O-377-09

TRADE MARKS ACT 1994
and
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF DESIGNATION NO. 928103
IN THE NAME OF STEVEN PALEOLOGOS

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 71546 IN THE NAME OF
ALERGAN INC

Trade Marks Act 1994 and

The Trade Marks (International Registration) Order 1996

IN THE MATTER OF Designation No. 928103
in the name of Steven Paleologos

And

IN THE MATTER OF Opposition thereto under No. 71546
in the name of Allergan Inc.

Background

1. On 18 June 2007, Steven Paleologos sought to extend protection of International Registration No 928103 for the mark LIPOTOX to the UK under the provisions of the Madrid Protocol. The designation is registered for the following specification of goods in Class 5:

> Dietary supplement, vitamins and minerals, pharmaceutical preparation.

2. On 14 January 2008, Allergan, Inc. filed notice of opposition to the designation, the grounds being in summary:

Under Section 5(2)(b)	because the mark applied for is similar to, and is sought to be registered in respect of goods that are identical or similar to the opponent's earlier marks such that there exists a likelihood of confusion.
Under Section 5(3)	because the opponent's trade mark BOTOX enjoys an extraordinarily high profile and reputation and experiences many entrants into the marketplace who seek to associate themselves with the established trade mark BOTOX. LIPOTOX is clearly in this category. Or else why did the applicant adopt a mark with the suffix OTOX? It is submitted that the applicant adopted the mark LIPOTOX to bring the mark BOTOX to the mind of the public and that the applicant is attempting to associate its product with the results of treatment using the BOTOX product. The adoption of the derivative mark LIPOTOX takes unfair advantage of, and is detrimental to the reputation enjoyed by the BOTOX mark and the distinctiveness of the BOTOX mark.
Under Section 5(4)(a)	by virtue of the law of passing off.

3. Details of the earlier marks relied upon by the opponents can be found as an annex to this decision.

4. The applicant filed a Counterstatement in which he denies the grounds on which the opposition is based. The applicant puts the opponent to proof in respect of the use that they have made of the earlier marks relied upon in the UK.

5. Both sides filed evidence which insofar as it is relevant I have summarised below. Neither party requested to be heard instead electing to file written submissions and to have the matter determined from the papers. I now go on to give my decision.

Opponent's evidence

6. This consists of a Witness Statement dated 3 November 2008 from Anthony Edward Sauerman, Vice President and General Counsel of Allergan Limited for the Eurasia region, a position he has held since November 2005. Mr Sauerman says that prior to this he had been employed as Legal Adviser for the Europe, Africa and Middle East regions. Much of this very long and often repetitive statement consists of information relating to the BOTOX product that is largely irrelevant to the determination of these proceedings.

7. Mr Sauerman gives details of the evolution of Allergan which he describes as "a major global pharmaceutical business that researches, develops, manufactures, markets and sells pharmaceutical and other products for the ophthalmic, neurological, medical aesthetics, medical dermatological and other speciality industries." He says that the business includes a wide range of prescription and non-prescription products for the treatment of diseases and disorders of the eye, skin, and is "pre-eminent in the neurological and medical aesthetics field. BOTOX has become one of the key products since its launch 18 years previously.

8. He gives details of the European expenditure on research and development, and the Worldwide and European net product sales; in the latter case this has grown from $272.5 million in 2003 increasing year on year to $550 million in 2006, the last full year prior to the relevant date.

9. Mr Sauerman next turns his attention to the BOTOX product which he says is the name of the best-known botulinum toxin product brand among the trade and has become a household consumer name in the US, EU and other countries around the world. He describes the product as having helped millions of patients suffering from debilitating neurological disorders and has been at the fore of treatment for the reduction of facial lines and wrinkles, being the best selling product of its kind. He says that the name originates from around 1986 when it was coined by Dr Mitchell Brin and research colleagues at Columbia University. In 1988 Allergan acquired the rights to the research and to develop, market and sell the botulinum toxin that at that time was being sold under the name Oculinum. Mr Sauerman says that in June 1991 Allergan purchased the assets and rights to the product from Oculinum Inc, in January 1991 beginning to sell the botulinum toxin, originally under the name Oculinum/BOTOX, in May1992 dropping the Oculinum to sell it under BOTOX alone.

