

O/171/06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2371142
BY RAJENDRA PATEL
TO REGISTER THE TRADE MARK:**

NUTRAMAN

IN CLASSES 3 AND 5

AND

**THE OPPOSITION THERETO
UNDER NO 93034
BY
NOVARTIS AG**

Trade Marks Act 1994

**In the matter of application no 2371142
by Rajendra Patel
to register the trade mark:
NUTRAMAN
in classes 3 and 5
and the opposition thereto
under no 93034
by Novartis AG**

BACKGROUND

1) On 20 August 2004 Rajendra Patel applied to register the trade mark NUTRAMAN (the trade mark). The application was published for opposition purposes in the “Trade Marks Journal” on 22 October 2004 with the following specification:

bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soap, perfumery, essential oils, cosmetics, hair lotions, dentifrices, including deodorants for personal use;

pharmaceuticals and veterinary preparations, sanitary preparations for medical purposes, dietetic substances adapted for medical use, food for babies, plasters, materials for dressings, material for stopping teeth, dental wax, disinfectants, preparations for destroying vermin, fungicides, herbicides, food and beverages which are adapted for medical purposes.

The above goods are in classes 3 and 5 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 15 December 2004 Novartis AG, which I will refer to as Novartis, filed a notice of opposition to the application. Novartis is the owner of United Kingdom trade mark registration no 1532688 for the trade mark NUTRAMENT. The application for registration was filed on 15 April 1993 and the registration procedure was completed on 18 September 1995. The application was advertised before acceptance. The registration is for the following goods:

Milk based beverages; all included in Class 29.

The trade mark was advertised before acceptance ie the registrar waived an objection against registration on the basis of evidence.

3) Novartis claims that the respective trade marks are similar and that:

pharmaceuticals, dietetic substances adapted for medical use, food for babies, food and beverages which are adapted for medical purposes

are similar to the goods of its registration. Consequently, there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of

the Trade Marks Act 1994 (the Act). Novartis claims that the trade mark had been used in respect of all of the goods of the registration in the five year period proceeding the date of publication of Mr Patel's trade mark.

4) Novartis claims that registration of the trade mark for the goods referred to in paragraph 3 would be contrary to section 5(3) of the Act. It claims that it has a reputation in respect of the goods of its earlier registration. It does not state why registration of the trade mark would be contrary to section 5(3) of the Act other than that the respective goods are similar to the goods of its registration and that they would pass through the same trade channels. So there is no clear indication as to the particular form of damage upon which it relies.

5) Novartis claims that registration of the trade mark would be contrary to section 5(4)(a) of the Act, it does not specify upon which particular rule of law it relies. Novartis claims that the trade mark NUTRAMENT has been used throughout the United Kingdom in respect of the goods of the registration and has been used on packaging and advertising materials. Novartis objects to the goods referred to in paragraph 3.

6) Mr Patel filed a counterstatement. He denies that the respective trade mark are similar and that the goods of the earlier registration are similar to: *pharmaceuticals, dietetic substances adapted for medical use, food for babies, food and beverages which are adapted for medical purposes*. He denies all the grounds and puts Novartis to proof of its claims. However, Mr Patel accepts the statement of use in relation to Novartis's registration.

7) Both sides filed evidence.

8) A hearing was held on 14 June 2006. Mr Patel was represented by Mr Wilkes of Groom Wilkes & Wright LLP. Novartis was represented by Mr Bryson of counsel, instructed by Abel & Imray.

EVIDENCE

Evidence of Novartis

Witness statement of Patrick James Barry

9) Mr Barry is a trade mark attorney and a partner of Abel & Imray. He states that the trade mark NUTRAMENT has been used continuously through out the United Kingdom since 1980. The use from 1980 to February 2004 was by and/or on behalf of Mead Johnson & Company, the original proprietor of the registration. Mr Barry states that the trade mark was assigned to Novartis on 28 April 2004, with all the common law rights in it. Mr Barry states that the approximate annual turnover in respect of goods in the United Kingdom is as follows:

1999 > £1m
2000 > £885,000
2001 > £1m
2002 > £940,000
2003 > £1m
to August 2004 > £630,000

10) Mr Barry states that the annual advertising expenditure has been approximately 15% of the turnover. He exhibits at PJB1 copies of invoices. Some are from Novartis but the majority are from Bristol-Myers Squibb Pharmaceuticals Limited, which I will refer to as BMSP. They are for vanilla, chocolate, strawberry and banana flavoured Nutrament. Also exhibited are pictures of tins of the beverage, for the same flavours. The tins describe the product as “the original energy and protein drink”. The wording on the tins states that the product contains vitamins C, E and B and describe it as a milk based drink.

Witness statement of Marie-Christine Seguin

11) Ms Seguin is a trade mark advisor for Novartis. Ms Seguin states that goods sold in the United Kingdom under the trade mark NUTRAMENT prior to February 2004 were sold by BMSP. She states that “during the relevant period” both BMSP and Mead Johnson & Company were subsidiaries of Bristol-Myers Squibb Company. In early 2004 Novartis acquired the intellectual property assets of Mead Johnson & Company’s global medical nutrition business, which included the trade mark NUTRAMENT. She states that the trade mark NUTRAMENT has been used consistently (sic) in the United Kingdom since 1980 in relation to a milk based beverage specifically designed to be a source of not only nutrition but also vitamins and minerals. She exhibits at MCS1 a copy of a product description for NUTRAMENT downloaded from the Novartis United States website on 2 September 2005. The following is included in the printout:

“Nutrament is a great-tasting source of nutrition for anyone who wants to deliver a peak performance – on the playing field, on the job, or just on the go. Nutrament is currently available at select Retail establishments, and is not available in Health Care Institutions. Its great, creamy, milkshake taste comes in seven delicious flavours..... Its nutritional power comes from 360 calories of energy – provided with a balance of carbohydrate, protein, and fat – plus one-third the Daily Value of 24 vitamins and minerals. Athletes and other busy people also like Nutrament because it’s convenient and portable. Anywhere they go, Nutrament can go too – as a satisfying meal replacement or as an extra source of energy. A 12-fl-oz can of Nutrament is perfect for breakfast on the run, lunch on the road (or at your desk), a quick supper before evening meetings, or a nutritional recharge before or after sports practice. Nutrament is ideal for filling the nutritional energy gaps in a fast-paced life.”

