

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2173107 BY
PHARMAGENIX LIMITED TO REGISTER A TRADE MARK IN
CLASSES 5 AND 39**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NUMBER 49884 BY PHARMAGENE LABORATORIES LIMITED**

TRADE MARKS ACT 1994

IN THE MATTER OF Application Number 2173107 by Pharmagenix Limited to Register a Trade Mark in Classes 5 and 39

and

IN THE MATTER OF Opposition Thereto Under Number 49884 by Pharmagene Laboratories Limited

BACKGROUND

1. On 24 July 1998 Pharmagenix Limited applied to register the trade mark PHARMAGENIX in Classes 5 and 39 of the register for the following specifications:-

Class 5 “Pharmaceutical preparations and substances”

Class 39 “Distribution of pharmaceutical preparations and substances”

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 17 June 1999 Somerville & Rushton, on behalf of Pharmagene Limited, filed a Notice of opposition. In summary, the grounds of opposition were:

- (i) Under Section 5(2) of the Act because the mark applied for is confusingly similar to the following earlier trade marks owned by the opponent and registered for the same or similar goods and services and there exists a likelihood of confusion on the part of the public:-

Registration No	Mark	Registration Effective	Classes	Goods/Services
UK Registration No. 2108553	PHARMAGENE	28 August 1996	5,	Pharmaceutical preparations, substances and products.
			9	Data files; data carriers; data storage media, magnetic disks, optical disks, all being pre-recorded.
			16	Printed matter, books, reports, manuals, research and information documents.

42 Collection and maintenance of genetic information; consultancy, information and advisory services relating to genetics, to gene form and to gene function.

Community Trade
Mark Registration No

455907	PHARMAGENE	16 December 1996	5,	Pharmaceutical preparations, substances and products.
			9	Data files; data carriers; data storage media, magnetic disks, optical disks, all being pre-recorded.
			16	Printed matter, books, reports, manuals, research and information documents.
			42	Collection and maintenance of genetic information; consultancy, information and advisory services relating to genetics, to gene form and to gene function.

- (ii) Under Section 5(4)(a) of the Act by virtue of the law of passing off.
- (iii) Under Section 5(3) of the Act because the mark applied for is similar to the earlier trade marks owned by the opponent and to the extent that the goods and/or services are deemed not similar, registration of the mark in suit would take unfair advantage of or be detrimental to, the distinctive character or the repute of the opponent's earlier trade marks.
- (vi) Under Section 3(6) of the Act because the application was made in bad faith.

4. On 13 September 1999 the applicants filed a Counterstatement denying the above grounds. Both sides have asked for an award of costs in their favour and have filed evidence. The matter came to be heard on 21 March 2002 when the applicants for registration were represented by Mr Tritton of Counsel instructed by Alexander Ramage Associates and the opponents by Mr Abrahams of Counsel instructed by Sommerville & Rushton.

Opponent's Evidence

5. This consists of two statutory declarations, one each from Joanne Claire Lazenby and Alastair James Riddell, dated 15 March 2000 and 6 June 2000 respectively.

6. Ms Lazenby is a trade mark attorney employed by Sommerville & Rushton, the opponent's professional representatives. She states that she was previously employed by Glaxo Wellcome Plc and has considerable experience in the searching and clearance for use in the UK of trade marks for new pharmaceutical preparations for human use.

7. Ms Lazenby refers to four Section 5 citations raised against the application in suit by the Registry during the examination stage, which she points out, were waived on the basis that the prefix PHARM is a reference to pharmaceutical and is commonly used in Class 5 goods. She states that this does not indicate that the proprietors of these marks themselves believes the marks can co-exist on the basis of the prefix PHARM being common and she adds that co-existence of marks commencing with PHARMA - on the UK Register does not indicate they co-exist in the market.

