

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2199390
BY AMERICAN HOME PRODUCTS CORPORATION
TO REGISTER A TRADE MARK IN CLASS 5

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 50354
BY KNOLL AKTIENGESELLSCHAFT

BACKGROUND

1) On 7 June 1999, American Home Products Corporation of Five Giralda Farms, Madison, New Jersey 07940 - 0874, United States of America applied under the Trade Marks Act 1994 for registration of a mark (reproduced below):



2) In respect of the following goods in Class 5: “Pharmaceutical preparations for use in hormone replacement therapy”.

3) On the 28 October 1999 Knoll Aktiengesellschaft of Knollstarasse, D - 67061 Ludwigshafen, Germany, filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of an International Trade Mark application 698501 registered inter alia for pharmaceutical preparations and substances in Class 5. The registration has a priority date of 4 May 1998 and a date of protection in the UK of 30 July 1998 having been published for opposition purposes in Trade Mark Journal 6269 on 24 March 1999 at page 303. No opposition was filed against the mark. The marks are similar and the goods of the application are identical to some of the goods for the opponent’s international registration. As such the mark in suit offends against Section 5(2)(b) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent’s claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 16 July 2001 when the applicant was represented by Ms Carboni of Messrs Linklaters, and the opponent by Mr Hinchcliffe of Counsel instructed by Messrs J Y & G W Johnson .

OPPONENT'S EVIDENCE

6) The opponent filed a declaration, dated 9 May 2000, by Stephen Geoffrey Hale a partner in the opponent's Trade Mark Attorneys.

7) At exhibit SGH1 Mr Hale provides a copy of the Registration certificate for International mark number 698501. This shows a device mark and a specification in Class 5. The registration has been classified under the Vienna Classification in classes 4.5, 5.7 and 27.3. These classes are identified as:

Class 4.5: "Plants, objects or geometrical figures representing a personage or an animal. Masks or fantastic or unidentifiable heads."

Class 5.7: "Grain, seeds, fruits".

Class 27.3: "Letters or numerals representing a human being, an animal, a plant or an object."

8) Mr Hale claims that the opponent's mark is officially recognised as conveying "an impression, amongst other things, of a stylised human personage having body elements". He claims his clients mark shows a head, a torso/ leg, another leg and two arms set against a circular background. He considers the applicant's mark also to show a human personage, hence his claim that the marks are similar.

9) Mr Hale points out that his client's mark is registered for pharmaceutical preparations and substances in general thus including hormone replacement therapy. Therefore, he claims, the goods are identical. He states that his clients registration covers both prescription and non-prescription goods.

APPLICANT'S EVIDENCE

10) The applicant has filed four declarations. The first, dated 7 August 2000, is by Sarah Lea Orchard who is employed by the applicant's Trade Mark Attorneys.

11) Ms Orchard makes the following observations:

- The opponent's mark consists of a stylised apple design incorporating the letter "i".
- The opponent's mark is used on a prescription only products for treating obesity, which reinforces the apple design view as it reflects the nutritional aspect of dietetic substances and weight reduction. The logo appears on the opponent's obesity website.
- The applicant's logo is a stylised figurine in the form of a swirling or dancing woman superimposed on a spherical background. The mark is evocative of the vitality of the goods applied for which are for use in hormone replacement therapy (HRT).
- Although registered for a range of goods the opponent intends to use the logo only on prescription treatments for obesity. The products of the two parties are different.

- The products will also have a product name, which will ensure that there is no confusion as the prescription will be made out in the product name not by reference to the logo. Also doctors and healthcare professionals are highly trained and are used to distinguishing between products.

12) Ms Orchard also includes evidence of other marks of human figures on the Register. However, this is of little or no relevance to the case because “state of the Register” evidence is, in principle, irrelevant: TREAT 1996 RPC 281.

13) The second declaration, dated 2 August 2000, is by Carole Anne Brownsey-Joyce an Intellectual Property Investigator. She states that she was hired to carry out an investigation into use of the opponent’s logo. The findings can be summarised as:

- The opponent’s concentrate on the development and production of pharmaceutical products for obesity, cardiovascular illness, illnesses of the central / peripheral nervous system, wound healing and gastroenterology.
- The opponent’s “obesity drug” has not been licensed for sale in the UK.
- An employee of the opponent company stated that the company only marketed prescription pharmaceutical products.
- An employee of the opponent described the opponent’s logo as “an “i” shaped man inside an apple”, and stated that the logo was to be used on a new obesity drug. This drug is known in other countries under three names Meridia, Rادuctil and Reductil.

14) The third and fourth declarations, dated 2 and 9 August 2000, are by Egon E. Berg a Vice President of American Home Products Corporation. These declarations appear to be identical other than the date. Mr Berg states that it is his company’s intention to use it’s trade mark in the UK in respect of pharmaceutical preparations for use in hormone replacement therapy which will be available only by prescription. The product will always have its brand name in addition to the logo.

15) Mr Berg claims that the logo depicting a dancing or swirling woman was specifically created to represent the vitality of hormone replacement therapy and is part of a marketing strategy. At exhibit EEB1 a sample of the packaging proposed to be used is provided and shows the logo used in isolation as well as in conjunction with the brand name.

OPPONENT’S EVIDENCE IN REPLY

16) The opponent filed a declaration, dated 22 November 2000, by Markas Marriott the Regulatory Affairs Manager of Knoll Limited the UK subsidiary of the opponent company. Mr Marriott has been with the company for six years.

