

O-028-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS 2382118 AND 2486779
BY OPUS HEALTHCARE LIMITED TO REGISTER THE TRADE MARK
“OPUS”
IN CLASSES 5 AND 10**

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER NOS 96584 AND 98786
BY CHIESI LTD**

AND

**IN THE MATTER OF REGISTRATION NO 2204467
FOR THE TRADE MARK “OPUS”
IN THE NAME OF CHIESI LTD
AND THE APPLICATION FOR REVOCATION THERE TO
UNDER NO 83230
BY OPUS HEALTHCARE LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF application Nos. 2382118 and 2486779
by Opus Healthcare Limited to register the trade mark
OPUS in Classes 5 and 10**

and

**IN THE MATTER OF consolidated oppositions thereto under nos. 96584 and
98786
by Chiesi Ltd**

and

**IN THE MATTER OF registration no. 2204467
for the trade mark OPUS
In the name of Chiesi Ltd**

and

**the application for revocation thereto under no. 83230
by Opus Healthcare Limited**

BACKGROUND

1) On 14 January 2005, Opus Healthcare Limited (“OHL”), of PO Box 8204, Ardleigh, Colchester, CO7 7WH applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark OPUS. This application, no. 2382118, is in respect of the following goods:

Class 5

Sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; medical dressings; surgical dressings; balms for medical purposes; preparations used to form a barrier between the skin and other substances; preparations for use in enhancing the performance of dressings; preparations for removal of adhesive materials; preparations for use in relation to medical dressings; barrier creams; barrier creams for use in the protection of peristomal skin; absorbent preparations for medical use; superabsorbent preparations for use with ileostomy, colostomy and urostomy pouches; all of the aforesaid being for administration to humans.

Class 10

Artificial limbs, eyes and teeth; orthopaedic articles; suture materials; surgical sponges; medical devices for use in increasing the effectiveness of colostomy and ileostomy pouches; medical devices for use inside colostomy and ileostomy pouches.

2) On 7 March 2008, Trinity-Chiesi Pharmaceuticals Ltd of Cheadle Royal Business Park, Highfield, Cheadle, SK8 3GY filed notice of opposition to the application. The grounds of opposition are that OHL's application:

- in respect of some of its Class 5 goods, offends under Section 5(1) of the Act because these goods and the mark is identical to its mark covered by its earlier registration no. 2204467 OPUS. This earlier mark completed its registration procedures on 13 July 2001.
- and insofar as the goods are not deemed to be identical, it offends under Section 5(2) (a) of the Act in that all its Class 5 and 10 goods are similar to its goods covered by its earlier registration.

3) The opponent's earlier registration is in respect of the following Class 5 goods:

Pharmaceutical preparations and substances, all for human use, but not including diagnostic products, biological preparations for laboratory purposes, biological preparations for pharmaceutical purposes, products for testing or diagnostic purposes.

4) The applicant subsequently filed a counterstatement denying the opponent's claims and putting it to strict proof of use.

5) On 3 September 2008, OHL filed an application for the revocation of the opponent's earlier mark that completed its registration procedure on 13 July 2001. OHL seeks complete revocation of the registration under Sections 46(1) (a) and (b) of the Act. It claims that the mark has not been put to genuine use in the United Kingdom, by the proprietor or with its consent, between 14 July 2001 and 13 July 2006 or between 2 May 2003 and 1 May 2008. Success for OHL would mean revocation taking effect on either 14 July 2006 or 2 May 2008.

6) The proprietor filed a counterstatement denying that the mark has not been put to genuine use in both of the above defined five year periods.

7) On 6 May 2008, OHL applied for an additional registration (no. 2486779) for the identical mark OPUS and in respect of virtually identical goods. On this occasion, its Class 10 specification does not include "artificial teeth", but is identical in all other respects to the specifications of its earlier mark. On the 24

November 2009, OHL filed a form TM21 and voluntarily removed *dietetic substances adapted for medical use, food for babies* from Class 5 and *artificial limbs, eyes; orthopaedic articles* from Class 10. The current specifications for this application are therefore:

Class 5

Sanitary preparations for medical purposes; plasters, materials for dressings; medical dressings; surgical dressings; balms for medical purposes; preparations used to form a barrier between the skin and other substances; preparations for use in enhancing the performance of dressings; preparations for removal of adhesive materials; preparations for use in relation to medical dressings; barrier creams; barrier creams for use in the protection of peristomal skin; absorbent preparations for medical use; superabsorbent preparations for use with ileostomy, colostomy and urostomy pouches; all of the aforesaid being for administration to humans.

Class 10

Suture materials; surgical sponges; medical devices for use in increasing the effectiveness of colostomy and ileostomy pouches; medical devices for use inside colostomy and ileostomy pouches.

8) No TM21 form has been filed in respect to OHL's earlier application and the Registry has made enquiries to confirm that this is the case.