10. Mr Sauerman goes on to give details of Allergan's worldwide intellectual property registrations, details of which he shows as Exhibits AES1/1 to AES1/8. He says that Allergan has filed applications to register BOTOX in respect of "cosmetics, face-creams and lotions, skin creams and lotions" in view of the extensive "on-label" and "off-label" use of the product for cosmetic purposes in the EU, and in expectation of using BOTOX in relation to a cream, but has not, as yet launched a face cream or the like under the name. Mr Sauerman next gives details of the BOTOX product, its uses and product approvals, stating it

is classified as a prescription only medicine in the US and EU. He mentions licences having been granted for 19 therapeutic and 2 cosmetic indications in over 75 countries, details of which are shown as Exhibit AES1/9. He says that the BOTOX product has been involved in extensive clinical trials and the subject of more than 1280 peer-reviewed English language scientific and medical articles.

11. BOTOX product vials feature the BOTOX trade mark in plain word or stylised logo form, with either the ™ or ® symbols, and are packaged in a box also bearing the brand. Micro-needles for injections of the BOTOX product also bear the brand. Photocopies of packaging for BOTOX preparation and needles are shown as AES2 which shows BOTOX in plain type and stylised logo form, accompanied by the ® symbol.

12. Mr Sauerman next gives details of the worldwide sales of the BOTOX product in the years 1997 to 2007, which ranges from $90.1million, rising year on year to $982.2 million in 2006, the last full year prior to the relevant date. For the same period he gives turnover for his company's main European markets, which for the UK records sales for medical and cosmetic usage ranging from $7,777,000 to $25,775,000 in 2006. He says that sales of off-label cosmetic use of the BOTOX product are made under the name VISTABEL and are not included although he goes on to give the sales for VISTABEL and BOTOX /VISTABEL combined. Mr Sauerman says that as a prescription-only medicine BOTOX can only legally be supplied via trained and qualified medical practitioners although non-medical establishments administer BOTOX for cosmetic treatments without supervision but not using products supplied by his company.

13. Mr Sauerman goes on to refer to the widespread use of BOTOX for the reduction of facial lines and wrinkles saying this is a widespread practice within the US and EU. He gives details of the number of injections administered in the US in the years 2003 to 2007 with an estimate of the treatments within the EU. He also gives details of uses of the Vistabel and Vistabex within the EU for the years 2001 to 2007. Mr Sauerman next refers to competitor products sold under the name DYSPORT and NEUROBLOC/MYOBLOC, setting out details of the respective market share, showing that BOTOX and similar Allergan botulinum toxin products hold the main share of a market worth $220.9 million. He goes on to compare the BOTOX and other botulinum toxin products.

14. Mr Sauerman next refers to the advertising and promotion of BOTOX which he says is governed by a prohibition of advertising prescription only medicines, saying that as BOTOX products have not been licensed for cosmetic use Allergan have been unable to promote the product for use in cosmetics indications. Notwithstanding this, Mr Sauerman says that the BOTOX product has received publicity amongst the general public, becoming well known primarily in relation to injections for the reduction of facial lines and wrinkles. He refers in particular to an article that appeared in the 3 November 2001 edition of the Guardian newspaper shown as part of Exhibit AES3/1. This reads:

> "BOTOX is by far the most popular brand of […] Botulinum toxin type A […] Incredibly, it has got this far without any marketing. Allergan, a pharmaceutical firm specialising in eye care (it makes contact lens solution, among other things), is in the curious position of not having a licence to sell Botox as a cosmetic treatment. As a result, Allergan cannot promote Botox for the very purpose that has made it such a golden egg. […] Like other cosmetic procedures, Botox spreads far better by personal recommendation than by magazine advertising."

