O-098-17

In the matter of UK Trade Mark Application No.3085533 ('EVONTRUS') in Class 5 in the name of Glaxo Group Limited (the Applicant)

and

Opposition No. 403995 by Evonik Industries AG (the Opponent)

and

In the matter of Appeals to the Appointed Person by the Applicant and the Opponent against the Decision of the Hearing Officer O-587-15 for the Registrar, The Comptroller General dated 10 December 2015 and his Supplementary Decision O-054-16 dated 28th January 2016

SUPPLEMENTARY DECISION

Procedural history

1. On 26 October 2016, I issued my Decision in which I invited sequential further submissions. For the reasons explained towards the end of that Decision, I invited the Appellant to put forward a proposal of an amended specification of goods which met two conditions. The first condition was the consideration which lay at the heart of the Hearing Officer's decision to reject the opposition in respect of *vaccines* because they were goods in respect of which '*rarely, if ever, will the patient be exposed to the trade mark applied to those goods'*. The second condition was that the proposed amended specification had to be '*clearly not objectionable'*, a condition which the Hearing Officer imposed (in view of the stage then reached in this Opposition) in his Decision dated 10 December 2015 when he invited further submissions as to a possible amended specification of goods. That second condition applies with even greater force on Appeal.

2. The parties filed their submissions in accordance with my directions, and I am grateful for them. The subsequent delay in issuing this Supplementary Decision is entirely my fault.

The outstanding issue

3. It will be recalled that in my Decision dated 26th October 2016, I made a preliminary analysis of the suggestion put forward at the hearing by the Appellant that '*anesthetics*' would satisfy the Hearing Officer's conditions. My preliminary

conclusion was that '*general anesthetics*' would do so, but not any wider class of anesthetics.

4. The proposal put forward by the Appellant reads as follows:

> '*Pharmaceutical and medicinal preparations and substances, all being administered intravenously by healthcare professionals; vaccines.*'

5. The Appellant submitted that this specification met the two conditions I set out above, in particular because 'there is no opportunity for the end user to obtain and view the pharmaceutical product in packaging bearing the trade mark.'

6. Although the Appellant's submission did not mention my preliminary analysis of its earlier suggestion of 'anesthetics' I infer that the proposal embraced the administration of a general anesthetic intravenously by a healthcare professional.

7. In its Response, the Respondent disputed that the proposed specification met the two conditions on essentially three grounds:

   7.1. First, the Respondent provided examples where the bag of fluid for an IV line (a) carried a trade mark and (b) the mark would be visible to the patient;

   7.2. Second, because the proposed specification was imprecise, thereby not meeting the second condition;

   7.3. Third, the Respondent cited examples of brand name drugs which could be administered either intravenously or in tablet form by mouth.

8. Like the Appellant, in its submission the Respondent did not address my preliminary analysis concerning '*general anesthetics*', although by implication, the Respondent invited me to dismiss it.

9. In its Reply submission, the Appellant submitted images of patients lying in hospital beds with their eyes closed attached to IV drips and suggested:

   9.1. in the vast majority of cases the patient will not be exposed to the trade mark in the context of intravenous drips at all, or if they are, will not give this any attention;

9.2. patients on an IV drip are often unwell or serious unwell and are not attentive to branding issues;

9.3. trade marks applied to IV bags are not intended to be a marketing opportunity to end users but are directed to health professionals.

10. Whilst I accept that many patients receiving an IV drip are unwell and pay no attention to any branding on an IV bag, this is not always the case. As the Appellant acknowledged in its Reply Submission, patients do walk along hospital corridors when attached to a IV drip mounted on a wheeled stand. This is an example of a situation where the patient may well observe branding on the IV bag. Even if the trade mark on an IV bag is aimed at health professionals, this does not exclude patients being exposed to the trade mark and at least some patients will pay attention to the trade mark on the IV bag.

11. This reasoning is sufficient to enable me to reject the Appellant's proposal. The Appellant's proposal includes goods which do not satisfy the first condition.

12. However, having rejected the Appellant's proposal, I have to consider my earlier preliminary analysis regarding '*general anesthetics*'. The position appears to be as follows:

12.1. '*General anesthetics*' seem to me to be a sub-set of '*Pharmaceutical and medicinal preparations and substances, all being administered intravenously by healthcare professionals*';

12.2. I indicated my preliminary view to both parties that this subset did satisfy the two conditions;

12.3. My preliminary view has not been disputed directly;

12.4. Considering my preliminary view again, it seems to be correct;

12.5. Even though the Appellant did not specifically put forward '*general anesthetics*' as a fall-back position, it would be perverse not to give effect to my preliminary and now concluded view that registration of the mark applied

for – EVONTRUS – is not objectionable under section 5(2)(b) for '*general anesthetics*' or, for that matter, '*vaccines'*.

13. Accordingly, I allow the appeal in so far as it related to '*general anesthetics*' but otherwise dismiss the appeal. To be clear, the outcome of the Appeal is that the application for EVONTRUS proceeds to registration in respect of the following goods in class 5, namely '*general anesthetics; vaccines.*'

Costs

14. In my Decision dated 26 October 2016, I made some observations as to the costs outcome in the event that the Appellant did not put forward a proposed amended specification (in that event, I would have ordered the Appellant to pay £300 as a contribution to the Respondent's costs of the Appeal). The following points remain pertinent:

    14.1. First, the Hearing Officer made no award of costs to either party 'given the fairly equal measure of success enjoyed by the parties in these proceedings overall';

    14.2. Second, both sides filed appeals of roughly equal weight and both filed a respondent's notice in response to the other's appeal;

    14.3. Third, having made those first two points, more time and effort was devoted to the Appellant's arguments on Appeal (than to the Opponent's), which have not succeeded.

15. Instead, the Appellant has succeeded only to a limited extent in relation to a suggestion floated for the first time during the Appeal hearing. That suggestion led to both sides making further submissions. The Appellant has not succeeded on the issues discussed in those further submissions.

16. Standing back and assessing the Appeal proceedings as a whole, even though the Appellant has achieved some limited success, almost all of the Appeal process (including the round of further submissions) has involved the Appellant raising

issues on which it lost in its attempts to obtain the widest possible specification of goods.

17. In these circumstances, I order the Appellant/Applicant to pay a contribution in the sum of £450 towards the Opponent's costs of the appeal process by 5pm on Wednesday 15th March 2017.

JAMES MELLOR QC
The Appointed Person
28th February 2017