9) During this time, Trinity-Chiesi Pharmaceuticals Ltd changed its name to Chiesi Ltd ("Chiesi") and subsequently filed notice of opposition to the application on virtually identical grounds to its opposition of OHL's earlier application.

10) Once again, OHL filed a counterstatement denying Chiesi's claims and putting it to strict proof of use.

11) All three sets of proceedings were subsequently consolidated and both sides filed evidence. Both sides ask for an award of costs. Neither side requested a hearing, but both sides provided written submissions in lieu of a hearing. After careful consideration of the papers, I give my decision.

Chiesi's Evidence

12) This consists of two witness statements by Nicholas Farrington who explains that he is Logistics Manager for Chiesi. His first witness statement is dated 3 September 2008 and the second, 8 December 2008. These are essentially identical, but one was filed in respect of the revocation action, the other in respect of the first opposition. I will summarise these together. Mr Farrington explains that he has been employed by Chiesi since 1995 as credit controller and

material manager before taking his present post. He states that Chiesi first used the OPUS mark in the UK sometime in 1995, but he has been unable to establish the exact date. He describes it as a house mark that identifies the “distributor trading identity OPUS PHARMACEUTICALS” which has been used by Chiesi “on many different pharmaceutical products since 1995” and as recently as June 2008.

13) Mr Farrington supports his comments with the following exhibits:

- Exhibit NF1 is an invoice dated 10 June 2008 and is for products totalling £22,134.20 plus VAT. Mr Farrington states that this invoice relates to products bearing the mark OPUS as well as the sub-brand MUSCINIL. There is no reference to OPUS on the invoice but the product code is recorded as OP\MUS\005\100 and the product description as MUSCINIL 5MG TABS X 100. Mr Farrington acknowledges that the invoice is dated after the end of the later relevant period but claims it is pertinent to demonstrate Chiesi’s continuing interest in the mark.
- Exhibit NF2 provides a further five copies of invoices for products sold under the OPUS mark, this time relating to dates that fall within both the relevant periods. The vendor is identified as Trinity Pharmaceuticals Ltd., that is, Mr Farrington states, a previous name of Chiesi. OPUS is not mentioned in these invoices. I note that some of the product codes begin with the letters OP. I assume that it is these products that he claims are sold under the house mark OPUS. Insofar as these invoices relate to products with such a code, their details are detailed below:

Date	Product Codes	Product	Total net amount of invoice	Net amount attributed to products with an OP product code
22 September 2003	OP\ANG\020\056 OP\LOF\025\084 OP\ZIL\375\028	ANGEZE 20MG TABS X 56 LOFENSAID 25MG TABS X 84 ZILEZE 3.75MG TABS X 28	£2,913.24	£193.80
16 February 2004	OP\ANG\020\056	ANGEZE 20MG TABS X 56	£1,814.47	£35.75
23 May 2003	OP\LOF\050\084	LOFENSAID 25MG TABS X 84	£69.18	£69.18
15 October 2003	OP\ZIL\375\028 OP\ZIL\375\028	ZILEZE 3.75MG TABS X 28 ZILEZE 3.75MG TABS X 28	£11.92	£11.92
27 August 2003	OP\ZIL\750\028	ZILEZE 7.5MG TABS X 28	£26.96	£26.96

- Mr Farrington states that Exhibit NF3 provides examples of packaging used on “some of the products identified” in the above listed invoices. Packaging for the ZILEZE, LOFENSAID and ANGEZE products are shown. These packages have a sign including the word OPUS appearing down the left-hand side of the front of the packaging that also bears the

distributor name “Opus Pharmaceuticals” and its address. An example of how the sign is used on the packaging is shown below:



OHL's Evidence

14) OHL filed evidence in the form of two virtually identical witness statements, dated 3 December 2008 and 27 February 2009, by Mr Stephen Antony White, Associate Director of Farncombe International Limited, a company providing intellectual property investigation services. The first was filed in support of OHL's revocation action, the second in support of OHL in the first opposition proceedings. He explains that, as a senior investigator with his company, he conducted investigations into the use of the mark OPUS for Boulton Wade Tennant in November 2007. Boulton Wade Tennant is OHL's representative in these proceedings. As part of this investigation, Mr White contacted Chiesi and spoke to Mr Nick Farrington. Mr White said the following about this contact:

“He said that Trinity originally had a trading livery called OPUS by which they sold products into the dispensing doctor market, “but that has since ceased to exist a number of years ago”. After some thought he said that this was “maybe four or five years actually”. He repeated that OPUS was “a dispensing doctor livery for Trinity but it no longer exists.””

Chiesi's Evidence

15) This takes the form of two further witness statements by Mr Farrington, dated 5 March and 8 June 2009. These are made in response to Mr White's identical witness statements and are also identical in content. I will therefore summarise them together.

16) Mr Farrington states that he cannot recall the precise details of the telephone conversation with Mr White. He states that use of the mark OPUS was wound down between 2004 and 2008, but that the mark was used again in 2008 (as detailed in NF1 of his previous witness statements) in part in response to a request from a major client for OPUS branded products. He further states that he was not aware of this intention to restart use at the time of the call with Mr White.

