

O-345-12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2573471**

**BY**

**MERCK CONSUMER HEALTHCARE LIMITED**

**TO REGISTER THE TRADE MARK:**

The logo for PROSportflex features the word "PRO" in a bold, dark blue, sans-serif font. The letter "O" is replaced by a white circle with a dark blue dot in the center, resembling a stylized eye or a target. To the right of "PRO", the word "Sportflex" is written in a lighter blue, sans-serif font. The "Sport" part is in a standard weight, while "flex" is in a bolder weight.

**IN CLASSES 5 AND 29**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 102352**

**BY**

**LRC PRODUCTS LIMITED**

1) An application to register the trade mark:



was filed on 25 February 2011 by Merck Consumer Healthcare Limited (Merck). The application was published on 3 June 2011. The application is for:

*preparations included in class 5 consisting of vitamins and/or minerals; nutritional supplements; vitamins, minerals and mineral salts; oils and fats and derivatives of oils and fats; cod liver oil;*

*preparations made or derived from seafood; nutritional supplements; edible oils and edible fats; foodstuffs containing oils or fats.*

The above goods are in classes 5 and 29 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) LRC Products Limited (LRC) has opposed the registration of the trade mark. LRC relies upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

3) Section 5(2)(b) of the Act states:

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

.....

(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.”

Section 5(3) of the Act states:

“(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.”

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

“4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

4) In relation to sections 5(2)(b) and 5(3) of the Act LRC relies upon 2 United Kingdom trade mark registrations:

- No 1395996 of the trade mark PROSPORT. The application for registration was filed on 16 August 1989 and the registration procedure was completed on 19 April 1991. The trade mark is registered for:

*bandages (other than elastic support bandages) and materials prepared for bandaging; surgical stockinette, plasters and dressings, all for surgical and medical use; analgesic balms; embrocations; liniments; rubifacients for medical purposes; all for use in sporting activities; all included in Class 5.*

- No 1395997 of the trade mark PROSPORT. The application for registration was filed on 16 August 1989 and the registration procedure was completed on 20 March 1992. The trade mark is registered for :

*support bandages and elastic bandages; all for use in sporting activities; all included in Class 10.*

The application was advertised before acceptance under the provisions of section 18(1) of the Trade Marks Act 1938.

Both registrations are subject to the proof of genuine use, as per section 6A of the Act.<sup>1</sup> LRC claims that it has made genuine use of the trade mark in respect of all of the goods for which they are registered in the period 4 June 2006 and 3 June 2011. It also claims, for the purposes of section 5(3) of the Act, that it has a reputation in respect of all of the goods of the registrations. In relation to section 5(3) of the Act LRC claims that use of the trade mark of Merck would take unfair advantage of the distinctive character and repute of its trade marks. It claims that it would lose the opportunity to license third parties to use its trade marks in respect of the goods of the application.

5) Under section 5(4)(a) of the Act, LRC claims that it has used the sign PROSPORT in the United Kingdom since January 1984 in respect of:

*bandages (other than elastic support bandages) and materials prepared for bandaging; surgical stockinette, plasters and dressings, all for surgical and medical use; analgesic balms; embrocations; liniments; rubifacients for medical purposes; support bandages, elastic bandages.*

6) Merck filed a counterstatement in which it denies all of the grounds of opposition and puts LRC to proof in respect of all of the claims that it has made. It denies that the respective trade marks are similar and that the respective goods are identical or similar.

7) Both parties filed evidence and written submissions. Neither party requested a hearing.

8) In relation to the second round of evidence filed by LRC, Merck wrote that it did not consider that the aforesaid evidence was evidence in reply and that it should have been filed as part of LRC's evidence in chief. It requested the register to "re-consider" the evidence. LRC responded that the evidence it had filed is intended to rebut parts of the evidence of Merck. Most of the evidence filed in the second round does not fall into the parameters for evidence in reply as per *Peckitt's Application* [1999] RPC 337. However, it is considered appropriate to take the evidence into account and to give it appropriate weight.

*First round of evidence for LRC*

*Witness statement of Claire Etain Wood*

9) Ms Wood states that PROSPORT has been used by LRC, or its predecessors in title or licensees, since 1983. Ms Wood states that exhibit CEW2 shows the range of goods upon which the trade mark was used originally. There is no indication as to the date that this exhibit was produced. It was produced by the Seton Group of Companies. ProSport is used in a stylised fashion and in a standard font and there is a strap line of "Whatever the sport!". The goods shown are knee, ankle, wrist, back, athletic and cricket supports, foam tubes for fingers and toes, muscular relief spray, warm-up rub, muscular massage cream and webbing. Exhibited at CEW3 are pictures of packaging from when the goods were supplied by Seton. There is no indication of the date from which the packaging emanates; however, as various examples have pictures of the former footballer Bryan Robson it would appear that they emanate from the early 1990s.

