

O/200/03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2269536
BY INSTITUT ROSELL INC
TO REGISTER THE TRADE MARK:**

GASTRO-AD

IN

CLASSES 5 AND 30

AND

**THE OPPOSITION THERETO
UNDER No 90440
BY MUNDIPHARMA AG
BASED UPON THE EARLIER TRADE MARK:**

GASTROBID

Trade Marks Act 1994
in the matter of application no 2269536
by Institut Rosell Inc
to register the trade mark:
GASTRO-AD
in classes 5 and 30
and
the opposition thereto
under no 90440
by Mundipharma AG

BACKGROUND

1) On 9 May 2001 Institut Rosell Inc (referred to afterwards as Rosell) applied to register the trade mark **GASTRO-AD**. The application was published for opposition purposes in the “Trade Marks Journal” on 27 June 2001 with the following specification of goods:

food supplements (or additives) made with soya flour, for the treatment of gastro-intestinal disorders

food supplements (or additives) made with soya flour, not for medical or pharmaceutical purposes.

The above goods are in classes 5 and 30 respectively of the International Classification of Goods and Services.

2) On 26 September 2001 Mundipharma AG (referred to afterwards as Mundipharma) filed a notice of opposition to this application. Mundipharma states that it is the owner of the following trade marks:

- United Kingdom registration no 1237042 for the trade mark GASTROBID. The application for this registration was filed on 4 March 1985. It is currently registered in respect of the following goods in class 5 of the International Classification of Goods and Services:

Pharmaceutical and veterinary substances and preparations, all for the treatment of disorders associated with the gastro-intestinal tract.

- Community trade mark application no 2146108 for the trade mark GASTROBID. The application for this registration was filed on 14 March 2001. The application is currently opposed. It is for the following goods in class 5 of the International Classification of Goods and Services:

Pharmaceutical preparations and substances.

3) Mundipharma states that its trade marks are visually and phonetically similar to Rosell’s application and that identical and similar goods are encompassed by the respective trade marks. It states that there is a likelihood of confusion between its trade marks and that of Rosell and so registration of the application would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4) Mundipharma states that there has been substantial and continuous use in the United Kingdom of its trade mark GASTROBID since January 1987 in relation to preparations for the treatment of gastro-intestinal disorders. Consequently, substantial goodwill and reputation exists in the trade mark in the United Kingdom. Mundipharma states that use of the trade mark GASTRO-AD in respect of the goods which it covers will lead to confusion and/or deception of the public, leading to damage of its business and/or the goodwill existing in its trade mark. Consequently, use of the trade mark of Rosell is liable to be prevented by the law of passing-off and registration of the application would be contrary to section 5(4)(a) of the Act.

5) Mundipharma requests that the application be refused and seeks an award of costs.

6) Rosell filed a counterstatement. It denies that its trade mark is similar or identical to that of Mundipharma and so denies that registration of the application would be contrary to sections 5(2)(b) and 5(4)(a); even in the latter case if Mundipharma establishes goodwill, for which it is put to proof.

7) Rosell requests that the application proceeds to registration and seeks an award of cost.

8) Both sides filed evidence.

9) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing, so I will make a decision after a careful study of the papers.

10) Mundipharma filed written submissions and I take these into account in reaching my decision.

EVIDENCE

Evidence of Mundipharma

11) There is a witness statement from Fiona Merle Crawford, a trade mark attorney. This statement deals with the steps that were taken to get evidence of use of the trade mark. It does not go to the substance of the case. Consequently, I will say no more about it.

Witness statement of Kenneth Williamson

12) Mr Williamson is director of sales and marketing for Napp Pharmaceuticals Limited. Mr Williamson states that the trade mark GASTROBID has been used by Napp Laboratories Ltd in the United Kingdom under licence from its associated company Mundipharma AG since January 1987. He states that this use has been in relation to a sustained release tablet containing metoclopramide as active ingredient. GASTROBID is used for treatment of dyspepsia, reflux oesophagitis, gastritis, duodenitis and hiatus hernia. He exhibits a printout from IMSWorld Product Launches file to show that the 28 tablet pack, 15 mg tablet was launched in January 1987 and the 56 tablet pack was launched in July 1989.

