

**DECISION OF THE TRADE MARKS REGISTRY**  
**TRADE MARKS ACT 1994**

**APPLICANTS: CEGEDIM (SOCIETE ANONYME)**

**APPLICATION N<sup>o</sup>. 2215407**

**CLASSES 9, 35 AND 42**

**AND**

**OPPONENTS : HAVAS MEDIMEDIA SA**

**OPPOSITION N<sup>o</sup>. 51286**

**MEDIMED**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF trade mark  
application No. 2215407 in the name of  
Cegedim (Societe Anonyme)**

**and**

**Opposition thereto No. 51286 by  
Havas Medimedia SA**

## **BACKGROUND**

### **Trade mark in issue**

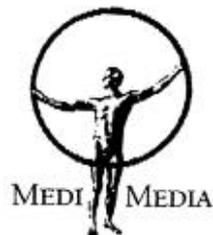
1. Trade mark application No. 2215407 – MEDIMED – was filed on 26<sup>th</sup> November 1999, but claimed an international priority date of 2<sup>d</sup> June 1999 (France).

### **Specification of goods and services**

- Class 9     Softwares and software packages (recorded computer programs); statistics processing softwares; digital compact disc or other storage medium containing statistical data.
  
- Class 35    Business management; business management assistance; data compilation and systemization in a central database; computer, business, economic and administrative databases services; computerized files management; business inquiries, information or consultancy.
  
- Class 42    Computer programming; leasing access time to a computer database (statistics data).

### **History**

2. Following publication, the application was opposed by Havas Medimedia SA on the following grounds under s. 3(6), 5(2)(b) and 5(4)(a). They are the proprietors of the earlier mark No. 1499576 applied for on 7<sup>th</sup> May 1992:



for the goods:

“Printed publications; instructional material; all relating to pharmaceutical, medical and veterinary matters; paper and paper articles and cardboard articles, all being point of sale promotional material; all included in Class 16.”

3. The opponents sought a late amendment to their pleadings, which I have taken as a preliminary point (see below).

## HEARING

4. The applicants did not attend. But the opponents were represented by Mr. Malynicz of Counsel, instructed by Messrs. A1 Trade Marks.

## EVIDENCE

### The Opponents' evidence

5. Mr. Philip Armiston Redman, an agent acting for the opponents, has submitted an undated Witness Statement submitting that respective marks are likely to confuse and exhibiting examples of the opponents' publications.
6. He states that the opponents, Medimedia SA (formerly Havas Medimedia) are publishers and suppliers of printed material all relating to medical, surgical and veterinary matters, and have carried on such business in the UK since 1992, both themselves and through their distributor. Having decided recently to close down their UK operation and premises, they nevertheless wish to continue to supply the UK market with the same and additional publications directly from France or other countries. Mr. Redman visited the UK premises, but unfortunately (he states) all the archive material had been destroyed in preparation for closure. However, he was able to rescue some publications and these have been exhibited at Exhibit PAR 1. A full list of these publications follows – and some comment on their significance.
7. The first publication is ‘Havas – sharing the word’, which is dated 2000. The opponents' activities are described: they are a ‘world leader’ in ‘multimedia’ and ‘the number one publisher of schools and reference books in continental Europe’ (page 1). Mr. Redman further states:

“In May 1999, *Havas* acquired full ownership of *MediMedia*, significantly expanding its scope in fields including pharmaceutical dictionaries and drug information systems.

*MediMedia* rounds out the international offering of *Vidal* with a presence in some 35 countries, in particular Germany with *Gelbe Liste*, in the Asia-Pacific region with MIMS, in Italy with *L'Informatore Farmaceutico*, in Switzerland with *Compendium*, in Spain with *Vademecum*, and in the US.

Expertise in database creation and information management, plus unrivalled local presence in different parts of the world are clear strengths as a fast-expanding pharmaceuticals industry goes global.”

