

O-282-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2225677
BY DCS EUROPE PLC**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 51396
BY ABBOTT LABORATORIES**

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by DCS Europe Plc**

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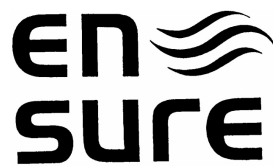
**IN THE MATTER OF Opposition thereto under No. 51396
by Abbott Laboratories**

Background

1. On 14 March 2000, DCS Europe Plc applied to register a trade mark in Class 5 in respect of:

Sanitary towels & tampons.

The trade mark is as follows:



2. On 7 September 2000, Abbott Laboratories filed notice of opposition to this application in which they say that they are the proprietors of various trade marks which consist of or incorporate the word ENSURE, details of which can be found as an annex to this decision. The grounds on which the opposition is based are as follows:

- 1. Under Section 5(2)(b)** because the application covers goods which are similar to those for which the opponents' trade marks are protected and there exists a likelihood of confusion.

- 2. Under Section 5(3)** because use of the mark applied for in relation to the services for which it is sought to be registered would, without due cause, take unfair advantage or be detrimental to the distinctive character or repute of the opponents' earlier trade mark.

3. Under Section 5(4)(a) by virtue of the reputation and the fact that the trade mark is well known.

3. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides ask that an award of costs be made in their favour.

4. Both sides filed evidence in these proceedings. The matter came to be heard on 21 January 2003, when the applicants were represented by Ms Brian Dunlop of Wynne Jones Laine & James, their trade marks attorneys, the opponents by Ms Denise McFarland of Counsel, instructed by Page White & Farrer, their trade mark attorneys.

Opponents' evidence

5. This consists of 6 Statutory Declarations. The first is dated 12 March 2001 and comes from David John Richards, a Director of Page White & Farrer, the opponents' representatives in these proceedings. Mr Richards confirms that the information contained in his Declaration is from his own knowledge or has been obtained from the books and records of his firm, to which he has full access.

6. Mr Richards recounts the filing of two of the opponents' earlier trade marks, Nos. 1476921 and 1479052 for the words ENSURE and ENSURE PLUS respectively. He recalls that supporting evidence of use had been filed, a copy of which is shown as exhibit DJR1. Mr Richards mentions that not all exhibits have been provided. The exhibit consists of a Statutory Declaration dated 9 February 1993 from Phillip Gilmour Cairns Beattie. Mr Beattie has provided a further Declaration dated 8 March 2001, updating the details of his earlier Declaration. For ease of reference I have combined the two.

7. Mr Beattie says that he is the Financial Director of Abbott Laboratories Limited, a position he has held since 1990. He says that his company is the British and wholly owned subsidiary of the opponents, and is responsible for the sale marketing and distribution of the opponents' products throughout the United Kingdom. Mr Beattie describes the opponents' company as "a research based ethical pharmaceutical company", involved in the research, development, testing and manufacture of a range of pharmaceutical, hospital, nutritional and diagnostic products.

8. In his first Declaration Mr Beattie says that the trade marks ENSURE and ENSURE PLUS were first used in the UK in 1979, although in his second he gives the date as 1981 for ENSURE and 1984 for ENSURE PLUS. He confirms that the use has been continuous and throughout the UK. The first Declaration claims use in respect of dietetic substances for medical use, infants' and invalids=foods and foods for babies, but in the latter this is refined to ENSURE being nutritional food for medical use that is in bar and liquid form, ENSURE PLUS being a liquid product in the style of a milk shake, with approximately 75% being sold through retail pharmacists, the remaining 25% being provided to hospital patients requiring nutritional supplements.

9. Few exhibits are dated, but as the first Declaration is dated 1993 it can be safely assumed that they originate from at least this date. A letter dated 13 December 1979 (exhibit PGCB1) mentions ENSURE but gives no details of the product itself, nor the manner in which the name is used. Exhibit PGCB5 is an information sheet for ENSURE and ENSURE PLUS, describing ENSURE as an **A**all purpose low residue liquid diet providing complete and balanced nutritional support[@], and ENSURE PLUS as a **A**high calorie low residue liquid diet supplying extra calories within a limited volume[@]. Exhibit PGCB7 describes ENSURE as a **A**complete liquid nutrition[@], and shows both ENSURE products to be available as a soup, beverage and a whip.

