

## O-228-04

IN THE MATTER OF APPLICATION NO. 2290671 IN THE NAME OF  
MAXIMUSCLE LIMITED

AND IN THE MATTER OF OPPOSITION NO. 91111 THERETO BY SHS  
INTERNATIONAL LIMITED

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### DECISION

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#### Introduction

1. On 25 January 2002 Maximuscle Ltd applied to register the trade mark MAX PRO for the following specification 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 confectionary 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 subsequently opposed by SHS International Ltd on grounds under section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. In a written decision dated 16 January 2004 Mr MacGillivray acting for the Registrar upheld the opposition under section 5(2)(b) in so far as it related to “medicated energy and protein preparations” in Class 5 and the goods in Class

32, but otherwise dismissed it. SHS International Ltd now appeals against the dismissal of the opposition under section 5(2)(b) in respect of “medicated nutritional powders, tablets and capsules, all for bodybuilding and sports nutrition” and the goods in Class 32. There is no cross-appeal by Maximuscle Ltd.

3. The objection under section 5(2)(b) is based upon the appellant’s earlier registration of MAXIPRO in Class 5 in respect of “pharmaceutical and veterinary preparations and substances; infants’ and invalids’ foods”. The appellant filed evidence of use of this mark, but on the appeal accepted that this added nothing to its case. Accordingly it is only necessary to consider the matter on the basis of normal and fair use of the respective marks.

#### Section 5(2)(b)

4. Section 5(2)(b) provides:

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 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.

#### The hearing officer’s decision

5. The hearing officer’s reasoning so far as material to the appeal was as follows. He began by directing himself as to the law in accordance with the Registry’s standard summary of the guidance given by the European Court of Justice in Case C-251/95 *Sabel BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Moda CV v Adidas AG* [2000] ECR I-4881. This summary is very well-known and it is unnecessary to repeat it here.

6. So far as the respective goods were concerned, the hearing officer stated as follows:

24. I now go on to consider whether the remainder of the applicant's Class 5 good ie "medicated nutritional powders, tablet 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 those 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.

30. I now to 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.

7. As to the respective marks, the hearing officer concluded that there was obvious visual similarity between them and that they sounded similar but that, in as much as they were both invented words or phrases or indirect allusions to the goods, they did not share any great conceptual association.
8. The hearing officer went on to consider the nature of the average consumer and concluded that, in the case of the goods in issue on the appeal, the customer would be relatively discerning since they were for specific purposes.
9. Overall, the hearing officer concluded that there was no likelihood of confusion in relation to the goods in issue on the appeal.

#### Standard of review

10. This appeal is a review of the hearing officer's decision. The hearing officer's decision with regard to section 5(2)(b) involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

#### Grounds of appeal

11. The appellant's principal contention on the appeal is that the hearing officer had erred in principle in that, although he directed himself correctly as to the law, he failed to apply the law to the facts of the case. In particular the appellant contends that the hearing officer was wrong to conclude (a) that there was no great conceptual similarity between the marks and (b) that the respective goods were not similar. With regard to (b) the appellant contends in particular that the hearing officer was wrong to find that the respective trade channels were different and that he wrongly disregarded the fact that the respondent's Class 5 goods in issue were specified as being "medicated".

## Assessment

12. I have to say that I have some sympathy with the appellant's point about the conceptual similarity of the marks, but I am doubtful whether this really qualifies as an error of principle. More importantly, however, this does not appear to me to have been an important factor in the hearing officer's reasoning since he concluded that the marks were visually and aurally similar.
  
13. So far as the respective goods are concerned, I consider that there is substance in the appellant's criticism so far as the Class 5 goods are concerned. Nowhere in paragraph 25 of the decision does the hearing refer to the fact that the goods in question are "medicated" or consider what is meant by "medicated" or consider the consequences of the goods being "medicated". In my judgment this is an error of principle since the hearing officer has effectively ignored a key characteristic of the goods. The dictionary definition of "medicated" is "impregnated with a medicinal substance" and "treated or mixed with drugs or other substances" (*New Shorter Oxford English Dictionary*).<sup>1</sup> In my view the inclusion of the word "medicated" means that the goods are ones that would be subject to regulation by the Medicines and Healthcare Products Regulatory Agency under the Medicines Act 1968, and therefore, even on the assumption that they are sold over-the-counter, they would be sold through the same or at least similar trade channels to pharmaceutical preparations and substances. Furthermore, I consider there would be an overlap between consumers of the goods specified in the respondent's Class 5 specification and consumers of the goods specified in the appellant's specification and that the goods specified by the respondent could be competitive to some extent with some goods falling within the appellant's specification.
  
14. The respondent's representative realistically accepted that the two marks were similar, but submitted that there was no likelihood of confusion because the respective goods sold by the parties were quite different. He was at pains to

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<sup>1</sup> Indeed, one of the illustrative quotations given is from the *Trade Marks Journal*: "A medicated preparation in tablet form for human use as a sedative and hypnotic".

stress that his company's products were not in fact medicinal in any way and therefore were not subject to regulation by the MHRA. I do not doubt that this is true, but it is irrelevant to the question I have to consider, which is the hypothetical question of what would happen in the event of normal and fair use of the mark applied for in relation to the goods specified. The respondent's argument implicitly recognises, however, that insofar as the specified goods are "medicated", this increases the likelihood of confusion.

15. During the course of the hearing the respondent's representative attempted to meet this point by offering to delete the word "medicated" from the specification. In my judgment, however, this is not a permissible amendment under section 39 of the 1994 Act.
16. I therefore conclude that the hearing officer did fall into error with regard to the Class 5 goods in issue on the appeal. In my judgment he should have concluded that there was some degree of similarity between the respective goods, and that having regard to this, to the similarities between the respective marks and to the distinctive character of the appellant's mark, there was a likelihood of confusion. I am fortified in this conclusion by the fact that the hearing officer did hold that there was a likelihood of confusion in the case of "medicated energy and protein preparations".
17. This point does not apply to the Class 32 goods, however. I see no error in the hearing officer's reasoning with regard to those and I consider his conclusion perfectly justifiable.

### Conclusion

18. The appeal is allowed with respect to the goods in Class 5 but dismissed with respect to the goods in Class 32.

### Costs

19. The hearing officer made no order for costs on the basis that the result was a draw. On the appeal the appellant has achieved a greater measure of success, but still failed in relation to Class 32. In the circumstances I shall order the respondent to pay the appellant £500 as a contribution to its costs of both sets of proceedings.

30 July 2004

RICHARD ARNOLD QC

Denise McFarland, instructed by J.E. Evans-Jackson & Co Ltd, appeared for the appellant.

Mr Eisenberg of the respondent appeared on behalf of his company.