8. I have carefully read this document and can find no specific reference to any activities in the UK. The name MEDIMEDIA is used arguably as much as a company name as a trade mark, and I am given no clue as to the extent and nature of any use in the UK.
9. A selection of three magazines: 'Caribbean Health', 'Diabetes International' and 'Africa Health' which, clearly, are published outside the UK but, as Health magazines of special interest to professionals, are accessible in the UK (judging by the UK address for remittance). I note there is use of 'Havas Medimedia' with device in the magazines after 2000, and use of the earlier mark above in the 1999 publications. Again, however, as to the extent of actual exposure of these publications in the UK, I am none the wiser.
10. Next, is a 'MEDIA BOOKLET' dated 1992, in English, which carries a sign and the words 'International Group'. It is 'designed' (page (i)) 'to provide information on' the opponents' 'products available globally'. The UK is not specifically listed.
11. 'Pharmafile' – a publication which was available in the UK as of Spring 1997 – provides listings of various manufacturers and services in the healthcare industry. The sign does not appear: the business 'MediMedia' is not listed in the index at the back of the document.
12. There are two editions of MIMS, Australia. I do not see how this proves anything. MIMS famously contains pharmaceutical prescribing information and the like. Though the MEDIMEDIA plus man device is used in the 1999 edition (not in the 2000), this can have no relevance to the UK market, which will have its own edition of MIMS.
13. Next there is a 1999 edition of 'KIMS', the equivalent publication for Korea. Though the opponents' mark is used I have no idea what this evidence is intended to show.
14. Finally Mr. Redman states that he has not been able to obtain reliable turnover and advertising figures in the UK for the opponents but wishes to make them available for the hearing. None of this information appeared.
15. My take on the evidence is that it proves little or nothing about the opponents' reputation or goodwill in the UK. I will return to this point under the s. 5(2)(b) and 5(4)(a) grounds.
16. To complete the summary of Mr. Redman's evidence, in submission, he says that the words MEDIMED and MEDIMEDIA are confusable especially as many may pronounce the word MEDIMEDIA as MEDIMEDDIA rather than MEDIMEEDIA.

### **The applicants' evidence**

17. Kathleen Rose O'Rourke is the applicants' solicitor and trade mark attorney. She has provided a witness statement dated 16<sup>th</sup> November 2001. In it, Ms. O'Rourke records her search of dictionaries and directories as to whether the letters 'MED' are commonly used as an abbreviation for 'MEDIA'. Exhibit KOR 1 shows the results. None of the dictionaries exhibited (Everyman's Dictionary of Abbreviations, Concise Oxford Dictionary, New Shorter Oxford Dictionary and Merriam-Webster's Collegiate Dictionary) show 'MED' as an abbreviation for 'MEDIA'.

## LAW

“5(2) A trade mark shall not be registered if because:

(a) ... ,

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

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

(3) ... .

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

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

(b) ... .

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

## DECISION

### Preliminary point

18. The opponents sought an amendment to the pleadings so as to include reference to Community Trade Mark (CTM) No. 000387373. This mark is the same as the UK registration, but the goods and services specified are more extensive. I have listed them in the ANNEX. Mr. Malynicz referred me to a recent decision of the High Court in *ST Dupont v EI du Pont de Nemours & Co* [2002] EWHC 2455. This was under the 1938 Act, but that, and the facts of the case, are not relevant to the force of Mr. Malynicz’s submission on this authority. The judge stated:

“11. Whether or not to permit a party to argue a new point, which should have been pleaded and is raised for the first time at, or very shortly before, the hearing, is, of course, a matter for the discretion of the tribunal before whom the hearing is taking place. ...

12. It is, of course, impossible to generalise with confidence on the proper approach for a tribunal in every case faced with an application by a party to argue a point raised for the first time during, or very shortly before, the hearing. ***However, in the absence of special factors, I would have thought that if there is no need for any significant adjournment, to enable the other party to put in evidence or otherwise prepare for a new and difficult point, then justice would normally indicate that the discretion be exercised in favour of permitting the point to be argued, especially if it is raised before the hearing starts.*** If the point is bad, then no prejudice will be caused to the other party by it being raised. If the

point is good, then, at least in the absence of special circumstances, it might well represent an unduly harsh penalty on the party wishing to raise the point, and a windfall which was hard to justify in favour of the party against whom the point was raised, if it could not be argued. That is all the more true where the point sought to be raised is by an objector to the registration of a trademark, where the public interest will be engaged. However, it should be emphasised that there will be cases in which this approach to late amendments will not be justified, see e.g. *Ketteman v Hansel Properties Ltd* [1987] AC 189, especially at 219D to 220H.