17) Mr Marriott confirms that the opponent intends to use it’s logo primarily in respect of a prescription drug for use in the treatment of obesity, although he points out that it is registered for pharmaceutical preparations and substances in general. He claims that there is a

considerable overlap between hormone replacement therapy and obesity treatment. He provides a number of exhibits which indicate that post menopausal women tend to gain weight and that the patient audience for hormone replacement therapy and prescription anti-obesity drugs is predominantly females aged between 40 - 59 years.

18) Mr Marriott claims that his company's logo depicts a person walking or running, representing "the positive aspects of lifestyle / behaviour modification, ie vitality, physical activity, improved quality of life motivation and sustained moderate weight loss promoted as benefits of successful obesity treatment". Similar positive aspects stem from HRT.

19) That concludes my review of the evidence. I now turn to the decision.

DECISION

20) The only the ground of opposition is under Section 5(2)(b) of the Act which states:-

*5.- (2) A trade mark shall not be registered if because -
(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier mark is protected,*

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

21) An earlier right is defined in Section 6, the relevant parts of which state

6.- (1) In this Act an 'earlier trade mark' means -

(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,

(b)...

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark."

22) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that: -

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods

/ services in question; *Sabel Bv v Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

23) The specification of the mark in suit is “Pharmaceutical preparations for use in hormone replacement therapy”. The opponent’s mark number 698501 has a specification of “Pharmaceutical preparations and substances, sanitary preparations; dietetic substances adapted for medical use, food for babies”. Clearly, in my view, the specification of the mark in suit is subsumed within the specification of the opponent’s mark. This was acknowledged by the applicant although they attempted to draw clear blue water between the goods of the two parties by asserting that the opponent intends to use the mark only for a prescription anti-obesity drug, as opposed to their use on a prescription drug for HRT. However, under Section 5(2)(b) I must consider the specifications for which the marks are registered or the specification for which they are sought to be registered. The goods of the two parties are therefore, in my opinion, to be regarded as identical for the purposes of Section 5(2): ORIGINS 1995 FSR 280.

24) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it

is registered, and any other relevant factors.

25) For ease of comparison I reproduce the marks of both parties below:

Applicant's Mark	Opponent's Mark
	

26) The applicant describes their mark a “A swirling or dancing woman” and claim that the image depicts vitality. The opponent describes their mark as the shape of a person walking or running within an outer apple shape. The applicant filed evidence of one of the opponent’s employees describing the opponent’s mark as “a little red apple with a green man inside”. At the hearing the applicant filed a depiction of the opponent’s mark taken from the opponent’s own website which it was claimed showed more clearly the concept of a man within an apple. The website image was in blue and red and to my mind the “arms” being the same colour as the rest of the figure reduced considerably the image of an apple. The red background now seemed merely a circular device. However, the marks have both been filed in black and white and should not limit my consideration of them to particular colour arrangements.

27) Ms Carboni contended that as both parties marks would be used on prescribed drugs the relevant public would therefore be medical practitioners and pharmacists. If this were correct then I accept that such individuals are highly trained and used to differentiating between drugs, although this is usually between the names of drugs. Clearly the applicant’s product is aimed at women within a certain age range and it is doubtful whether a a doctor would prescribe HRT drugs to a male or to either a very young or a very elderly woman, and equally a pharmacist would query the prescription with the doctor if such a mistake occurred. However, although the applicant’s specification is restricted to pharmaceuticals for use in HRT which are very likely only to be available on prescription the same does not apply to the specification of the opponent’s mar. The opponent’s goods could include “over the counter” medicines. The relevant public cannot therefore be restricted to medical practitioners and pharmacists, but must also include women receiving HRT treatment.

28) Pharmaceutical preparations are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. Even so allowance must be made for the notion of imperfect recollection. The resemblance between the marks is such that, comparing the marks (without added matter) and assuming use on identical goods, even medical practitioners, pharmacists and women on HRT would be caused to believe that there was an economic connection between the party or parties using these marks on HRT products.

29) Ms Carboni also asserted that the marks would always be accompanied by the trade mark name of the product. The possible use of a trade name in addition to the mark applied for is irrelevant. It is the mark applied for alone that must be considered: ORIGINS: The comparison is mark for mark.

30) In considering the marks of both parties as applied for without colour, to my mind both convey an image of a person and suggest movement. The applicant also supplied a detailed critique of the marks pointing out the differences between the angles of the “heads”, “arms” etc. However, the consumer will not usually have the benefit of making a direct comparison between the marks and so one must consider the overall impression that they convey.

31) I believe that this case is one where the words of Evershed J. in *Smith and Hayden Co.’s Application* (1946) 63 R.P.C. 97 at 102 are particularly relevant:

“When all is said, the question is in truth, as observed by Lord Justice Luxmore and the House of Lords in the *ARISTOC* case, one of first impression, on which no doubt different minds may reach different conclusions. It is not profitable in such a case to indulge in a minute analysis of letters and syllables, a process indeed notoriously productive of confusion in regard to words.”

32) Although this case was determined under the 1938 Act and was concerned with “word” marks, the views are still relevant when considering cases under the 1994 Act and device marks.

33) Ordinarily I would also consider whether the opponent’s mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, no evidence has been filed. In such circumstances the opponent’s marks cannot be regarded as enjoying an above average reputation at the relevant date.

34) With all of this in mind I come to the conclusion that when all factors are considered, that there was a realistic likelihood of confusion at 4 May 1998. Consequently, the opposition under Section 5(2)(b) succeeds.

35) The opposition having succeeded the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £1535. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15TH day of August 2001

George W Salthouse
For the Registrar
The Comptroller General