

TRADE MARKS ACT 1994

AND

THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

**IN THE MATTER OF APPLICATION No. M605138
BY FARMABAN S.A. TO PROTECT A TRADE MARK
IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 70293
BY BEIERSDORF AG**

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BACKGROUND

1. On 15 November 1999, Farmaban S.A. on the basis of a registration held in Spain, requested protection in the United Kingdom of the following trade mark:

LENOPLAST

for a specification of goods which reads:

"Bandaging material, in particular gauze bandages, bandages, dressings, adhesive tapes, and absorbent cotton; dental filling material and dental impression compounds; air fresheners; weed and pest-control preparations."

2. The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and the particulars of the International Registration were published in accordance with Article 10.

3. On 22 May 2000 Beiersdorf AG filed notice of opposition to the conferring of protection on this International Registration. They frame their principle objection in the following terms:

"2. The mark the subject of International Registration 605138 is similar to an earlier trade mark, the mark LEUKOPLAST, registered by the opponent under number 1232259 which is registered in respect of "Medical and surgical plasters; materials prepared for bandaging", following the advertisement of the mark for opposition

purposes in Trade Marks Journal No 5383, at page 2341, on the 11th September 1985, and is registered in respect of goods in part identical and in part similar to those in respect of which the earlier trade mark 1232259 is protected. Because of this similarity, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association, with the earlier trade mark. The relative grounds for refusal accordingly exist under the provisions of section 5(2)(b) of the Trade Marks Act 1994.”

The opponents also allege, because of their use of the protected trade mark that protection should be refused under the provisions of Section 5(4)(a).

4. The International Registration holders (for ease of reference I will refer to them hereafter as the applicants) filed a counterstatement in which they deny the above grounds.

5. Both sides ask for an award of costs.

6. Both parties filed evidence. At the conclusion of the evidence rounds I wrote to the parties stating that I considered that a decision could be reached on the basis of the papers filed but reminding them of their right to a hearing. In the event neither side asked to be heard. Written submissions have however been received from both parties; I shall refer to these as necessary later in my decision. Acting on behalf of the Registrar and after a study of the papers I give this decision.

7. To the extent that the evidence of both parties consists of relevant facts, as opposed to irrelevant facts or submissions, I summarise it below.

Opponents' evidence

8. This consists of a statutory declaration dated 7 March 2001 by Clifford John Green. Mr Green states that he is the National Sales Manager of Beiersdorf UK Limited, which he explains is the operating arm of Beiersdorf AG in the United Kingdom. He has held this position since September 2000 having worked for the Company since May 1989. Mr Green confirms that he is authorised to speak on his Company's behalf adding that the information provided comes from his own knowledge or from Company records.

9. The points I take which emerge from Mr Green's declaration are:

(i) that the trade mark LEUKOPLAST has been used for over ten years to identify bandaging products sold by the opponents - exhibit CJG1 consists of a “current” sales brochure (presumably 2001) showing the current LEUKOPLAST product range. Mr Green states that this range has not changed materially throughout the sales period; I note that the LEUKOPLAST trade mark is used in respect of surgical tape;

(ii) that products bearing the LEUKOPLAST trade mark are sold throughout the United Kingdom to a range of customers. A list of forty nine current customers is provided. These are direct users of the products, hospitals and health authorities, or intermediaries who sell on to such users. Though sold to relatively few authorities the

product will be used by many healthcare professionals in the course of their work.

(iii) sales figures for products sold under the LEUKOPLAST trade mark are provided for the eleven years to 2000; for the years 1997 to 1999 they are as follows:

<u>Year</u>	<u>Sales (£)</u>
1997	68, 493
1998	89, 862
1999	62,624

Applicants' evidence

10. This consists of a statutory declaration dated 24 September 2001 by Michael Arthur Lynd. Mr Lynd explains that he is, inter alia, a Trade Mark Attorney and Partner in the firm of Edward Evans Barker who are the applicants' professional representatives in these proceedings. There are no points of relevance upon which I need to draw.