10) Ms Wood states that sales of PROSPORT products from 1983 to 1990 were (in chronological order): £200,000, £400,000, £450,000, £550,000, £700,000, £700,000, £650,000 and £600,000. Ms Wood states that she has been advised that current sales of PROSPORT products are in excess of £100,000 per annum. Exhibited at CEW4 is historic advertising for PROSPORT products. On one example, winter 1987 appears. The products are all promoted for sporting purposes. A picture of a display shelf at page 118 shows use in relation to sprays and creams. The packing all bears the name ProSport in a stylised fashion. Exhibited at CEW5 are what Ms Wood describes as examples of LRC's most recent product packaging. This all emanates from 19 December 2011 and so after the material period for proof of use and the date the date of application for registration. The products shown are: Scholl ProSport elasticated knee support, elasticated ankle support and elasticated elbow support. Exhibited at CEW6 are screenshots from amazon.co.uk and sainsburys.co.uk. These show the same Scholl ProSport products and athletic/cricket supports and wrist supports. Ms Wood also describes this exhibit as showing the most recent manifestation of the packaging and so the matter appears to emanate from after the last material date; there is certainly nothing that indicates that it emanates from on or before 3 June 2011.

11) Exhibited at CEW7 are screenshots from web.archive.org. Pages from scholl.com on 28 January 2011 show Scholl ProSport elasticated knee support, elasticated ankle support and elasticated elbow support. A page from prospord.com on 9 March 2009 describes ProSport as "The UK's No 1 brand in sport supports". Other pages from the same website from 2008 and 2009 show elasticated ankle, elbow, wrist and knee supports and elasticated athletic/cricket supports. The products are promoted as being suitable for both sporting activities and for everyday use.

12) Exhibited at CEW8 are redacted copies of invoices issued by SSL International plc dated 10 February 2010, 2 July 2010, 1 October 2010, 2 December 2010, 10 January 2011 and 21 March 2011. These show sales of ProSport “elast knee”, “elast ankle” and “elast wrist”.

13) Exhibited at CEW9 are screenshots and a downloaded page (on 28 November 2011) from the website seven-seas.com; which Ms Wood states is owned or controlled by Merck; these show Seven Seas JointCare ProSportflex, which is designed for “support energy release, metabolism and muscle function”. The Internet user is advised that “exercise helps keep you healthy but requires your joints to work hard” and that the product contains “Glucosamine and Chondroitin for smooth movement and the partial construction of joint tissue”. Exhibited at CEW10 are copies of video promotions for Seven Seas JointCare ProSportflex; two of which relate to golf and one to running.

14) Exhibited at CEW11 is a Wikipedia entry relating to Virgin Group.

15) Exhibited at CEW12 are extracts from *Complete Family Health Encyclopaedia* (second edition of 1995) and *Complete Family Health Guide New Medicine* (published 2005). At page 223 of the exhibit there is a definition of bandage, which advises that one of the uses of a bandage is to support a sprain or strain. The extracts also relate to cartilage, joints, sprains, sports injuries and osteoarthritis. At page 232 there is comment upon the use of nutritional therapy in relation to sports injuries, including chondroitin and glucosamine which “may help recovery from cartilage, ligament or tendon damage”.

#### *Evidence for Merck*

#### *Witness statement of Nicholas Guy Fraser*

16) Mr Fraser is the company secretary of Merck.

17) Mr Fraser gives evidence about the Seven Seas Jointcare products. He states that the Jointcare products are designed to help keep joints supple and flexible. Mr Fraser states that PROSportflex is a tertiary trade mark. (It is not pertinent that in use the trade mark is used with two other trade marks. The opposition has to be considered on the basis of the application.) Mr Fraser states that the product is directed at people who are engaged in professional and serious amateur sport. Mr Fraser states that the PROSportflex product evolved from Merck’s previous SPORTFLEX product. He exhibits at NF4 a copy of a promotional leaflet for Seven Seas NeutraTaste SportFlex which he states was distributed at the launch of the product in late 2002. The trade mark SPORTFLEX is registered in the United Kingdom under registration no 2293069 for goods in classes 5 and 29. Mr Fraser gives further evidence about the SPORTFLEX brand. (This is not pertinent. LRC is not objecting to the trade mark SPORTFLEX but to the trade mark the subject of the application.) Mr

Fraser states that it was decided in 2010 to relaunch the SPORTFLEX product in 2011 as PROSportflex, Pro being to connote professional. He exhibits at NF14 a promotional advertisement for Seven Seas Jointcare PROSportflex for Tesco. Exhibited at NF15 is a page from a Powerpoint® presentation for the promotion of the brand, which is targeted around golf.

