmaceuticals industry own and use trade marks with the prefix BECL or BECLO, and that these are primarily used in respect of an asthma treatment based on Beclomethasone Dipropionate from which the prefixes BECL/BECLO appear to have been drawn.



An earlier trade mark is defined in Section 6, the relevant parts of which state:

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

- 5 (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

10 The opponents rely on three trade marks; two registered in the United Kingdom under number 1511853 (BECLAZONE) and number 1440496 (CROMOGEN), and a Community Trade Mark application number 219972 (CROMOGEN), all of which qualify as earlier trade marks within the meaning of Section 6(1). As it is clear that the specification of the application covers the same goods as these earlier marks I need only give consideration to the similarity of the marks.

15 I consider this ground first on the basis of the approach adopted by the European Court of Justice in *SABEL v. PUMA* 1998 RPC 199. The Court considered the meaning of Article 4(1)(b) of the Directive (EC Directive 104/89) which corresponds to Section 5(2) of the Act and stated that:

20 “..... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be  
25 appreciated globally, taking into account all factors relevant to the circumstances of the case.

That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in  
30 particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive- ‘..... there exists a likelihood of confusion on the part of the public .....’ - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and  
35 does not proceed to analyse its various details.”

I also have regard to the approach adopted by the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* (Case C-39/97) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of  
40 the trade mark and the similarity of the goods stated:

“A 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 these goods or services. Accordingly, a lesser degree of similarity between these goods  
45 or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation

of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.”

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Finally, the court gave the following judgement on the interpretation of Article 4(1)(b):

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“On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

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Looking first at the similarity of BECLOGEN and CROMOGEN it is self evident that both marks share the terminal letters OGEN, and although both sides accept the suffix GEN to be devoid of any distinctive character when used in relation to pharmaceuticals, this does not mean that it can be disregarded for the purposes of comparison. The suffix is, however a small, and by virtue of its position, the least important part of the marks, it being generally accepted that for the purpose of comparison it is the beginnings which are the most significant, and in this case there is no similarity whatsoever. The opponents themselves say “I believe that Norton’s customers would pay most attention to the prefix of the trade mark, particularly as the suffix lacks distinctive character”.

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Although I have considered the similarity of the respective marks by reference to their individual elements, it is clear from the above that the correct approach is to look at the marks as a whole, with due regard given to the closeness of the respective goods and the reputation the earlier mark enjoys in respect of those goods. The marks BECLOGEN and CROMOGEN share a common feature but also have a more significant element which makes them visually, aurally and conceptually very different. In my view the marks are so different that even taking into account that the goods are identical and accepting that the opponents may have a reputation in their mark, when considered “globally” there is no real likelihood of confusion.

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The opponents’ mark BECLAZONE and the applicants’ mark BECLOGEN share the prefix BECL, which creates a degree of visual and aural similarity between the two marks. The sales and advertising figures for the BECLAZONE product are modest in terms of the overall size of the pharmaceutical industry, but more impressive given that they relate essentially to a single type of product for the control of asthma, and I consider it reasonable to conclude that they have acquired a reputation in respect of these goods.

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The goods covered by the opponents’ registration and sold by them under the BECLAZONE mark are identical to those for which the applicants seek to register their mark. Ms Gregory refers to the fact that the opponents have used their mark on goods available as a prescription only medicine, whereas the applicants initially intend to use their mark in respect of goods available over the counter. The applicants have not limited their specification to reflect this distinction, and as I am required to consider the position should the applicants’ mark be put into normal and fair use, I must take into account what they are notionally able to do, particularly as Ms Gregory qualifies the applicants’ intentions as “initially” which does not exclude therefore, the possibility of the mark

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being used on prescription only medicines.

The circumstances of the trade are relevant and should be taken into account. Some pharmaceutical products, such as to treat minor ailments or that have no adverse side effects, risk or danger through incorrect usage, are obtainable by self-service. This is not the case in respect of more intensive pharmaceuticals or those for more serious conditions which are only available from a qualified pharmacist, either on prescription, (which from the evidence would seem to describe the opponents' goods) or by specific request.

Ms Gregory provided details of other marks with the prefix BECL/BECLO that are on the register to show that a number of other companies use trade marks with this prefix, but the fact that a mark is registered is not evidence that it is being used (see BECK KOLLER (1947) RPC 76) and cannot in itself be relied upon in determining the likelihood of confusion. There is, however, support to be gained from the extract taken from the Chemist & Druggist monthly price list (exhibit JJG2) which shows that BECLO-AQUA, BECLOFORTE, BECLOFORTE EASI-BREATHE, BECLAFORTE INTEGRA, BECLOMIST, BECODISKS, BECONASE, BECONASE ALLERGY, BECOTIDE, BECOTIDE 100, BECOTIDE 100 EASI-BREATHE are all used alongside the opponents' trade mark BECLAZONE for what appear to be the same type of goods. Although the list is dated January 1999, which is after the relevant date, given the long development periods for pharmaceuticals and that product names seem to stay in the market for some time (the opponents' mark was launched in 1993), I see no reason to conclude that the position would have been significantly different at the relevant date.

That there are a number of companies apparently selling very similar goods under names with BECL/BECLO as a prefix is not surprising given that the products are based on Beclomethasone Dipropionate and that there appears to be a practice in the industry to use the constituent pharmaceutical in the name of the product. It does, however, indicate that the manufacturers, medical practitioners, pharmacists and the market are able to tolerate and differentiate similar trade marks being used for similar products, although I accept that the position might be somewhat different if the goods were obtainable by self selection by the end user.

The opponents' case, relies upon the argument that there may be confusion through imperfect recollection, and the proposition that the inclusion of the suffix OGEN in the applicants' mark will be insufficient to indicate a different trade origin to the public, but also that the prefix "BECL" will be picked out of the applicants' mark and through poor recollection confused with the opponents' mark. In the SABEL- PUMA case it was said "The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details." which, if applied to this case would support the view that there is little real likelihood of confusion. Taking all of the above into account, I find that I come to the view that the marks are not so similar as to create a likelihood of confusion, and consequently, the opposition under Section 5(2)(b) fails.

This leaves the matter of the grounds under Section 3(6) of the Act, which reads:

**3(6)** A trade mark shall not be registered if or to the extent that the application is made in bad faith.

5 Apart from referring to their earlier trade marks the opponents do not say why they consider the application to have been made in bad faith. It may well be that they are alleging that the applicants are seeking to appropriate a mark which they know belongs to the opponents. The applicants counter this saying that on the basis of their investigations they considered it appropriate to proceed with the application. Given that a number of companies besides the opponents appear to use trade marks with the prefixes BECL/BECL0 in respect of the same goods as the opponents, this does not seem unreasonable, and I find that the opposition also fails under Section 3(6).

10 Finally, the Registrar has no discretion to refuse an application which meets the requirements for registration set out in the Act, and consequently, this final ground cannot succeed. The opposition having failed on all grounds the applicants are entitled to an award of costs in their favour. I therefore direct the opponents pay to the applicants the sum of £435 as a contribution towards their costs.

15 **Dated this 2 day of November 1999**

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25 **Mike Foley  
for the Registrar  
The Comptroller General**