13) Mr Williamson states that the United Kingdom wholesale turnover figures for the past five years or so, he is writing this in May 2002, have ranged from approximately £800,000 to £1

million per annum. He states that the current retail price of GASTROBID is £10.33 for a pack of 56. He gives the following annual United Kingdom turnover figures:

Year	Approximate sales at wholesale price		
	Full year	3quarters	2 quarters
last two quarters of 1997			(£510,000)
1998	£990,000		
1999	£920,000		
2000	£830,000		
first three quarters of 2001			(£630,000)

14) Mr Williamson gives the following figures for the promotional expenditure on GASTROBID:

1987 £864,400
 1988 £288,400
 1989 £411,500
 1990 £143,400
 1991 £154,600
 1992 £6,200
 1993 £43,500
 1994 £43,400
 1996 £40,500
 1997 nil
 1998 nil
 1999 nil
 2000 nil

15) Mr Williamson exhibits a copy of the artwork for the GASTROBID 56 tablet pack. The pack shows use of the word GASTROBID in title case in conjunction with the word Continus. On the front of the packet the word Continus is below GASTROBID. On the back of the packet the following appears: "Each Gastrobid Continus tablet contains....." The packet also states that GASTROBID and CONTINUS are registered trade marks.

Evidence of Rosell

16) This consists of a statutory declaration by Jonathan Sutton. Mr Sutton is a trade mark agent. Parts of Mr Sutton's declaration are submissions and comment on the evidence of Mundipharma. This is not evidence of fact and I will say no more about it.

17) Mr Sutton exhibits at JS1 an extract from "Collins English Dictionary" showing the entries for gastro and words with the prefix gastro. Gastro is defined as being a combining form meaning stomach. There are various words with the prefix most of which relate to conditions of the stomach or procedures relating to conditions of the stomach.

18) Mr Sutton exhibits the results of a search of the United Kingdom and Community Trade Mark registers. He states that this uncovered in excess of fifty registrations in class 5 in the names of numerous proprietors. Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 stated:

Aln particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g.* *MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.@

I too disregard the state of the register evidence, which tells me nothing about what is happening in the market place. In the case of pharmaceutical products the evidence could have at least been supported by evidence that the various products are licensed for use in the United Kingdom. Not only do I not know if they have been used, I do not know if they have been licensed for use.

19) Mr Sutton exhibits a statutory declaration from Nicholas Thorne. Mr Thorne is a pharmacist. He states that GASTROBID is distributed in the United Kingdom by Napp Laboratories Limited. Mr Thorne states that GASTROBID is used for the treatment of various disorders of the stomach. He also states that GASTROBID is a prescription only product.

20) Mr Sutton states that Rosell uses the trade mark GASTRO-AD on the goods for which protection is sought in Canada and the USA. He states that the trade marks GASTROBID and GASTRO-AD co-exist upon the Canadian trade marks register and exhibits documentation to this effect. The documentation shows that a declaration of use for GASTRO-AD was filed on 2 December 1987 and a declaration of use for GASTROBID was filed on 26 June 1986. The GASTROBID trade mark is in the name of Purdue Frederick. Mr Sutton exhibits printouts from the mundipharma.co.uk website which states that Purdue, Mundipharma and Napp are associated companies. It also states that Mundipharma has manufacturing capacity in the United Kingdom through Napp and in Canada through Purdue Frederick. I note that the Canadian registration for GASTRO-AD is not for the same goods as the United Kingdom application. It is for pharmaceutical products, namely tablets for the relief of problems of the digestive system.

Evidence in reply of Mundipharma

Second witness statement of Kenneth Williamson

21) Parts of Mr Williamson's statement are a critique of the evidence of Mr Sutton and submission. This is not evidence of fact and I will say no more about it.

22) Mr Williamson exhibits a graph showing GASTROBID annual wholesale sales for the years 1998 to 2001 expressed as a percentage of total annual sales in the United Kingdom of:

1. all branded metoclopramide products (whether sustained release or not), and
2. all sustained release metoclopramide products.

Mr Williamson states that this illustrates in the period 1998 to 2001 the annual sales of GASTROBID represented between 10.2% and 12.4% of all United Kingdom sales of branded metoclopramide products and between 60.7% and 65.6% of all United Kingdom sales of sustained release metoclopramide products.

23) Mr Williamson states that as a result of preparing the above graph he discovered that he had given incorrect figures as to the sales of GASTROBID for the years 1998 to 2001. He states that the figures should be as follows:

Year	Approximate sales turnover at wholesale price
1998	£242,690
1999	£215,770
2000	£206,080
2001	£212,330

Second witness statement of Fiona Merle Crawford

24) Parts of Ms Crawford's statement are a critique of the evidence of Mr Sutton and/or submission, not evidence of fact. I will say no more about these aspects of Ms Crawford's evidence.