12) Exhibited at MCS2 are pages downloaded from the Internet on 2 September 2005:

- medicdirect.co.uk. A page on a bland diet which it states is normally for people suffering from chronic gastritis. This refers to various foods and beverages that can be eaten eg cornflakes, toast, scrambled egg, ice cream, Ready Brek, Weetabix and Ovaltine. It also lists, together, Complan, Build up and NUTRAMENT.
- piribo.com. The pages relate to a strategic report about the weight control market in the United States, it is priced at £2170. NUTRAMENT is included in a list of weight control products, it is categorised as being a general adult nutritional (sic).
- oarsport.co.uk. The pages relate to a diet for rowers. The relevant part of the material states:

“Liquid nourishment such as Nutrament, Carnation, Instant Breakfast or Ensure and a long list of power bar choices can also provide an appropriate pre-event meal.”

13) Ms Seguin states that as the NUTRAMENT product is marketed essentially on the basis of its health and fitness benefits, it is no surprise that Novartis and the previous owner are pharmaceutical companies. She states that this represents an industry wide convergence of pharmaceutical and nutritional products into what are termed nutraceuticals or functional foods; foodstuffs or beverages which have components or ingredients incorporated into them to give specific medical or physiological benefits. Ms Seguin exhibits at MCS3 material downloaded from the Internet on 2 September 2005:

- dotpharmacy.co.uk. An article on nutraceuticals or functional foods. The article states that there is no legal definition of a functional food but that most interested parties agree that the term is used in relation to foods marketed at having specific health benefits. The Leatherhead Food Research Association states that to be classified as a functional food a product should carry a health claim on the packaging. The article refers to the following products:
 - Spread fats – products to beneficially alter blood cholesterol levels. Reference is made to Benecol and Pact.
 - Yoghurts and probiotics – to promote gut health and reduce the incidence of vaginal infections. Reference is made to Yakult, Nestlé’s LCI and Culturelle.
 - Cereals and grains – calcium fortification, protection against hot flushes and breast cancer. Reference is made to Kellogg’s All-Bran Plus and Nutrigrain bars and Burgen bread.
 - Drinks – some are fortified with antioxidant vitamins A, C and E, some with calcium. Reference is made to Tropicana fruit juice and Red Bull Stimulation drink.
- faia.org.uk. An article of functional foods states that a “food can be described as functional if it can be demonstrated to affect beneficially one or more target functions in the body, beyond adequate nutritional effects, in a way that is relevant to either an improved state of health and well-being and/or reduction of disease”.

- askmen.com. An article on nutraceuticals states that they “are whole foods, food ingredients or supplements that have specific health or medical benefits.”

Evidence of Mr Patel

14) Mr Patel has furnished a witness statement. He exhibits at RJ1 a copy of the Trade Marks Registry’s cross-search list. He points out that the Registry’s cross search list does not link goods in classes 5 and 29. Mr Patel states that his product will be sold through pharmacies and other health care establishments. He exhibits at RJ3 details of registered trade marks in class 5 that start with the prefix nutra. Of 37 trade marks 23 are in the ownership of Mr Patel. Two are in the ownership of Mead Johnson & Company. A further registration is for the trade mark NU-TRACE. The rest of Mr Patel’s statement can be characterised as being submission and not evidence of fact and so I will say no more about it here.

Evidence in reply of Novartis

15) This consists of a further witness statement by Ms Seguin. Ms Seguin’s statement contains no evidence of fact. It is a list of submissions and criticisms of the evidence of Mr Patel and so I will say no more.

DECISION

Preliminary issue

16) On 6 June 2006 a further witness statement by Mr Barry. Exhibited to this witness statement was a copy of the document assigning the NUTRAMENT registration to Novartis. This was filed in response to written submissions in support of Mr Patel’s case that were received on 15 May 2006. In these submissions it was stated that there was no evidence that on the sale of the registration to NUTRAMENT that the goodwill was also transferred. At the hearing Mr Wilkes objected to the admission of the additional evidence; although he stated that he did not do so strongly.

17) Rule 13C(6) of the Trade Mark Rules 2000 (as amended) states:

“The registrar may, at any time if she thinks fit, give leave to either party to file evidence upon such terms as she thinks fit.”

