

**O-016-04**  
**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2290671**  
**BY MAXIMUSCLE LIMITED TO REGISTER A TRADE MARK**  
**IN CLASSES 5, 30 AND 32**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER**  
**No. 91111 BY SHS INTERNATIONAL LIMITED**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF application No. 2290671  
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**IN THE MATTER OF opposition thereto under  
No. 91111 by SHS International Limited**

### **BACKGROUND**

1. On 22 January 2002 Maximuscle Limited applied to register the trade mark MAX PRO in classes 5, 30 and 32 of the register for the following specifications of goods:

#### **Class 5**

Medicated nutritional powders, tablets and capsules, all for bodybuilding and sports nutrition; medicated energy and protein preparations.

#### **Class 30**

Nutritional, energy, protein and weight gain confectionery bars including meal replacement bars and sweets for the sports market.

#### **Class 32**

Nutritional, energy and sports drinks for sports people and athletes; not including cola flavoured drinks.

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

3. On 18 September 2002 SHS International Limited filed a Notice of Opposition. In summary the grounds were:

(i) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier trade mark owned by the opponent which covers identical goods and there exists a likelihood of confusion on the part of the public;

<b>REGISTRATION NUMBER</b>	<b>MARK</b>	<b>REGISTRATION EFFECTIVE</b>	<b>SPECIFICATION OF GOODS</b>
1153889	MAXIPRO	12 May 1981	<b>Class 5</b> – Pharmaceutical and veterinary preparations and substances; infants and invalids foods

(ii) Under Section 5(3) of the Act because the mark applied for is similar to the earlier trade mark owned by the opponent and to the extent that the goods are not similar, registration of the mark applied for would take unfair advantage of or be detrimental to, the distinctive character or the repute of the opponent's earlier mark;

(iii) Under Section 5(4)(a) of the Act by virtue of the law of passing off.

4. On 19 December 2002 the applicant filed a Counterstatement denying the grounds of opposition.

5. The opponent filed evidence and the parties are content for a decision to be taken without recourse to a hearing.

### **Opponent's Evidence**

6. The opponent's evidence consists of a statutory declaration by Rosa Elizabeth Charlotte Plant dated 4 April 2003. Ms Plant is Company Secretary of SHS International Limited (SHS), the opponent company.

7. Ms Plant confirms that SHS is the registered proprietor of trade mark registration number 1153889 for the mark MAXIPRO and states that her company has used this trade mark continuously in the UK for more than twenty years and since at least as early as September 1980. She explains that all UK use has been made by her company SHS (formerly known as Powell & Scholefield Ltd) and its subsidiaries.

8. Ms Plant draws attention to Exhibit MP2 to her declaration which, she explains, contains samples of labels showing how the mark is used in the UK. The use shown is in relation to a powdered whey concentrate which is described as a food for special medical purposes in the dietary management of hypoproteinaemia.

9. Ms Plant provides the following figures relating to the value of products sold in the UK under the MAXIPRO mark for the years 1999 to 2002:

<b>YEAR</b>	<b>VALUE (£ STERLING)</b>	<b>QUANTITY</b>
1999	131986	12818
2000	117831	11621

2001	116764	11674
2002	112140	10999

and she provides at Exhibit MP3 to her declaration, a breakdown of sales under product codes.

10. Next, Ms Plant refers to Exhibit MP4 to her declaration, which contains samples of materials relating to the promotion of the MAXIPRO mark on high protein supplements, in particular illustrations of how it can be incorporated into the diet eg in recipes.

## DECISION

### Section 5(2)(b)

11. Firstly I go to the ground of opposition under Section 5(2)(b) of the Act. Section 5(2) reads as follows:

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

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

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

12. An earlier right is defined in Section 6, the relevant parts of which state:

"6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

13. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 224;

- (b) 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 B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, page 224;
- (g) account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*, paragraph 29.
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, page 224;
- (i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 333, paragraph 29.

14. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection of such a mark. The opponent has filed evidence which relates to the use of its trade mark, which it states has been in use since 1980. While the evidence provides information in relation to the value and quantity of sales under the MAXIPRO mark from 1999 to 2002 and shows use of the mark in relation to a food for special medical purposes in the dietary management of hypoproteinaemia, there is no indication of the market

share this represents, there is no monetary value provided in relation to the promotion or advertising of the product, no details of customers (neither the number of customers nor their geographical location) and no supporting evidence from the third parties or the trade.