17) Mr Farrington does not recall that he said, to Mr White, that the OPUS mark had ceased to exist, "maybe four or five years [ago]". He says that, upon refreshing his memory from consulting sales records, it became clear to him that cessation of use did not occur until Spring 2004, only three and a half years prior to the phone conversation and that, as such, there is clear proof of use within the relevant five year periods.

DECISION

18) Chiesi has been put to strict proof of use by OHL in both of the opposition proceedings. Therefore, the Trade Marks (Proof of Use, etc) Regulations 2004 apply in these cases. The provision reads as follows:

"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 of a kind falling within section 6(1)(a), (b) or (ba) 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, ...

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

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services...”

19) Chiesi's mark was registered on 13 July 2001 and OHL's applications in suit were published on 7 December 2007 and 28 November 2008 respectively. The earlier mark was therefore registered more than five years before the publication of OHL's applications and, as such is subject to the proof of use requirements. The relevant period in which use must be shown is the five years ending with the respective dates of publication, namely 8 December 2002 to 7 December 2007 and 29 November 2003 and 28 November 2008.

20) Further, as a consequence of OHL's revocation action, Chiesi's must also demonstrate genuine use within the context of Section 46 of the Act.

21) Section 46 reads as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made. Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that——

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from——

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

22) Consideration has to be taken, also, of 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.”

Consequent upon section 100 the onus is upon the registered proprietor to prove that it has made use of the trade mark in suit, or that there are proper reasons for non-use.

23) The application for revocation is based on Sections 46(1) (a) and 46(1)(b). In *Philosophy di Alberta Ferretti Trade Mark* [2003] RPC 15, the Court of Appeal held that an application for revocation on the grounds of non-use may be made only after the five years following completion of the registration procedure has ended. The date for revocation cannot be less than five years from the date the registration procedure was completed. In *WIS/ Trade Mark* [2006] RPC 22, Geoffrey Hobbs QC, sitting as the Appointed Person said:

“...This permits revocation with effect from the day following the fifth anniversary of completion of the registration procedure in the case of an application which succeeds under s.46(1)(a) and with effect from any subsequent date at which there has been suspension of use for an uninterrupted period of five years in the case of an application which succeeds under s.46(1)(b).”

24) Therefore, and as OHL claimed in its application for revocation, I have to consider whether there was genuine use in the UK of OPUS, for all or any of the goods for which it is registered, by the proprietor or with his consent between 14 July 2001 and 13 July 2006 and between 2 May 2003 and 1 May 2008.

25) I intend to consider the issue of genuine use, both in the context of the two opposition proceedings and in the context of the revocation, as a single issue. In doing so, I am mindful that there are four distinct but overlapping relevant five year periods, namely, 8 December 2002 to 7 December 2007 and 29 November 2003 to 28 November 2008 in respect of the opposition proceedings and 14 July 2001 to 13 July 2006 and 2 May 2003 to 1 May 2008 in respect of the revocation action.

26) The basis of what constitutes genuine use was decided by the European Court of Justice (ECJ) in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] ETMR 85 at paragraph 47:

“1. Article 12(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that there is “genuine use” of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark that is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

27) In *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38, the ECJ considered the extent of use, the amount of use and the types of use that can be considered when deciding whether there has been genuine use of a trade mark:

“20. It follows from those considerations that the preservation by a trade mark proprietor of his rights is predicated on the mark being put to genuine use in the course of trade, on the market for the goods or services for which it was registered in the Member State concerned.

21. Moreover, it is clear from paragraph 39 of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive, even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to be justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case-by-case assessment which is for the national court to carry out. The

characteristics of those products and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical products or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account.

23. Similarly, as emerges from paragraphs 35 to 39 of *Ansul* set out above, the characteristics of the market concerned, which directly affect the marketing strategy of the proprietor of the mark, may also be taken into account in assessing genuine use of the mark.

24. In addition, use of the mark by a single client which imports the products for which the mark is registered can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor of the mark.”

28) In *Laboratoires Goemar S.A. v La Mer Technology Inc* [2005] ETMR 114, Neuberger LJ held that:

“45 The notion that the use of the trade mark must be substantial or significant before it qualifies as "genuine" seems to me to run into two difficulties in any event. The first is that it does not involve attributing the word "genuine" its natural meaning, although this point of course potentially substantially weakened by the fact that the equivalent word used in the text in Art.10 in other languages may carry with it a slightly different meaning.

46 Secondly, once one imposes a requirement of significance or substantiality, it becomes potentially difficult, time-consuming, and expensive to decide whether, in any particular case, that requirement is satisfied. In this connection, Mr Tritton made a fair point when he suggested that the introduction of a test of significant use could lead to detailed arguments about the precise nature and extent of the market in which a particular trade mark is to be used, as well as a detailed enquiry in many cases as to the precise nature and extent of the use of the particular mark over the relevant five-year period. I do not regard that as a particularly desirable outcome.