In various proceedings before the Registry the issue of admission of additional evidence has been considered, by analogy, on the same basis as the admission of additional evidence on appeal; which is covered by *Hunt-Wesson Inc’s Trade Mark Application* [1996] RPC 233, *Wunderkind Trade Mark* [2002] RPC 45, *État Française Représentée Par la Ministère de L’ Agriculture de la Forêt v Bernard Matthews Plc* [2002] ETMR 90 and *EI Du Pont de Nemours & Company v ST Dupont* [2004] FSR 15. However, the analogy is obviously not very exact as the considerations for evidence at first instance are of their nature different from those on appeal (one, inter alia, has to take into account the effects of the Henderson rules). I do not consider that the additional evidence requires any reply. It also simply supports what was stated earlier by Mr Barry. In Mr Barry’s first statement he specifically stated that the assignment was together with all common law rights in the

trade mark. I think any reasonable person would read this as meaning the goodwill. I would and have accepted this on face value, in the absence of any contradictory evidence. If Mr Barry's evidence was to be impugned, the procedure outlined by Latham LJ in *Deepak Fertilisers and Petrochemical Limited v Davy McKee (UK) London Limited* [2002] EWCA Civ 1396 should have been followed:

“49. The general rule in adversarial proceedings, as between the parties, is that one party should not be entitled to impugn the evidence of another party's witness if he has not asked appropriate questions enabling the witness to deal with the criticisms that are being made. This general rule is stated in Phipson on Evidence 15th Edition at paragraph 11-26 in the following terms:

“As a rule a party should put to each of his opponent's witnesses in turn so much of his own case as concerns that particular witness, or in which he had a share, eg if the witness has deposed a conversation, the opposing counsel should put to the witnesses any significant differences from his own case. If he asks no questions he will generally be taken to accept the witness's account and will not be permitted to attack it in his final speech. Failure to cross-examine will not, however, always amount to acceptance of the witness's testimony, if for example the witness has had notice to the contrary beforehand, or the story itself is of an incredible or romancing character.”

50. The caveat in the last sentence that I have quoted, is important particularly in the context of the Civil Procedure Rules in which, by Part 32 r. 1(3) the court is given a power to limit cross-examination. Nonetheless, the general rule remains a valid rule of good practice and fairness. The judge of fact is, however, in a different position from the protagonists. So long as a matter remains clearly in issue, it is the judge's task to determine the facts on which the issue is to be decided. However it seems to me that where, as in the present case, an issue has been identified, but then counsel asks no questions, the judge should be slow to conclude that it remains an issue which has to be determined on the basis of an assessment of reliability or credibility without enquiry of the parties as to their position. The judge should be particularly cautious of doing so if he or she has not given any indication of concern about the evidence so as to alert the witness or counsel acting on the side calling the witness, to the fact that it may be that further explanation should be given in relation to the issue in question.”

So, the additional evidence was adding braces to Mr Barry's belt. I do not consider that any useful purpose would be achieved by not allowing the evidence in; it confirms but changes nothing. In such circumstances I think that it is better to have it in than out and so I admitted the evidence. However, I note, that, perhaps rather than worryingly, that the date that Mr Barry gives in his witness statement is incorrect. The assignment agreement gives the date of assignment as 17 February 2004, which is also the date recorded upon the Registry's database.

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

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

“it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

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

19) The trade mark upon which Novartis relies are earlier trade marks as defined by the Act.

20) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77, *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723 and *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM) C-106/03 P*.

The average consumer and the nature of the purchasing decision

21) All of the goods in question are goods that are bought and used by the public at large. The average consumer of *milk based beverages* is, in my view, the public at large. The same applies for the goods of the application being challenged; although *pharmaceuticals* will also have expert, professional consumers (see *Biofarma SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-154/03*). That *pharmaceuticals* will also have expert, professional consumers in this case has no real effect as the larger group of potential consumers will be the public at large.

22) The goods of the earlier registration, milk based beverages, are not goods that will usually involve a careful or educated purchasing decision. The goods of the application are either for medical purposes or for babies. The former goods will affect the health of the individual and, in my view, will be purchased with a reasonable degree of care and consideration. The purchaser of food for babies is likely to be interested in the nature and contents of the goods and exercise a degree of caution and care in the purchasing decision. So the goods of the application will be bought with a reasonable degree of circumspection and care although are unlikely, for most consumers, to involve the sort of care in the purchase as such goods as computer software, where there are issues of compatibility, or cars.

Comparison of trade marks

23) The trade marks to be compared are:

Novartis's trade mark:

Mr Patel's trade mark:

NUTRAMENT

NUTRAMAN

24) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). 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*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 and he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). "The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public" (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

25) It was Mr Wilkes's submission that the nutra prefix in relation to the goods was non-distinctive. State of the register evidence had been supplied by Mr Patel. Twenty three of the trade mark registrations are owned by Mr Patel and two others by the predecessor in title to Novartis's registration. One of the registrations is for the trade mark NU-TRACE, which I would not see as a 'Nutra' trade mark. Mr Bryson submitted that Nutra might allude to nutrition. The state of the register evidence does not tell me what is happening in the market place, there is no evidence that the public are used to distinguishing between various Nutra prefixed trade marks for the goods in question (see *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04 re state of the register evidence). However, a large number of trade marks including a common element, although just sitting on the register, could be indicative that the common element is descriptive. Mr Bryson's partial concession re Nutra indicates that it might be considered descriptive and non-distinctive. There is no necessity for a prefix or suffix to exist on its own in trade or in dictionaries to be perceived by the relevant public as being descriptive (see *Eurohypo AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-439/04). A non-distinctive element will have an effect on the consideration of the similarity of the trade marks. In *José Alejandro SL v Office for Harmonization in the Internal Market (Trade Marks and Designs), Anheuser-Busch Inc Intervening*(Case T-129/01) [2004] ETMR 15 the CFI stated:

"The Court notes that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark."