10. Exhibit PGCB10 consists of two letters dating from April and September 1990, informing a UK organisation known as the Advisory Committee of Borderline Substances (ACBS), that Abbott Laboratories Limited intended to extend its range of ENSURE PLUS nutritional product, the product already having ACBS approval.

11. Mr Beattie gives the sales figures for the ENSURE and ENSURE PLUS products for the years 1985 through to 1992, which range from , 129,215 rising year on year to , 5,496,625, and , 37,034 rising year on year to , 2,637,252, respectively. His further Declaration gives the figures for the period 1995 to 1999, which is given as , 6,000,000 dropping to , 5,000,000, and , 10,000,000 rising year on year to , 19,000,000, respectively. Mr Beattie also gives the combined advertising/promotional expenditure for the products over the years 1985 to 1992, which ranges from , 248,000 in 1985 rising to a peak of , 604,000 in 1992.

12. Mr Beattie exhibits an sample of an ENSURE bar and sample packaging. These show use of ENSURE in respect of a **A**honey-crunch[@]bar and an asparagus soup, and ENSURE PLUS in respect of a strawberry milkshake. It is not possible to date these as originating from prior to the relevant date. Mr Beattie describes the ENSURE and ENSURE PLUS products as **A**the leading medical nutritional/dietary supplement products in their category in the United Kingdom[@]with an annual expenditure of , 1,500,000 per annum on advertising and promotion of the products. Exhibit PB2 is introduced as a sample of the promotional materials. In all but one case these bear an endorsement **A**date of preparation[@]showing this to be after the relevant date. One advertisement relating to ENSURE PLUS strawberry milkshake is dated at May 1997.

13. Mr Beattie refers to the products that the applicants intend to use the mark applied for in connection with, saying that his company is concerned that the applicants will go on to sell sanitary products that pass through the same trade channels and to some of the same customers as his company's ENSURE products, which he believes will lead to confusion and cause damage to their reputation.

14. The next Statutory Declaration is dated 8 June 2001 and comes from Judy Hole, the proprietor of Kemsley Pharmacy, a position she has held for 9 years.

15. Ms Hole says that her company is responsible for the distribution and sale of a wide range of pharmaceutical, medical and sanitary products in the Sittingbourne area of Kent. She confirms that she is familiar with the ENSURE and ENSURE PLUS range of medicated food products

produced by the opponents, and that this is one of the best selling ranges of such products in the UK although does not say on what basis she makes this statement. Ms Hole says that her company also distributes most of the major brands of sanitary products.

16. Ms Hole states that she believes that she would find it confusing if the trade mark ENSURE and device were to be used for sanitary products passing through her stores since she would associate it with the opponents' well known ENSURE and ENSURE PLUS brands. Ms Hole states that it is unusual in the field of medical and sanitary products for the same brands to be used by different companies, and that her initial reaction would be that such products came from the same source. Ms Hole says that the ENSURE and ENSURE PLUS range of medicated food products are purchased regularly by some patients, many of whom are women, and that the applicants' and the opponents' goods appearing on shelves in the same retail outlets has a clear potential for confusion.

17. The following Statutory Declaration is dated 11 June 2001 and comes from Michael Watts, Executive Director of the British Association of Pharmaceutical Wholesalers (BAPW), a position he has held since 1989. Mr Watts says that the BAPW represents all of the full line pharmaceutical wholesalers in the UK, who distribute and sell a wide range of pharmaceutical, medical and sanitary products, and who between them have more than 13,000 retail outlets and a sales turnover in the year 2000 of approximately , 5.5 billion.

18. Mr Watts says that the ENSURE and ENSURE PLUS range of medicated food products are very well known, both to him and the members of his association, and that it is one of the best selling ranges of such products in the UK. He says that these wholesalers also distribute most of the major brands of sanitary products including sanitary towels and tampons. Mr Watts states that he believes that he and the members of the BAPW would find it confusing if the applicants' mark were to be used on sanitary products passing through their stores since they would associate it with the opponents. He concludes saying that it is unusual in the field of medical and sanitary products for the same brands to be used by different companies, and that his initial reaction would be that such products came from the same source.

19. Next is a Statutory Declaration dated 8 June 2001 from Denis Pay, Chairman and Managing Director of Sangers (Maidstone) Limited, a position he has held since 1979. He says that the company has more than 50 outlets involved in the distribution and sale of a wide range of pharmaceutical, medical and sanitary products throughout the UK.