DECISION

11. I shall deal first with the objection based on Section 5(2)(b) of the Act; this reads as follows:

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

(a)

(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.”

12. An earlier right is defined in Section 6 of the Act, the relevant part of which states:

“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).....”

13. In these proceedings the opponents' rely on registration No. 1232259 dated 17 December 1984 which clearly qualifies as an "earlier trade mark" within the meaning of section 6(1)(a) of the Act; I also note that this registration stands in the name of BSN medical GmbH & Co. KG, although nothing turns on this point.

14. In reaching a conclusion 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] 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. 19.

15. For convenience, the respective trade marks and goods are shown below:

opponents' trade mark	applicants' trade mark
LEUKOPLAST	LENOPLAST (stylised)
opponents' goods	applicants' goods
Medical and surgical plasters; materials prepared for bandaging.	Bandaging material, in particular gauze bandages, bandages, dressings, adhesive tapes, and absorbent cotton; dental filling material and dental impression compounds; air fresheners; weed and pest-control preparations.

Similarity of goods

16. In their Statement of Grounds, the opponents say that their goods are in part identical and in part similar to the goods in respect of which the applicants are seeking protection in the United Kingdom. In order to decide this point one looks to the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case) [1996] RPC 9 and the comments of the Court in the *Canon* case mentioned above. In *Treat*, Jacob J identified the following as factors to be considered when determining the similarity or otherwise of goods:

- (a) The uses of the respective goods or services;
- (b) the users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets, and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are in competition with each other; that enquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or the services in the same or different sectors.

17. I acknowledge that in view of the *Canon* judgment the *Treat* case can no longer be wholly relied upon, but the Court of Justice did say that the factors identified by the government of the United Kingdom in its submissions (which are those listed in *Treat*) are still relevant in respect of a comparison of goods.

18. Applying these factors to the case before me it is, in my view, self evident that the “Medical and surgical plasters; materials prepared for bandaging” which appear in the opponents’ specification of goods are either identical or at the very least similar to the “Bandaging material, in particular gauze bandages, bandages, dressings, adhesive tapes, and absorbent cotton” which appear in the applicants’ specification. Similarly applying the same factors to those goods which remain in the applicants’ specification ie. “dental filling material and dental impression compounds; air fresheners; weed and pest-control preparations”, I have little difficulty in concluding that these goods are neither the same nor similar to the goods appearing in the opponents’ specification. Having reached this conclusion and in view of the comments of Mr Geoffrey Hobbs QC sitting as the Appointed Person in *Raleigh International* [2001] RPC 202 where he said:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences",

it will not be necessary for me to consider these goods any further when I turn to compare the respective trade marks.

Distinctive character of the opponents’ mark

19. The opponents’ trade mark consists of the word LEUKOPLAST in a slightly stylised typeface. The distinctive character of an earlier trade mark is a factor to be borne in mind in coming to a view on the likelihood of confusion (*Sabel v Puma*, paragraph 24). That distinctive character can arise from the inherent nature of the mark or can be acquired through use.

20. In these proceedings the opponents have filed evidence of the use that they have made of their LEUKOPLAST trade mark and this is summarised above. The LEUKOPLAST trade mark has been used since 1990 in relation to surgical tape with turnover in the period 1990-1999 amounting to some £500k. However, I am given no indication as to the size of the market for such goods, nor am I provided with any information regarding the opponents’ market share.

21. In their written submissions, the applicants say:

“In accordance with the decision in *Sabel BV vs. Puma AG*, the more distinctive is the earlier mark the wider the penumbra of protection. The trade mark LEUKOPLAST upon which the opponents rely is not, *per se* particularly distinctive consisting as it does of no more than a combination of a prefix which is conventional in the medical field and a suffix which is also conventional in the medical field. The use evidenced by the opponents by way of the statutory declaration of Clifford John Green of 7th March 2001 shows annual sales at only a modest level (well below £100,000 per year). At a unit cost of considerably in excess of £1 per unit (currently £1.99 for the 2.5cm tape and £3.34 for the 5cm tape) the best gloss that can be put on the opponents’ figures is that they sold only some 40,000 rolls of tape in their best year of sales - the year 2000. It is submitted for the applicants that this is not sufficient usage to render the opponents’ LEUKOPLAST trade mark more distinctive by virtue of extensive use.”