This is a view that the CFI has also upheld in *Koubi v OHIM – Flabesa (CONFORFLEX)* Case T-10/03, paragraph 60 and *Grupo El Prado Cervera v OHIM – Debuschewitz (CHUFAFIT)* Case T-117/02, paragraph 51. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04 the CFI stated:

“59. It should be noted in this connection that the fact that one component of the signs at issue is identical does not lead to the conclusion that the signs are similar unless it constitutes the dominant element in the overall impression created by each of those signs, such that all the other components are insignificant (*MATRATZEN*, paragraph 33).”

On the premise that Nutra was non-distinctive, Mr Wilkes considered that the ends of the trade marks were the distinctive and dominant elements of the trade marks, the elements that are key to whether the trade marks are similar. It was Mr Wilkes’s submission that the main element of Mr Patel’s trade mark clearly relates to goods for use by men, whilst ment indicates a means of doing something or the result of an action. To some extent the premise of Mr Wilkes rests upon the average consumer analysing the trade marks, an unlikely activity. However, even without analysis and ascribing meaning to the ends of the trade marks, if nutra is non-distinctive the average consumer is likely to rely on other elements in the trade marks to distinguish between them. In relation to *pharmaceuticals* I am not aware that nutra has any obvious connotations.

26) In my view, a further issue has to be tackled and considered. NUTRAMENT is very close to the word nutriment. In oral use it is quite likely to be indistinguishable from the word nutriment; it is quite possible that many consumers may presume that the spelling of Novartis’s trade mark is a correct or variant form. (See *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* Case C-363/99 [2004] ETMR 57 at paragraph 99 – “In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.”) Nutriment means nourishment or sustenance; this strikes me as having very little distinctive character for *milk based beverages* which can be considered to be nutriments or to contain nutriments. (In relation to *pharmaceuticals* nutriment might be seen as indicating goods that aid the recovery of a body that requires building up, it does not appear to be directly descriptive.) If the earlier trade mark has a very low degree of distinctiveness then the average consumer will distinguish between it and other trade marks by reference to small differences. Mr Bryson submitted that the average consumer would not know of the word nutriment, although they would know the words nutrition or nutritious. It is a submission that I find surprising. Nutriment is not an obscure word that is known only to lexicologists, philologists or specialists in a particular field of activity. It is, in my view, a common or garden word; part of the general and common vocabulary. Of course, the ECJ has held that the average consumer is deemed to be reasonably well informed. There is nothing to suggest to me that nutriment is not a word that will not be known to the average consumers of the goods.

27) Mr Wilkes submitted that the respective words are not phonetically similar. The first five and the seventh letters will be voiced in the same manner; there is not a great deal of phonetic difference in the final vowels of each of the trade marks. This leaves

the final t of NUTRAMENT, which will quite possibly trail off in speech. I consider that the respective trade marks have a good degree of phonetic similarity. The common elements I have outlined in relation to phonetic similarity obviously also apply to the visual similarity. However, if the nutra element is indicative of nutriment or nourishment, then the other differing elements are likely to take on greater importance for the average consumer. The trade marks share the nutra element, this would only have significance in relation to conceptual similarity if the element is readily identified by the average consumer. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04* the CFI held that the conceptual meaning must be clear:

“the fact remains that that meaning must be clear, so that the relevant public are capable of grasping it immediately (see, to that effect, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel*(BASS) [2003] ECR II-4335, paragraph 54).”

The CFI in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH Case T-292/01* [2004] ETMR 60 held:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

There are various scenarios to be considered. In one, nutra has a conceptual meaning for the average consumer and so there is a conceptual similarity, however, this is then balanced against it being non-distinctive for the goods and so making the ends of the words the more important elements. Nutra may have no conceptual association for the average consumer and so there is no conceptual similarity and the average consumer will not look to small elements to distinguish the trade marks. NUTRAMENT will effectively be seen as nutriment by the average consumer and so have a very low degree of distinctiveness and so, again, be distinguished by small elements. Finally, the average consumer may see no conceptual meaning in relation to nutra or NUTRAMENT.

28) Of course, in considering the elements making up the trade marks, it is necessary to still compare them in their entirety. I am of the view that the strongest similarity lies in the aural comparison. I consider that the proximity of NUTRAMENT to nutriment, or the conceptual associations of nutra (in the context of the goods), will lead the average consumer to distinguish by small elements. I consider that owing to the proximity of NUTRAMENT to nutriment that the trade marks are conceptually different; one having a readily accessible meaning and the other being an invented word. If this were not the case, and the average consumer identifies nutra with nutriment or nutrition, I consider that the he or she will take the respective trade marks in their entirety and not see a conceptual similarity; although not being conceptually similar, they would not be conceptually dissimilar. It is settled law that the beginnings of words are usually more important than the ends in considering similarity (see *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-336/03* and *Tripcastron* (1925) 42 RPC 264) but this will be dependent on how distinctive the beginning is.

29) It is my conclusion that there is a low degree of similarity between the trade marks.

Similarity of goods

30) In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* the European Court of Justice held in relation to the assessment of the similarity of goods that the following factors, inter alia, should be taken into account: their nature, their intended purpose (the original incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected), their method of use and whether they are in competition with each other or are complementary. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(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 service;
- (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 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) 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.”

In relation to the terms used in specifications Jacob J stated:

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

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

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

I take on board the class in which the goods or services are placed is relevant in determining the nature of goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). Although it dealt with a non-use issue, I consider that the words of Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 are also useful to bear in mind:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

31) The goods of the earlier registration are:

milk based beverages; all included in Class 29.