20. Mr Pay says that the ENSURE and ENSURE PLUS range of medicated food products are very well known to him, and that it is one of the best selling ranges of such products in the UK, although does not say how he knows this to be the case. He says that his company also distribute most of the major brands of sanitary products including sanitary towels and tampons. Mr Watts states that he believes that he would find it confusing if the applicants' mark were to be used on sanitary products passing through his stores since he would associate it with the opponents. He concludes saying that it is unusual in the field of medical and sanitary products for the same

brands to be used by different companies, and that her initial reaction would be that such products came from the same source.

21. The final Statutory Declaration is dated 4 July 2001, and comes from David Simpson, Head of buying for Unichem Limited, a position he has held since October 1999. Mr Simpson gives evidence of the extent of his company's business, and attests to his awareness of the opponents' ENSURE and ENSURE PLUS brands of goods, and gives his personal opinion on the potential for confusion. However, as Mr Simpson's association with Unichem commenced after the relevant date, and he has given no details of any prior involvement with the industry this evidence can be of little or no assistance in determining these proceedings.

Applicants' evidence

22. This consists of a Witness Statement dated 4 December 2001 from Brian Kenneth Charles Dunlop of Wynne-Jones Laine & James, the applicants' representatives in these proceedings.

23. Mr Dunlop goes to the Declaration by Phillip Beattie in which Mr Beattie states that the marks ENSURE and ENSURE PLUS are used on products specifically designed for patients who are suffering from malnutrition. He goes on to comment on the lack of any indication as to whether the sales and advertising/promotion figures given by Mr Beattie relate to the UK only, and consequently, cannot be used as an indication as to how well known the ENSURE and ENSURE PLUS products are in the UK.

24. Mr Dunlop next outlines the results of his investigations into the availability of the ENSURE and ENSURE PLUS products, which consisted of enquiries made at a number of retail chemists and a nutrition centre in Cheltenham, which, he says, showed that the products are not readily available or widely stocked. He gives his view as to why he considers the evidence indicates that the opponents' ENSURE products would only be known to a limited market sector and does not establish that the products have a high profile in the pharmaceutical sector.

25. Mr Dunlop disputes that the respective goods share the same channels of trade, saying that they are located in completely different locations within a chemist, and particularly so in relation to prescription food supplements. He also comments that the applicants' goods would only be sold to the female population whereas the opponents' goods would be sold to both men and women, extrapolating that this reduces the number of common users by at least 50%, and by extension, the risk of confusion. He goes on to refer to exhibit BKCD1 which, he says, shows that females that are malnourished more often than not suffer from a medical condition that would reduce the need for sanitary towels, and that combined with other factors such as age, the potential pool of common users is reduced even further. Mr Dunlop recounts his previous involvement with another manufacturer of sanitary products, going on to say that the present products (which I take to mean those that the opponents supply under the ENSURE brand) are sold by prescription or issued by qualified personnel in hospitals, and that consequently, the consumers are not the direct purchasers of the opponents' goods.

26. Mr Dunlop comments on the Declarations of Mr Richards and Mr Beattie, noting the inconsistency in the date of first use claimed, the omission of sales figures for the years 1985 to 1992, and where given, that these are not said to relate to the UK. He concurs with Mr Beattie's statement that the opponents' goods sold under the name ENSURE are sold in a specialised market, which, he says supports his assertions that confusion is highly unlikely.

Opponents' evidence in reply

27. This consists of a Witness Statement dated 28 February 2002 from Phillip Gilmour Cairns Beattie. Mr Beattie comments on the evidence given by Mr Dunlop, noting that he is not a specialist in the relevant market, he does not say by how, when or by whom the investigations in Cheltenham were carried out, or give the source of, or any corroboration of the information not within his own knowledge, and consequently, this evidence should be accorded little weight. Mr Beattie exhibits (PB1) a copy of the Comptroller's Practice Notice on Hearsay evidence.

28. Mr Beattie confirms that the sales and advertising/promotion figures given in his earlier Declaration relate to the UK. He goes on to explain that the products sold by his company under the ENSURE brand have been approved by the ACBS, (see exhibit PB2). Mr Beattie says that the ENSURE product range is available on prescription and is not openly available on the shelves of pharmacies or health food shops. He explains because his company's products have a limited shelf life they are not held in stock, exhibit PB3 being an example of packaging showing a 'Best before' date.