15. The Exhibit consists of a large collection of articles and features that mention BOTOX which appeared in a range of mainstream, business and technical publications.

16. Exhibit AES4 consists of a selection of press releases to the global media between January 1991 and November 2005. As stated by Mr Sauerman, these indicate that the information was released from the Allergan headquarters in Irvine California. Whilst he says that this was to the international media there is nothing that shows they reached the EU or UK.

17. Mr Sauerman goes on to refer to the advertising and promotion of BOTOX in the US, saying that this is possible subject to certain provisions concerning the content of advertisements. He says that between May 2002 and 2005 Allergan ran a high-profile consumer advertising campaign for BOTOX in relation to the cosmetic treatment of "frown lines", with advertisements appearing in over 20 leading national consumer magazines and on major television networks. Mr Sauerman says that many European consumers visiting the US are likely to have been exposed to these advertisements and international media coverage. He goes on to give details of the amounts spent promoting the BOTOX product within the EU to qualified persons for therapeutic use in the years 2003 to 2006, which ranges between $7,641,000 in 2003, hitting a peak of $18,317,000 in 2005 before falling back to $16,821,000 in 2006.

18. Notwithstanding the lack of advertising to the public, Mr Sauerman says that through "an extraordinary amount of press coverage for many years" BOTOX is recognised by the public as distinct and the most famous botulinum toxin brand. In particular he mentions the public's appetite for the beauty secrets of celebrities from the UK, EU and the USA. He refers to Exhibits AES3/2 and AES3 which relate to US and UK press coverage, respectively. The exhibit relating to the exposure of BOTOX to the UK dates from 30 November 2001 when the Guardian Weekend edition ran a feature on "…The Botox craze…". Mr Sauerman repeats various statements from the media statements. Mr Sauerman refers to Exhibit AES5 which he says evidences "the common practice among the media to identify brand names by capitalizing its first letter and opposed to using the ® or ™ symbols. The exhibit consists of letters from Allergan to (and replies from) various publications seeking cooperation in the use of BOTOX, requesting that this only be used in relation to the Allergan product, and in conjunction with the ® symbol. He later refers to contact with the Oxford University Press and Chambers Harrap Publishers Limited regarding the use of BOTOX in dictionaries that they publish, including the use of BOTOXED as a "derivative adjective." Details of these and the publisher's responses are shown as Exhibits AES8/1 and AES8/2.

19. He next refers to Exhibit AES6 which consists of articles, features and other materials from various medical, educational, charitable, government and other publications. Mr Sauerman says that these identify BOTOX as a unique and well-known botulinum toxin brand among trade, practitioners and other public organisations. Mr Sauerman says that the BOTOX brand is so well known that it has entered into many leading UK dictionaries, the earliest that he is aware of having appeared in the 1998 Edition of The British Medical Association (BMA) New Guide to Medicines and Drugs. He says that as can be seen from Exhibits AES7/6 and AES 7/15 (consisting of extracts from the 1998 and 2001editions) the BMA publication contains the reference "Botox: a brand name for botulinum toxin (a muscle relaxant). References to BOTOX as a trade mark entered into the 2002 editions of The Encarta Essential English Dictionary, the Concise Oxford Dictionary, and the Shorter Oxford

English Dictionary, extracts from which are shown as Exhibits AES7/17, AES7/18 and AES7/19, respectively.

20. Mr Sauerman goes on to refer to non-medical dictionaries and Wikipedia, the online encyclopaedia, where BOTOX has been mentioned in relation to cosmetic and therapeutic treatments, extracts of which are shown as Exhibits AES7/20 to AES7/25, AES7/27 to AES7/33. He returns to The British Medical Association New Guide to Medicines and Drugs (Sixth edition 2004), an extract of which is shown as Exhibit AES7/26, Mr Sauerman highlighting that along with the BOTOX entry above, this also mentions the Dysport and Neurobloc brands.

