

O-116-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 81382
FOR A DECLARATION OF INVALIDITY
IN RESPECT OF TRADE MARK REGISTRATION No. 2314102
IN THE NAME OF MS S TUSSIE**

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**IN THE MATTER OF Application No. 81382
for a Declaration of Invalidity in respect of
Trade Mark Registration No. 2314102
in the name of Ms S Tussie**

BACKGROUND

1. Trade Mark No. 2314102 is for the mark BOTOMASK which is registered in Class 3 for a specification of “Non surgical beauty products, soaps, perfumery, essential oils, cosmetics”.
2. The mark stands registered from a filing date of 25 October 2002.
3. On 11 August 2003 Allergan, Inc. applied for the invalidation of the trade mark on the following grounds (as amended):
 - (i) Under Section 47(1) of the Act as the mark was registered in breach of Section 3(3)(b) because the mark is of such a nature, because it contains the prefix BOTO, as to deceive the public into believing that goods sold under the mark would contain botulism toxin type A, whereas the goods contain no botulinum toxin type A;
 - (ii) Under Section 47(2)(a) because the applicant is the proprietor of earlier trade marks to which the conditions set out in Section 5(2)(b) of the Act obtain, because the mark registered is similar to the following earlier registrations which are registered for similar goods and that there is a likelihood of confusion:

Registration No.	Mark	Date Registration Effective	Specification of goods
1504721	BOTOX	29 June 1992	Class 5: Pharmaceutical preparations; pharmaceuticals for the treatment of neurological disorders and muscle dystonias; all included in Class 5.
2255853	BOTOX	14 December 2000	Class 5: Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports

			injuries, cerebral palsy, spasms, tremors and pain.
2255854		14 December 2000	Class 5: Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain.
2248312		12 October 2000	Class 5: Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, cerebral palsy, spasms, tremors and pain. Class 16: Printed educational materials.
European Community Registration No. 1999481	BOTOX	14 December 2000	Class 5: Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain.

European Community Registration No. 2015832		14 December 2000	Class 5: Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain.
European Community Registration No. 1923986		12 October 2000	Class 5: Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, cerebral palsy, spasms, tremors and pain. Class 16: Printed educational materials.
European Community Registration No. 2575371	<i>It's not magic, it's</i> 	7 February 2002	Class 5: Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, cerebral palsy, spasms, tremors and pain.

(iii) Under Section 47(2)(a) because the applicant is the proprietor of earlier trade marks (see above) to which the conditions set out in Section 5(3) of the Act obtain in that the mark in suit is detrimental to the distinctive character (dilution) and/or takes unfair advantage of the distinctive character (free-riding) and/or takes advantage of

the repute (free-riding) of the applicant's BOTOX registrations, whether the applicant's goods are considered to be similar or dissimilar;

(iv) Under Section 47(2)(b) because there is an earlier right to which the condition set out in Section 5(4)(a) is satisfied, in that use of the mark in suit is liable to be prevented by the law of passing off.

4. The registered proprietor filed a counterstatement denying the grounds of invalidity, adding that the registered proprietor's product is a cosmetic beauty treatment which is applied to the skin in a non-invasive manner.

5. Both sides have filed evidence and ask for an award of costs in their favour.

6. The matter came to be heard on 8 March 2005 when the applicant for invalidity was represented by Mr Mellor of Counsel instructed by Carpmaels & Ransford and the registered proprietor by Mr Stephens of First Corporate, the registered proprietor's professional advisors in these proceedings.

APPLICANT'S EVIDENCE

7. The applicant's evidence consists of six witness statements, one each from Anthony Sauerman, Judy Williams, Nicholas Keith Howick, Michelle Irving, Dr Lucy Glancey and Dr R Saleh.

8. Anthony Sauerman's witness statement is dated 19 February 2004. Mr Sauerman is regional Senior Counsel for Allergan Limited (a subsidiary of the applicant company).

9. Mr Sauerman explains that Allergan Limited is the owner and manufacturer of a prescription pharmaceutical product that is marketed and sold globally under the BOTOX brand name. He adds that the BOTOX trade mark identifies the Botulinum Toxin Type A purified neurotoxin complex product manufactured and sold by Allergan and that use of the BOTOX trade mark distinguishes that product from similar Botulinum Toxin products manufactured and sold by other companies.

10. Mr Sauerman states that the BOTOX product is licensed for a range of indications in different countries, some of which are therapeutic uses and some of which are cosmetic uses. A list of these uses is attached at Exhibit AS2 to Mr Sauerman's statement. The list shows licensed uses in the UK as "therapeutic". Mr Sauerman adds that cosmetic uses are aimed at removing or reducing lines from the face, such as brow furrow, crow's feet and frown lines. Mr Sauerman goes on to say that in most countries, including the UK, it is legal and indeed common practice, for physicians to prescribe the use of a pharmaceutical product for unlicensed indications. While the BOTOX product does not currently have a license for a cosmetic indication in the UK, it is widely prescribed by physicians for cosmetic purposes and Mr Sauerman states that it is quite common and legal, for cosmetic clinics under the care of a physician to prescribe the BOTOX product for cosmetic purposes.