***13. On the other hand, where permitting a point, not so far pleaded, to be raised at the last minute will involve severe disruption, the obvious example being the hearing having to be adjourned for a significant time, different considerations may well apply.*** In such circumstances, the tribunal may think it right to permit the point to be raised even though an adjournment is required, on appropriate terms as to costs and directions. However, in many cases, the tribunal may conclude that it is simply too late for the point to be raised, and that the delay, disruption and distress caused by an adjournment could not be justified.” (Emphasis mine).

19. Mr. Malynicz pointed out the ‘unfettered’ discretion of the hearings officer, and the potency, he held, consideration of the CTM would add to the opponents’ case. In his view:

“We say this CTM is in effect a killer registration. ... it is very strong. The goods or services become identical or so similar as makes no difference. To that extent it is potentially determinative.”

Whether this was well founded or not remained to be seen, but, it nevertheless, reflected the opponents’ state of mind, and thus their likely intentions in pursuing the matter. One of the usual reasons for resisting a late amendment to pleadings is that it may multiply or extend proceedings: further evidence, further submissions and further hearings. In this case, however, the opponents can prey in aid the opposite: allowing the mark to proceed to registration without a consideration of the CTM may well invite an invalidity action under s. 47 of the Act.

20. Next, Mr. Malynicz contended that he could not see additional evidence rounds being generated by allowing the CTM into the proceedings. He stated:

“I cannot see that they would need an adjournment or a further round of evidence or anything else, save for written submissions on a point of law. ... It seems to me that the only way they can deal with our CTM is to say what they have already said, the marks are different.”

Judging by the manner in which the applicants’ responded (see below) this was a fair point.

21. Next, the public interest in not keeping invalid marks on the register – raised by the Judge in *ST Dupont*– was also brought to my attention. And, finally, Mr. Malynicz also pointed out one fact in *ST Dupont* that was relevant to these proceedings: the request to amend in that case had been (effectively) sought ‘for the first time’ in the opponents’ skeleton argument, and that rather reflected matters here.

22. As I stated above, the applicants did not attend the hearing. My decision at the hearing on this issue is best summarised in a letter I wrote to the applicants on 29<sup>th</sup> November 2002:

“The opponents have made a late request to amend the pleadings, as described in their skeleton argument. Essentially they also wish to rely on the Community Trade Mark 000387373. In this context, I was referred to the very recent decision of Mr. Justice Neuberger in *ST DUPONT v EI DU PONT DE NEMOURS* (Case No. HC/2002/APP/0083, 22<sup>nd</sup> November 2002), in particular, paragraph 26. I made no decision on the leave to amend at the hearing, but heard the matter *de bene esse*.

I wish to give you the opportunity to provide me with submissions on the above. First, on the request itself, and, second, assuming that it is granted, any submissions additional to those you have already made in your skeleton dated 27<sup>th</sup> November 2002. I require these submissions within two weeks of the date of this letter, that is, by Friday 13<sup>th</sup> December 2002. The opponents are entitled to respond (strictly in reply) should they feel the absolute need to do so. That will be the last word. I will then make a decision on the leave to amend, which will form part of my decision on the substantive issues in this opposition, in the normal way.”

23. The applicants replied, in a letter dated 11<sup>th</sup> December 2002, in the following terms:

“Objection is raised to the request to amend the pleadings to also rely on Community trade mark number 000387373. It seems remarkable that neither the Opponents, who must have known of the existence of the Community trade mark, or their professional advisers who could have easily ascertained the existence of the mark on reasonable enquiry, are only at this stage raising the possibility that the opposition should also be based on that Community mark.

If the request to amend the pleadings is granted, then the Applicant will of course have been severely prejudiced as the entire course of the proceedings up until the day before the hearing was proceeding on the basis that the Grounds for Opposition were as set out in the original Notice. The fact that Community trade mark number 000387373 covers a much broader range of goods and services is obviously material and could in fact have altered the advice provided to the Applicant and decisions taken by the Applicant during the Opposition proceedings.