21. Mr Sauerman refers to his company's success in preventing misuse of the BOTOX name, related documents being shown as Exhibit AES9. He makes particular mention of earlier proceedings before the registry, a copy of the decision being shown as Exhibit AES/10. Mr Sauerman further says that in August 2005 (and subsequently) his company published a legal trade mark notice in The Times and The Daily Mail stating that BOTOX® is a registered trade mark of Allergan, Inc, and that the mark should not be used to indicate products of other companies. Exhibit AES11/2 and AES11/3 show copies of these notices.

Applicant's evidence

22. This consists of two Witness Statements. The first is dated 14 April 2009 and comes from Steven Paleologos, the applicant. Mr Paleologos says that in 2005 he started a business to distribute, sell and manufacture dietary supplements, vitamins and minerals under his own brand names. He says that he subsequently coordinated the development of a weight-loss program using two dietary supplements that he branded LIPOTOX, the product being sold in tablets and as a powdered meal replacement shake. The LIPOTOX product has been selling in Greece since March 2007 with the intention of it being launched in England, Germany and Australia within the next six months.

23. Mr Paleologos says that his Greek parentage and ability to speak Greek influenced his choice of the name LIPOTOX. The prefix LIPO is formed from the Greek word LIPOS meaning "fat" and the suffix "TOX" from the Greek words "TOXICO" meaning "toxic" and "APO-TOXINOSI" meaning "detoxify".

24. The second Witness Statement is dated 15 July 2009 from Nicholas Keith Howick, a partner in Carpmaels & Ransford, the applicant's representatives. Mr Howick refers to the applicant's evidence that from 2005 to 14 April 2009 (when Mr Paleologos executed his Witness Statement) he has used the LIPOTOX mark exclusively in relation to the distribution, sale and manufacture of dietary supplements, vitamins and minerals. Mr Howick says that it also shows that Mr Paleologos did not have the intention of using LIPOTOX for pharmaceutical preparations. There is no requirement that a trade mark be in use for any, let alone all of the goods at the time that an application is made; there is futurity in that the applicant can have the intent to so use the mark. In the absence of evidence to the contrary, and the statement attributed to Mr Paleologos does no more than say how the mark has been used and may be used in the short term, the statement of intent to use on the application must be taken at face value.

Decision

25. Turning first to the ground under Section 5(2)(b). That section reads as follows:

> "**5**(2.-) A trade mark shall not be registered if because –
>
> (a) …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

26. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "**6**.-(1) In this Act an "earlier trade mark" means –
>
> a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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."

27. The opponents rely on eight earlier marks that are the word BOTOX in plain script, and that word with some minor stylisation or additional matter of varying degrees of descriptive significance. All but two of these had been registered for more than five years at the relevant date so are subject to The Trade Marks (Proof of Use, etc.) Regulations 2004. Section 4 of these Regulations amend section 6 of the Act by the addition of the following:

> **"6A Raising of relative grounds in opposition proceedings in case of non-use**
>
> (1) This section applies where -
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if –
>
> (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United

Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) …….

(7) …….

28. Also of relevance is section 100 of the Act which states:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

29. The two leading authorities on the guiding principles to be applied in determining whether there has been genuine use of a mark are: *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. These inform me that I must consider all facts and circumstances in determining whether the commercial exploitation of the mark is real or token, in particular, whether the use, be it in relation to goods already available or simply about to placed "on the market', is of a scale sufficient to have created or preserved an outlet for the goods, bearing in mind that quantitative significance is not determinative. The assessment takes into account the nature of the goods and characteristics of the relevant market, without imposing a requirement that the mark must have come to the attention of the end user or that a significant market share has to be achieved.

30. The earlier marks consist of the word BOTOX which self evidently is formed from an elision of the first syllables of the full description "**bot**ulinum **tox**in". Even so, BOTOX is a word that has no reference to the character or quality of the goods for which it is used; it is wholly distinctive and by all accounts unique to the opponents. It is a mark with no dominant distinctive element.

