

O-295-04

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NUMBER 2290709
BY RECKITT BENCKISER HEALTHCARE (UK) LIMITED
TO REGISTER A TRADE MARK
IN CLASS 5**

DECISION AND GROUNDS OF DECISION

Background

1. On 23 January 2002 Reckitt Benckiser Healthcare (UK) Limited of Dansom Lane, Hull, HU8 7DS, United Kingdom applied to register the trade mark **MAX STRENGTH** in Class 5.

2. The application was made in respect of the following goods:

“Pharmaceutical preparations and substances; medicated beverages and preparations for making medicated beverages.”

3. Objection was taken under Section 3(1)(b) of the Act because the mark consists of the words Max Strength being a term that others in the trade would wish to use to denote the medicinal content of their product.

4. Objections were also taken under Section 5(2) of the Act but these objections were subsequently waived and I need say no more about them.

5. On 16 September 2003 the applicant filed evidence of use of the mark which was intended to show that the mark had acquired a distinctive character as a result of the use made of it. However this evidence was not considered sufficient to overcome the objection under Section 3(1)(b) which was maintained.

6. At a hearing, at which the applicant was represented by Mr B A Ramage of Alexander Ramage Associates, their trade mark attorneys, the objection was maintained.

7. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

The Law

8. Section 3(1)(b) of the Act reads as follows:

“3.-(1) The following shall not be registered-

(b) trade marks which are devoid of any distinctive character,

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it”.

The Prima Facie Case For Registration

9. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act was summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips* [2002] ECR I-5475, paragraph 35).

41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from

those of other undertakings”.

10. I must assess the mark’s distinctiveness in relation to the goods for which the applicant seeks registration, which is the range of pharmaceutical and medicated goods listed above. I must also have regard to the perception of the relevant consumers of the goods, which in my view includes the general public as well as members of the medical profession and pharmacists.

11. The mark consists of the word MAX, which according to Collins English Dictionary (5th Ed. 2000) is an abbreviation for “maximum”, and the word STRENGTH. Assuming notional and fair use of the mark, which includes use on the packaging of the goods, it seems unlikely to me that the relevant consumer will consider this mark to denote trade origin because it will simply be seen as an indication of the strength of the product, bearing in mind the nature of the goods.

12. Mr Ramage, on behalf of the applicant, did not argue that the mark qualifies for registration as an unused mark, and I believe this to be the correct position. For the reasons given the mark is not capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings. It is devoid of any distinctive trade mark character, and therefore it follows that this application is debarred from prima facie acceptance under Section 3(1)(b) of the Act.

The Case for Registration based on Acquired Distinctiveness.

13. The evidence submitted in support of this application consists of a Witness Statement dated 9 September 2003 of Rosina Margaret Baxter who states that she is deputy director of trade marks for Reckitt Benckiser plc and that she is authorised to make the statement on behalf of Reckitt Benckiser Healthcare (UK) Ltd (the Applicant).

14. Ms Baxter states that for many years the applicant and its predecessors in business have marketed a range of pharmaceutical products and preparations for making medicated drinks for alleviation of the symptoms of cold and flu, under or by reference to the trade mark LEMSIP. She says that variants of the LEMSIP range are distinguished by other trade marks, one of which is the mark of the subject application, MAX STRENGTH.

15. She states that MAX STRENGTH products were first put on the market in the United Kingdom in August 1995. Samples of the product packaging are exhibited as Exhibits RB1 & RB2. The MAX STRENGTH products account for approximately 60% of LEMSIP sales. The sales figures at Retail Selling Price for the MAX STRENGTH product range are given as:

YEAR	SALES VALUE (£, to nearest thousand)
1995	450,000
1996	1,378,000

1997	2,720,000
1998	4,755,000
1999	8,009,000
2000	10,536,000
2001	8,460,000

It is stated that these figures represent an estimated 12 million packs of the product sold in the period 1995 to 2001.

16. She states that the applicant's MAX STRENGTH brand is the market leader for oral decongestants, the total market of which in the UK is worth £73.7m (Exhibit RB3) and that MAX STRENGTH products are sold in approximately 97% of all chemists, 95% of all grocers and drugstores, 99% of all major multiple grocers and drugstores and 71% of independent grocers and drugstores in the UK.

17. The applicant's annual advertising and promotional spend on MAX STRENGTH products in the UK are given as:

COLD/FLU SEASON	ADVERTISING / PROMOTIONAL SPEND (£)
1997/1998	3.1 million
1998/1999	3.4 million
1999/2000	2.0 million
2000/2001	2.0 million

18. She states that the applicant's advertising of the MAX STRENGTH product included television campaigns in 1998 and in the 2000 / 2001 cold flu season throughout the UK. Exhibit RB4 is a copy of a video tape showing two television adverts.

19. Exhibit RB5 contains copies of trade press articles and advertising for MAX STRENGTH.

The Decision

20. The question to be determined is whether, through the use made of it, the sign applied for has acquired a distinctive character in respect of the goods contained within the specification as filed on the form of application.

21. It is now well established that this question must be asked through the eyes of the average consumer who is reasonably well informed and reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, Case C-342/97 [1999] ECR I-3830 para. 26). In *Windsurfing Chiemsee*, Case C108&109/97 [1999] ETMR 585, the European Court of Justice ruled on the nature of the enquiry as to whether a mark has acquired a distinctive character under Article 3(3) (Section 3(1) proviso). It held that the national authorities may take into account evidence from a variety of sources. The Court said:

“In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations” (paragraph 51).

22. It is also well established that use does not necessarily equate with distinctiveness. As Morritt L.J. put it in *Bach Flower Remedies Ltd v Healing Herbs Ltd* [2000] RPC 513:

".....use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have materiality."

23. I note that in Exhibit RB5 of the applicant's evidence an article from the trade press informs retailers that "consumers are trading up to the **extra strength** products", and advises them to "stock the extra strength range, the LEMSIP Cold+Flu Max Strength range". This appears to me to indicate an equivalence between the descriptive words EXTRA STRENGTH and the words MAX STRENGTH in their descriptive sense.

24. I note also that in the trade journal and press articles shown in Exhibits RB3 & RB5 the product range is always referred to as LEMSIP MAX STRENGTH, the words MAX STRENGTH alone are never relied on by the trade or the applicant to identify the product.

25. In my assessment there is nothing in the evidence to show that the mark applied for has been used in a distinctive manner as a trade mark or promoted as one. It is always used in conjunction with the LEMSIP name and logo. This fact by itself is not decisive, it is common practice to use secondary trade marks.

26. However, in my opinion, the average consumer on seeing the words MAX STRENGTH as shown on the packaging of the applicant's goods will not see them as a secondary trade mark indicating trade origin, they will see them as an indication that the product is the maximum strength available, a desirable quality in a product being purchased by a consumer suffering from a cold or flu and wanting an effective remedy to alleviate their symptoms. The evidence indicates that the relevant consumers of these goods are the general public, pharmacists and other retailers.

27. The evidence of use does not establish that the sign has come to identify the goods as originating from a particular undertaking and thus distinguishing it from those of other undertakings.

Conclusion

28. For the reasons indicated, the mark is not acceptable prima facie because it is debarred from registration under Section 3(1)(b) of the Act.

29. The evidence filed to substantiate the claim that the mark has acquired a distinctive character is insufficient to satisfy the proviso to paragraphs (b), (c) and (d) of Section 3(1) of the Act.

30. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

Dated this 28th day of September 2004.

Anne Pritchard

**For the Registrar
The Comptroller-General**