In the event that the pleadings are amended as requested, we simply reiterate the submissions we filed denying that trade mark application number 2215407 is similar to the trade mark the subject of UK registration number 1499576 and Community trade mark number 000387373 and that the Opponent has not substantiated the claims made under sections 3(6), 5(4)(a) and 5(5).

A request for an award of costs against the Opponent has already been made but, in the event that the pleadings are amended as requested by the Opponents, then we would submit that the hearing officer should give serious consideration to awarding the maximum amount of costs against the Opponents, whether or not the opposition is successful.”

24. There is no contention here, on behalf of the applicants, to put in supplementary evidence or detailed further submissions. Against the background of their existing evidence – which is of

limited magnitude and (largely) polemical – I am not surprised. They have said rather little thus far, and the proposed amendment to the pleadings has not stimulated much more, despite the assertion that their advice to their clients would have been different – to the point of prejudice, if I allowed the amendment now.

25. I note the following policy statement from the Registry’s TPN 4/2000:

**“Amendments to statements of case & counter-statements**

22. As parties will be expected to file focussed statements of case and counter-statements, the Trade Marks Registry will consider requests to amend these documents later in the proceedings. Amendments may include adding or removing a ground of opposition/revocation or invalidity or correcting information contained therein. If an amendment becomes necessary parties should seek leave to make the amendment at the earliest opportunity. When seeking leave to amend, full details of the amendment, together with the reasons for the amendment, should be submitted. Whilst each request to amend will be considered on its merits the Registry will aim to give favourable consideration to such requests on the basis that it is likely to avoid a multiplicity of proceedings and thus help resolve the dispute between the parties quickly and at less cost. If the amendment requires the other party to file an amended counter-statement or additional evidence, an award of costs to cover this may be made.”

Overall, I am minded to allow in the CTM. It is an argument that needs to be made and, I believe, including it now is the best course to avoid further clashes over the registration of this mark.

26. Turning to the substance of the hearing, I will take each of the grounds as they are set out in the opponents Statement of Grounds.

**S. 3(6): Bad faith**

27. This ground was abandoned at the hearing.

**S. 5(2)(b): the earlier mark**

28. I will be making reference to guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

**Comparison of goods**

29. The application embraces the following goods and services:

Class 9     Softwares and software packages (recorded computer programs); statistics processing softwares; digital compact disc or other storage medium containing statistical data.

- Class 35 Business management; business management assistance; data compilation and systemization in a central database; computer, business, economic and administrative databases services; computerized files management; business inquiries, information or consultancy.
  - Class 42 Computer programming; leasing access time to a computer database (statistics data).
30. In my view, most of these are identical, or very similar, to those specified in opponents' CTM:
- Class 9 Magnetic data media, compact discs, interactive compact discs, optical discs, CD ROM, software, computer programs.
  - Class 35 Advertising; business management; business administration; office functions; arranging newspaper subscriptions, information, investigations, business research, business information, direct mail advertising, dissemination and distribution of samples, printed publication; market study, opinion poll, statistical information and studies; products promotion in the medical and pharmaceutical field on data base, management of computer files, organization of exhibitions intended for commercialization or advertisement.
  - Class 42 Medical care, veterinary and agricultural services; legal services, scientific and industrial research, computer programming, research in the pharmaceutical and medical field; prospecting, laboratories, professional consulting unrelated to conducting business.

There may be particular examples which present a more arguable case than others: even if it is possible to limit 'computer programming' in the second list of services in Class 42 (after the first semicolon) to 'the pharmaceutical and medical field', these are still captured by the applicants' 'computer programs', also in Class 42. More problematic for the opponents to claim as similar to anything they do, perhaps, are the services of 'leasing access time to a computer database (statistics data)'. However, I intend to proceed on the basis that the goods and services are identical, or very similar. This has a direct effect on the likelihood of confusion, as a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa* (*Canon*, paragraph 17). It thus represents the opponents' best case.

### **Distinctiveness of the earlier mark**

31. There are two issues here: the earlier mark's inherent capacity to distinguish and its distinctiveness on the marketplace. The law states (*Sabel*, paragraph 24) that:

“.. 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.”