*Second witness statement of Claire Etain Wood*

18) Exhibited at CEW13 is a copy of the notification from the Intellectual Property Office to LRC that Merck's trade mark may be identical or similar to its earlier trade mark.

19) Exhibited at CEW14 are copies of customer reviews of ProSport knee, ankle and elbow supports emanating from January 2010, May 2010, February 2011, September 2011, October 2011, November 2011 and May 2012. Where the packaging can be seen it bears the name Scholl. Exhibit CEW15 consists of printouts downloaded on 23 April 2012, so considerably after the date of application, of trade marks that include flex, or in one case flexi, for joint care tablets. However, page 255 shows that FlexiHerb was first available at Amazon.co.uk on 27 April 2009, page 257 and that FlexNow was first available at Amazon.co.uk on 23 November 2010. The other two products were first available at Amazon.co.uk after the date of application. There is no indication as to when the Optiflex product first became available. Exhibited at CEW16 are pictures of bottles of cod liver oil and chelated copper. Exhibited at CEW17 are pictures of a container of Flexible! cod liver oil from Sainsbury's. Ms Wood notes that the packaging of the cod liver oil products refer to maintaining bones or supple and flexible joints and that the chelated copper assists with the maintenance of healthy bones and joints.

20) Exhibited at CEW18 are extracts from *Complete Family Health Encyclopaedia* (second edition of 1995), part of this was exhibited with Ms Wood's first statement. Included in the material is matter relating to vitamins and the definition of a compress. Exhibited at CEW19 are extracts from *Complete Family Health Guide New Medicine* (published 2005) in relation to bursitis and osteoarthritis and the treatments for such conditions. Omega 3 fatty acids may be used as therapy for bursitis and glucosamine and chondroitin for osteoarthritis. Exhibited at CEW20 are extracts from *Foods that Harm Foods that Heal* and *Gillian McKeith's Food Bible*. Ms Wood states that the "publications describe the benefits to human health of consuming foodstuffs, and by extension nutritional supplements, that contain fatty acids, vitamins and minerals". Ms Wood exhibits at CEW21 a copy of the report *Supplements Who needs them?*, produced by NHS choices and Bazian, and a copy of a study entitled *Consumer consumption of vitamin and mineral food supplements*.

*Witness statement of David John Kelly*

21) Mr Kelly is a solicitor. Mr Kelly purchased a PROSportflex product on 9 May 2012 from Boots. Mr Kelly states that he saw no point of sales material indicating that particular types of customers were being encouraged to purchase the product. He bought the product at the medicines counter which is situated adjacent to the pharmacist's counter. Mr Kelly states that there was no documentation inside the packet.

***Findings of facts***

*Proof of genuine use*

22) In relation to the grounds of opposition under section 5(2)(b) and 5(3) of the Act, Merck must establish genuine use of its trade marks from 4 June 2006 to 3 June 2011. The use must be by it or with its consent. There is no indication of the relationship between SSL International plc and LRC. Consequently, the sales are evidence of the sales of the product but the nature of the way the trade mark is used, ProSport, cannot be taken as a form of use with the consent of the proprietor. The only use shown in the material period which can be considered to be by the proprietor or with its consent comes from exhibit CEW7 which consists of screenshots from web.archive.org. These show use of Scholl ProSport in relation to elasticated knee supports, elasticated ankle supports, elasticated elbow supports (pages 165 to 168). Pages 169 to 186 come from prosport.com. The nature of use of the trade mark is not always clear, however, there is clear use at times of ProSport on its own eg on page 172. The pages show the same products as pages 165 – 168 with the addition of elasticated athletic/cricket supports and elasticated wrist supports.

23) Section 100 of the Act 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 genuine use of the trade marks within the material period.

24) The Court of Justice of the European Union (CJEU) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 stated:

“36. “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of



confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular 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.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

25) In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25 the Court of Appeal dealt with issues relating to use of a trade mark in a form which does not alter the distinctive character of the mark in the form in which it was registered. Lord Walker stated:

“43 I have no wish to be overcritical of the way in which the deputy judge expressed himself, especially since I think he was a little overcritical of the way in which the hearing officer had expressed himself. But I am inclined to think that the deputy judge made the issue rather more complicated than it is. 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?”

44 The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

"Bare ruin'd choirs, where late the sweet birds sang"

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vaultlike trees in winter, and the dissolution of the monasteries).