47 Although the use of the instant mark within the jurisdiction can be said to be close to exiguous, I do not think it could be characterised as *de minimis*. Even if it could be so characterised, I do not consider that that concept would be a useful or helpful one to invoke or apply, even if it had not been effectively ruled out by the European Court.

48 I turn to the suggestion, which appears to have found favour with the judge, that in order to be "genuine", the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is

used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the Directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be "consistent with the essential function of a trade mark" as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the Directive will be established.

49 A wholesale purchaser of goods bearing a particular trade mark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler."

29) Further, in *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-416/04 P the ECJ stated:

"72 It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order in *La Mer Technology*, paragraph 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of this judgment, even minimal use of the trade mark can be sufficient to establish genuine use (order in *La Mer Technology*, paragraph 27)."

30) Taking account of this guidance from the courts it is clear that genuine use does not need to be quantitatively significant and that when asking if the use is sufficient it is necessary to assess all surrounding circumstances. On the face of it, the evidence presented by Chiesi appears to establish a trading presence on the relevant market although this presence is far from overwhelming. The invoices submitted relate to five transactions of three distinct products, sold between 23 May 2003 and 16 February 2004 and total sales of only £337.61. All five transactions took place during the earlier three relevant periods. However, four of these five transactions took place before the start of the latest relevant period (which begins on 29 November 2003). However, Mr Farrington states that the mark has been used since 1995 and as recently as June 2008. This latter sale is within the latest relevant period. Further, it is also only one month after the end of the later of the two relevant periods in the revocation action and relates to

a net amount of £22134.20. Preparations for this significantly larger sale are likely to have been underway within this relevant period and would, to my mind, support a claim of genuine use during that period.

31) This use is not internal to Chiesi, nor is it merely token. It is sufficient, as represented by the evidence, to have created or maintained a share in the relevant market and therefore can be viewed as warranted. This use has been demonstrated over a period of time that spans all four of the relevant periods identified earlier. However, the earlier mark can only be relied upon to the extent that it has been used. This requires an assessment of both the form in which the mark has been used and the goods on which it has been used in respect of.

Use of the mark as registered

32) It is established case law that to qualify as genuine, use of a mark must be in the form registered or in a form which does not alter the distinctive character of the mark in the form in which it is registered. The leading English authority on the issue is the Court of Appeal decision in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc (BUD)* [2003] RPC 25. This court of appeal decision provides me with some guidance on how to approach this issue:

“.....The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

33) More recently, the same issue has been considered by both the Court of First Instance (CFI) and the ECJ. These cases have been reviewed by Richard Arnold QC, sitting as Appointed Person, in *NIRVANA Trade Mark* (BL O/262/06) and *REMUS Trade Mark* (BL O/061/08). He summarised his review in *NIRVANA* (and reiterated it in *REMUS*) in the following way:

“33. The first question is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period....

34. The second question is whether the sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all...”

34) In the *NIRVANA* and *REMUS* cases, Mr Arnold was considering whether use of a mark that consisted of two distinct words was sufficient to demonstrate use of only one of those words. Therefore, the circumstances of those cases are slightly different to both this current case and that of the *BUD* case. Nevertheless, the general principals as summarized by Mr Arnold are relevant here.

35) The registered mark is the word *OPUS* in ordinary typeface. There is no embellishment or additional material and it follows that its distinctive character resides in the word alone.

36) The marks shown in the evidence, all consist of the letters O, P, U and S appearing individually in squares. These squares appear in three different arrangements, two of which can be seen in the representation in my earlier paragraph 13. The first of these, which can be seen in this representation, is where two squares appear side by side and directly above two further squares. The top two squares contain the letters O and P respectively and the bottom two contain the letters U and S. All these elements are shown in pastel blue and mauve. The differences, between this version and the mark as registered, is the addition of the four squares, the colour and also the arrangement of the letters so that the first two appear above the second two. The differences are such as to make the identification of the word *OPUS* far from obvious. This is exacerbated by the fact that the pastel blue coloured letter U appearing in a pastel mauve coloured square, makes the letter quite difficult to pick out of the mark. This, combined with the fact that the letters do not appear alongside each other in a linear way, result in a mark where the word *OPUS* is not prominent or obvious. Taking all of this into account, I find that the differences are such as to change the distinctive character of the mark, as registered.

37) The second mark consists of the mark, as described above, being repeated three times, with each four squares repeat appearing below the next. In addition, there is a further set of four squares below and in a line of four. Here the letters O, P, U and S appear side by side and the word *OPUS* can be seen. The overall configuration of the squares forms an L-shape, with the word *OPUS* appearing in the horizontal arm of the letter L. Here, the word *OPUS* is more clearly an identifiable element of the mark. It differs from the mark, as registered, in that it has sixteen separate square elements, each containing one of the letters O, P, U or S. The orientation of these squares creates the L-shape that also provides a point of difference as does the use of the two pastel colours identified earlier. The word *OPUS*, however, is instantly recognisable, despite it, and the rest of the mark, being similarly affected by the colours used, as in the first mark discussed above. Taking all of this into account, I consider these points of difference to be insufficient to alter the registered mark's distinctive character, and I therefore, accept the exhibits as being an illustration of genuine use of the mark as registered.