22. In the absence of the sort of additional information mentioned above (e.g. market size/market share etc) the evidence of use of their LEUKOPLAST trade mark provided by the opponents does not assist me greatly. However, the absence of compelling evidence of acquired distinctiveness is far from fatal to their case. Notwithstanding the applicants’ comments which I have reproduced above, the word LEUKOPLAST the subject of the earlier trade mark is, in my view, an inherently distinctive trade mark for all the goods for which it is registered; it is arguable therefore to what extent this inherent distinctiveness could be improved by actual use of the trade mark.

Similarity of marks

23. The visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by those marks bearing in mind their distinctive and dominant components, *Sabel v Puma*, paragraph 23. The matter must be judged through the eyes of the average consumer of the goods/services in question, *Sabel v Puma*, paragraph 23. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant but rarely has the chance to make direct comparisons between marks. Imperfect recollection must, therefore, be allowed for, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* I must also of course consider “notional and fair use” of both parties trade marks, as per the comments in *React* trade mark [2000] R.P.C. at page 288.

24. The opponents’ comments contained in their written submissions in relation to the similarity of the respective trade marks are as follows:

“3. The opponents’ mark and the opposed mark are not identical. The beginnings and ends of both marks are identical, with the only difference being an N in the opposed mark compared with UK in the opponents’ mark. While there are clear differences both visually and phonetically when concentrating on that particular portion of both marks, such concentration is artificial. The marks should be compared as a whole and through the eyes of the general viewer, ie. neither through the eyes of the celebrated moron in a hurry, nor yet through the eyes of a trade mark practitioner, or other party specifically asked to contrast and compare the two. The last is particularly important since it is unlikely that, in practice, situations would often if ever arise where both

products would appear side-by-side save perhaps transiently in the store cupboard of a customer who had changed allegiance from one party to the other.

4. The common suffix PLAST would no doubt be taken as indicative of the type of product i.e. a “plaster” type product in the “plasters and bandaging” sense - by the normal viewer. The distinguishing part of the mark might thus be considered to be the first portion, LEUKO in one case and LENO in another. Both sound like prefixes and although the customers for these products may be sufficiently classically or medically trained to wonder whether the prefix in the opponents’ mark might be allusive, the use of the letter K rather than the more normal C in compounds (such as LEUCOCYTE) means that for at least a substantial proportion of those who are using the applicants’ or opponents’ products, both are seen as sticky plasters in tape form with a name beginning with L. It is, we submit, widely accepted that the initial letters of invented word marks are of considerable importance compared to the remainder of the mark.

5. A comparison of the two marks should, we submit, give rise to the conclusion that the two marks in question, LENOPLAST and LEUKOPLAST, are simply too close. In this connection, it is useful to look at the lists of marks in this area conveniently provided by the exhibits MAL1 and MAL2. We submit that, in terms of close similarity, LENOPLAST and LEUKOPLAST emerge as an obvious pair of closely similar marks owned by different parties, while no such similar close pair is found elsewhere in those lists.”

25. The applicants’ comments contained in their written submissions in relation to the similarity of the respective trade marks are as follows:

“3. The prefixes LEUKO- and LENO- are neither visually nor phonetically similar. There is no possibility of a customer buying a LENOPLAST product in the belief that it is a LEUKOPLAST product. Equally there is no possibility of a customer orally confusing the two marks. They look different and they sound different.

The meaning conveyed by the respective marks is different. The -PLAST suffix is presumably a reference to the fact that the goods can be in the nature of plasters; the LEUKO prefix of the trade mark upon which the opponents rely means “white”; the prefix LENO- of the trade mark of the application in suit presumably derives from the English word LENO referring to a thin, muslin like fabric (Chambers 20th Century Dictionary).”