45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgment, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who "normally perceives a mark as a whole and does not proceed to analyse its various details."

26) In *Boura v Nirvana Spa & Leisure Ltd* BL O/262/06 Mr Richard Arnold QC, sitting as the appointed person, stated:

"15. It is clear from BUD and BUDWEISER BUDBRÄU and the four Court of First Instance cases that the normal approach to the assessment of distinctive character applies in this context. As the European Court of Justice has reiterated in numerous cases, the distinctive character of a trade mark must be assessed (i) in relation to the goods or services in question and (ii) according to the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect."

He went on to state:

"34 The second question is whether that 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."

27) In *Atlas Transport GmbH v Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle)* (HABM) the General Court (GC) held:

“42 Aus alledem ergibt sich, dass die zusätzlichen Elemente der Briefköpfe der von der Klägerin vorgelegten Rechnungen nicht als ein untrennbar mit dem Element „Atlas Transport“ verbundenes Ganzes angesehen werden können, dass sie eine untergeordnete Stellung im Gesamteindruck einnehmen, den die streitige Marke so, wie sie in den Briefköpfen benutzt wurde, hervorruft, und dass die meisten von ihnen eine schwache Unterscheidungskraft haben. Folglich ist entgegen den Ausführungen der Beschwerdekammer in der angefochtenen Entscheidung die Unterscheidungskraft der eingetragenen Marke bei ihrer Benutzung auf den zu den Akten gereichten Rechnungen nicht im Sinne von Art. 15 Abs. 2 Buchst. a der Verordnung Nr. 40/94 beeinflusst worden.”

*In Fruit of the Loom, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-514/10* the GC stated:

“28 It must be observed that Article 15(1)(a) of Regulation No 207/2009 relates to a situation where a national or Community registered trade mark is used in trade in a form slightly different from the form in which registration was effected. The purpose of that provision, which avoids imposing strict conformity between the form of the trade mark used and the form in which the mark was registered, is to allow its proprietor in the commercial exploitation of the sign to make variations which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. In accordance with its purpose, the material scope of that provision must be regarded as limited to situations in which the sign actually used by the proprietor of a trade mark to identify the goods or services in respect of which the mark was registered, constitutes the form in which that same mark is commercially exploited. In such situations, where the sign used in trade differs from the form in which it was registered only in insignificant respects, and the two signs can therefore be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark which was registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade. However, Article 15(1)(a) does not allow the proprietor of a registered trade mark to avoid his obligation to use that mark by relying on his use of a similar mark covered by a separate registration (*Case T-194/03 II Ponte Finanziaria v OHIM – Marine Enterprise Projects (BAINBRIDGE)* [2006] ECR II-445, paragraph 50).

29 Thus, a finding of an alteration of the distinctive character of the mark as registered requires an assessment of the distinctive and dominant character of the added elements, carried out on the basis of the intrinsic qualities of each of those elements, as well as of the relative position of

the different elements within the arrangement of the trade mark (see judgment of 10 June 2010 in Case T-482/08 *Atlas Transport v OHIM – Hartmann (ATLAS TRANSPORT)*, not published in the ECR, paragraph 31 and the case-law cited).”

28) The use with Scholl does not form an indissoluble entity (see *Atlas Transport*). ProSport stands out on its own as a separate entity. PROSPORT naturally divides into two elements, pro and sport. The use of ProSport does not create a different perception of the trade mark, it does not change its distinctive character. Use of ProSport is use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. (Merck submits that ProSport and PROSPORT would not be considered a series of trade marks. That argument is doubtful in itself. However, it is not pertinent, as the question of 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 is in not dependent or linked to the issue of whether trade marks form a series.)

29) The use before and after the material period cannot be taken into account in deciding upon a fair specification. However, it can be taken into account as showing a continuity of use which helps to support a claim to the genuineness of the use. Ms Wood gives no figures for the sale of PROSPORT branded products during the material period. She states:

“I am advised by Stewart Lee, senior brand manager for the Opponent, and believe, that current sales of PROSPORT branded products are significantly in excess of £100,000 per annum.”

Ms Wood’s statement is dated 9 January 2012 and so “currently” is not indicative of the material period.

30) The requirement for genuine use can be satisfied in relation to creation of a market as well as maintaining one. The invoices in terms of sales of products need to be taken into account to show use, they cannot be taken into account in relation to being use of the particular form of the trade mark with the consent of the proprietor. Use of a trade mark does not have to be quantitatively significant. Taking into account the continuum of use that is shown, LRC has established genuine use of its trade mark in the material period.