Mr Patel did not challenge the claim to use made by Novartis, so the requirements of rule 13(C)(1) of the Trade Marks Rules 2000 (as amended) do not come into effect. So I have to consider notional and fair use in respect of all potential goods encompassed by the specification; my comparison cannot be restricted to the goods upon which I have seen use. I have to work on the presumption that if the claim to use had been challenged Novartis might have put in different evidence. In this case I cannot see that this will make any difference to the case of either side. The goods of the application which Novartis considers similar to its goods are:

pharmaceuticals, dietetic substances adapted for medical use, food for babies, food and beverages which are adapted for medical purposes.

32) I consider that the normal meaning for *pharmaceuticals* is goods that have specific curative or palliative effects. They will be viewed as being drugs or medicines. They will normally be in such forms as pills, lotions, gels and liquids and can be swallowed, injected, applied topically or in the form of a pessary. I do not consider that foods can be described as *pharmaceuticals* even if the food might be used to allegedly improve or maintain the health of the consumer. In my experience

pharmaceuticals are in discrete areas of shops. They are taken in specific and clearly identified doses, unlike *milk based beverages*. I cannot see how a pharmaceutical can be substituted for by a *milk based beverage* and so do not see them to be in competition with each other. There is no symbiotic or dependent relationship between the respective goods, or indeed any relationship, so I do not see them as being complementary. The main purpose of a *milk based beverage* is to slake the thirst, with a pleasant flavour; it does not have a primarily medical purpose; if it did it would be in class 5 (as per *Altecnic*). Novartis can claim that the products could be in liquid form and be ingested but this tells little; brandy would satisfy the same criteria. Mr Bryson admitted that Novartis's case was weakest in relation to pharmaceuticals. He saw the strongest argument in favour of similarity lay with Ms Seguin's statement that there is an industry wide convergence of pharmaceutical and nutritional products in what are called nutraceuticals or functional foods. There is a premise, if the products "converge", in Ms Seguin's statement that functional foods contain pharmaceuticals or are closely allied to them. The actual exhibited evidence does not support this; one sees goods such as Benecol, Yakult, All Bran, Nutrigrain bars, Tropicana and Red Bull. The definition of functional foods is that they are or claim to beneficially affect one or more functions of the body. So various cereals are supposed to lessen the chance of heart disease; effectively any food product that claims to have health properties can be described as functional foods. The goods are foods which make claims to aid bodily health which will encompass a vast number of foods; no doubt most goods made with wholemeal flour could make some claim about health properties. Shredded Wheat is advertised as aiding a healthy heart and so is a functional food; on the basis of Ms Seguin's convergence theory am I to presume that this product is similar to *pharmaceuticals*? If one analyses reductio ad absurdum one will always find a similarity between goods and/or services. The issue is not whether goods or services have similarities but whether they are similar; the two should not be conflated; otherwise association in the strict sense will take over from likelihood of confusion (see *Alecansan, SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-202/03* and *Eurodrive Services and Distribution NV c Oficina de Armonización del Mercado Interior (marcas, dibujos y modelos) (OAMI), Case T- 31/04*). In *Sihra's Trade Mark Application* [2003] RPC 44 Patten J referred to a threshold that has to be crossed:

"12. It is clear that the flexibility inherent in this global approach leaves intact the threshold requirement for a recognisable degree of similarity between the goods and services in question. The distinctiveness and strength of the earlier mark may lessen the degree of similarity required, but it does not eliminate it. The remedy for the proprietor of a distinctive mark which is challenged in respect of non-similar goods is to oppose registration under s.5(3)."

I find that *pharmaceuticals* are not similar to *milk based beverages* in Class 29.

33) It strikes me that *dietetic substances adapted for medical use, food and beverages which are adapted for medical purposes* potentially cover a very wide range of goods. Such goods would be likely to be sold in a discrete area of a supermarket, for those requiring a special diet. It could not be said that they are symbiotic or have a dependent relationship. The very nature of goods, being for medical purposes, so having specific characteristics, means that they are unlikely to be substituted. So, I do not consider that the goods are complementary or in competition. The intended

purpose could be the same, to nourish and/or to supply a pleasurable drink related experience. The nature of the beverage goods would be the same, in that they would be in liquid form, however, the food items would be of a different nature. I note that Novartis's product is promoted as a potential substitute for a meal but that does not give it the same nature as a food, as food would normally be considered. **I consider that only beverages which are adapted for medical purposes, of the above goods, are similar to the goods of the earlier registration, to a limited degree.**

34) This leaves *food for babies*. Mr Bryson submitted that milk was is the "paradigm" food for babies and so has to be similar to milk based beverages in class 29. There is a fundamental syllogism in this argument: babies drink milk, Novartis's registration is for a milk based beverage, so the two are similar. There are also alcoholic beverages made from milk, Mr Bryson's logic could apply to them. *Food for babies* could be in liquid form, it could be milk based; so, it may have the same nature as the goods of the earlier registration. The intended purpose is for nourishment, which may be the intended purpose of the goods of Novartis, however, it is aimed at a very specific group; one is looking at *food for babies* not at food for children. *Food for babies* has to satisfy particular nutritional and safety requirements. The intended purpose is to supply nourishment for babies, that is not the purpose of Novartis's goods. *Food for babies* represents a very specific and specialised group of products which are sold in discrete areas of shops. I cannot see that *food for babies* have a symbiotic or dependant relationship, mutually or otherwise, with Novartis's goods. Owing to the specialised nature of *food for babies* I am not of the view that, in any meaningful sense, that such goods would be substituted for by the goods of Novartis. One might give a baby a carbonated, sugar drink instead of baby formula, it does not make the products equivalents. **I find that *food for babies* is not similar to the goods of the earlier registration.**

35) Mr Bryson looked for assistance in his claims that the respective goods are similar to the decision of the hearing officer in BL O/107/06, a non-use revocation case. Unfortunately, Mr Bryson in his skeleton argument omitted parts of the paragraph:

"23. It would seem from the General Remarks section of the Nice Classification guide that a multipurpose composite object (the example given is a clock incorporating a radio) may be classified in all classes that correspond to any of its various functions. The quoted example suggests that the functions must both be clearly present in the product in question. Although the general guidance does not deal specifically with a product of the kind at issue here it seems to me that one should not rule out the possibility that it could perform two functions, one medicinal and one not (according to strength or formulation perhaps), and hence the support a claim to genuine use in more than one Class. Whether it does so is a question of fact. On my reading of the evidence the product is described as an aloe vera juice and the promoter expressly renounces any claim to it being a medicine. It is merely said to be a dietary food supplement or therapeutic juice."