29. Mr Beattie refutes Mr Dunlop's assertions regarding the potential market for the opponents' products, saying that the total number of persons who have taken his company's products will be substantial. He refers to exhibit PB4 which consists of a copy of his company's brochure entitled 'Medical nutrition: a Community perspective' which contains summaries of academic and medical studies relating to the incidence of malnutrition amongst hospital patients. Exhibit PB5 consists of a letter from the Chief Dietician of a hospital giving details of the use of the opponents' ENSURE and ENSURE PLUS products, and her views on the consequences should these names be used on alternative products. Exhibits PB6 and PB7 consist of details of the report of the Malnutrition Advisory Group, exhibit PB8 being a printout of an article 'Screening for malnutrition' taken from the November 1999 edition of Nursing Standard, all attesting to a high incidence of malnutrition amongst the elderly and persons admitted to hospital. Mr Beattie refers to exhibit PB10 which consists of an extract from an online magazine for pharmacists which contains a survey undertaken amongst pharmacists in the US.

30. Mr Beattie exhibits two charts (PB11) showing ENSURE PLUS to have a higher market share than two of its main competitors, and having over 50% of the market. Exhibit PB12 consists of a survey conducted at the end of 1998 by MORI on behalf of Ross Products (UK), the previous name of the opponents' company. The survey was commissioned to look at the level of service provided by the opponents and that of other companies to see if there were differences in the quality of service provided. The survey appears to have been conducted amongst healthcare professionals and patients/carers who had recently come into contact with the opponents'

products. The survey shows a high degree of satisfaction with the products and services provided.

31. Mr Beattie goes on to say that his company is active in over 130 countries worldwide, and is not limited to nutritive products, referring to two of his company's earlier trade marks that have been registered in respect of sanitary substances and preparations. He does not say that his company sells such goods in the UK under the ENSURE name. Mr Beattie goes on to say that because his company carries out many of its activities under the house mark "A" device, and has a reputation in many fields, customers would be likely to expect other products falling in Class 5 sold under inter alia, the ENSURE name to be the goods of his company.

32. Mr Beattie refers to exhibit PB13 which consists of photographs of shelving in a retail establishment, showing foodstuffs and sanitary products being displayed alongside one another, disproving the claim by Mr Dunlop that they are sold in different parts of a retail chemist. This, he says establishes the link in the mind of the consumer. Exhibit PB14 consists of a National Health Service publication dating from December 2001 listing various products, including ENSURE and ENSURE PLUS, and in a separate section, cotton goods and appliances.

33. Mr Beattie explains how, and why he considers there to be a larger common pool of end users than stated by Mr Dunlop, and outlines some circumstances in which he considers confusion may arise. He goes on to say that the dictionary extract at exhibit PB15, shows that the potential users of sanitary products is not restricted to women. Mr Beattie disputes Mr Dunlop's assertions that malnourished females more often than not suffer from a medical condition that would reduce the need for sanitary towels, eliciting in support a letter from a Professor of Clinical Nutrition and Metabolism (exhibit PB16).

34. Much of the remainder of Mr Beattie's Statement consists of points of clarification, is a repetition of details already mentioned, or simply refutes points raised by Mr Dunlop, and adds little more to the case. Mr Beattie refers to the possible detrimental effect should the applicants use the same name on sanitary products that his company uses on foodstuffs in support, referring to exhibits PB17, PB18 and PB19. These consist of letters from senior healthcare professionals involved in dietary or nutritional issues, either expressing concern at the potential use of ENSURE products by a company other than the opponents (although does not say how they came to know or what the product is), and detailing the extent of the use of ENSURE products. Exhibits PB20 and PB21 consist of details of cases that involved goods to be found in Class 5, Mr Beattie highlighting the special considerations that may apply to cases involving such goods.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

35. Turning first to the objection founded under Section 5(2)(b). That section 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.”

36. An earlier trade mark is defined in Section 6 of the Act as follows:

“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,”

37. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723, in particular, that the likelihood of confusion must be appreciated globally and take into account all relevant factors.

38. The applicants are seeking registration in respect of very specific goods which the evidence shows to be available for self-selection by the consumer, which makes the visual similarity of primary significance, although I do not discount the importance of aural similarity. The opponents’ earlier marks cover pharmaceutical, veterinary and sanitary substances and preparations; infants=and invalids=foods, dietetic substances adapted for medical use and liquid nutrition. As they stand, without any form of qualification, these descriptions are capable of covering goods obtained by self-selection, over the counter, or by prescription, be it from a General Practitioner or prescribed in a hospital as part of ongoing treatment, making visual, and aural similarity of equal standing.