31) It is necessary to decide upon a fair description for the goods for which genuine use has been shown and which fall within the parameters of the specification. The description must not be over pernickety<sup>ii</sup>. It is necessary to consider how the relevant public would describe the goods<sup>iii</sup>. The General Court (GC) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

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 sub-categories 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 sub-category 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.

In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

32) Fair specifications cannot be outwith the parameters of the registrations; consequently, any specification must be limited to *all for use in sporting activities*.

33) The use shown is in respect of elasticated athletic/cricket supports, elasticated wrist supports, elasticated knee supports, elasticated ankle supports and elasticated elbow supports. The class 5 specification specifically excludes *elastic support bandages*. Consequent upon this exclusion, there has been no use in relation to the class 5 registration; none of the other class 5 goods cover the goods in relation to which use has been shown. The class 10 specification covers *support bandages and elastic bandages*. All of the goods in relation to which use has been shown are *support bandages*, even if most of them are elasticated. **A fair specification for the class 10 registration is:**

***support bandages; all for use in sporting activities; all included in Class 10.***

The section 5(2)(b) and 5(3) grounds of opposition must be considered upon the basis of this specification.

*Reputation for section 5(3) of the Act*

34) LRC must establish that its trade marks were known by a significant part of the public concerned by the products covered as of 25 February 2011.<sup>iv</sup>. The CJEU in *General Motors Corporation v Yplon SA* stated how a party would establish this reputation:

“27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

35) LRC has given no turnover figures between 1991 and the date of application. It has given no indication of the market share that it enjoys. There is scant evidence of promotion and advertising since the days of Seton. There is no indication as to where the products are sold and the geographical spread. LRC has failed to establish a reputation for the purposes of section 5(3) of the Act.

**Consequently, the ground of opposition under section 5(3) of the Act is dismissed.**

### *Goodwill*

36) A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Joined Cases T-114/07 and T-115/07*, in which the GC stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.”

The reasoning of the GC, *mutatis mutandis*, is followed in relation to the Act. LRC must establish a protectable goodwill as of 25 February 2011. When PROSPORT was being used by Seton the range of goods included sprays and creams. The evidence does not show when this use ended, or when Seton ceased to own the trade mark. Reputation does not evaporate with the cessation of use in relation to a sign or particular goods or services in relation to a sign<sup>v</sup>. However, reputation in respect of goods can fade and disappear. In the absence of any clear evidence, as to the extent of sales of creams and sprays and when the sales were made, it is not established that as of 25 February 2011 there was any existing goodwill in relation to these goods. The goodwill that is established at the date of application can go no further than being for support bandages and athletic supports. Although these goods are primarily aimed at those with sporting injuries or ailments, they can be used by others. **The goodwill as of the date of application for registration is for support bandages and athletic supports.**

37) Mr Fraser gives evidence in relation to use. However, this is not use of the trade mark the subject of the application but use of the trade mark with two other trade marks; as he states, as a tertiary trade mark. Even this type of use started sometime in 2011 and so does not show any period of concurrent use. Consequently, the earliest date of the behaviour the subject of the complaint is the date of application for registration.

## **Other matters**

38) Merck spends much time on how it uses its trade mark and how it used the forerunners of its trade mark. In *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-116/06*, the GC stated:

“76 Consideration of the objective circumstances in which the goods and services covered by the marks in dispute are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is prospective. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors (*QUANTUM*, paragraph 75 above, paragraph 104, and *T.I.M.E. ART/Devinlec v OHIM*, paragraph 75 above, paragraph 59).”

(Also see *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05* and *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-147/03*.) It is necessary to consider the trade mark the subject of the application in respect of the goods for which the application has been made.

39) There is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little: *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J stated:

“22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no



confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

In this case the absence of any evidence of confusion falls squarely within the parameters of the case law. Merck has always used the trade mark with other matter which indicates the supplier of the goods. It has also used it in relation to a very limited range of goods. The evidence also shows that recently the use of the trade mark of LRC has been in conjunction with the Scholl trade mark. The public will have been able to identify the difference between the origins of the goods through the house marks that accompany the trade marks when in use.

40) In its written submissions Merck comments on the use of ProSport rather than PROSPORT. It has been decided that this is 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. Having decided this, the comparison between trade marks has to be made on the basis of the trade mark as registered; as per the judgment of the GC in *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 147/03*:

"65 Before examining the visual, phonetic and conceptual comparison of the signs carried out by the Board of Appeal, it is necessary to reject the applicant's argument that the Board of Appeal ought to have examined the earlier national mark not as it was registered but as it was used, by the sign reproduced in paragraph 10 above.