31. The BOTOX product has been one of the opponent's key products since its launch 18 years previously, originally as Oculinum/BOTOX, and since May 1992 as BOTOX alone. The name has been used as a trade mark in plain word or stylised logo form, with either the ™ or ® symbols, with product packaging and micro-needles for injections of BOTOX also

bearing the name. The BOTOX product is used in the treatment of neurological disorders and as a prescription-only medicine which can only legally be supplied to medical practitioners. The product has also been prominently used by non-medical establishments as a treatment for the reduction of facial lines and wrinkles but not using products directly supplied by Allergan. There is a mention of BOTOX being used for cosmetics, face-creams and lotions, skin creams and lotions" but later there is confirmation that the opponents have not launched a face cream or the like under the name.

32. The world-wide and European figures relating to expenditure on research and promotion are of an impressive scale, as is turnover albeit less so for the UK for which they record sales for medical and cosmetic usage ranging from $7,777,000 to $25,775,000 in 2006. There have been sales of the product under the name VISTABEL but this can have had little or no effect on any reputation. Whilst there are competitor products, the Allergan botulinum toxin product is said to hold the main share of a market worth $220.9 million.

33. The opponent's claim to BOTOX having become the best-known botulinum toxin product brand among the trade, and a household name amongst consumers, is not disputed. The BOTOX product is said to have been has been involved in extensive clinical trials and the subject of more than 1280 peer-reviewed English language scientific and medical articles, which given that the product can legally only be used by trained and qualified medical practitioners is a reasonable indication that it is likely to be very well known in this sector of the trade. As a prescription only medicine the BOTOX product is prohibited from being advertised, and consequently, Allergan have been unable to promote the product for use in cosmetics indications. Nonetheless, UK press coverage, particularly in relation to the use of the product by celebrities, has been of a scale sufficient to bring the product into the minds of the public who have an appetite for such details.

34. The name has appeared in UK dictionaries from as early as the 1998 Edition of The British Medical Association (BMA) New Guide to Medicines and Drugs. Entries in more general works such as the 2002 editions of The Encarta Essential English Dictionary, the Concise Oxford Dictionary, and the Shorter Oxford English Dictionary followed. To my mind this is indicative that the exposure of BOTOX (in the plain script and in the stylised or BOTOX plus forms) to the consumers, be they medical practitioners, providers of cosmetic treatments or the public at large, has been of a scale such that the only reasonable conclusion that can be reached is that there has been genuine use of the earlier marks in respect of a botulinum toxin product. From this analysis I consider it logical to also accept that this use has established a significant reputation and enhanced the distinctive character of BOTOX in relation to the botulinum toxin product, factors that I will take into account in determining the likelihood of confusion.

35. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the 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 B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG,* who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.,*

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG,*

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG,*

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,*

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG,*

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,*

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV,*

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

36. The decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan's Manufacturing (UK) Ltd*, [2005] EWHC 1303 indicate that the circumstances in which the relevant goods and the trade marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. That said, the matter must be considered by applying an assessment of all relevant factors. This should be balanced by the decision of the CFI in *Devinlec Développement Innovation Leclerc SA v OHIM* (Case T- 147/03) in which they stated that a conceptual difference between the marks at issue may be such as to counteract to a large extent any visual and aural similarities between the signs. However, this requires at least one of the marks to have a clear and specific meaning so that the public is capable of grasping it immediately, which for the record I do not consider to be the case here.

37. On a visual comparison it is clear that BOTOX and LIPOTOX have the same "OTOX" ending, and to that limited extent they share some similarity, but that is as far as it goes. The remainder of the opponents mark consists of the letters "BO" whereas the mark applied for has the letters "LIP". Clearly there is absolutely no similarity here, and whilst it is the marks as a whole that must be compared, I cannot ignore that the difference exists in the beginning of the marks which is generally accepted as being of most significance in any comparison. This is particularly relevant when comparing a short word such as BOTOX where minor differences from another word have a disproportionate impact on the question of similarity. On my assessment the respective marks BOTOX and LIPOTOX are not visually similar.