8. Ms Lazenby goes on to refer to Exhibit "JL5" to her declaration which is a list of all UK registrations and applications in Class 5 which comprise PHARMA and she states that of these, there are some fifty registrations or advertised applications commencing with PHARMA. She also draws attention to her Exhibit "JCL 6", a copy of a print out from the Avantiq database compiled from data supplied by International Medical Statistics of sales of pharmaceutical preparations through hospitals and pharmacies in the UK provided under marks commencing with PHARM. She states that the total number of such marks shown on this list as currently in use is four.

9. Mr Lazenby submits that pharmaceutical trade marks are usually invented words and the assessment of the likelihood of confusion of one pharmaceutical trade mark with another, should consist of such points as:

"Are the key consonants the same? This is more important than vowels, since inevitably all words will share some vowels. Do these consonants share the same position? Is the length of each word the same? Is the first syllable of each word the same? Regardless of whether that first syllable is "common", this is the part which will be the most memorable, and which is most likely to be clearly written and pronounced since endings of words in both speech and writing tend to be indistinct. In short, there is a "one to one" comparison of the mark in question with each and every "close" mark or generic name found in the searches. Obviously, manifestly different marks or names could be dismissed without such close scrutiny. Any "close" mark would, however, be compared in this way."

10. Next, Ms Lazenby goes on to apply her criteria to the mark in question and she states that:-

- "The first nine letters of each mark are identical

- The length of each mark is almost identical (there being only one letter difference)
- The first syllable is identical
- The second syllable is also identical
- The third syllable could be identical (if pronounced with a long “e”)
- Six out of the seven consonants are identical
- These six share exactly the same position in each mark”

She adds that the only differences are in the endings which, she says, is the position least likely to facilitate a distribution by members of the public or those health professionals who prescribe or dispense pharmaceutical preparations.

11. Ms Lazenby concludes by stating that when assessing the risk of confusion it is the overall impression made by any word which will determine if confusion is likely and she explains that she has chosen to list the similarities in a precise way to show that they are so numerous that it is quite possible that their accumulative effect is such that PHARMAGENIX will have the same overall impression and appearance as PHARMAGENE.

12. The opponents second declaration is by Alastair James Riddell, Chief Executive Officer of Pharmagene Plc (the opponents).

13. Mr Riddell explains that the companies which make up the Pharmagene group were incorporated in March 1996 and have two parallel objectives:-

- (i) To generate near term revenue by providing drug discovery services to other pharmaceutical companies. Customers include Smith Kline Beecham, Janssen, Astra, Allergan, Bayer, Chiroscience Limited, Nycomed Amersham, Kyowa Hakko Koygo, Merck, Novartis and Pfizer. He adds that to date, these services have generated approximately £1.2m. This part of the business is operated under the title Laboratories and Informatics Divisions.
- (ii) To use this revenue to finance the group’s own programme of researching pharmaceutical preparations with the intention that these will be taken through into full development, and if approval is given for them, put on the market for use by patients in this country under the PHARMAGENE name. To date, eight drug discovery programmes have been initiated. This part of the group’s business is called the Pharmagene Therapeutics Division. Revenue from services provided to other pharmaceutical companies is not the only source of investment for this part of the business; in addition some £16m has been raised.

14. Mr Riddell adds that the Pharmagene group of companies have a unique position in the pharmaceutical industry because they have established one of the world’s most comprehensive collections of human tissue (all gained with fully informed consent) representing all the main organ systems of the human body, together with their associated clinical history. He states that the group’s agreements with various professional medical organisations, mostly from oncology departments of major hospitals, give them access to human tissue from thousands of donors. Usually, drugs are not tested on human biology until clinical trials have begun but because of

the opponents assembly of this human tissue bank they can test drugs on human tissue samples at a much earlier stage in development than had previously been possible. The efficacy of any particular drug, as well as any potential side effects from it, can therefore be predicted at a much earlier state in its development than was previously possible. This decreases the risk to patients. It also of course represents a considerable saving to companies who would otherwise not be able to assess efficacy and safety until much later in the development process, after considerable sums had been spent on clinical trials. Further information on how these tests contribute to the development of pharmaceuticals is produced as "Exhibit AJR 2" "to Mr Riddell's declaration.