66 It is important to note that, under the provisions of Regulation No 40/94 governing examination of opposition to registration of a Community trade mark, the purpose of demonstrating genuine use of an earlier national

mark is to provide a means for its proprietor, at the express request of the Community trade mark applicant, to furnish proof that during the period of five years preceding the date of publication of the Community trade mark application its mark has been put to actual and genuine use on the market. In accordance with Article 15(2)(a) and Article 43(2) and (3) of Regulation No 40/94, that proof also applies where the sign used differs from the earlier mark as it was registered in elements which do not alter the distinctive character of the mark. In the absence of such demonstration, in particular if the elements used alter the distinctive character of the earlier mark, or in the absence of demonstration of justifiable grounds for lack of use, the opposition must be dismissed. Accordingly, demonstration of genuine use of an earlier mark in connection with opposition proceedings has neither the aim nor the effect of granting its proprietor protection for a sign or elements of a sign which have not been registered. Accepting the opposite argument 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 of a Community trade mark.

67 In this case, since the applicant registered only the earlier mark as reproduced in paragraph 5 above, which is the basis of the opposition on which the Board of Appeal was asked to rule in the contested decision, only that mark enjoys the protection accorded to earlier registered trade marks. It is therefore also that mark which, for the purposes of examination of the opposition, had to be compared with the mark applied for, as the Opposition Division and the Board of Appeal legitimately did, in respect of the goods for which the proof of genuine use had been furnished by the applicant, in this case ‘watches and watch bands or straps’ in Class 14.”

41) In its evidence, LRC refers to its ownership by Reckitt Benckiser and that Reckitt Benckiser is a large company with a large product range. The size of the owner of an earlier right or the number of products that it produces is not pertinent to the considerations that have to be made in respect of the grounds of opposition. It is also not pertinent that the Virgin trade mark has been used in relation to a wide range of activities. Virgin is the primary trade mark of Virgin Group, PROSPORT is not the primary trade mark of either Reckitt Benckiser or LRC.

42) Merck states that “PROSPORT is prima facie non-distinctive since the prefix PRO is understood by the average consumer to mean “for” so that PROSPORT simply means “for sport”. (Earlier in its submissions it states that PROSPORT would be seen as an invented word. In its evidence Merck states that pro means professional.) There is a presumption of validity in relation to an earlier registered trade mark, a presumption that was confirmed by the CJEU in *Formula One Licensing BV v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-196/11P:

“41 Therefore, in such opposition proceedings, it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42 It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43 However, as the appellant rightly points out, their verification has limits.

44 Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation 40/94, read in conjunction with Article 8(2)(a)(ii).

45 Such a finding would be detrimental to national trade marks identical to a sign considered as being devoid of distinctive character, as the registration of such a Community trade mark would bring about a situation likely to eliminate the national protection of those marks. Hence, such a finding would not respect the system established by Regulation No 40/94, which is based on the coexistence of Community trade marks and national trade marks as stated by the fifth recital in the preamble to that regulation, given that the validity of an international or national trade mark may be called into question for lack of distinctive character only in cancellation proceedings brought in the Member State concerned by virtue of Article 3(1)(b) of Directives 89/104 and 2008/95.

46 It should be noted that Article 8(2)(a)(ii) of Regulation No 40/94 expressly provides, in opposition proceedings, for trade marks registered in a Member State to be taken into consideration as earlier trade marks.

47 It follows that, in order to avoid infringing Article 8(1)(b) of Regulation No 40/94, it is necessary to acknowledge a certain degree of distinctiveness of an earlier national mark on which an opposition against the registration of a Community trade mark is based.”

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

### *Average consumer and the purchasing process*

43) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-117/03 to T-119/03 and T-171/03 the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

44) The goods of the application and of the earlier registration will be bought by the public at large. The class 5 goods of the application must fall within the parameters of the class and so *oils and fats and derivatives of oils and fats* will be dietetic substances for medical use or dietary supplements. The class 5 goods will be purchased in order to benefit the health and will be bought on the basis of the particular health benefit attached to them. Consequently, they are likely to be bought with a reasonable degree of care and consideration. *Nutritional supplements* in class 29 are likely to be bought in the same manner. Consequently, the effects of imperfect recollection will be reduced. The other class 29 goods are very general and could be bought with little care and consideration eg edible fats will include margarine. Consequently, the effects of imperfect recollection are likely to be increased. The class 5 goods and *nutritional supplements* can be bought straight from the shelf, and so be a visual purchase. However, they could also be bought after discussion with a sales assistant, eg in a health food shop, and so the purchase could be an oral one. Consequently, in relation to the aforesaid goods aural and visual considerations may be of equal importance. The other goods of the application are likely to be bought from shelves and so visual similarity is of greater importance than aural similarity.