39. The opponents rely on six trade mark registrations, all of which incorporate the word ENSURE. This is an ordinary English word meaning “to make certain or sure”, and is a word that I would consider likely to be known to most English speaking persons. It could also be said to have a passing reference to the goods, for example, they “ensure” consumers obtain the requisite dietary intake, and whilst I do not go so far as to say that it lacks a distinctive character, what distinctiveness it does possess is at the lower end of the scale. The mark applied for consists of the letters EN placed above the word SURE. EN is a prefix that can be used to form a verb

from a noun, or to form nouns and adjectives. SURE is also an ordinary English word meaning, inter alia, “free from hesitancy or uncertainty”. Whether the applicants’ mark is seen as ENSURE or EN-SURE, a similarity in the conceptual idea will be conveyed by the respective marks. Whilst as a totality the two marks contain identical letters, the separation in the applicants’ mark creates a difference in their appearance, but this distinction would be lost when spoken or heard. I do not overlook the fact that the applicants’ mark has a device element, as do two of the opponents’ earlier marks, but it is often said that in composite marks, “words speak”, and taken in their totality I would say that in their distinctive and dominant components, the respective marks are similar.

40. In determining whether the respective goods are similar I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, the *Treat* case, and the judgment of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C- 39/97, which indicated the question of similarity should be determined by a consideration of the following factors:

- (a) the nature of the goods or services;
- (b) the end-users of the goods or services;
- (c) the way in which the goods or services are used;
- (d) whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

41. Quite clearly dietetic/nutritional substances and sanitary towels/tampons are quite different in their nature and the way that they are used. Part of the evidence is directed towards establishing that the relevant public (or market) for the opponents’ nutritional foodstuffs is limited, and potentially different. These arguments are based on the assertion that malnutrition is not a widespread condition, and that a malnourished person, in particular, women, would not, as a consequence of being malnourished, need to use the applicants’ sanitary towels and tampons. This is an argument based on the opponents’ actual use of the mark, but on the notional assessment of the scope of the respective specifications that I am required to carry out, I see no reason why the user in both cases could not be the same. I do not see that they could, by any

reasonable assessment, be considered to be in competition; one is not used in place of the other, nor complementary. I do not have any evidence as to how the trade classifies such goods, but from a purely pragmatic position based on their obvious differences, I do not consider it likely that the trade would classify these goods in the same way, or that a manufacturer of one would also produce the other. They may well touch the same wholesale and retail outlets, but apart from perhaps sharing the same aisle because of a connection with health and hygiene, I do not consider that they would be considered to be same-shelf items. I appreciate that there is evidence in the form of photographs that shows foodstuffs for use in weight control, and sanitary towels being sold in proximity to one another, but they also show tins of baked beans, biscuits, sugar, hair dyes and a body-wash, etc, on a shelving next to sanitary products. This may be explained by the photographs having been taken in retail outlets with limited shelf space, but in any event, the mere fact that they may be displayed alongside does not make the goods the same or similar.

42. The opponents' claim use of their ENSURE mark dating from 1979, and there is a letter of that date that shows that they were using the mark, although not how, or in relation to what. Few of the exhibits showing the mark can be dated. However one that can be is a Declaration dated February 1993 which is evidence enough that the exhibits to that Declaration were available at least at that date. These show ENSURE and ENSURE PLUS being used in relation to nutritional goods, described as a low residue diet, available in liquid and powder form, and later, in the form of a bar. Whilst they may well have been using the "A" device house mark, there is nothing that supports the claim that this use has impacted upon the consumer's perceptions of the opponents' trade.

43. The evidence seems to focus these goods primarily at persons with medical conditions, being stated as being available, on prescription, to patients in hospitals, hospices, and those convalescing. Turnover figures have been provided for both ENSURE and ENSURE PLUS for the years 1985 to 1999, although there is an unexplained gap for 1993 and 1994. I have no definitive evidence of the overall size of the market by which to put these figures into context, but they seem to me to be reasonably substantial amounts for marks used on a limited range of products. When bolstered by appreciable expenditure on advertising and taken in the context of the opponents' goods sold under ENSURE PLUS having more than a 50% market share, I consider it reasonable to assume that the opponents are likely to have established a nationwide reputation in respect of dietetic foodstuffs in liquid powder and bar form for use by persons with, or recovering from a medical condition, malnutrition or otherwise. Although being available on prescription, does raise a question as to whether this reputation subsists with the ultimate consumer or with the practitioner.