38) The third mark, shown in the representation at paragraph 13, is of a similar arrangement to the second, but differs in that the four letters O, P, U and S appear in a line together in a different place. Here, the fifth of six pairs of squares has an additional two squares alongside and it is these four squares where the word OPUS is clearly visible. In the second mark, the two additional squares appeared alongside the seventh and last pair of squares. To my mind, this does not introduce any significant difference between the second and third variations of the mark and I find that this version also, serves as use of the mark as registered.

39) I should add that the packaging presented as evidence of use does include, on the back, the name and address of the distributor. This distributor, as Chiesi stated earlier, is called "Opus Pharmaceuticals". This existence of this name, albeit in small print on the back of the packaging, may additionally have the effect of alerting the consumer to the word OPUS in the marks as used.

40) In summary, I find that the mark used does not alter the distinctive character of the mark as registered and it therefore serves to demonstrate genuine use of that mark. This use relates to time periods that cover all four relevant periods in these consolidated proceedings.

Fair specification

41) There is an additional issue that I must address. Chiesi's mark is registered for *pharmaceutical preparations and substances*, albeit with some limitation. This covers a wide range of goods and I must decide if the evidence reflects use on such a wide range of goods and if not, what would be a fair specification. I, therefore, move on to consider the scope of goods that use has been shown. In doing so, I keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

"29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the

specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. 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 s.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."

42) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pedantic way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same

mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

43) Finally, I am also mindful of the guidance provided by *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (ALADIN)* Case T-126/03:

"42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

...

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

44) The evidence submitted by Chiesi illustrates the OPUS mark being used in respect of three pharmaceutical products, namely ZILEZE, LOFENSAID and ANGEZE. In its written submissions, it explains that these are NSAIDs, antimuscarinics and isosorbide mononitrate and that these are used to treat a range of conditions such as insomnia, angina, inflammation [sic? – inflammation?] and fever. Chiesi contend that use in respect of such a wide range of products is

consistent with the mark's position as a house mark and should permit the registration to stand in an un-amended form.

45) OHL, in its written submissions, contends that the evidence does not demonstrate any use, but as an alternative argument, it contends that even if I find that there has been genuine use, it is only in respect of *prescription medication for human oral use, in tablet form*. I assume such a limitation is suggested as a result, at least in part, of the telephone conversation between Mr White and Mr Farrington where Mr White attributes comments to Mr Farrington to the extent that he said that OPUS products were sold "into the dispensing doctor market". Chiesi's evidence is unclear on this point, but nevertheless it has not challenged Mr White's comments on this point and as such I accept that this is the case.

46) The term *pharmaceutical preparations and substances*, whilst with some limitations, is broad and covers a very wide range of products. Chiesi demonstrated use in respect of pharmaceuticals for use in the treatment of insomnia, angina, inflammation [sic? – inflammation?] and fever and, based upon Mr Farrington's alleged comments, are available only to the dispensing doctor market. Applying the guidance provided by the above quoted case law, does such use permit Chiesi to retain its current wide specification? The medical trade is familiar with sub-dividing *pharmaceutical preparations* into smaller categories and it is common to describe them by reference to their active ingredients or to their purpose. Chiesi has provided information regarding both of these, demonstrating use in respect of, what appears to be, three or four diverse products. Whilst this evidence is far from overwhelming, when applying the guidance provided by the courts, particularly that provided in *ALADIN*, I believe it would be appropriate to permit Chiesi to retain a specification for *pharmaceutical preparations and substances, all for human use* (together with the current exclusion).

47) Having reached this conclusion, I need to go on to consider if such goods should be limited to being only available on prescription, as OHL contend. Chiesi appear to concede (in that they have not contested OHL's claim) that its goods are sold "into the dispensing doctor market". A restriction to goods being provided in this way does not appear to be an overly restrictive approach, with the pharmaceutical market often making such a distinction. Taking all of this into account, I believe that a restriction on Chiesi's goods all "being available only on prescription" would be appropriate.

48) Finally, OHL also contend that Chiesi's goods should be limited to being in tablet form. It is common for pharmaceuticals to be available in different forms, for example, in tablet, powder or liquid form and in light of Chiesi demonstrating use in respect of pharmaceuticals that have diverse applications it would not be appropriate to restrict its specification to goods provided only in tablet form,

anymore than it would be to limit to only those applications. I believe such an approach is consistent with the guidance set out in ALADIN.