38. As with the visual comparison the commonality of ending creates a similarity in the respective marks aural appreciation, but the initial syllable "BOT" in the opponents mark shares no similarity whatsoever with the first syllable "LIP" in the mark applied for. Both are affected by the following syllable which creates a sound of "BOAT" compared to "LIE". Clearly there is absolutely no similarity here. The earlier mark has only two syllables whereas the applicants mark has three, adding to the distinction in their sounds when spoken. I must take into account the laziness in pronunciation of syllables and letters, but also the tendency to slur the endings of words which is where any similarity exists. Balancing everything I conclude that the respective marks are not aurally similar.

39. I have already commented on the derivation of the word BOTOX. Even though it has some factual basis it is nonetheless likely to be regarded as an invented word by the real end user/consumer. However, being available on prescription means that the product will primarily be supplied to informed practitioners who I have no doubt will understand that BOTOX has its origins in "**bot**ulinum **tox**in". The mark applied for consists of the word LIPOTOX which the applicant says he constructed from the Greek word LIPOS meaning "fat" and the suffix "TOX" from the Greek words "TOXICO" meaning "toxic" and "APO-TOXINOSI" meaning "detoxify". Whilst the opponents do not go so far as to challenge the veracity of the explanation given by Mr Paleologos in their written submissions they suggest that his choice is a subconscious attachment of the reputation of the BOTOX name. This is a matter that the opponents should have raised earlier or dealt with through cross-examination of Mr Paleologos, but as things stand I have to take his words at face value; they are not obviously implausible. But whatever is the case, the roots of LIPOTOX would be hidden from all but scholars or those adept in performing the linguistic gymnastics of word or trade

mark analysis. To the average consumer of the goods in question LIPOTOX would be an invented word. This opens the potential for there to be conceptual similarity to some consumers, but not to others.

40. Taking these assessments into account I consider the differences to so clearly outweigh the similarities that the respective marks cannot be considered similar.

41. The established tests in assessing the similarity or otherwise of goods and services is set out in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*. I must consider the uses and users of the respective goods or services, the physical nature of the goods or acts of service, and the trade and distribution channels through which they reach the market. In the case of self-serve consumer items this will also include consideration of where the respective goods are likely to be found, particularly in multi product outlets such as supermarkets. The extent to which the respective goods or services are competitive or complementary is also a relevant consideration guided by how they are classified in trade, and known by the relevant consumer. Other than where the proof of use provisions have been applied, the comparison is a notional one based on the wording used in the specifications rather than the actual markets involved.

42. In *Saint-Gobain SA v OHIM* Case T-364/05 the CFI stated:

> "67…. [I]t is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed."

43. The evidence is fairly conclusive in showing that BOTOX is a brand of botulinum toxin used to treat neurological disorders and in the reduction of facial lines and wrinkles. With the results of the proof of use requirements in mind, the assessment of the similarity (or otherwise) of the applicant's goods will be based on a comparison with botulinum toxin, and the goods covered by the two earlier registrations (CTM 3700317 and UK No. 2357789) for which there was no requirement to prove use, namely, the cosmetics, face creams and lotions, skin creams and lotions covered by them.

44. From the descriptions found in the evidence it is clear that the botulinum toxin could fall within the general description "pharmaceutical preparations" in the specification of the application. I appreciate that the opponent's botulinum toxin product is available on prescription only, but as the applicant's "pharmaceutical preparations" are not limited in any way the term covers both goods that are available by prescription and over the counter. Consequently, identical goods are involved. (see *Gérard Meric v OHIM,* Case T-133/05 paragraph 29). Additionally, as I have found the respective goods to be "notionally" identical, I must infer that they operate in the same sector, and share the same channels of trade, from manufacture to retail. I can see no reason why the consumer of the respective goods should be any different.