44. However, no matter how strong a reputation in a product, this factor alone is not, of itself, sufficient to make the respective goods similar. Taking all of the factors into account I have little difficulty in finding that the dietetic substances adapted for medical use, infants' and invalids= foods and liquid nutrition for which the opponents' earlier marks are registered, to be dissimilar goods to the sanitary towels & tampons covered by the application.

45. This leaves the more general terms “pharmaceutical, veterinary and sanitary substances” for which two of the opponents earlier marks have been registered. I believe that I can remove the “veterinary” element of this from my consideration. The question, therefore, is whether pharmaceutical or sanitary products, when described as “substances or preparations”, would include goods the same or similar to sanitary towels & tampons.

46. Ms McFarland referred me to earlier proceedings in which the applicants in these proceedings sought to, and in part, succeeded in revoking the opponents’ registrations, numbered 1100805 and 1132516. The Hearing Officer in those cases revoked the registrations in respect of all goods other than invalid’ foods, with effect from 12 November 2000. However, this is after the relevant date in these proceedings and I must therefore consider the position as if the revocation had no effect.

47. Ms McFarland made particular reference to the Hearing Officer’s interpretation of the scope of the term “sanitary substances and preparations” which he put as follows:

“The natural meaning of sanitary preparations and substances is I believe goods such as disinfectants and antiseptics. In the context of the International Classification of Goods and Services it might also be considered to encompass sanitary towels, tampons and the like goods.”

48. A number of authorities have dealt with the proper approach to the meaning of particular terms. In the *OFREX* case [1963] RPC 169 Pennycuik J said:

“What is said is that staples do not come within class 39 as an item of stationery..... In order to answer that question, the first step I think is to look at the ordinary meaning of the word “stationery”, which as defined in the Oxford English Dictionary is: “the articles sold by a stationer; writing materials, writing table appurtenances, etc”. I feel no doubt that staples are stationery, according to the ordinary meaning of the word.”

49. That was, of course, a case under the preceding law. The following passage from *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 puts a more recent gloss on the point:

“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.”

50. In the *TREAT* case, Jacob J made the following comments with regard to the interpretation of terms used within specifications:

"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."

51. This invites me not only to consider the natural and ordinary meaning of a word, but to apply a practical consideration based on what the term would be regarded to mean in the trade in question. In the context of goods, the ordinary meanings given in Collins English Dictionary, for the words "preparation"-something that is prepared, esp a medicine, and "substance"-the tangible matter of which a thing consists, leads me to the same view as that of the Hearing Officer, namely, that *"The natural meaning of sanitary preparations and substances is I believe goods such as disinfectants and antiseptics"*. If this is the end of the matter I would have to reach the conclusion that the opponents' earlier marks do not cover the same, nor similar goods to sanitary towels and tampons.

52. The Hearing Officer considered the matter in relation to the International Classification of Goods and Services, coming to the conclusion that in respect of that index the words sanitary preparations and substances "might" be considered to encompass sanitary towels and tampons. This is a far from conclusive statement and in the absence of any reasoning as to why he took this view I should not place too much reliance upon it. It does not follow that just because sanitary towels and tampons are in Class 5 they must be covered by the term "sanitary substances". It is a common misconception is that each class heading automatically covers all goods or services in a class. As part of the Nice Classification, class headings are only intended to convey general indications as to what the classes contain (see the General Remarks in the International Classification). A class heading loses its function as a heading when written as a "statement of goods or services" on a trade mark application. For example, the heading of Class 15 is "Musical instruments" but on interpretation cannot include "music stands" or "musical instrument cases" which are also in the class. Furthermore, none of the class headings mention parts and fittings.

53. I have no evidence from or of the market place, but it seems to me that whilst there can be no dispute that the term "sanitary" would relate to sanitary towels and tampons, the descriptors "substances" and "preparations" relate to a product of a particular nature, and would not be used in relation to such goods any more than they would the sanitary knickers or sanitary napkins also found in Class 5. This difference in nature would, I believe, mean that sanitary substances and preparations would have different uses, although I see no reason why they should not be used by the same users. I cannot see that one would be used in place of, or to complement the other, and whilst they may well meet in the distribution chain, would, for the reasons I give above, usually be retailed on shelves, if not areas discrete from one another. Taking into account my assessment of the extent of the opponents' reputation, I do not see that this assists them, and consequently, that the term sanitary substances and preparations covers goods that are neither the same, nor similar to sanitary towels and tampons.