Without the omitted parts one might get the impression that the hearing officer was refuting the judgment of the Court of Appeal in *Altecnic Ltd's Trade Mark Application*, the class of the goods will define the nature of the goods to some extent, if perhaps only to a very limited extent. If the proposition is merely that similarity is

not defined by class and that highly similar goods exist in different classes, then that is clearly correct.

Conclusion

36) First Council Directive 89/104 of December 21, 1988 requires goods or services to be similar for there to be a finding of likelihood of confusion; not that the goods may have similarities (also see paragraph 32 above). Once one part of the cumulative process is absent the claim collapses, as was stated by the CFI in *Alecansan, SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-12/04:

“35 However, a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services referred to in the application for registration are identical or similar to those in respect of which the earlier mark is registered. Those conditions are cumulative (*Canon*, paragraph 22, concerning the provisions of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), and Case C-106/03 P *Vedial v OHIM* [2004] ECR I-9573, paragraph 51, concerning Article 8(1)(b) of Regulation No 40/94). Thus, even where the sign applied for is identical to a mark which is highly distinctive, it must be established that the goods or services covered by the opposing marks are similar (judgment of 1 March 2005 in Case T-169/03 *Sergio Rossi v OHIM– Sissi Rossi (SISSI ROSSI)* [2005] ECR II-0000, paragraph 53; see also, by analogy, *Canon*, paragraph 22).”

The above judgment is in full accord with the corollary in relation to similarity of signs as per *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM)* C-106/03 P. Consequently, the only goods for which a likelihood of confusion can be seen are *beverages which are adapted for medical purposes*.

37) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). I have already decided that I consider that the respective signs and the conflicting goods are only similar to a limited degree. The strongest area of similarity of the trade marks rests with oral use. However, aural similarity does not give rise to a presumption that there will be confusion. As the ECJ held in *Mülhens GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-206/04 P:

“21 It is conceivable that the marks’ phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the

conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.

22 Therefore, one cannot deduce from paragraph 28 of the judgment in *Lloyd Schuhfabrik Meyer* that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.”

The ECJ went on to state:

“35 That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (see, to that effect, Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-0000, paragraph 20).”

The nature of the goods of the application means that they are likely to be purchased from the shelf than by oral request eg they are not the sort of goods that are likely to be purchased in a café or bar. Even if that latter were the case, caution would have to be exercised as to whether there would be confusion as per the judgment of the CFI in *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-3/04*:

“56 As OHIM has wisely observed, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (see, to that effect, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 55).”

38) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (CFI Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, the judgment of 4 May 1999 of the ECJ in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585). As I have already indicated, I consider that NUTRAMENT is at the very bottom of the level of distinctiveness. However, Mr Bryson claims that the product enjoys a reputation; a very significant reputation as he considers that it satisfies the test laid down in by the ECJ in *General Motors Corporation v Yplon SA Case C-375/97* [2000] RPC 572 (*Chevy*) for section 5(3) of the Act:

“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.”

Mr Barry gives approximate turnover figures, none of which exceed £1 million per annum. He states that approximately 15% of the turnover is spent in advertising or promotion. There are no examples of advertising, there is no indication where the advertising has taken place or to whom it has been aimed; it may have been aimed at the trade rather than the public. Based on the turnover figures the expenditure on advertising is certainly not large. There is no indication as to where the goods have been sold, or the nature of the places where the goods are being sold. None of the invoices exhibited are to any of the main supermarket chains; a good number are to cash and carries. The evidence is more noticeable for what is left unsaid, rather than what is said. Mr Bryson pointed to the dotpharmacy exhibit which states that in 1997 the United Kingdom market for functional foods was £239 million and tried to extrapolate a market share of the market from this. The first problem with this is that there are no figures for sales of the goods in 1997, so no comparison can be made. There is also the problem that the definition of functional foods is so vague, effectively foods that carry a health claim, according to the Leatherhead Food Research Association (exhibit MCS3); so the description is self-defining. Included in the goods described as functional foods are Tropicana and Red Bull products, this shows how broad the term can be. There is nothing by which to test Novartis’s claim to a reputation. There are references to the NUTRAMENT product in the three Internet printouts exhibited at MCS2. However, these are among a variety of other information. The references are also not in relation to use as a functional food; one is for a bland diet for health reasons, one is for weight control and one is for training for rowing (all of these, of course, emanate from after the date of application). NUTRAMENT’s claim to being a functional food rests with the claim on the side of the tin that the vitamins inside help to promote a healthy heart. The actual main claim, on the front of the tin, is that the product is an energy and protein drink. The description of the product at MCS1 makes no reference to the product being a functional food, there is no health claim, it is promoted as being an energy source, for fitness and weight control and as a meal replacement. The evidence that Novartis has filed shows that it has used the trade mark; nothing more, nothing less. Trade marks are supposed to be used, that is their purpose; proprietors cannot claim enhanced protection simply because of the fact of use. **On the basis of the evidence before me I have no hesitation in coming to the conclusion that Novartis has not established that it has a reputation for the purposes of either sections 5(2) or 5(3) of the Act.**

39) In considering the limited distinctiveness of the earlier trade mark I bear in mind that this does not preclude there being a likelihood of confusion. In *Sadas SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-346/04* the CFI stated:

“61. In any event, although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion (see, by analogy *Canon*, paragraph 24), it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services

covered (see, to that effect, Case T-112/03 *L'Oréal v OHIM – Revlon(FLEXI AIR)* [2005] ECR II-0000, paragraph 61).”