49) Taking all of these findings into account, for the purposes of comparison with OHL's goods, Chiesi's specification of goods should read:

*Pharmaceutical preparations and substances, all for human use, **and being available only on prescription** but not including diagnostic products, biological preparations for laboratory purposes, biological preparations for pharmaceutical purposes, products for testing or diagnostic purposes.*

Summary of findings in respect of proof of use

50) I have found there is use of Chiesi's mark, as registered, during all four relevant periods. Such use is in respect of a list of goods as set out in paragraph 49 above. It, therefore, has an earlier right on which it can rely for both its oppositions to OHL's applications. OHL's revocation action is successful, but only insofar as I have limited Chiesi's specification of goods in paragraph 49. I will therefore proceed to consider the merits of the two sets of opposition proceedings.

Section 5(1) and Section 5(2) (a)

51) I find it convenient to consider both grounds for opposition together. The relevant parts of Section 5 read:

“(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

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

...,

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

52) 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) 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.”

53) Chiesi relies upon one earlier right, namely no. 2204467. This was registered 13 July 2001 and therefore qualifies as an earlier mark as defined by Section 6 of the Act.

54) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law 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 B.V.* [2000] FSR. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723. It is clear from these cases that:

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

(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) 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*,

(d) 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*,

(e) in determining whether similarity between the goods or services covered by two 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*,

(f) 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*,

(g) 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*,

(h) 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.*

Comparison of the marks

55) It is established by the relevant case law that it is the mark as registered that must be compared with the applicant's mark and not the mark as used. To do so would lead to unlawful extension of the protection enjoyed by the proprietor of an earlier mark which is the basis of an opposition to registration; *Devinlec Développement Innovation Leclerc SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, paragraph 66, Case T-147/03. The CFI made such a finding in respect of opposition proceedings under the Community Trade Mark Regulations, but can apply equally to the circumstances in the current case. The comparison is therefore between the identical words OPUS without any additional matter or embellishment. These are self-evidently identical and I do not detect any dissent in the evidence and submissions, from either party, on this point.

Comparison of the goods

56) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

57) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

58) Chiesi, in its grounds of opposition and in its submissions contends that OHL's Class 5 and Class 10 goods are the same or similar to its *pharmaceutical preparations and substances for human use*, but does not elaborate on why this is the case. For convenience, I reproduce the wider of OHL's two Class 5 specifications and Class 10 specifications of goods below and I will consider the issue of similarity based upon these:

Sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; medical dressings; surgical dressings; balms for medical purposes; preparations used to form a barrier between the skin and other substances; preparations for use in enhancing the performance of dressings; preparations for removal of adhesive materials; preparations for use in relation to medical dressings; barrier creams; barrier creams for use in the protection of peristomal skin; absorbent preparations for medical use; superabsorbent preparations for use with ileostomy, colostomy and urostomy pouches; all of the aforesaid being for administration to humans

Artificial limbs, eyes and teeth; orthopaedic articles; suture materials; surgical sponges; medical devices for use in increasing the effectiveness of colostomy and ileostomy pouches; medical devices for use inside colostomy and ileostomy pouches.

59) Chiesi's *pharmaceutical preparations and substances*, whilst with limitations (as detailed in paragraph 49), still constitutes a broad category of goods covering a wide range of preparations and substances used in the treatment, prevention, or diagnosis of illness, disease and injury. I bear in mind the limitations to Chiesi's specification as detailed in paragraph 49, but I will only refer to them where, and if, I find such limitations affect my analysis. With this in mind, firstly I will consider OHL's *preparations for use in enhancing the performance of dressings; preparations for use in relation to medical dressings*. The broad term *pharmaceutical preparations* can include preparations that are pharmaceutical in nature and with the purpose of enhancing the performance of dressings or for use in relation to medical dressings. Therefore, it follows that OHL's term overlaps with Chiesi's goods. Such an overlap is sufficient to find that there is identity of goods.

60) Next, I shall consider OHL's *sanitary preparations for medical purposes; balms for medical purposes; dietetic substances adapted for medical use; preparations used to form a barrier between the skin and other substances; preparations for removal of adhesive materials; barrier creams; barrier creams for use in the protection of peristomal skin; absorbent preparations for medical use; superabsorbent preparations for use with ileostomy, colostomy and urostomy pouches; all of the aforesaid being for administration to humans*. The end user is likely to be the same as for pharmaceutical preparations, namely a person who has a health problem requiring diagnosis or treatment. The method

of use may be the same, ingestion in the case of dietetic substances and also for many pharmaceutical preparations. Other pharmaceutical preparations may, similarly to sanitary preparations and balms for example, be applied or sprayed externally. It is likely that sanitary preparations and balms could be used to complement pharmaceutical preparations in certain treatments or even as alternative treatments having the same objective. The channels of trade are likely to be the same in that they are all likely to be available through pharmacies. I conclude that these products share a reasonably high level of similarity to Chiesi's pharmaceutical preparations.