25) Ms Crawford exhibits pages from the November 2002 issue of MIMS to show that GASTROBID is the only prescription only medicine available having the prefix gastro. She states that the only other preparation with this prefix is the over the counter antacid GASTROCOTE. There are two references to GASTROBID. However, I noted that none of them refers to GASTROBID on its own but to GASTROBID CONTINUS, as the packet exhibited to the first witness statement of Mr Williamson did.

26) Ms Crawford gives evidence in relation to the switching of medicines from being prescription only to over the counter and vice versa and the prescribing of certain medicines which are available over the counter.

27) I will comment upon one particular matter in the submissions/critique of the evidence of Mr Sutton by Ms Crawford. She comments upon the fact that GASTROBID is owned by Purdue Frederick in Canada and so the situation is quite different. This submission sits ill with the use of the evidence of Napp who from the evidence of Mr Sutton share a similar position to that of Purdue Frederick. This is especially the case taking into account the passing-off claim which, on the evidence, all rests with a goodwill residing with Napp.

Evidence of use of GASTROBID

28) From the pleadings it appeared that Mundipharma was relying upon reputation and goodwill in relation to its claim of passing-off. However, from the submissions of Mundipharma it appears that it wishes to claim reputation to assist it in its claim under section 5(2)(b) of the Act. I am immediately struck with a problem in relation to the evidence. There is a dearth of evidence showing actual use of the trade mark despite the claims made by Mundipharma as to the extent of its promotional activities. However, what there is shows use of GASTROBID CONTINUS, not GASTROBID on its own. According to the MIMS exhibit this is how it would be prescribed. So I have a claim to a reputation with no evidence that the trade mark has ever been used on its own. Undertakings can use more than one trade mark. Indeed the packaging indicates that GASTROBID and CONTINUS are both trade marks. It is common practice for a house mark to be used with a specific brand. Neither GASTROBID nor CONTINUS is a house mark. The house mark that is used is Napp. From the evidence I have no way of knowing if GASTROBID lives independently or is joined in the perception of the customers with CONTINUS like a Siamese twin. If I was to make any comparison based

upon the evidence I would have to make it with GASTROBID CONTINUS not GASTROBID; not something that Mundipharma pleads.

29) Mr Williamson makes great play of the position of GASTROBID, although this should be GASTROBID CONTINUS, in relation to sales of branded metoclopramide products and sustained release metoclopramide products. He, however, does not give a break down in relation to the market as a whole, including generic products. Nor does he give a breakdown in relation to other products which are used for the same purposes as GASTROBID. The issue of reputation will rest on the market as a whole for the products, which will be defined by their use and not necessarily by their chemical make-up. He chooses an exceptionally narrow sector and then makes his claim to a leading market position within it. Such narrow self-selection tells me nothing about the reality of the market as a whole.

30) Taking into account the above factors I consider that there is no viable claim to enhanced protection through reputation.

31) To get off the ground for a claim of passing-off Mundipharma must establish goodwill. Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 states:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see Smith Hayden (OVAX) (1946) 63 RPC 97 as qualified by BALI [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

32) The evidence, in my view, clearly does not satisfy the tests set out by Pumfrey J, there is no evidence from the trade or the public other than that of Mr Thorne. In this case there is the added problem that it is not clear what sign has actually been used in relation to the goods. Ms Crawford and Mr Williamson refer to GASTROBID but the sparse exhibits showing use show GASTROBID CONTINUS. I note that Mr Thorne refers to GASTROBID in his evidence. However, this tells me little. He could have just referred to GASTROBID as this was the trade mark in issue. His evidence also does not tell me if he has any personal direct knowledge of the product. He could have obtained the information from a reference source. I do not consider that Mundipharma has established goodwill in relation to the business identified by the sign GASTROBID and so the claim under section 5(4)(a) must fall. It does not strike me that this does any great harm to Mundipharma's case as I cannot see how it could be any better off under section 5(4)(a) than under section 5(2)(b).

33) I also note that Mundipharma claim goodwill. However, the evidence would indicate if there was a proven goodwill to a business associated with the sign GASTROBID in the United Kingdom it would accrue to Napp. The goods are supplied by Napp, the packaging only

refers to Napp, MIMS only refers to Napp and Mr Thorne's declaration refers to Napp. Mundipharma does not need a locus standi to raise this ground of objection. However, it would seem reasonable that it makes clear who has any claimed goodwill in the United Kingdom and that the evidence should deal with this issue.