15. While the opponent had a presence in the UK market place prior to the relevant date for these proceedings, the evidence does not demonstrate a reputation among the relevant public in its earlier cited trade mark. The onus is upon the opponent to prove that its earlier mark enjoys a reputation or public recognition and on the basis of the evidence filed in this case I do not believe the opponent has discharged this onus. In *DUONEBS* (BL O/048/01) a decision of Simon Thorley QC sitting as the Appointed Person, it was said:

“In my judgement I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that the ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

16. I conclude that the opponent cannot claim an enhanced distinctive character for its mark. However, even if I am wrong in relation to the reputation of the opponent’s mark I would point out that reputation is only one element which forms part of a global consideration under Section 5(2). It was held in *Marca Mode v Adidas AG* [2000] ETMR 723:

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

17. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must compare the mark applied for and the opponent’s registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods within the respective specifications.

18. Turning to a comparison of the respective goods I have to decide whether the goods covered by the application are the same or similar to the goods covered by the opponent’s registration. In determining whether the goods covered by the application are similar to the goods covered by the opponent’s trade marks I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297) as set out below:

“The following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in particular 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 competitive. This inquiry 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 services in the same or different sectors.”

19. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice (3-39/97) the Treat case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in TREAT) are still relevant in respect of a comparison of goods and/or services.

20. The opponent’s earlier registration comprises Class 5 goods. The specification is widely drafted in that it includes “Pharmaceutical and veterinary preparations and substances” but it also specifically includes “infants and invalids foods”.

21. The mark in suit covers goods in Classes 5, 30 and 32 and I firstly consider the Class 5 goods of the applicant and opponent.

22. The applicant’s Class 5 application is for “medicated nutritional powders, tablets and capsules, all for body building and sports nutrition; medicated energy and protein preparations”.

23. It seems to me that the opponent’s Class 5 specification would encompass the applicant’s “medicated energy and protein preparations” as I see no reason why “medicated energy and protein preparations” could not be foods for infants or invalids. I have no doubt that “infants and invalids foods” in Class 5 could include “medicated energy and protein preparations and accordingly I believe these goods of the applicant and opponent to be identical.

24. I now go on to consider whether the remainder of the applicant’s Class 5 goods ie “medicated nutritional powders, tablets and capsules, all for bodybuilding and sports nutrition”, are similar to the goods of the opponent’s registration.

25. Turning to the uses of the respective goods, the applicant's goods are specifically for bodybuilding and sports nutrition whilst the applicant's goods are either for infants or invalids, or intended to be used for pharmaceutical purposes ie as drugs in the treatment, prevention or diagnosis of disease, or for veterinary purposes on animals. The respective uses are different. Furthermore, it seems to me that the respective users of the goods are different in that the dedicated users of the applicant's goods are sportspersons and bodybuilders whereas the users of the opponent's goods are infants, invalids or those suffering from medical conditions. Going to the physical nature of the goods I have no doubt that they could be identical in appearance. The applicant's goods are in the form of powders, tablets and capsules. This could also be the case in "infants and invalids foods" which, in particular, could be in powder form and this could also be the case with "pharmaceutical preparations". Next I consider the channels of trade through which the goods reach the market. While I have no specific evidence before me on this point, it seems to me that the respective goods are specialised products with very different markets and users. Even if the goods were to be sold in the same outlet it is my view that they would be located on different counters/shelves or in different "departments". Finally, I go on to consider the extent to which the respective goods are competitive. As the respective goods have different uses and users it seems to me that they are not in competition with each other and are not alternative products for relevant customers.

26. In light of the above, obvious differences exist. The substantial nature of these differences in the use and users of the goods and the consequential results are such that I conclude that the applicant's specification, in so far as it covers "Medicated nutritional powders, tablets and capsules, all for body building and sports nutrition", is not similar to those goods covered by the opponent's registration.

27. I now turn to the applicant's Class 30 specification which is for "Nutritional, energy, protein and weight gain confectionary bars including meal replacement bars and sweets for the sports market". Firstly, I note that while the confectionery bars include meal replacement bars and sweets for the sports market, they are not limited as to their market or purpose.