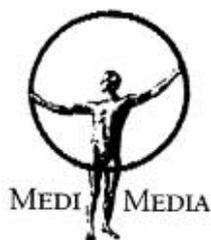
Thus there are two routes to possession of a 'strong' mark: choose one that is 'fancy' or arbitrary (in relation to the goods or services it brands), or use the mark a lot in the marketplace. The latter can make up for deficiencies in the former, and I do not believe that

the former need exclude the influence of the latter - the effect of both can be additory and summative.

32. However, as I have found above, there is little or no evidence at all of use of the opponents' mark in the UK. What there is, is thin attestation to any 'market place' distinction at all.
33. Nevertheless, the mark does carry a significant capacity to distinguish when taken as a whole, that is, with the words and the 'man' device. However, I do not believe that the MEDIMEDIA (or MEDI MEDIA) element (or elements) dominate. MEDIA has a common meaning, being a general reference to the agencies of mass communication. MEDI, on the other hand, has no such common meaning, but 'med' is a shorthand for medical (see the evidence of Ms. O'Rourke). In view of this, I do not consider the written elements of the mark to overshadow the whole – particularly when medical publications and the like are considered - but, taken together with the 'man' device, the totality has significant capacity to distinguish.

### Comparison of marks

34. The opponents' mark is:



35. This is to be compared with MEDIMED. The case law counsels that 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; (see *Sabel*, paragraph 23).
36. Visually, the marks have significant differences. This rather contradicts Mr. Malynicz's view that the marks were, visually, very close, and this represented his best case. That case, however, is based on the assumption that:

“.. normal fair use of that [i.e. the opponents'] mark is use as a word only mark. For instance, if I am a customer or a supplier or if I have to write to this company, I do not use the device. I use the word. Normal fair use in trade is as a word only. It is not only a word only mark, but that is one use of it.”
37. I struggle with this. One might also perceive of situations where a use of a particular mark on a particular good invites a wider understanding of normal and fair use. For example, items traded under a 'mixed' mark that are typically ordered verbally would tend to emphasise the word element in a mark over any device element. But I feel this would be obvious or require evidence. Neither is apparent here.

38. Further, the mark as registered includes a strong device element I do not believe I can ignore – indeed, the case law indicates that I should not - *Sabel* (paragraph 23) states that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.
39. The opponents registered their mark as it is, and I remain to be convinced that ‘normal and fair use’ incorporates examples that (without good reason) arguably change its character so as to extend its penumbra of protection under s. 5(2)(b). Of course, there may well be instances where a ‘mixed’ word plus device mark is so well known on the marketplace that the word component becomes as indicative of the product or services branded as the mark taken as a whole. I note that *Premier Brands UK Ltd v. Typhoon Europe Ltd* [2000] F.S.R. 767, at page 779, states that ‘..in the absence of argument or evidence to the contrary, the way in which the proprietor actually uses the mark can be said, at the very least *prima facie*, to be the paradigm case of its use in a normal and fair manner’. However, this was very much in the context of the extensive reputation of the mark at issue: use of a mark may alter its distinctive character – that much is clear from the case law (see *Sabel*, paragraph 24); notoriety enhances protection – but each case must be considered on its merits, as part of the global appreciation also advocated by the case law (*Sabel*, paragraph 22).
40. As I discuss below, I do not believe the opponents can argue any enhanced reputation on the marketplace. And I do not see in this case, based on their evidence, that it would be right for me to (effectively) extend the protection of the opponents’ mark simply because there might be (unexceptionally) examples in trade where it might be used as a word mark only. Many device marks with a word element would be treated in this way during verbal communication: they do not, thereby, become word only marks. Further, in my view, the distinctiveness of the opponents’ mark, as I have discussed above, rests in both the words and the device together. I do not believe I can consider it as a word mark alone.
41. Having said this, it is a dominant component within the mark, and must be considered as such. This is the clear import of the case law, where the overall impression created by marks bears in mind their distinctive and dominant components (*Sabel*, paragraph 23). Mr. Malynicz submitted that:
- “.. the two marks are about as similar as is possible to be, short of complete identity. It is possible to imagine something that is closer to our mark, but this is pretty close. If you added an S to the end of our mark, perhaps that would be closer. If you just added an I to the end of their mark, that would be closer. In my submission, these are very close visually for a start, and that is probably our best case. If they are sitting next to each other side by side, all but two of the letters are taken and that is non distinctive material, we say, at the end of the last syllable.”
42. The marks are visually close only if one ignores the device element. Even doing this, the one is one word, the other two. Further, close visual similarities between marks are not, necessarily, determinative: KOJAK and KODAK differ by one letter, yet are unlikely to be confused - for reasons other than appearance, which I will consider, for the marks in suit, now.
43. Aurally, I believe the marks demonstrate significant differences. MEDIMED will be pronounced in English as MED-E-MED (three syllables); the opponents’ mark, as MED-E-MEE-DE-A (five syllables). Mr. Redman’s suggestion that it could be pronounced MED-E-