54. Adopting the "global" approach advocated, I do not consider that the consumer, familiar with the opponents use of their mark, on encountering the applicants' goods bearing the mark applied

for, will be deceived or confused such that they believe the applicants' goods are those of, or connected in some way with the opponents, and the objection under Section 5(2)(b) fails accordingly.

55. Turning to the ground under Section 5(3) of the Act. That section reads as follows:

“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@

56. I have already concluded that the marks are similar, and that the application covers a range of different goods. In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039) Mr Simon Thorley QC sitting as a Deputy High Court Judge said:

"What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants use of the sign is:

- (a) without due cause; and
- (b). takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."

57. Turning first to the question of the opponents' reputation. In *General Motors Corp v Yplon S.A.* [2000] RPC 572, the European Court of Justice (ECJ) found (in paragraph 26 of its judgement) that a trade mark has a 'reputation' for the purposes of section 5(3) when it is known by a significant part of the public concerned for the products or services covered by the earlier trade mark. The ECJ went on to say:

"In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."

58. In my consideration of the extent of the opponents' reputation in the United Kingdom as shown by the evidence, I took the view that this, in effect, subsists in prescription dietetic

foodstuffs in liquid, powder and bar form for use by persons with, or recovering from a medical condition. Whilst in respect of this limited range of goods the turnover would indicate the likelihood of a significant reputation, the public (and market) in this case must be considered in the context of the specifications of the earlier marks relied upon, namely, all users of pharmaceutical, veterinary and sanitary substances and preparations, infants=and invalids=foods, dietetic substances adapted for medical use and liquid nutrition. I have no evidence that goes to the extent of the trade in such goods, but it seems to me that unrestricted in their use or type, practically every consumer must potentially be considered a user, and in the context of that market, the significance of the reputation is somewhat more limited.

59. In *Premier Brands UK v Typhoon Europe* [2000] FSR 757, the claimant argued that the distinctive character of its TY.PHOO trade mark, which was registered for kitchenware but only used on a small scale for such goods, had been significantly enhanced by the reputation that the same trade mark had acquired as a result of a much greater trade in tea. Neuberger J. said this:

“I accept that the three decisions of the ECJ to which I have referred support the proposition advanced by Mr Arnold on behalf of Premier. However, it seems to me that they do not detract from what may be said to be the fundamental point made by Mr Bloch on behalf of TEL on this aspect, namely that , in connection with a particular registered mark, the less use it has had in connection with the goods for which it is registered, the less distinctiveness it is likely to have acquired, and, therefore, the more protection claimed for it has to be limited to its inherent distinctiveness.”

60. The position, as I see it is that the opponents’ reputation has been established on a narrow range of dietetic foodstuffs. Given the stark differences between foodstuffs and sanitary towels and tampons, I am unable to see how the applicants could derive any advantage, let alone unfair.

61. The question that arises, therefore, is whether use of the mark applied for would have an adverse effect upon the distinctiveness or repute of the opponents’ earlier marks. The relevant considerations in determining the answer to this question seem to be those set out in *Oasis Stores Ltd’s Trade Mark* application [1998] RPC 631. The Hearing Officer commented that:

“Any use of the same or a similar mark for dissimilar goods or services is liable, to some extent, to dilute the distinctiveness of the earlier mark. The provision is clearly not intended to have the sweeping effect of preventing the registration of any mark which is the same as, or similar to, a trade mark with a reputation. It therefore appears to be a matter of degree. In considering detriment under this heading it appears to me to be appropriate to consider:

- 1. The inherent distinctiveness of the earlier trade mark;*
- 2. The extent of the reputation that the earlier mark enjoys;*
- 3. The range of goods or services for which the earlier mark enjoys a reputation;*
- 4. The uniqueness or otherwise of the mark in the market place;*

5. *Whether the respective goods/services, although dissimilar, are in some way related or likely to be sold through the same outlets;*
6. *Whether the earlier trade mark will be any less distinctive for the goods/services for which it has a reputation than it was before,*
7. *Whether the reputation of the earlier trade mark is likely to be damaged or tarnished in some significant or material way .”*

