

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2226448
BY VECTURA LIMITED TO REGISTER A TRADE MARK
IN CLASSES 1, 5 AND 10**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NUMBER 51771 BY POWDERJECT RESEARCH LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application Number 2226448
by Vectura Limited to Register a Trade Mark
in Classes 1, 5 and 10**

and

**IN THE MATTER OF Opposition thereto under
Number 51771 by PowderJect Research Limited**

BACKGROUND

1. On 20 March 2000 Ventura Limited applied to register the trade mark POWDERHALE in Classes 1, 5 and 10 of the register for the following specification of goods:-

Class 1

Chemical substances and products for use in the manufacture of medical preparations.

Class 5

Pharmaceutical and veterinary preparations, substances and products; chemical preparations and products for medical and veterinary purposes; inhalants; powders for inhalers; powders for asthma inhalers; powders for transdermal injection; medicinal powders for delivery as aerosols.

Class 10

Medical and veterinary apparatus and articles and parts and fittings therefor; inhalers and parts and fittings therefor, asthma inhalers and parts and fittings therefor; inhalers for the delivery of systemic drugs.

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

3. On 23 November 2000 J A Kemp & Co on behalf of PowderJect Research Limited filed a Notice of Opposition. In summary, the grounds of opposition were:

- (i) Under Section 5(2)(b) 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 or services and there exists a likelihood of confusion on the part of the public:- UK trade mark registration Nos 1588241, 2203418, 2163271, 2172944, 2206107; Community Trade Mark

registration Nos 39024, 1253186, 889212. Details of these registrations are at Annex One to this decision. The opponents claim to be the proprietor of a family of UK trade marks having the prefix POWDER.

- (ii) 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 not similar, registration of the mark applied for would take unfair advantage of or be detrimental to, the distinctive character or the repute of the opponent's earlier marks.
- (iii) Under Section 5(4)(a) of the Act by virtue of the law of passing off in light of the common law rights possessed by the opponent in their trade mark POWDERJECT in respect of pharmaceutical preparations and medical apparatus and instruments and parts and fittings thereof.

4. The applicants, through their agents Abel & Imray filed a Counterstatement denying the grounds of opposition. Both sides filed evidence and asked for an award of costs in their favour. Neither party requested a hearing.

Opponent's Evidence

5. This consists of two witness statements, one each from Charles Swingland and Monica Anne Marshall dated 7 September 2001 and 10 September 2001 respectively.

6. Mr Swingland is the Company Secretary of PowderJect Research Limited (PRL), formerly Oxford Biosciences Limited (OBL), the name change to PRL from OBL taking place on 12 May 1997.

7. Mr Swingland explains that PRL are the intellectual property owning arm of the PowderJect group of companies which in the UK comprised PowderJect Pharmaceuticals Plc, PowderJect Research Limited, Evans Vaccines Limited and PowderJect Technologies Limited. The PowderJect group was set up with the main aim of developing and exploiting new technology in the pharmaceutical and medical fields. He adds that next technology, pioneered and exclusively developed by the group, is the transdermal injection of particulate (powdered) pharmaceuticals and vaccines and the apparatus and instruments for use in this administration method, as well as the formulation and formation of particulate pharmaceuticals for administration by this method. This proprietary administration route with which the PowderJect group is concerned is commonly referred to as a so-called needless injection whereby drug or vaccine compositions are injected into the skin without the use of a needle, typically using a high-pressure helium jet. Mr Swingland goes on to explain that the PowderJect group are currently at the stage of product development and product trials in the UK with a view to obtaining marketing approval for their products.

8. Mr Swingland states that the PowderJect group has the policy of adopting a family of trade marks having the prefix POWDER - coupled with a suffix to form a fanciful word. He adds that the POWDER-prefixed trade marks which has received most exposure by the PowderJect group is the trade mark POWDERJECT, itself, which is used as a house mark within the

PowderJect group. He states that this trade mark has been used by the PowderJect group continuously since at least 1997 in the United Kingdom in connection with corporate presentation and shareholder documentation and other documentation concerning promotion of the PowderJect group companies and the PowderJect products. The trade mark POWDERJECT has also been used in connection with UK trials since at least 1998.

9. Mr Swingland goes on to state that the PowderJect group has maintained a high profile, in particular for the POWDERJECT mark, as far as the pharmaceutical profession, trade and industry is concerned, by means for example of presence and presentations at medical congresses throughout the world, including in the UK, in the areas of drug delivery, vaccines, transdermal injections, and diabetes treatments in particular. Moreover the PowderJect group has undertaken numerous fund-raising activities in, in particular, the City of London. He explains that the trade marks POWDERJECT and POWDERJECT SMALL PARTICLES have been used in corporate presentation to the City of London since at least 1997, whereby the PowderJect group has developed brand recognition and goodwill with the City. Mr Swingland points out that since the inception of the PowderJect group, it has been the policy of the group that the house mark POWDERJECT should be used prominently throughout all group literature and presentations and the trade mark is used on company products, including all injection devices, where the mark is clearly displayed on the casing, except in those instances where for example in some trials, regulations mean application of the mark is not permitted.