11. Mr Sauerman states that the BOTOX trade mark was first used in the UK in 1992.

12. Turning to product sales, Mr Sauerman states that the value of BOTOX sales in the UK for the last five years is as follows:

To the year ending	Amount (pounds sterling)
1999	£ 1,507,000
2000	£ 2,476,000
2001	£ 4,186,000
2002	£ 5,964,000
2003	£ 6,500,000

13. Mr Sauerman explains that the promotion of therapeutic uses mainly takes the form of providing materials and medical information concerning the BOTOX product to physicians, and attending exhibitions. He adds that the annual amount spent on promoting the BOTOX product in the UK, all relating to therapeutic use, for the past four years is:

Year ending	Amount
2000	US \$ 294,000
2001	US \$ 500,000
2002	US \$ 922,000
2003	US \$ 709,000

14. Mr Sauerman states that the BOTOX product has been the subject of a number of scientific papers concerning its therapeutic and cosmetic uses and examples of these papers are attached at Exhibit AS3 to his statement. He adds that BOTOX has attracted significant coverage in the UK press over the last few years and some examples are attached at Exhibit AS4 to his statement. Mr Sauerman points out that while this coverage is not always correct, Allergan has taken steps to rectify this situation when it can. He claims that the coverage has resulted in a broad awareness of the trade mark BOTOX and its uses, among the general public as well as those who have been treated with the product.

15. Mr Sauerman states that the BOTOX product has become so well known that the word BOTOX has been entered into some dictionaries, which recognise the word as a trade mark. Mr Sauerman draws attention to Exhibit AS5 to his statement, which contains copies of entries from Collins and Chambers. These state that the BOTOX product is a temporary treatment to make lines on the face less apparent and that it is used to treat muscle spasm and remove wrinkles.

16. Mr Sauerman asserts that the mark in suit, BOTOMASK, is a similar mark which seeks to associate the product sold under that mark with the BOTOX product. He draws attention to Exhibit AS7 to his statement, an example of a box containing the “BotoMask” product and to Exhibit AS8, a product package insert, the product being purchased by The Cheshire Image Clinic in February 2004, that refers to “BotoMask” and other related products. Mr Sauerman states that BOTO is used consistently on its own or in combination. He refers to the following questions and answers in the package insert:

“Q: Does Transformulas BotoMask actually contain Botulinum Toxin?”

A: Yes, Botulinum Type A is present in Transformulas BotoMask, which is the same substance found in the now popular Botulinum Toxin injections.

Q: What is Botulinum Toxin Type A?

A: A type of neuro-toxin produced by bacterium clostridium botulinum, which is responsible for the muscle relaxation.”

And he also draws attention to what is written on the box containing the “BotoMask” product. Under the words “Transformulas[®] for age lines” is written:

“BotoMask[®] - l’effet Boto[™] ...”

17. Mr Sauerma n submits that the above insinuates that the “BotoMask” product shares the same effect as the BOTOX product and this is deliberately designed to create an association between the marks. He goes on to refer to a quote from the leaflet (Exhibit AS8):

“The benefits of the traditional injection treatment can now be utilised in a much safer, non-invasive treatment which can be used in the home-for astonishing results.”

and contends that as the “traditional injection treatment” is the one used by BOTOX, it is no coincidence that BOTO is so similar to BOTOX.

18. Mr Sauerma n states that the applicant has reason to believe that the claim that “BotoMask” contains Botulinum Toxin Type A is false. He adds that at the request of the Irish Medicines Board Allergen recently tested a sample of “BotoMask” and found the product to contain no botulinum toxin of any sort whatsoever. A copy of the test report is attached at Exhibit AS9 to Mr Sauerma n’s statement. Allergen has not had the opportunity to test the sample purchased by The Cheshire Image Clinic. He goes on to state that The Irish Medicines Board instigated the testing of the sample of “BotoMask” on their own initiative when they became aware of the “BotoMask” product through “BotoMask” advertising. The Irish Medicines Board were concerned that if the “BotoMask” product did contain Botulinum Toxin Type A it should be a licensed pharmaceutical, which it is not, and under the Irish pharmaceutical licensing regulations the result of licensing would be that the advertising of the “BotoMask” product and its sale directly to the public would be contrary to the regulations.