DECISION

Likelihood of confusion - section 5(2)(b) of the Act

34) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

35) Mundipharma in its statement of grounds describes Community trade mark no 2146108 as a registration. In fact the records of this office and OHIM show that it is an application that is currently under opposition. Consequently, the basis of this trade mark has to be considered under section 6(2) of the Act:

“References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

36) The trade mark registration and application upon which Mundipharma rely are both earlier trade marks within the meaning of section 6 of the Act.

37) In determining the question under section 5(2)(b), 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 BV* [2000] FSR 77. Owing to my findings above in relation to the use of the trade mark of Mundipharma I do not need to consider the issue of reputation which according to the case law can effect the outcome.

Comparison of goods

38) The goods of the application are:

food supplements (or additives) made with soya flour, for the treatment of gastro-intestinal disorders

food supplements (or additives) made with soya flour, not for medical or pharmaceutical purposes.

The goods of the earlier trade marks are:

pharmaceutical preparations and substances

and

pharmaceutical and veterinary substances and preparations, all for the treatment of disorders associated with the gastro-intestinal tract.

39) The European Court of Justice in *Canon* held in relation to the assessment of the similarity of goods, that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

40) Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I will give the words in the specifications their natural meaning, but within the context that they appear in a specification derived from the International Classification of Goods and Services. I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). Consequently, the class 5 and 30 specifications of Rosell cannot be considered of a piece. I will first deal with the class 5 specification of the application. In considering the goods of the earlier trade marks I consider them in their entirety. The goods are not limited for prescription use.

41) Pharmaceutical preparations and substances will normally be seen as being drugs of some description. Veterinary substances and preparations will encompass anything that is used in the treatment of animals. I cannot see that food supplements will be seen as being drugs and so will not be encompassed by the term pharmaceutical. However, food supplements, if for animals, could be a veterinary preparation or substance and in such a context, taking into account that both sets of goods are for gastro-intestinal disorders, would be identical goods. For those goods which are not for animals, the goods have the same purpose; treatment of

gastro-intestinal disorders. This identity of purpose also means that they could be in competition. It is very feasible that someone with gastro-intestinal problems might use a food supplement to relieve the symptoms as well as a pharmaceutical product. I, therefore, consider that the respective goods are complementary and that the end users are the same. Food supplements could be in the form of tablets and so could be in the same form as pharmaceutical products and taken in the same way. It is likely that both sets of goods will be available in pharmacies. On the basis of the evidence before me, or the absence of it, I cannot hazard whether the goods would be in the same area of the pharmacy. **Taking into account all these factors I consider that as far as the class 5 specification of Rosell encompasses goods for veterinary purposes it is identical to the goods of registration no 1237042. In so far as the goods of the application in class 5 do not encompass goods for veterinary purposes I consider that the respective goods are highly similar to the goods of registration no 1237042 and application no 2146108.**

42) The goods in class 30 of the application are not for medical or pharmaceutical purposes. They are also not for animal use; supplements for animals are appropriate to class 31. The goods of the earlier trade marks are all for medical or veterinary purposes. The fundamental purposes of the goods is therefore different. A food supplement could be taken in addition to a pharmaceutical product to improve the condition of a person, even if that supplement was not directly for medical purposes. The goods could, therefore, to some degree be complimentary. The goods of the earlier trade marks are curatives or palliatives. The goods of the application in class 30 are specifically not this. However, it could be that someone who is averse to taking medication would take supplements in the hope of reaching the same goal. There is a potential degree of competition between the goods; although I would not consider to a great extent. The end users could well be the same; in one case trying to alleviate a problem with pharmaceutical goods and in another trying to improve the condition of the body with a supplement. It is quite possible that the both sets of goods could be sold in pharmacies. However, there is no evidence as to where the respective goods would be for sale and whether they would be in discreet areas. I make no finding as to if they would be found in the same areas of retail premises. By ticking or crossing the boxes of the *Canon* test it is possible to get a distorted picture and a perverse result. **Taking into account all the matters I have considered above and bearing in mind that the goods are in class 30 and the exclusion clause, I consider that there is a reasonable but not overwhelming degree of similarity between the respective goods.**

Comparison of trade marks

43) The trade marks to be compared are:

Earlier trade mark:

GASTROBID

Application :

GASTRO-AD

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). 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). I take into account 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 Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* page 84, paragraph 27).