45) *Support bandages; all for use in sporting activities; all included in Class 10* will be bought with some care as the purchaser will wish to make sure that the support bandage is suitable for the condition that is being treated or prevented.

Consequently, the effects of imperfect recollection are likely to be lessened. The goods are likely to be bought from the shelf. (Although it cannot be taken as being determinative, the use by Seton shows its goods being on a supermarket shelf.) Consequently, visual similarity will be of greater importance than aural similarity.

46) The trade marks to be compared are:



47) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>vi</sup>. 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<sup>vii</sup>. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>viii</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>ix</sup>.

48) The application is in colour, the earlier registration is not. In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J stated:

“119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch

are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.”

Consequently, the application must be drained of colour in the comparison.

49) Pro is commonly used in brands to denote professional; to try and convey to the consumer that the goods or services are of a higher (professional) standard. Sport is directly descriptive of goods for use in relation to sport. Consequently, there is no one distinctive and dominant component in the trade mark of LRC; the distinctiveness lies in the trade mark as a whole. There is a limited degree of stylisation of the trade mark of Merck; different fonts are used and there is a dot in the centre of the first letter o. LRC has tried to show that flex is lacking in distinctive character for the goods of the application. It has adduced evidence of two trade marks that were in use before the date of application, FlexNow and FlexiHerb. Both products are designed to improve the health of joints. In *Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch), Floyd J stated:

“29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c).”

By analogy, that there is limited evidence that, at the date of application, two others undertakings had used flex or flexi in relation to supplements, is not, of itself, indicative that the flex element lacks distinctiveness. The products of the specification of the application are not flexible. It takes a little digging to associate flex with indicating that the products will give flexibility, a vague concept. Flexibility is not a term that is commonly used in relation to the body. In relation to the goods of the application it is not considered that flex is devoid of distinctive character. The class 5 goods and the *nutritional supplements* could all be designed for sportspersons and so the pro and sport elements of Merck's trade mark separately lack distinctive character. However, Sportflex “hangs together” both visually and aurally. Sportflex has no obvious meaning and the pro element acts as a qualifier of the nature of Sportflex. The distinctive and dominant component of the trade mark of Merck is Sportflex.

50) Aurally the trade marks share the words PROSPORT and, despite the other element of Merck's trade mark, there is aural similarity. There is a degree of stylisation of Merck's trade mark, however, as it consists of readily identifiable word elements, the average consumer will recall it more by the words per se than the stylisation. The trade marks are visually similar. Conceptually the trade mark of LRC will be perceived as professional sport. Owing to the "hanging together" of Sportflex, which is an impenetrable term, the conceptual associations of Merck's trade mark, for the average consumer, will be limited to pro meaning professional. Consequently, any conceptual similarity is very limited, taking the trade marks in their entireties.

**51) The similarity of the trade marks must be considered on the basis of a comparison of them in their entireties and taking into account the distinctive and dominant components. The trade marks have a reasonable but not overwhelming degree of similarity.**

#### *Comparison of goods*

52) In "construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade<sup>xv</sup>". Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning<sup>xi</sup>. Consideration should be given as to how the average consumer would view the goods and/or services<sup>xii</sup>. The class of the goods and/or services in which they are placed may be relevant in determining the nature of the goods and/or services<sup>xiii</sup>. In assessing the similarity of goods and/or services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary<sup>xiv</sup>. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed<sup>xv</sup>.

53) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the GC explained when goods are complementary:

"82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48)."

54) The premise of LRC in relation to similarity is that because the same consumer could take supplements , vitamins and the like to improve, for instance, joint health and as its bandages are used on joints for therapeutic purposes, the respective goods are similar.

55) *Cod liver oil* is classified in class 5 and so the class 29 *edible oils and edible fats* do not contain *cod liver oil*. There are no points of coincidence within the parameters of the case law between *support bandages; all for use in sporting activities; all included in Class 10* and *edible oils and edible fats; foodstuffs containing oils or fats*. The respective goods are not similar.

56) The remaining goods of the application have a completely different nature to the goods of LRC. LRC claims that the goods are complementary as they could be used in relation to the same condition. The respective goods are not indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking. They are not complementary. (On the basis of LRC's argument a walking stick or crutch would be complementary to the goods of the application.) LRC also claims that the respective goods are in competition. There is nothing fungible in the nature of the respective goods. The goods are not in competition. The goods of the application are all ingested; the goods of the earlier registration are placed on the outside of the body. Their methods of use are completely different. When Mr Kelly purchased the goods of Merck he did not comment on seeing any support bandages in the vicinity of the goods. This is not determinative of the issue. However, there is nothing to suggest that support bandages would be found in the same areas of shops as the goods of the application.