10. Mr Swingland draws attention to:

- (i) Exhibit CS1 to his declaration which comprises a copy of a booklet relating to the 6th Annual Bio Partnering Europe Conference held in London in October 1998 and at which the PowderJect group was amongst the presenters. The details include a brief description of the presentation by PowderJect and a listing of the numerous attendees together with their corporate affiliations.
- (ii) Exhibit CS2 which comprises copies of sets of overheads provided in connection with presentation made by members of the PowderJect group of companies to conferences in London on 1 December 1999 and 28 February 2000. In connection with the Management Forum Conference of 28 February 2000 details of the conference which include a section headed “Who should attend” make it clear that the conference is directed principally to the pharmaceutical industry and those interested in pharmaceutical administration.
- (iii) Exhibit CS3 which consists of copies of the first pages of overheads of similar presentations made by the PowderJect group to the medical and pharmaceutical professions with a particular interest in drug delivery.
- (iv) Exhibit CS4 containing copies of sets of overheads provided in connection with presentations made by the PowderJect group to seek funding. Overheads entitled “Building a World-Class Company from Oxford University Science” relate to a presentation made on 19 March 1998. Those entitled “supersonic injection of powder medicines” relate to a business development presentation

made on 13 April 1999 at a meeting held with CANTAB Pharmaceuticals Plc, Cambridge, UK.

- (v) Exhibit CS5 which comprises copies of overheads used by the PowderJect group in connection with other presentations to the business sector relating to the promotion of products with the aim of obtaining funding.
- (vi) Exhibit CS6 consisting of copies of scientific articles by PowderJect personnel concerning the PowderJect drug delivery system. The journals in which these articles appeared are Nature Medicine (October 2000), AASQS (March 2001) and the Drug Delivery Companies Report 2001. All refer to drug delivery by powder injection. However, they are published after the relevant date for these proceedings - the date of application for the mark in suit.

11. Mr Swingland concludes that as a result of the promotion by the PowderJect group of companies and as a result of the interest in the particular administration route concerned, which avoids injection by needle, the trade mark POWDERJECT has acquired a substantial reputation in the UK within the pharmaceutical and medical fields. He believes that people well acquainted with PowderJect's activities will be likely to mistake the POWDERHALE product for a new product of the PowderJect's range.

12. Ms Marshall is a Chartered Patent Attorney, Registered Trade Mark Attorney and a partner in the firm of J A Kemp & Co, the opponent's professional advisors in this opposition.

13. Ms Marshall refers to Exhibit MAM 1 to her declaration which is a copy of print-outs of the results of searches of UK and European Community (CTM) registered trade marks and pending trade mark applications which she carried out on 9 October 2000 utilising the Marquesa trade mark search system. The searches were carried out to locate entries in classes 1, 5 and 10 containing the word POWDER.

14. From the results of her searches, Ms Marshall concludes that the only registrations covering preparations for use in the medical and pharmaceutical field or administration apparatus for use in these fields which feature the POWDER-prefix (excluding the present opposed application which postdates all) are in the name of PowderJect Research Limited. PowderJect Research Limited are the proprietors of:

POWDERCAINE (CTM Registration No 889212 and UK Registration No 2163721),

POWDERJECT (CTM Nos 1253196 & 39024 and UK Registration Nos 2203418 & 1588241),

POWDERJECT SMART PARTICLES (UK Registration No 2172944),

POWDERVAX (UK Registration No 2206107)

15. Ms Marshall goes on to state that insofar as the other entries cover goods in the same areas and include the word "POWDER", this is used entirely descriptively and appears as the

second word or later within the mark as a whole. She concludes that from the search results of Exhibit MAM1, in practice, PowderJect Research Limited has in the UK, an effective monopoly of registered trade mark rights featuring the prefix POWDER together with a further element to form a distinctive mark.

Applicant's Evidence

16. This consists of a witness statement from Hazel Hearn dated 10 December 2001. Ms Hearn is a registered Trade Mark Attorney employed by Able & Imray, the applicant's professional advisor in these proceedings.

17. Ms Hearn draws attention to Exhibit HH1 to her statement which comprises a brochure of the applicant, copyright 2001, illustrating use of the trade mark POWDERHALE. This brochure describes POWDERHALE as an innovative formulation system for dry powder inhalers.