28. The opponent's earlier mark is registered in respect of goods which include "infants and invalids" foods. The uses of the opponent's goods and those of the applicant overlap in that an objective of infants and invalids foods is often the gaining of weight by individuals, particularly following illness or disability, which is often assisted by highly nutritional foods in the nature of confectionery eg preserves, sweets and sweet preparations of fruit, nuts, honey etc. The applicant's specification specifically includes "weight gain confectionery bars". While the applicant's goods are not dedicated to infants or invalids they could well provide high energy nutrition suitable to both. Going to the physical nature of the respective goods I see no reason why "infants and invalids foods" would not encompass bar shaped products, in the nature of confectionery eg sweet preparations to encourage weight gain etc. Next I consider the channels of trade through which the goods reach the market. While I have no specific evidence before me on this point, it seems to me that the respective goods share similar uses and could be of the same or a similar nature. Accordingly, it would be logical for such goods to be produced by the same manufacturer, although ultimately, at the point of sale, they are likely to be found in different outlets or on different counters/shelves.



29. In light of the above I find that there is a good deal of similarity between the applicant's Class 30 goods and the opponent's "infants and invalids foods". They could well share essentially the same users, general purpose, be of the same nature and be produced by the same undertaking.

30. I now go on to consider the applicant's Class 32 specification which is for "Nutritional, energy and sports drinks for sports people and athletes .....". I note that the goods are directed at sports people and athletes and it seems to me that following my earlier reasoning in relation to those Class 5 goods of the applicant directed at "bodybuilding and sports nutrition" (paragraphs 24 to 26 of this decision refer), and the substantial differences in the use and users of the respective goods, that the applicant's goods in Class 32 are not similar to those goods covered by the opponent's earlier registration.

31. I now go on to compare the mark in suit with the opponent's earlier trade mark. The applicant's mark comprises the two words MAX PRO while the opponent's mark consists of the word MAXIPRO. While the words/elements MAX and PRO could be regarded as alluding to the well known words maximum and professional it seems to me that given the relevant goods, any allusion is relatively indirect and in totality the marks possess a good degree of inherent distinctiveness.

32. The respective marks must be compared as a whole and by reference to overall impression but, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade. The average customer 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). I must bear this in mind when reaching my conclusions.

33. Turning to a visual comparison of the marks, the applicant's mark comprises two words and the opponent's mark one word. The opponent's mark also contains an additional letter, the letter I, in the middle (the fourth letter) of the mark. The beginnings ie the first three letters MAX, and the endings ie the last three letters PRO are common to both marks. The difference lies in the middle portion of the marks. Bearing in mind the overall length and construction of the respective marks, the fact that the first three and last three letters are identical, that the difference between the marks is in the middle portion where it may have relatively less impact, the fact that the public rarely has the opportunity to compare trade marks directly and that imperfect recollection could come into play, it seems to me that there is obvious visual similarity between the marks as a whole.

34. In relation to aural comparisons it is my view that the factors influencing the visual considerations are also applicable. The beginnings and terminations of the marks are the same and given their overall length and construction, the marks sound similar. I would only add that

the fact that the mark in suit comprises two words, as opposed to the one word mark of the opponent, would not be obvious in oral use.

35. Finally, I turn to a conceptual comparison. Insofar as the respective marks are, in totality, invented words or indirect allusions they do not share any great conceptual association. However, if the mark applied for is perceived as alluding to the words “Maximum” and “Professional” I would only add that these allusions could be drawn (if less obviously) out of the opponent’s mark.

36. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must also consider in relation to the goods at issue, who the average customer is and make due allowance for imperfect recollection.

37. The opponent’s registration includes pharmaceutical products, which could be distributed by medical or pharmaceutical specialists only, as well as products which could be sold “over the counter”. Accordingly, I must assume that the notional coverage of the mark takes into account prescription goods and “over the counter” sales. In relation to the goods specified by the applicant it seems to me that the Class 5 and 32 goods are specialised in that they are dedicated to discrete markets ie bodybuilding and sports nutrition or those requiring medicated energy and protein preparations. The applicant’s Class 30 goods are not so limited.

38. In relation to the purchase of those goods “over the counter” by the relevant public it is in my view that with the exception of the applicant’s Class 30 goods, the customer for the goods would be relatively discerning given the specific purposes of the Class 5 and Class 32 products. This mitigates against a likelihood of confusion, although it does not follow that confusion will not result as all relevant circumstances must be taken into account. Turning to the position where a medical practitioner may be involved in the selection of products; I would add that I believe that this does not necessarily impact upon the likelihood of confusion or result in any greater likelihood of confusion. I am fortified in this view by the comments of Professor Annand, acting as the Appointed Person in the cases of Oropram/Seropram (BL O/208/02) and Allergan’s Application (BL O/293/02) when she stated:

“For my own part, I do not believe that different standards exist or are necessary to exist. The test of likelihood of confusion is flexible enough to allow each case to be judged according to its own peculiar facts. Relevant considerations may include those mentioned by the First Board of Appeal in *TEMPOVATE/EMOVATE, EUMOVATE*, supra, namely that some medicinal products are administered over the counter without prescriptions, some consumers resort to self-prescription and professionals are often overworked and may write prescriptions in hardly legible handwriting (although drugs may be prescription only, professionals maybe on hand to assist choice with OTC products and pharmacists usually check illegible prescriptions).”