26. The parties’ trade marks consist of 9 and 10 letters respectively; each consists of three syllables; the last five letters of each trade mark are identical, consisting of the letters PLAST; in relation to this suffix, I note that the opponents accept that it is meaningful in relation to the goods which are in conflict in these proceedings. The prefixes of each trade mark differs by one letter in length and by two letters in the middle of the prefixes ie. LEUKO v LENO. Visually the trade marks share obvious points of similarity. Their lengths are similar, they each begin with the same two letters LE and end with the same six letters OPLAST.

27. In so far as the oral/aural comparison is concerned, how the respective trade marks are

likely to be pronounced is open to debate. In my view the opponents' trade mark is most likely to be pronounced LOO CO PLAST; the applicants' trade mark is open to different pronunciations the most likely in my view being LEN O PLAST although LEE NO PLAST (as in the surname LENO) is also a possibility.

28. Conceptually I note both the applicants' comments in regard to the derivation of the respective prefixes and the opponents' comments to the effect that any potentially allusive meaning will be lost to the vast majority of those who are using the respective parties goods.

29. At paragraph 23, I outlined the criteria I have to apply in reaching a conclusion on this point. I must consider the overall impressions created by the respective trade marks bearing in mind their distinctive and dominant components. The parties agree that the PLAST element of each trade mark is liable to be seen as a reference to plaster (in the sense mentioned above). That being the case, the prefix elements of the respective trade marks take on a greater significance, although one must take care not to make a comparison on this basis alone. In essence, I must keep in mind the totalities of the trade marks ie. the sum of their distinctive and non-distinctive components; the average consumer of the goods (with all the traits he or she is known to have) must also be borne in mind. I also note that neither specification of goods is limited in any way and it is therefore open to either party to sell their goods to whomever they wish. In reaching a conclusion under Section 5(2)(b) I have placed no reliance on the use made of the applicants' LENOPLAST trade mark which was set out in Mr Lynd's declaration. This use began after the material date in these proceedings.

30. Considering matters in the round, are the respective parties' trade marks similar? In my view they share a degree of both visual and oral similarity; if there is any conceptual similarity it is limited to the presence of the PLAST suffix present in the respective trade marks; in my view, the marks are more likely to be taken by the average consumer as invented words. The PLAST suffix is clearly meaningful in relation to the goods in conflict, therefore, it is likely that for the purposes of comparison the attention of the average consumer will shift (to some extent at least) to the prefix elements of the respective trade marks. That being the case one is then comparing LEUKO and LENO whilst bearing in mind that these elements form part of a greater whole. It is well established that it is the beginnings of trade marks which are generally the most important for the purposes of assessing similarity. While both trade marks begin with the letters LE when taken as prefixes in their totality, they are in my view, visually, orally and conceptually dissimilar, sufficiently dissimilar for there to be no confusion as to origin. The objection based on Section 5(2)(b) of the Act is dismissed accordingly.

31. The final objection is based on Section 5(4)(a) of the Act. This reads as follows:

“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”.

32. The jurisprudence on the common law tort of passing off insofar as the Trade Marks

Registry is concerned is clearly set out by Geoffrey Hobbs QC acting as the Appointed Person in *Wild Child* [1998] 14 RPC, 455:

"A helpful summary of the element 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:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) 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
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

The restatement of the elements of passing off in the form of this classical trinity has been referred to as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

33. Given that I have found the parties trade marks to be dissimilar under Section 5(2)(b) of the Act, I do not see how the opponents can be in any better position under this section. Even if I were to accept (which I do not) that the opponents' evidence had established a protectable goodwill in relation to surgical tape, given my views on the dissimilarity of the trade marks themselves, there can be no question of misrepresentation and consequently no damage. The opposition under this head is dismissed accordingly.

34. The opposition has failed and the applicants are entitled to a contribution towards their costs; I order the opponents to pay to them the sum of £800. 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 21ST day of October 2002

**M KNIGHT
For the Registrar
the Comptroller-General**