61) Next I shall turn to *plasters, materials for dressings; medical dressings; surgical dressings*. These goods have the same intended purpose as pharmaceutical preparations and substances in that they treat human health problems. The end users will accordingly be the same, namely people requiring to be treated. Their method of use is on the face of it different, being stuck or applied to the body rather than, in the main, ingested or applied externally (in the case of ointments) or sprayed. They are not complementary in the sense that they are closely connected in the sense that one is indispensable or important for the use of the other; *Sergio Rossi SpA v OHIM – Sissi Rossi [SISSI ROSSI]*, Case T-169/03. That said, as many human health problems involve a combined treatment of pharmaceutical preparations and plasters and dressings, the relevant public may be exposed to both marks in the same circumstances. They are not, on the face of it, in competition with pharmaceutical preparations. The respective channels of trade may be the same in that they are sold in pharmacies. Taking all of this into account, my conclusion is that these products share a moderate level of similarity to Chiesi's goods.

62) OHL's *food for babies* shares no obvious similarity to pharmaceutical preparations and substances. The intended purpose of such goods is to provide sustenance and maintain nutritional balance for babies rather than a medical treatment and is therefore different to that of *pharmaceutical preparations* where the intended purpose is, as I have already said, to treat health problems. *Pharmaceutical preparations*, if for ingestion, are normally in tablet or liquid form and this is different to the nature of food for babies which is in the form of a packaged meal or snack. They are not complementary, in the sense identified in SISSI ROSSI or in competition with each other. There is no obvious commonality in respect of trade channels. Even where baby food is sold in a pharmacy, it is displayed in its own discrete area. Finally, there may be some overlap in end users as babies, or more precisely adults responsible for babies, may also require pharmaceutical preparations for those babies. Nevertheless, taking all these points together, I conclude that there is no similarity between these goods.

63) OHL's Class 10 goods are all for use in, or closely related to the medical field. The goods therefore share the same purpose, which is treatment of illness or other medical conditions. However, their respective natures are different with OHL's goods being artificial body parts or medical articles or devices whereas Chiesi's goods are in the form of preparations or substances. All of OHL's goods

are specialist medical products and it is likely that these would only be available from specialist outlets and predominantly for members of the medical profession who will also be a relevant consumer for Chiesi's goods. It is less clear if there are further similarities in trade channels, but the respective goods may be produced by the same undertakings. Further, there is not any obvious complementarity in the sense identified in *SISSI ROSSI*. That said, *pharmaceutical preparations* may be used in the treatment of persons fitted with colostomy and ileostomy pouches, for example. In summary, I find that the respective goods share a moderate level of similarity.

The average consumer

64) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods at issue. I have found that Chiesi's goods are sold only through prescription. Here, highly attentive healthcare professionals influence or determine the choice of product by or on behalf of the end-user, but this should not rule out the possibility that the end user should be included as a relevant consumer with an active, rather than passive, role in the acquisition process (see paragraphs 57-63 of *Case C-412/05P Alcon Inc v OHIM and Biofarma SA* ("*Alcon*").).

65) Regarding OHL's goods, there is no indication that its Class 5 goods are available only on prescription or only for specialised use by medical professionals, I must take into account that they could be purchased over the counter or from the shelf in a pharmacy or even a supermarket by the general public and may be of low cost. I therefore take the average consumer to be *both* end user (as per the *Alcon* case) and healthcare professionals, such as doctors, pharmacists and pharmaceutical wholesalers and distributors. It is appreciated that this does not represent a single, homogenous group of customers but allows for a varying degree of knowledge and brand discrimination. Medical professionals will be at one end of the spectrum and ordinary members of the public at the other.

66) In respect to OHL's Class 10 goods, their nature suggests that they are predominantly available to specialist medical professionals where the purchasing act will be well considered and based upon a greater knowledge of the industry compared to consumers from the general public.

Distinctive character of the earlier trade mark

67) I have to consider whether Chiesi's mark has a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of it. The mark consists of the word OPUS meaning a musical

composition¹. It has no meaning in respect to Chiesi's goods and it therefore has a reasonably high level of inherent distinctive character, but not the highest level that would exist in a made up word for example.

68) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. Chiesi has provided evidence of a small amount of use of the mark but such a modest level is insufficient to demonstrate that it has established any significant reputation in respect of the mark. The reasonably high level of inherent distinctive character is therefore not enhanced through Chiesi's use of the mark.

Likelihood of confusion

69) Of course, Section 5(1) of the Act does not require there to be a likelihood of confusion. For an opposition to succeed, it merely requires that the respective marks are identical and are in respect of identical goods. I have found that the respective marks are identical and that OHL's *preparations for use in enhancing the performance of dressings; preparations for use in relation to medical dressings* are identical to Chiesi's goods. It follows that the grounds for oppositions based upon Section 5(1) are successful insofar as they apply to these goods (listed in both of OHL's applications), but are unsuccessful in respect of all other of OHL's goods.