44) Both sides have expended a lot of energy in relation to the importance of the GASTRO elements of the trade marks. In relation to pharmaceutical products or food supplements I have no doubt that the average consumer will see GASTRO as referring to the stomach or disorders thereof. He or she is likely to be aware of gastroenteritis, and possibly to have suffered from it. The GASTRO element occurs at the beginning of the trade marks. It is the largest part of the trade mark. However, owing to its meaning and the nature of the respective goods I do not consider that the average consumer will see this as the distinctive or dominant component of the trade marks. It is a part of the trade marks but at the same time acting as a descriptor. I have no reason to doubt Mundipharma's evidence that there are only two products on the market in the United Kingdom for medical purposes that use GASTRO as a prefix. But there are two and both are for problems linked to the digestive system. It strikes me that it would be a bizarre argument that these two products do not use the prefix GASTRO to clearly indicate their purpose; not a covert allusion but a direct reference. Mr Hobbs QC, sitting as the appointed person, in *Torremar* [2003] RPC 4 stated:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1988] FSR 283).”

I consider that the average consumer looking at the trade marks in their entirety will not see the GASTRO element as being distinctively similar.

45) Both trade marks end with the letter D. The BI and A elements have no visual or phonetic similarity. The BID and AD elements can easily lodge in the mind as they are easily pronounced and have their own meanings as words, if words that are not necessarily directly relevant to the goods. The AD element is also emphasised by the presence of the hyphen. (Something that obviously will not be noticed in oral use.) (It is also possible that AD will be seen as an abbreviation for additive, bearing in mind the goods of the application.)

46) The average consumer of the goods of the earlier trade marks could be a medical professional but equally a customer buying the goods from a supermarket shelf. The goods of the application are not specialised. However, it is likely that the purchaser is likely to take some time in selecting them. I am of the view that the average consumer, for instance in the pharmacy or supermarket, will display some care and consideration in the purchase of the goods. They are not bags of sweets. However, they are equally not computers or motor cars. It is also to be taken into account, in my view, that the average consumer is likely to spend more time in reading the purpose and the method of taking the products than studying the trade marks. These are very much products where the purpose, means of ingestion and possible side effects are key issues. It is also to be born in mind that the consumer is unlikely to have the luxury of directly comparing the trade marks. He or she is likely to rely upon memory and be prey to the vagaries of imperfect recollection.

47) I keep firmly in mind that I am still comparing the trade marks in their entireties. Taking into account all the above factors I come to the conclusion that the trade marks are not similar.

Conclusion

48) For me to find that there is a likelihood of confusion the respective signs have to be similar. This is what the Directive states and it is what is pointed out in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

Without similarity there cannot be confusion. The objection under section 5(2)(b) must fail. So the interdependency principle for goods and signs cannot assist Mundipharma (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). I also do not need to consider the distinctiveness of the earlier trade mark. (The issue of reputation I have already dealt with.) However, for the sake of completeness I will comment upon the distinctiveness of the earlier trade mark. There is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). The natural corollary to this is that there is a lesser likelihood of confusion where the earlier trade mark is lacking in distinctiveness. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49). Owing to the descriptive nature of the GASTRO element of GASTROBID and its presence at the beginning of the word I do not consider that Mundipharma’s trade mark is particularly distinctive. This limited distinctiveness and the descriptiveness of the GASTRO element will lead the public to focus on other and smaller elements and allow them to distinguish the two trade marks through these other elements.

49) The issue of the position in Canada has had no influence upon me. I do not know what has gone on there or why and the registration of Rosell is for different goods. I have to consider the issue in relation to the position in the United Kingdom under the Act and the Directive.

Passing-off – section 5(4)(a) objection

50) I have already decided that Mundipharma has not proved that it, or Napp, enjoys goodwill in relation to the trade mark GASTROBID and so this objection must fail. As I also said above I cannot see, anyhow, how Mundipharma could be in any better a position in relation to this ground than under section 5(2)(b). Taking into account that the same sign is involved and that if goodwill had been established it would have only related to a prescription only drug for certain disorders, the position would have been worse.

COSTS

51) Institut Rosell Inc having been successful, it is entitled towards a contribution towards its costs. I order Mundipharma AG to pay it the sum of £750. 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 11 day of July 2003

**David Landau
For the Registrar
the Comptroller-General**