40) In making a global appreciation I take into account the nature of the goods, the average consumer and that he or she will seldom have the opportunity to compare the trade marks directly, so suffering from the vagaries of imperfect recollection. I also bear in mind that the goods of the application are likely to be purchased with a reasonable degree of care. As there has been no challenge to the use of the earlier trade mark, I have to consider the specification for all potential goods that it could cover. **I have come to the conclusion that there is not a likelihood of confusion. If NUTRAMENT were not to be considered as being not very distinctive, taking into account all other factors, I would have still come to the same conclusion. The grounds of opposition under section 5(2)(b) of the Act are dismissed.**

Section 5(3) of the Act

41) Section 5(3) of the Act reads:

“(3) A trade mark which is identical with or similar to an earlier trade mark, 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.”

In paragraph 37 I have dealt with the claim to reputation. I decided that Novartis has not established that it has a *Chevy* reputation. **In the absence of the requisite reputation this ground of opposition must be dismissed.**

Passing-off – section 5(4)(a) of the Act

42) Section 5(4)(a) of the Act states:

“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,”

I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case* [1998] RPC 455. In that decision Mr Hobbs stated that:

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products 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:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) 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
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

.....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, 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 whether deception or confusion is likely is ultimately a single question of fact. In arriving at the conclusion of fact as to whether 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 fields 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 court attaches 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.””

43) The first matter that I have to decide is the material date. It is well established that the material date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9). Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark”.

Consequently, the material date cannot be after the date of application. There is no evidence of use of Mr Patel’s trade mark, consequently, the date of the behaviour complained of is the date of application for registration, 20 August 2004.

44) There is no doubt that at the material date Novartis had a goodwill associated with the sign NUTRAMENT. The use on the product appears in a particular get-up. I have to consider the issues relating to the claim of passing-off purely upon the evidence. The product is marketed as per the exhibits at PJB1 as an energy and protein drink. On the side of the tin there is a statement that the product is rich in various vitamins which will help promote a healthy heart. This appears to be an added puff rather than the main selling point of the product which carries the energy and protein drink message boldly on the front of the tin twice. Novartis’s website describes the product as being:

“a great-tasting source of nutrition for anyone who wants to deliver a peak performance – on the playing field, on the job, or just on the go”.

The law of passing-off looks askance at those trying to monopolise descriptive words. In *Radio Taxicabs (London) Limited v Owner Drivers Radio Taxi Services Limited* [2004] RPC 19 Mr John Randall QC, sitting as a deputy judge of the High Court, analysed the existing law in relation to this matter:

“55 The leading case is of course the decision of the House of Lords in *Office Cleaning Services v Westminster Window and General Cleaners* (1946) 63 R.P.C. 39. The principal speech is that of Lord Simonds, with whom all three of the other judges expressly agreed. The whole speech repays reading but it includes the following passages:

“... I think it convenient to state the question which your Lordships have to decide. I will begin with a negative. The question is not whether a trader who has chosen to incorporate in his trading style words which are descriptive of the services he performs cannot as a matter of law succeed in a passing-off action based on the use by another trader of a trading style which, by reason of the incorporation of those words, is calculated to deceive, unless he establishes by evidence that such words have acquired a secondary meaning or have ceased to be descriptive of the services rendered.” (p.41, ll.45-52)

"It is not a condition of success in the supposed action that the Plaintiffs should establish that the words in dispute had acquired a secondary meaning." (p.42, ll.6-7)

"The real question is the simple and familiar one. Have the Appellants proved that the use by the Respondents of the trading style 'Office Cleaning Association' is calculated to lead to the belief that their business is the business of the Appellants?" (p.42, ll.8-10)

"... in the case of trade names the Courts will not readily assume that the use by a trader as part of his trade name of descriptive words already used by another trader as part of his trade name is likely to cause confusion and will easily accept small differences as adequate to avoid it." (p.42, ll.28-31)

"... the Appellants do not claim that the words 'Office Cleaning' have acquired a secondary meaning, by which I understand them to mean that they do not claim that these words mean a service of cleaning offices as rendered by them and them alone. Such a claim would indeed be impossible to maintain. But, while making this disclaimer, they nevertheless contend that as a trade name 'office cleaning' is so much identified with their business that any trader who ventures to use these words as part of his trade name must clearly differentiate, This seems to me to be no more than a restatement of the familiar problem. The Court will undoubtedly take into consideration long user of a descriptive name but will not forget that, since it is descriptive, small differences may suffice." (pp.42, l.48 to p.43 l.4)