15. Mr Riddell states that the Pharmagene name is well respected in the research and development sectors of the pharmaceutical industry because they are the only group of companies which can provide this type of research. He adds that they extensively promote our activities under the Pharmagene name, through the following (which I must point out are mostly outside the UK or after the relevant date):

(i) Presentations at various conferences, including:

Drug Discovery Technology 2000, Basle, Switzerland, April 2000.

BIO 2000, Boston, USA, March 2000.

Society for Neuroscience Meeting, Miami, USA, November 2000.

6th & 7th European Biopartnering Meeting, London, UK October 1998 & 1999.

"From Genes to Drugs", SMI Conference, London, UK April 2000.

"Improved Predictive in Vitro Screening", Vision in Business Conference London, UK March 2000.

"Functional Genomics", JBC Conference, London, UK November 1997

"From Genes to Proteins", Cambridge Healthtech Institute Conference, San Francisco, USA, June 1997

"Plulmonary Hypertension", JBC Conference, San Diego, USA, January 1998.

(ii) Discussion of the techniques in articles in the scientific and medical press, sample copies of which are at Exhibit AJR 3 to Mr Riddell's declaration.

(iii) Copies of the opponents press references which are at Exhibit MRJ 4 to his declaration, all of which are after the relevant date.

16. Accordingly, Mr Riddell concludes that the Pharmagene group of companies enjoy a high degree of respect from the research and development sector of the pharmaceutical industry.

Applicant's Evidence

17. This consists of a statutory declaration by Robin Harper dated 8 December 2000. Mr Harper is a trade mark attorney. He states that he is well versed in the problems surrounding trade marks in the pharmaceutical industry both through direct knowledge and practice and in a variety of capacities. He is a past Global Trade Mrk Director of Smith Kline Beecham and a member of the Association of British Pharmaceutical Industries Intellectual Property Committee. In this opposition he has been retained by the agents for the applicants.

18. In response to the opponent's evidence Mr Harper states that Ms Lazenby mentions various PHARM(A) marks in use, none of which are by the opponents. He says that two of these are by Pharmacia & Upjohn AB, namely PHARMORUBICN and PHARMALGEN, one by Boeringer namely PHARMATON and one by Reckitt & Colman namely LEMSIP PHARMACY. In Mr Harper's view, as a variety of organisations are using the PHARM(A) prefix he would not expect anyone to claim confusion because the prefixes are the same.

19. Mr Harper goes on to refer to Exhibits "RH 1" to "RH 6" to his declaration which comprises published material providing examples of the use of PHARM(A) as part of a company name, trade mark, or dictionary word, mainly to do with the pharmaceutical industry.

20. Mr Harper next turns to Mr Riddell's declaration and points out that there is no evidence of annual turnover of any goods or services under the mark and he adds that while the opponent's could be in a niche market, the sale of pharmaceutical products is hardly a niche market. Mr Harper also points out that much of Mr Riddell's evidence refers to evidence which post dates the relevant date for the opposition proceedings and relates to use outside the UK.

Opponent's Evidence in Reply

21. This comprises a further statutory declaration by Joanne Claire Lazenby which is dated 8 May 2001. She points to paragraph 6 of Mr Harper's declaration in which the word PHARMAGENIX appeared where the word PHARMAGENE was appropriate (corrected later by Mr Harper by pen amendment) and she states that this is an instance of confusion between the marks.

22. This completes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

23. Prior to the hearing Mr Abrahams withdrew the ground of opposition based upon Section 3(6) of the Act.

24. I turn to the ground of opposition based upon Section 5(2)(b) which reads as follows:-

"5.-(2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or

services similar to those for which the earlier trade mark is protected, or

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

25. 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,"

26. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik 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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* 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*, paragraph 23;
- (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*, paragraph 23;
- (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-Mayer Inc*, 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*, 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*, paragraph 26;
- (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*, 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-Mayer Inc*, paragraph 29.

27. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection afforded to such a mark. The opponents have filed evidence relating to the reputation of their trade mark PHARMAGENE, but the evidence shows that prior to the relevant date this mark had not been used in relation to pharmaceutical products. This fact was confirmed by Mr Abrahams at the hearing. The evidence confirms that the opponents have since 1996 undertaken research and development on human tissue in relation to the development of drugs and have expressed the intention to put on the market pharmaceuticals for use by patients in this country. However, this limited and somewhat specialised use is a long way from establishing a relevant reputation in relation to the current Section 5(2) proceedings, bearing in mind the goods and services specified by the applicant. Furthermore, I have no independent evidence going to the repute of the opponent, and the evidence relating to the promotion of the trade mark PHARMAGENE in the UK before the relevant date is very sparse. While I have no doubt that the opponents had a presence in research and development, in relation to tests on human tissue, prior to the relevant date, I am unable to find that they have a reputation in their mark for the purpose of these proceedings. I must therefore compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks.

28. In essence the test under Section 5(2)(b) is whether there are similarities in marks and also goods and services which would combine to create a likelihood of confusion and in my considerations I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, taking into account the categories of goods and services in question and how they are marketed.

29. At the hearing it was common ground that the applicant's and opponent's Class 5 specifications of goods included the same and similar goods. However, in relation to the applicant's Class 39 specification, Mr Tritton submitted that these services were not similar to those goods and services covered by the opponent's registrations. I do not accept this view. While I have no evidence before me on the point, it seems to me that it would be perfectly normal in trade for the producers of pharmaceutical preparations to also be in the business of distributing their products to customers. In my opinion the two activities would be closely connected in the market place and exist side-by-side. Bearing in mind the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297), as approved by the European Court of Justice in the *CANON-MGM* judgement, I feel sure that the applicants services in Class 39 are similar to those covered by Class 5 of the opponent's registrations.

30. In the evidence and at the hearing both parties focussed on the state of the Trade Marks Register and the position in the market place in relation to trade marks commencing with the prefix PHARMA. I find the state of the register position to be of very little assistance as mere evidence of entries on the register without evidence of whether and to what extent the marks concerned are used is of little or no value. Turning to the evidence and submissions about use of the prefix PHARMA in the market place, the parties disagree as to the level and extent of third party use. Nevertheless, it is apparent that the opponents do not possess a monopoly in the prefix PHARMA and at the hearing Mr Abrahams made it clear that they do not claim such a monopoly. It is common ground that the respective trade marks must be compared as a whole.

31. The mark in suit comprises the invented word PHARMAGENIX. While the prefix PHARMA in my view alludes to the descriptive word Pharmaceutical, it seems to me that the suffix GENIX is abstract in its connotations. The opponent's mark consists of the invented word PHARMAGENE and the suffix GENE is a common dictionary word referring to a unit of heredity composed of DNA. In Mr Tritton's submissions, the mark PHARMAGENE is descriptive of pharmaceuticals where genetic information is important and is only deserving of a very narrow penumbra of protection. I do not share this view as it seems to me that there are no pharmaceuticals incorporating genes or to treat genes as such and the illusory nature of the mark is sufficiently indirect and skilful.

32. Turning to a comparison of the marks it is clear that they must be compared as a whole although, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

33. Firstly I turn to a visual comparison of the respective marks. The similarities and differences are plain to see. Both marks share the same prefix and share the letters GEN as their seventh, eighth and ninth letters. They differ in respect of their length, the mark in suit PHARMAGENIX being eleven letters and the opponent's mark PHARMAGENE being ten letters, the endings of the marks also differing. However, as mentioned earlier, my decision on similarity must be governed by overall impression and notwithstanding the fact that both marks

commence with the prefix PHARMA (in which the opponent does not possess a monopoly) and share the next three letters (GEN), the terminations of the marks are conspicuously different. I find the position on visual similarity to be very close but, on balance, it seems to me that in totality the marks look different and would be distinguished visually in use. However, I have not reached this decision without some hesitation.