MED-DE-A I think is far-fetched. The opponents' mark is separated by the device, and the MEDIA element is a common English word. Most consumers will recognise it as such and, without evidence to the contrary, say it, I believe, the way it is usually said (MEE-DE-A). For the same reason, though it is generally considered true that the stress in a word is on the first syllable and, as Mr. Malynicz stated, further suffixes are under emphasised or slurred, the manner in the MEDIA element is presented in the mark makes it a separate word, not a suffix.

44. Conceptually, the marks share the MEDI- element. This, I believe, will have a medical connotation. Mr. Malynicz certainly thought so. However, the MEDIA element of the opponents' mark has a very clear meaning, which differs from that of the applicants' mark.
45. In summary, I consider that the two marks share similarities. But I do not regard these as persuasive.

### **The average consumer**

46. The case law states that ‘.. the matter must be judged through the eyes of the average consumer of the goods/services in question’ (*Sabel*, paragraph 23), 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*, paragraph 27). In this matter, the goods and services in question suggest an average consumer may well be a professional; this certainly appears to be the opponents' target market. One may consider that such individuals will take more care over the purchasing process.

### **Likelihood of Confusion**

47. As part of the global appreciation, Mr. Malynicz suggested that I take into account the medical nature of the opponents' products, as there was case law supporting the belief that such earlier marks should be given a wider than normal sphere of protection. He cited the *Terbuline Trade Mark* [1990] RPC 21 and the decision of the Appointed Person in *OROPRAM* (O/208/02). I regard the former – from an Old Act case – as difficult to take as authoritative under the new regime. As for the latter, the Appointed person stated:

“.. I do not believe that different standards exist or are necessary to exist. The test of likelihood of confusion is flexible enough to allow each case to be judged according to its own peculiar facts.”

48. Even if I was to find that a comparison of ‘medical’ names should invite a lower threshold for finding a likelihood of confusion, I believe that would apply to the names of medicines, not to the products and services at issue here. But, in fact, I do not. My own belief is that trade mark law should be blind to this particular public service, which is really the purview of legislation relating to the safety of medicines. In general, such products should be subject to the same considerations as set out in the case law cited above. Of course (and this is in keeping with the view of the Appointed Person in *OROPRAM*) there may well be particular facts in a particular

case which make confusion more or less probable. One illustration might be characteristics associated with the average consumer (see the list cited in *OROPRAM* paragraph 25, from a decision of the First Board of Appeal in *TEMPOVATE/EMOVATE, EUMOVATE*, Case R 1178/2000-1, 14<sup>th</sup> February 2002). But see also my decision in *PROLONID/HEALONID (BL SRIS O/478/00)*.

49. I have found the marks to possess similarities, but also differences as well. They could be described as similar, but I do not believe, taking into account the ‘multi-factorial’ analysis required under s. 5(2)(b) (see *Reef Trade Mark* [2003] RPC 5, paragraph 14), that they are confusingly so, even assuming complete identity between the goods at issue. There may be some association with the earlier mark, but no confusion as to trade source (see *Sabel*, paragraph 26). This ground fails.