70) Next, I shall consider Chiesi's ground for opposition based upon Section 5(2)(a) of the Act. I must adopt the global approach advocated by case law and take account of all the relevant factors. To summarise my findings, I have found that:

- the average consumer for the respective goods can, in some instances, be the specialist consumer in the form of medical professionals, but many of the respective goods may also include the less knowledgeable general public;
- the marks are identical;
- Chiesi's mark enjoys a reasonably high level of distinctive character;
- OHL's *Sanitary preparations for medical purposes; balms for medical purposes; dietetic substances adapted for medical use; preparations used to form a barrier between the skin and other substances; preparations for removal of adhesive materials; barrier creams; barrier creams for use in the protection of peristomal skin; absorbent preparations for medical use; superabsorbent preparations for use with ileostomy, colostomy and*

¹ "opus n." *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 20 January 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e39661>>

- urostomy pouches; all of the aforesaid being for administration to humans* share a reasonably high level of similarity with Chiesi's goods;
- OHL's *plasters, materials for dressings; medical dressings; surgical dressings* share a moderate level of similarity with Chiesi's goods;
 - There is no similarity between OHL's *food for babies* and Chiesi's goods;
 - In respect of OHL's *[a]rtificial limbs, eyes and teeth; orthopaedic articles; suture materials; surgical sponges; medical devices for use in increasing the effectiveness of colostomy and ileostomy pouches; medical devices for use inside colostomy and ileostomy pouches*, there is a moderate level of similarity to Chiesi's goods.

71) Firstly, in light of the guidance provided by the ECJ in *Waterford Wedgwood plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-398/07, paragraph 34, that a finding of likelihood of confusion presupposes that the goods or services covered are identical or similar. It follows, as a natural consequence of this, that where I have found that there is no similarity between the respective goods, there is no likelihood of confusion. This is the case in respect of OHL's *food for babies* in Class 5.

72) Next, given that the respective marks are identical, that there is a reasonably high level of similarity between the respective goods and that the nature of the purchasing act and relevant consumer can be the same, I find there will be a likelihood of direct confusion between Chiesi's goods and the following of OHL's goods:

Sanitary preparations for medical purposes; balms for medical purposes; dietetic substances adapted for medical use; preparations used to form a barrier between the skin and other substances; preparations for removal of adhesive materials; barrier creams; barrier creams for use in the protection of peristomal skin; absorbent preparations for medical use; superabsorbent preparations for use with ileostomy, colostomy and urostomy pouches; all of the aforesaid being for administration to humans

73) In respect of these goods, I find that the consumer will, upon seeing the mark OPUS used in conjunction with the respective goods, assume that they originate from the same undertaking.

74) Finally, in respect of OHL's *plasters, materials for dressings; medical dressings; surgical dressings* in Class 5 and all of its Class 10 goods, here I found only a moderate level of similarity between the respective goods. Nevertheless, taking account of all the other factors such as the identity of the marks, the trade channels, relevant consumer and the nature of the purchasing act, I find that there is also a likelihood of confusion in respect of these goods.

Once again, the consumer, even the specialist and knowledgeable medical professional, upon seeing the mark OPUS used in respect of these goods will assume that they originate from the same undertaking.

75) I should add that these finding would not be disturbed if I had allowed Chiesi's specification of goods, as registered, to stand. The limitation to *being available only on prescription*, imposed as a consequence of my finding regarding genuine use, has not resulted in any different outcome, than I would have reached in the absence of such a limitation, regarding my analysis of likelihood of confusion.

76) In summary, in respect of OHL's application no. 2382118, Chiesi's opposition is successful against all of the goods listed except *food for babies*. In respect of OHL's application no. 2486779, Chiesi's opposition is successful in its entirety.

COSTS

77) OHL's revocation action against Chiesi's mark has been partially successful. However, Chiesi has been wholly successful in one of its oppositions and in the overriding majority of its other opposition to OHL's two applications. Therefore, on balance, the outcome of these consolidated proceedings favours Chiesi who is entitled to a contribution towards its costs. In its written submissions, Chiesi argues that consideration should be given to departing from the scale of costs because the revocation action and second opposed application need not have been filed and therefore need not have been contested. I am not persuaded by this argument. OHL achieved a measure of success in its revocation action and certainly had an arguable case for pursuing the action. In regard to the second of OHL's applications and Chiesi's subsequent opposition, as this has been consolidated with the other proceedings, the additional cost of this action to Chiesi was essentially limited to the official fee required to commence this second opposition. Such additional cost can be dealt with within the normal scale. The award costs is therefore made with due notice to the published scale.

78) Therefore, taking account of the fact that all three sets of proceedings were consolidated, no hearing has taken place but that Chiesi did file written submissions in lieu of attendance. I award costs on the following basis:

Notice of Opposition x 2 and Application to revoke	£700
Preparing evidence & considering other sides evidence	£800
Filing written submissions	£400
TOTAL	£1900

79) I order Opus Healthcare Limited to pay Chiesi Limited the sum of £1900. 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 27 day of January 2010

**Mark Bryant
For the Registrar,
the Comptroller-General**