34. In relation to aural use I believe the opponent's case to be of similar weight. Both marks share the same beginnings and it is widely accepted in relation to the spoken use of trade marks that customers have a propensity to slur the endings of words. However, in my view this is of limited significance in the present comparison as the terminations of the respective marks would sound markedly different and serve to distinguish the marks in aural use.

35. At the hearing Mr Abrahams raised a number of issues which impact upon aural use. Firstly, it was his view that the mark in suit is likely to be pronounced as PHARMA-GENE-IX. In other words, the seventh, eight and ninth letters (GEN) would not be pronounced as GEN (to rhyme with "pen") but as GENE (to rhyme with "jean"). It is obvious that on Mr Abrahams' pronunciation the respective marks would be considerable more similar in aural use. However, I have little doubt that the public at large would not describe the mark in suit in the manner suggested by Mr Abrahams. The combination of the three letters GEN is common in the English language. It is also an abbreviation in its own right and a suffix forming nouns. GEN is invariably pronounced with a 'short e' to rhyme with "pen", "hen", "men" etc. The only exception I am aware of, is when the letters GEN are followed by the letter E to make the word GENE or connected words e.g. genealogy, this being an exception as other words commencing with the prefix GENE e.g. "general", "generous", "generate" etc. are pronounced with a "short e". Mr Abrahams also argued that the respective marks would be closer when used in their possessive form. However, in my view such use would not make any appreciable difference to the similarity of the marks.

36. Next I turn to a conceptual comparison of the marks. Both marks consist essentially of invented words but as they both contain the prefix PHARMA it may well be that the relevant public would perceive an allusion to pharmaceutical(s). However, I do not believe that, in their totality, the marks share a conceptual similarity. At the hearing Mr Abrahams contended that the customer for the PHARMAGENIX product could believe that it was another product from the PHARMAGENE range, perhaps a version of the product formulated specially for women as the "IX" termination could denote a female connotation as in e.g. "Testatrix". In response to this Mr Tritton submitted that the average customer for the goods would not make such a connection when encountering the marks. I agree with Mr Tritton.

37. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must consider who the average consumer is and make appropriate allowance for imperfect recollection. In this regard I do not believe the error within Mr Harpers' declaration (paragraph 21 of this decision refers) has any significant bearing on the position.

38. Both the applicant's and opponent's specifications cover a wide range of goods, some of which would only be available on prescription, whilst others would be available over the counter. The average customer may therefore be either an ordinary member of the public

purchasing an over the counter product or a medical professional prescribing a prescription drug. In relation to over the counter products, I do not believe that there are any special circumstances which suggest that the average customer pays a particularly high or low level of attention to the selection of such goods. They are not casual "bags of sweets" cases but neither are they expensive and important purchases, such as a motor car. Turning to the position where a medical practitioner is involved in the selection and prescription of the products, I would only add that I do not believe that this would result in any greater likelihood of confusion.

39. On a global appreciation, allowing for an appropriate level of defective recollection, I do not believe the average customer is likely to confuse the applicant's mark PHARMAGENIX with the opponent's mark PHARAMGENE. I conclude that the opposition under Section 5(2)(b) fails.

40. Next, the Section 5(4)(a) ground. Section 5(4)(a) of the Act states:-

"5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

41. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the WILD CHILD case (1998) 14 RPC 455. In that decision Mr Hobbs stated that:

"The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art. 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off".

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd v Borden Inc [1990] RPC 341 and Erven Warnink BV v J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

42. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed". the relevant date is therefore the dates of the application for the mark in suit.

43. Earlier in this decision I found that the application in suit and the opponent's registrations were not confusable. Accordingly it is my view that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) therefore fails.

44. Finally I turn to the grounds of opposition under Section 5(3) of the Act which states:-

5.-(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

The term "earlier trade mark" is defined in Section 6 of the Act, which is set out earlier in this decision.

45. In the light of my earlier findings in relation to Section 5(2)(b), the Section 5(3) ground cannot succeed and it places the opponent in no stronger position.

46. The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay to them the sum of £650. This sum is 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 05 day of April 2002

**JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General**