**s. 5(4)(a): the earlier right.**

50. Following the decision of the Appointed Person in the *WILD CHILD Trade Mark* ([1998] R.P.C. 455) case, I must consider whether, at the date of application, the opponents possessed under their mark a protectable goodwill for the goods at issue, that there would be confusion if the applicants used their mark in trade and that would lead to damage to the opponents’ established goodwill.

51. I note the following from *Reef Trade Mark* [2002] R.P.C. 19 (paragraphs 26 and 27) that ‘Passing off is essentially a question of fact: does the defendant in fact make a false representation as to the origin of this goods by using the mark in suit?’, and that:

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

52. In my view, the opponents have not even done enough to raise a *prima facie* case that they have goodwill under their mark. Mr. Malynicz was not unaware of the criticism directed to the quality of the evidence under this ground; he even accepted that his clients might struggle here, stating that ‘Passing off is difficult for us.’ However, he referred to the Statement of Mr. Redman, which claimed trade since 1992 in the UK, and that:

“..The Opponents’ offices in London receive a steady flow of visiting clinicians from such countries who are able to obtain an array of ... publications. The work of the Opponents is internationally famous and they and their products are very well known to medical practitioners throughout the United Kingdom and elsewhere.”

Mr. Redman later states that ‘reliable turnover and advertising figures for the United Kingdom ... would be placed on file as soon as possible and certainly so as to be available for the

Hearing'. Nothing was produced, and his views as given above are those of a non-legal professional in relation to the creation of goodwill in the UK. The import of *Reef*, joined with the exiguous nature of the evidence, leaves me with fatal doubts as to the creation of any goodwill under the mark in the UK, even for publications, let alone the other of the goods and services specified.

53. Besides, even if Mr. Malynicz's contention of a subsisting goodwill was correct, following my findings above under s. 5(2)(b), I do not believe the opponents could show that confusion would follow from use of the applicants' mark in the UK. This ground fails, and the opposition fails.

## **COSTS**

54. The applicants have successfully resisted the opposition and are entitled to an award of costs. Ms. O'Rourke suggested that I should award close to the maximum in view of the late (and permitted) request to amend the pleadings. I'm not sure why. The applicants were not put to any extra and excessive inconvenience in terms of filing further evidence, nor were they required to appear at an additional hearing. They did not appear at any hearings. Should any additional award reimburse a party for the extra effort the other party's tardiness has caused, or punish the latter for being so in the first place? In some instances, perhaps, both. However, in the circumstances of this case, I do not believe that the one page letter from Ms. O'Rourke should go unnoticed in costs, but not to the extent requested. I order the opponents to pay the applicants £1000.

**Dated this 11<sup>th</sup> Day of February 2003.**

**Dr W J Trott  
Principal Hearing Officer  
For the Registrar.**

## ANNEX

Class: 09:	Magnetic data media, compact discs, interactive compact discs, optical discs, CD ROM, software, computer programs.
Class: 16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks; prescription notebooks, prescriptions, stationery for doctors, medical phonebooks, therapeutical repertories, periodicals, medical dictionaries, drug dictionaries; printed matter, newspapers, journals, catalogs, books, publications, brochures.
Class: 35	Advertising; business management; business administration; office functions; arranging newspaper subscriptions, information, investigations, business research, business information, direct mail advertising, dissemination and distribution of samples, printed publication; market study, opinion poll, statistical information and studies; products promotion in the medical and pharmaceutical field on data base, management of computer files, organization of exhibitions intended for commercialization or advertisement.
Class: 38	Telecommunications; press agencies, communication by computer terminals, electronic messaging; radio, telegraphic, telephone communications; news transmitting; television broadcasting, transmission of information by telematic access codes; radio or television broadcast.
Class: 41	Education; providing of training; entertainment; sporting and cultural activities; arranging and conducting of colloquiums, conferences, congresses, symposiums, seminars, round tables namely in the medical and pharmaceutical industrial field, film production, organization of exhibition with educational purposes; publication of books and journal organization of exhibition for educational and cultural purposes.
Class: 42	Medical care, veterinary and agricultural services; legal services, scientific and industrial research, computer programming, research in the pharmaceutical and medical field; prospecting, laboratories, professional consulting unrelated to conducting business.