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

DECISION

19. Firstly, I go to the ground of opposition based upon Section 5(2) 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."

20. 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,"

21. 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-Mayer*

Inc [1999] RPC 117, *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.

22. 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.

23. 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 POWDERJECT, but the evidence does not demonstrate that prior to the relevant date (20 March 2000) the mark had been used in relation to the sale of pharmaceuticals or medical apparatus. Indeed, Mr Swingland's evidence confirms that the PowderJect group are at the stage of product development and product trials in the UK, where they are looking to obtain marketing approval for their products. The evidence shows that since 1997 the PowderJect group have actively promoted their research and development activities under the mark POWDERJECT, often with the aim of obtaining funds. However, these research and development activities are mainly related to the delivery of drugs and vaccines through transdermal injections, which is a somewhat specialised and limited area of application. Furthermore, I have no independent supporting evidence going to the repute of the opponent and the evidence going to repute is somewhat limited in that, in the main, the promotion of the opponent's activities has been through a relatively small number of presentations at business/medical conferences.

24. On the basis of the evidence before me it seems to me that any reputation the opponent may possess is limited to research and development in the delivery of drugs and vaccines through transdermal injections, a highly specialised area of activity. Such reputation is of limited application to the current Section 5(2) proceedings bearing in mind the range of goods specified by the applicant. However, I will take it into account in reaching my decision.

25. In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion 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, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. In this case it is accepted that the opponent's POWDERJECT mark has a reputation, albeit a limited degree. However, it was held in *Marca Mode v Adidas AG* (2000) ETMR 723:

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (Canon, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

26. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must 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 on a full range of the goods covered within the respective specifications.

27. Both the class 5 and Class 10 specifications of the applications in suit and the opponent's registrations obviously cover the same and similar goods. These specifications are widely

drafted, include (inter alia) “pharmaceutical and veterinary preparations” and "medical and veterinary apparatus".

28. The applicant has also specified “Chemical substances and products for use in the manufacture of medical preparations” in Class 1 and I now go onto consider whether these goods are similar to those within the opponent’s registrations. While I have no evidence before me on the point it seems to me that it would be normal in trade for the producers of pharmaceutical preparations to also be in the business of producing chemical substances and products for use in the manufacture of pharmaceutical or medical preparations. Both the pharmaceutical preparations and the chemical products for use in the manufacture of pharmaceutical preparations could well be sold to the same buyers, eg pharmacists or hospital trusts and 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 take the view that there is similarity between the applicant’s Class 1 goods and the opponent’s Class 5 goods, ie pharmaceutical preparations.

29. In the evidence, the opponents have focussed on the state of the Trade Mark Register and the position regarding in relation to trade marks commencing with the prefix POWDER. I find such evidence to be of very little assistance as mere evidence of entries on the register does not demonstrate the position in the market place in relation to marks commencing with the prefix POWDER. Furthermore, the word POWDER, whether or not it is used as a prefix or elsewhere in a trade mark, cannot of itself be distinctive in relation to products which are in powder form. I would add that it is well accepted that marks must be compared as a whole - see *Sabel BV v Puma AG* (mentioned earlier in this decision).

30. The opponent’s claim a family of trade marks bearing the prefix POWDER. While the common feature of the opponent’s registrations is the prefix POWDER I do not consider it appropriate to link these marks together in the consideration of likelihood of confusion and the possibility of imperfect recollection. In a recent unreported decision of the Appointed Person - In the matter of Application No 2070392 to register a series of four trade marks in the name of The Infamous Nut Company Ltd in classes 29 and 31 and in the matter of Opposition thereto under No 47392 by Percy Dalton (Holdings) Ltd (SRIS O/411/01) at paragraphs 35, 36 and 37, Professor Ruth Annand stated that:

“It is impermissible for Section 5(2)(b) collectively to group together several earlier trade marks in the proprietorship of the opponents.

Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by Section 6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant’s mark must be considered against each of the opponent’s earlier trade marks separately (*ENER-CAP Trade Mark* [1999] RPC 362).

In some circumstances it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a “family of marks” in the proprietorship and use of the

opponent (AMOR, Decision No 189/1999 of the Opposition Division, OHIM OJ 2/2000 p 235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in classes 29 and 31.”

31. I would add that in the present case, with the limited exception of the POWDERJECT mark, the opponent’s evidence has not demonstrated enhanced distinctiveness in relation to their earlier trade marks.