## **CONCLUSION**

39. On a global appreciation taking into account all the relevant factors, I have come to the following conclusions –

(i) The respective Class 5 specifications of the applicant and opponent cover identical goods in that “infants and invalids foods” could include “medicated energy and protein preparations”. However, the remainder of the applicant’s Class 5 specification ie “medicated nutritional powders, tablets and capsules, all for body building and sports nutrition”, comprises goods which are not similar to those covered by the opponent’s earlier registration.

(ii) The Class 30 specification of the applicant comprises goods which are similar to the opponent’s “infants and invalids foods”.

(iii) The applicant’s Class 32 specification consists of goods which are not similar to those covered by the opponent’s earlier registration.

(iv) The respective marks are visually and aurally similar.

(v) The customer for the goods of the opponent (with the possible exception of the opponent’s Class 30 goods) are likely to be relatively careful and discerning, but in relation to the applicant’s “medicated energy and protein preparations” in Class 5 and also its Class 30 specification, the goods and marks share sufficient similarity so that a likelihood of confusion exists on the part of the relevant public.

(vi) The dis-similarity between the goods covered by the opponent’s registration and the applicant’s Class 32 specification means that there is no real likelihood of confusion in relation to these particular goods.

40. The opposition is partially successful under Section 5(2)(b). It succeeds in relation to the application for “medicated energy and protein preparations” in Class 5 and also in respect of Class 30. However, it fails in relation to “medicated nutritional powders, tablets and capsules, all for body building and sports nutrition” in Class 5 and in respect of Class 32.

41. Next I go to the Section 5(3) ground. Section 5(3) of the Act 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.”

42. Section 5(3) requires consideration of:

- (i) whether the trade mark opposed is identical with or similar to the earlier trade mark;
- (ii) whether the trade mark opposed is sought to be registered for goods or services which are not similar to those for which the earlier trade mark is protected;
- (iii) whether, and to what extent, the earlier trade mark has a reputation in the United Kingdom;
- (iv) whether the use of the later trade mark is “without due cause”;
- (v) whether the use of the later trade mark;
  - (a) takes unfair advantage of; and/or
  - (b) is detrimental to the distinctive character of the repute of the earlier mark.

43. Earlier in this decision I accepted that the respective marks are similar and that the respective specifications included goods which are dissimilar (points (i) and (ii)).

44. Guidance in relation to reputation under Section 5(3) have been set out in *General Motors Corporation v Yplon SA* [2000] RPC 572, in paragraphs 23 to 27. Paragraph 26 indicates the standard that must be reached:

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

45. This test sets out a high threshold in my view and the onus is upon the opponent to prove that its trade mark enjoys a reputation and public recognition. In the present case there are obvious and glaring deficiencies in the opponent’s evidence on this point – paragraphs 14 and 15 of this decision refer.

46. In light of the above I am unable to find or infer that the opponent had a reputation in the UK at the relevant date, especially taking into account the strict requirements which need to be satisfied under Section 5(3) to expand the parameters of “normal” trade mark protection. The opposition under Section 5(3) of the Act must fail on this basis. However, if in the event I am wrong on this point I go on to consider whether the opponent is able to make out any of the adverse consequences set out in paragraph 42(v) of this decision.

47. It is clear from a number of reported cases that Section 5(3) is not intended to have the sweeping effect of preventing the use of any sign that is the same as, or similar to, a registered mark with a reputation.

48. In my view the opponent’s use and consequently its reputation is in relation to a food for special medical purposes in the dietary management of hypoproteinaemia and it seems to me far

from obvious that it would be damaged in any way or as a result of the applicant's use of its mark in relation to "Medicated nutritional powders, tablets and capsules, all for body building and sports nutrition" or "Nutritional, energy and sports drinks for sports people and athletes". No evidence has been filed to support the contention that the relevant customer would expect the aforementioned goods of the applicant to emanate from the opponent or that the opponent's reputation would be in any way damaged by such use by the applicant. The onus lies with the opponent and the onus has not been discharged.