45. This leaves "dietary supplements, vitamins and minerals" which even taking account of the opponent's reputation would not, in any reasonable analysis, be considered similar to the sophisticated botulinum product, either in nature, purpose or channels of trade.

The skin and face creams/lotions covered by the earlier marks are classified in Class 3 so are clearly neither for pharmaceutical or medical purposes, nor for use as dietary supplements. It may well be that they contain vitamins and/or minerals but having something as an ingredient does not make it the same as the goods they form part of. There is no evidence that such goods exist in the same sector or share the same channels from manufacture to retail. However, these are ordinary goods that potentially could be bought by the same end consumer. In my view the "dietary supplements", "vitamins" and "minerals" in the application are different to the goods covered by the opponent's earlier marks.

46. Whilst the word BOTOX has a strong link to the opponents and their botulinum toxin product, there is nothing that establishes that "tox" or "otox" as a suffix is unique to, or recognised as being indicative of them. Use of LIPOTOX may bring the opponents and their product to mind but I see no reason why any association would cause the public to wrongly believe that the goods are likely to have originated from them or an economically linked undertaking. Taking account of all of the factors and adopting a "global" approach, I take the view that whilst there is identity with the goods of the earlier marks in respect of "pharmaceutical preparations", and consequently also the connected notional circumstances of the manufacture and market, and even allowing for the undoubted reputation and enhanced distinctiveness of BOTOX, the differences in the respective marks are such that use of the mark applied for will not lead to confusion. The opposition under Section 5(2)(b) therefore fails.

47. The next ground is under Section 5(3) of the Act. That section reads:

> "**5.-**(3) A trade mark which -
>
> (a) 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 or international trade mark (EC) 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."

48. The opponent relies on the same earlier rights as it did under section 5(2)(b).

49. An essential requirement for any objection under this ground is that the respective marks be either the same or at the very least similar. In my assessment under Section 5(2)(b) I found this not to be the case and I see no reason to reach a different conclusion under this ground. So The objection therefore falls at the first hurdle and is dismissed.

50. The final ground is under Section 5(4)(a) of the Act, which reads:

> "**5**.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –
>
> (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
>
> (b) ….

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

51. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person, in *Wild Child Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

1) That the opponent's goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

2) That there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicant are goods of the opponent; and,

3) That the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

52. To the above, I add the comments of Pumfrey J in the case of *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 in which he said:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See Smith Hayden (OVAX) (1946) 63 RPC 97 as qualified by BALI [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28 Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing office (sic) that it is not shown on the balance of possibilities that passing off will occur."

53. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later) or the date at which the acts first complained of commenced, as per the comments in *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty* Ltd [1981] RPC 429. As there is no evidence that the mark applied for has been used, the relevant date for determining the opponent's claim will be the filing date of the application in suit, that it to say 18 June 2007.

54. I have already found the opponents and their BOTOX trade mark to have a strong reputation in respect a botulinum toxin product and I see no reason why the position should be any different in respect of goodwill so the first component is in place.

55. Whereas the previous two grounds were essentially based on marks in the form as registered, with the results of any use being a factor for consideration, an objection based on an allegation of passing off is founded on a mark as actually used whether or not it is registered, and it is here that the opponent's case hits the same hurdle. They have used the BOTOX mark in very much the form in which it is registered and in no other form that is any more similar to the mark that is the subject of these proceedings. Consequently, I do not see how I can conclude that use by the applicant can be a misrepresentation much less one that is likely to cause the opponents to suffer or be likely to suffer damage. The ground under Section 5(4)(a) is also dismissed.

56. The opposition having failed on all grounds the applicant is entitled to a contribution towards his costs. I therefore order that the opponents pay the applicant the sum of £1,500 towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of December 2009

Mike Foley
for the Registrar
the Comptroller-General