57) LRC's case boils down to the users of the goods of the application also potentially using *support bandages; all for use in sporting activities; all included in Class 10* because they may be prone to or suffering from a condition in which both sets of goods may be used. So at an extreme level they could have the same users, as could the walking stick and the supplement. The wide range of differences between the respective goods means that the very slight point of confluence, at the best, gives rise to a minimal level of similarity.

### *Conclusion*

58) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>xvi</sup>. There is an enormous distance in similarity between the respective goods. The reasonable but not overwhelming similarity of the trade marks does not bridge the distance between the respective goods. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion<sup>xvii</sup>. The distinctive character of a trade mark can be appraised only,



first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public<sup>xviii</sup>. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the services for which it has been registered as coming from a particular undertaking, and thus to distinguish those services from those of other undertakings<sup>xix</sup>. LRC's trade mark is highly allusive of the goods in relation to which it has established use; it has very limited distinctiveness. The evidence does not establish that at the date of the application for registration of the trade mark of Merck, that the distinctiveness of LRC's trade mark had been improved by use. The goods of LRC will be bought with some care and the supplements and the like of Merck will also be bought with some care.

**59) There is not a likelihood of confusion and the opposition under section 5(2)(b) of the Act is dismissed.**

***Section 5(4)(a) of the Act – passing-off***

**60) The goodwill of LRC is slightly wider than the specification of its earlier registration, after proof of use. However, owing to the distance in the respective goods and the differences in the trade marks, there would neither be misrepresentation nor damage. The ground of opposition under section 5(4)(a) of the Act is dismissed.**

## **Costs**

61) Merck having been successful is entitled to a contribution towards its costs. The evidence that it supplied was without pertinence in the issues under consideration. No award will be made in respect of this evidence. Costs are awarded on the following basis:

Preparing a statement and considering the statement of LRC	£300
Considering the evidence of LRC	£250
Written submissions	£250
Total	£800

**LRC Products Limited is ordered to pay Merck Consumer Healthcare Limited the sum of £800. 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 13th day of September 2012**

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

---

<sup>i</sup> Section 6A of the Act reads:

“(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, 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) 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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“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.”

<sup>ii</sup> *Animal Trade Mark* [2004] FSR 19:

“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 pernickety 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.”

iii *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

“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.”

iv *General Motors Corporation v Yplon SA* Case C-375/97.

v See *Ad-Lib Club Limited v Granville* [1971]:

“In support of that statement there is cited the case of *Norman Kark Publications Ltd. v. Odhams Press Ltd.*, [1962] 1 All E.R. 636; [1962] R.P.C. 163 in which the first paragraph of the headnote reads:

"In an action to restrain the use of a magazine or newspaper title on the ground of passing off the plaintiff must establish that, at the date of the user by the defendant of which the plaintiff complains, he has a proprietary right in the goodwill of the name, viz., that the name remains distinctive of some product of his, so that the use of the name by the defendant is calculated to deceive; but a mere intention on the part of the plaintiff not to abandon a name is not enough".

---

Wilberforce, J. went at length into the principles underlying proprietary right in goodwill and annexation of a name to goodwill and the laws of the right to protection of a name and on the facts of that particular case he held that the plaintiff company had lost its right in respect of the name TODAY as part of the title of a magazine.

It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period of time the goodwill attached to that business. Indeed it is obvious. He may wish to reopen the business or he may wish to sell it. It further seems to me clear in principle and on authority that so long as he does retain the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a trader who has either temporarily or permanently closed down his business should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law.

In the present case, it is quite true that the plaintiff company has no longer carried on the business of a club, so far as I know, for five years. On the other hand, it is said that the plaintiff company on the evidence continues to be regarded as still possessing goodwill to which this name AD-LIB CLUB is attached. It does, indeed, appear firstly that the defendant must have chosen the name AD-LIB CLUB by reason of the reputation which the plaintiff company's AD-LIB acquired. He has not filed any evidence giving any other reason for the selection of that name and the inference is overwhelming that he has only selected that name because it has a reputation. In the second place, it appears from the newspaper cuttings which have been exhibited that members of the public are likely to regard the new club as a continuation of the plaintiff company's club. The two things are linked up. That is no doubt the reason why the defendant has selected this name."

<sup>vi</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>vii</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>viii</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

<sup>ix</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

<sup>x</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>xi</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

<sup>xii</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

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

<sup>xiii</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

---

<sup>xiv</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

<sup>xv</sup> He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

<sup>xvi</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

<sup>xvii</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>xviii</sup> *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

<sup>xix</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.