49. The Section 5(3) ground fails.

#### **Section 5(4)(a)**

50. Next, the Section 5(4)(a) ground. Section 5(4)(a) states:

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

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

51. The laws on the common law tort of passing off 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 4<sup>th</sup> Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman 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 marks 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 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.”

52. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, or mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as either deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective field of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the courts attach importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

53. Thus, to succeed in a passing off action, it is necessary for the opponent to establish that at the relevant date (i) they had acquired goodwill under their mark, (ii) that use of the applicant’s mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

## GOODWILL

54. In my consideration under the Section 5(2) and 5(3) grounds I have criticised the opponent's evidence relating to the reputation of their trade mark. Nevertheless, it demonstrates that prior to the relevant date the opponent had used the mark in the UK and that the mark was known in the UK in relation to a food for special medical purposes in the dietary management of hypoteinaemia. In my view the activity and recognition shown suffices to provide the opponent with the necessary goodwill to mount a passing off action. As stated in Kerly's Law of Trade Mark and Trade Name (13<sup>th</sup> Edition) at paragraph 14-08 on page 420:

*“The mark or other indication concerned need not be universally known. A small trader with a limited clientele is as much entitled to protect his brands and business name as any large concern. The overriding consideration, in judging the extent of the reputation, is whether the claimant has built up a goodwill to the point where substantial damage will be caused to it by the acts complained of.”*

55. To succeed under this heading the opponent has to show that the relevant public will believe that the goods provided by the applicant are goods of the opponent.

56. I have already compared the applicant's and opponent's trade marks and found them to be closely similar. It is well established that in the law of passing off there is no limitation in respect of the parties field of activity. Nevertheless the proximity of an applicant's field of activity to that of the opponent's is highly relevant as to whether the acts complained of amount to a misrepresentation.

57. In essence the question I have to address is whether the relevant public seeing the applicant's mark used on medicated nutritional powders, tablets and capsules, all for body building or sports nutrition, or on drinks for sports people or athletes, would be likely to believe the goods were being offered by the opponent. In *Harrods v Harrodian School* [1997] RPC 697, Millet L J stated:

*“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services.”*

58. I have no evidence before me on whether the public would associate a business whose reputation relates to a food for special medical purposes in the dietary management of hypoteinaemia, with a business trading in medicated nutritional powders, tablets and capsules, all for body building or sports nutrition, or in drinks for sports people and athletes, but it seems to me to be no obvious reason why such an association should be made. At any rate it is for an opponent who wishes to claim that they have the characteristics of, or would be recognised as a producer of such goods, to support such a claim with evidence.

59. In the absence of evidence to the contrary I do not consider the opponent's goodwill will extend to the above mentioned goods for which the applicant seeks registration. In my view the applicant's use of this mark on these goods will not amount to a misrepresentation.

60. In the recent case of *South Cone v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* 16 May 2001, HC 2000 APP 00617, Pumfrey J in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) 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 requirements of the objection itself are considerable 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 to the relevant date.”*

61. I do not consider that the opponent has discharged the onus of showing that the necessary misrepresentation required by the tort of passing off will occur in relation to the Class 32, 5 services specified within the application and the opposition under Section 5(4)(a) fails.

## **CONCLUSION**

62. The opposition has succeeded in relation to Class 30 of the application and has partially succeeded in relation to Class 5 ie that part of the specification which reads “medicated energy and protein preparations”. However, the opposition has failed in respect of Class 32 and that part of Class 5 of the application which covers “medicated nutritional powders, tablets and capsules, all for body building and sports nutrition”. Accordingly, the application may progress to registration if within twenty eight days of the expiry of the appeal period the applicant files a Form TM21 restricting its specifications to the Class 32 goods applied for and to “Medicated nutritional powders, tablets and capsules, all for body building and sports nutrition” in Class 5. If the applicant fails to file a Form 21 restricting the specifications (as above), the application will be refused in its entirety.

## **COSTS**

63. Both sides have achieved a measure of success and it seems to me that overall, the ratio of success is generally equal. The opposition has succeeded in relation to Class 30, failed in relation to Class 32 and has been partially successful and partially unsuccessful in relation to Class 5.



Accordingly, I make no order as to costs.

**Dated this 16th day of January 2004**

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