62. I have already stated that I consider the word ENSURE to have a relatively low level of inherent distinctiveness in respect of the goods for which it is registered. The opponents appear to have made reasonably substantial use of ENSURE, but only in relation to dietetic foodstuffs available on prescription. Their ENSURE PLUS mark has a significant share of the market in such goods and appears to enjoy a high reputation, or at least awareness amongst pharmacists, but I have nothing by which to assess the uniqueness or otherwise of the mark. I see no reason why the respective goods could not be sold in the same outlets, for example, retail pharmacies, in fact this seems to be borne out by the evidence, but are so different in nature and purpose that I do not see that the opponents’ trade mark will be any less distinctive for the goods for which it enjoys a reputation.

63. It is possible that an association drawn between the two sets of goods could have a detrimental effect on the reputation of the opponents’ mark; who would want the consumer to have sanitary towels on their minds when eating their food? A similar issue was considered in the *Claeryn/Klarein* case [1996] RPC 281, in which the proprietors of the mark Claeryn (used on gin) complained of the use of Klarein on a detergent. The Court explained:

“...it is also possible that the products to which the other use of the trade mark or the resembling sign relates, appeals to the senses of the public in such a way that the trade mark is impeded in its attractiveness and its capacity to incite sales in respect of the goods for which it is registered”

64. The opponents’ dietetic foodstuffs are specialised to the extent that they are available on prescription to persons with a medical condition, who are, or may be at risk of becoming malnourished. The ultimate consumer of such goods is not likely to think “I’m malnourished I need to obtain some special foodstuffs”. The foodstuffs will be obtained, by prescription, or the recommendation of a person connected with the medical profession, be it a doctor, dietician or pharmacist. In such circumstances it is not so much the trade mark, or even that the foodstuffs appealed to the sensations of the consumer that stimulated the desire to buy, but rather that a well informed and expert practitioner considers that the goods to be suitable to deliver the required nutrition.

65. Whilst the opponents may not like the idea of the consumer making any kind of association between their goods and those of the applicants, in the circumstances of this case I do not consider that use of the mark applied for in relation to the goods covered by the application would, as put by Laddie J in *Barclays Bank v Advanta* [1996] RPC 307 “...inflict some harm on the character or repute of the registered mark which is above the level of *de minimis*”. The

ground under Section 5(3) fails accordingly.

66. Finally there is the ground under Section 5(4)(a). That section 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

.....

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.”

67. Mr Geoffrey Hobbs QC sitting as the Appointed Person in *Wild Child* (1998 RPC 455) set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (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.

68. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

*“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 requirement of the objection itself are considerably more stringent than the enquiry under Section 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 at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

69. Section 5(4)(a) of the Act offers protection to the goodwill and reputation built up by a trader through the use of a sign. The opponents' have undoubtedly achieved a substantial level of sales of their dietetic foodstuffs under the ENSURE brand, and are likely to have built a reputation and goodwill in the name in relation to such goods. These sales have been in respect of dietetic foodstuffs specifically for use by persons who are, or are at risk of becoming malnourished, and are far removed from the sanitary towels and tampons covered by the application. On the evidence and facts before me I do not see how I can find that they will suffer damage by the applicants' use of the mark in respect of the goods that they seek to protect, and the objection under Section 5(4)(a) also fails.

70. The opposition having failed on all grounds, the applicants are entitled to an award of costs. I therefore consider the opponents to pay the applicants the sum of , 1,750 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of September 2003

**Mike Foley
for the Registrar
The Comptroller General**

Annex

Number	Mark	Class	Specification
1100805	(image below)	5	Pharmaceutical, veterinary and sanitary substances and preparations; infants=and invalids=foods.
1132516	(Image below)	5	Pharmaceutical, veterinary and sanitary substances and preparations; infants=and invalids=foods.
1476921	ENSURE	5	Dietetic substances adapted for medical use; invalids=foods; all included in Class 5.
1479052	ENSURE PLUS	5	Dietetic substances adapted for medical use; invalids=foods; all included in Class 5.
40484 (CTM)	ENSURE	5	Dietetic substances adapted for medical use.
		29	Liquid nutrition.
		32	Liquid nutrition.
321075 (CTM)	ENSURE	5	Dietetic substances adapted for medical use.

**ENSURE**