32. I now go on to compare the mark in suit with the opponent’s earlier marks. The mark in suit comprises the invented and fanciful word POWDERHALE. While the prefix POWDER is a dictionary word describing, eg chemical preparations or pharmaceutical preparations in powder form, the suffix HALE (while perhaps alluding to inhalation or good health) is abstract in its connotations. The opponent’s marks POWDERJECT, POWDERCAINE and POWDERVAX also comprise invented words with the descriptive prefix POWDER. Again the suffix to each of these marks whilst perhaps alluding to characteristics of the goods, is sufficiently illusory to ensure that the marks in their totality are fanciful. While the opponent also has a registration for the series of two trade marks POWDERJECT SMART PARTICLE and POWDERJECT SMART PARTICLES I do not believe that this places them in any stronger position given their registrations in POWDERJECT.

33. The respective marks must be compared as a whole and by references to overall impression but, as recognised in *Sable 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.

34. Firstly, I turn to a visual comparison of the respective marks. The similarities and differences are plain to see. Both the applicant’s mark and the opponent’s registration share the directly descriptive prefix POWDER. However, my decision must be based on overall impression and the terminations of the marks are conspicuously different and I can think of no satisfactory explanations as to why these would be marginalised or ignored in use. In totality the marks look different.

35. In relation to aural use, the marks share the same prefix and it is widely accepted that in the spoken use of trade marks customers have a tendency to slur the endings of words. However, this is of limited significance in the present comparisons as the terminations of the respective marks are strong elements which sound markedly different and I have no doubt that they serve to distinguish the marks in aural use.

36. Next, I turn to a conceptual comparison of the marks. The respective marks consist of invented words but contain the prefix POWDER. I do not believe that, in totality, the marks share a conceptual similarity. While the customer of the goods may perceive that the products may come in powdered form or administer powder, this concept in itself is directly descriptive of the nature of the goods and it not one which, in itself, is worthy of protection or monopoly.

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 also consider who the average customer is and make appropriate allowance for imperfect recollection.

38. The applicant's and opponent's specifications cover a wide range of goods. The customer for the Class 1 and Class 10 goods would be careful and discerning, which mitigates against a likelihood of confusion in relation to these goods. Turning to the goods in Class 5, they include prescription only products and also goods which could be purchased 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 product. 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, taking into account the overall differences between the marks, the nature of the goods and allowing for an appropriate level of defective recollection, I do not believe the average customer is likely to confuse the applicant's mark POWDERHALE with the opponent's earlier registrations. 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 Article 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 (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 the matter 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 date 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.

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

46. 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.

47. The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay to them the sum of £900. 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 27 day of May 2002

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General

REGISTRATION NO: 158241

MARK: POWDERJECT

GOODS: CLASS 10 - Medical apparatus and instruments; injectors for medical purposes; parts and fittings for all the aforesaid goods; all included in Class 10.

REGISTRATION NO: 2203418

MARK: POWDERJECT

GOODS: CLASS 5 - Pharmaceutical and veterinary preparations; vaccines; pharmaceutical and veterinary preparations in powder or particulate form.

SERVICES: CLASS 42 - Scientific and medical research

REGISTRATION NO: 2163271

MARK: POWDERCAINE

GOODS: CLASS 5 - Pharmaceutical, veterinary and sanitary preparations.

CLASS 10 - Surgical, medical and veterinary apparatus and instruments; injections for medical purposes; parts and fittings for all the aforesaid goods.

REGISTRATION NO: 2172944

**MARK: POWDERJECT SMART PARTICLE
POWDERJECT SMART PARTICLES**

A series of two trade marks

GOODS: CLASS 5 - Pharmaceutical, veterinary and sanitary preparations.

CLASS 10 - Surgical, medical and veterinary apparatus and instruments; injectors for medical purposes; parts and fittings for all the aforesaid goods.

SERVICES: CLASS 42 - Scientific and medical research and development; provision of information relating to pharmaceutical, veterinary and sanitary preparations; provision of information relating to surgical, medical and veterinary apparatus and instruments.

REGISTRATION NO: 2206107

MARK: POWDERVAX

GOODS: Class 5 - Pharmaceutical preparations and products, vaccines.

EUROPEAN COMMUNITY REGISTRATION NO: 39024

MARK: POWDERJECT

GOODS: Class 10 - Medical apparatus and instruments; injectors for medical purposes; parts and fittings for all the aforesaid goods.

EUROPEAN COMMUNITY REGISTRATION NO: 1253186

MARK: POWDERJECT

GOODS: Class 5 - Pharmaceutical and veterinary preparations; vaccines; pharmaceutical and veterinary preparations in particulate or powder form.

Class 10 - Medical apparatus and instruments.

SERVICES: Class 42 - Scientific and medical research

EUROPEAN COMMUNITY REGISTRATION NO: 889212

MARK: POWDERCAINE

GOODS: Class 5 - Pharmaceutical, veterinary and sanitary preparations.

Class 10 - Surgical, medical and veterinary apparatus and instruments; injectors for medical purposes; parts and fittings for all the aforesaid goods.