"So long as descriptive words are used by two traders as part of their respective trade names, it is possible that some members of the general public will be confused whatever the differentiating words may be. I am ready to believe that in this case genuine mistakes were made. I think they ought not to have been made. In the Vacuum Cleaner case it appeared that ninety per cent. of its customers had addressed the Plaintiffs, the British Vacuum Cleaner Coy., Ltd., as the 'Vacuum Cleaner Coy'. In spite of this fact and of actual instances of confusion Parker J. refused to grant an injunction to restrain the 'New Vacuum Cleaner Co' from using the words 'vacuum cleaner' in conjunction as part of its registered or other name. So in *Turton v Turton* (42 Ch D 128) the possibility of blunders by the general public was held not to disentitle the defendant from trading in his own name though the plaintiff had longed traded in the same name. It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the general public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered." (p.43, ll.21-37)

56 In *The Cellular Clothing Co Ltd v Maxton and Murray* [1899] A.C. 326, Lord Shand pointed out that the consequence of a claimant establishing a distinctive reputation in words which are in ordinary usage would be to give that claimant a right more valuable than a trade mark, being unlimited in point of time. He went on to say (at 340):

"That being so, it appears to me that the utmost difficulty should be put in the way of anyone who seeks to adopt and use exclusively as his own a merely descriptive term".

57 There is also a helpful statement of principle in the judgment of Parker J. in *Burberrys v J.C. Cording & Co Ltd* (1909) 26 R.P.C. 693 at 700 (l.53)- 701 (l.37):

"The Plaintiffs based their case at the trial entirely on the probability of deception, if the Defendants continue to use the word as they are and have been using it. The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but property in the trade or good-will which will be injured by its use. If the use of a word or name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business. If no case of deception by means of such misrepresentation can be proved, it is sufficient to prove the probability of such deception, and the Court will readily infer such probability if it be shown that the word or name has been adopted with any intention to deceive. In the absence of such intention, the degree of readiness with which the Court will infer the probability of deception must depend on the circumstances of each particular case, including the nature of the word or name, the use of which is sought to be restrained. It is important for this purpose to consider whether the word or name is *prima facie* in the nature of a fancy word or name, or whether it is *prima facie* descriptive of the article in respect of which it is used. It is also important for the same purpose to consider its history, the nature of its use by the person who seeks the injunction, and the extent to which it is or has been used by others. If the word or name is *prima facie* descriptive or be in general use, the difficulty of establishing the probability of deception is greatly increased. Again, if the person who seeks the injunction has not used the word or name simply for the purpose of distinguishing his own goods from the goods of others, but primarily for the purpose of denoting or describing the particular kind of article to which he has applied it, and only secondarily, if at all, for the purposes of distinguishing his own goods,

it will be more difficult for him to establish the probability of deception. But whatever be the nature of history of the word or name, in whatever way it has been used, either by the person seeking the injunction or by others, it is necessary, where there has been no actual deception, to establish at least a reasonable probability of deception. In such cases the action is, in effect, a *quia timet* action, and unless such reasonable probability be established, the proper course is, in my opinion, to refuse the injunction, leaving the plaintiff to his remedy if cases of actual deception afterwards occur.”

In *Associated Newspapers Limited and others v Express Newspapers* [2003] FSR 51 Laddie J stated:

“25. The jurisprudence to the effect that it is difficult if not impossible to succeed in a passing off action where the mark relied on is descriptive is based on the principle that no trader should be allowed to secure a monopoly over words which customers would regard not as an indication of origin but as merely descriptive of the type of goods or services being offered and which, for that reason, other traders are likely to want to use. Where a mark possesses the ability to convey to the customer an indication of a particular trade origin for goods made available under it, it can be protected by passing off proceedings.”

45) It seems to me that NUTRAMENT for goods that are specifically marketed as supplying nutriment, if not using that word, is describing the goods. The distinctiveness will rest more in the get-up than in the word.

46) There is no need for goods or services to be similar to succeed in a passing-off claim. However, the difficulty of establishing confusion where there is a distance between the fields of activities was considered by Millet LJ in *Harrods v Harrodian School* [1996] RPC 697 Millet LJ 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”

In the same case Millet LJ held:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

In *Lego System Aktieselskab and Another v Lego M Lemelstrich Ltd* [1983] FSR 155 the distance between the fields of activity was bridged by an enormous reputation, Lego being classed as a household word, and survey evidence.

47) The marketing of the NUTRAMENT product in no way suggests that the beverage is designed for people suffering from or recovering from illness. The very opposite is the case, it is promoted as being for “athletes and other busy people”. A

very different group of consumers to those for *pharmaceuticals, dietetic substances adapted for medical use, food for babies, food and beverages which are adapted for medical purposes*. The tins bear images of stylised persons taking part in sporting activities. I cannot envisage that anyone seeing the trade mark NUTRAMAN on *pharmaceuticals, dietetic substances adapted for medical use, food for babies, food and beverages which are adapted for medical purposes* would be under apprehension that the producers of the product NUTRAMENT were responsible for the goods; the nature of Novartis's product and the way in which it is marketed would militate against deception or confusion. Even if NUTRAMENT were considered to have a reasonable amount of distinctiveness taking into account its use, I still cannot see the public concerned being deceived or confused. I do not believe that they would see any link between the different products sold under the different signs. **In the absence of deception or confusion the grounds of opposition under section 5(4)(a) are dismissed.**

48) In *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 Lord Fraser commented upon what the plaintiff must establish:

“That he has suffered, or is *really likely* to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached.”

The evidence of Novartis does not support a claim that it is really likely to suffer substantial damage to the property in its goodwill; the nature of the promotion of the goods, the nature of the goods and the differences in the signs would militate against such an occurrence.

COSTS

49) Rajendra Patel having been successful is entitled to a contribution towards his costs. I order Novartis AG to pay Rajendra Patel the sum of £1200. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of June 2006

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