19. Mr Sauerma n goes on to explain that recently the product package insert appears to have changed by the removal of references to botulinum toxin type A. Attached at Exhibit AS10 is a copy of a product package insert contained in “BotoMask” product packaging purchased directly from Transformulas during the week commencing 26th January 2004. He adds that the website of Transformulas has changed so that there is no longer a reference to Botulinum Toxin. Attached at Exhibit AS11 is a copy of part of the Transformulas website from Autumn 2003 and attached at Exhibit AS12 is a copy of the current website page, showing the difference.

20. Mr Sauerma n states that the “BotoMask” product is sold through various trade channels, for example through beauty salons as well as direct to the public. He contends that this is emphasised in a transcript of a GMTV feature from June 2002 attached at Exhibit AS13 to Mr Sauerma n’s statement, where different trade channels are referred to. Mr Sauerma n asserts that the emphasis throughout the promotional feature is on deliberate association of the “BotoMask” product with the BOTOX[®] trade mark, for example:

“How is it applied? In the same way as any good beauty mask to the whole face, neck and décolleté – traditional BOTOX could only be applied to the face area”.

21. Mr Sauerman concludes that the message seems designed to cause confusion to the consumer, to suggest that the “BotoMask” product is clearly associated with the BOTOX product and mark, the aim being to persuade consumers that the “BotoMask” product will work instead of or as well as the “traditional” BOTOX product, with the same active ingredient, but without the need for injection. A consumer can buy the “BotoMask” product directly from Transformulas, without advice from a medical practitioner or cosmetic specialist, believing it to be an effective treatment, achieving the same effects as a BOTOX treatment. In Mr Sauerman’s view the central aim and effect of the “BotoMask” marketing message is to generate confusion in the mind of the consumer between “BotoMask” and BOTOX®.

22. Ms Williams witness statement is dated 19 February 2004. She is Sales & Marketing Manager for the UK of Allergan Limited.

23. Ms Williams points out that she is responsible for managing the activities for the sales organisation for the BOTOX product in the UK. She explains that the BOTOX product is licensed in the United Kingdom for the following therapeutic (treatments):

- Treatment of blepharospasm and hemifacial spasms (approved 5/17/94)
- Cervical dystonia (approved 07/02/97)
- Treatment for dynamic equinus foot deformity due to spasticity in ambulant pediatric cerebral palsy patients, 2 years of age or older (approved 06/03/98)
- Management of hyperhidrosis of the axillae (approved 7/19/01)
- Focal spasticity, including the treatment of wrist and hand disability due to upper limb spasticity associated with stroke in adults (approved 5/2/02).”

24. Ms Williams states that while the BOTOX product is not licensed for any cosmetic uses in the UK, physicians may legally prescribe the use of a pharmaceutical product for unlicensed indications, and many prescribe the use of the BOTOX product for cosmetic purposes. She adds that, a great number of cosmetic clinics under the care of a physician purchase the BOTOX product from Allergan for cosmetic purposes and the most common off-label treatments are designed to reduce lines on the face, such as frown lines, brow furrow and crow’s feet.

25. Ms Williams’ explains that because BOTOX does not have a cosmetic licence, it is illegal for Allergan, or anyone else, to promote the product in any way whatsoever and, because the BOTOX product is a prescription only medicine (POM), it is illegal for Allergan to advertise the product direct to the public at all. She adds that Allergan goes to great lengths to ensure that it adheres to the rules against off-label promotion and advertising direct to the public. Unavoidably, this places Allergan at a competitive disadvantage against cosmetic products that are not subject to the same rules as pharmaceutical products and POMs. Because cosmetic products are not licensed products as such, there are no rules against off-label promotion and against advertising direct to the consumer.

26. In Ms Williams view the registered proprietor is associating its product with the BOTOX mark by using a similar mark and claiming similar effects for its product, thus creating confusion in the minds of customers.

27. Ms Williams goes on to refer to the copy of the product label that accompanied the sample of “BotoMask” purchased by The Cheshire Image Clinic in February 2004 (Exhibit JW1 to her statement). She states the following points would create confusion;

- “9.1 The name “BotoMask” is very similar in sound and sight to BOTOX; ®
- 9.2 Other product names have the same effect: “BotoSkinTonic”. “BotoSkinSerum” and “BotoSystem”.
- 9.3 The claim that “BotoMask” contains botulinum toxin type-A suggests that it is the cream version of BOTOX ®,
- 9.4 The claim that the “benefits of the traditional injection treatment can now be utilised in a much safer, non-invasive treatment” suggest that the two products have the same effect; and
- 9.5 On the front of the “BotoMask” box, the words “BotoMask – l’effect Boto...” clearly simply a strong link with BOTOX® and therefore causes confusion.
- 9.6 The claim that the product relaxes subdermal muscles matches the conclusions of BOTOX® clinical trials:-
- 9.7 *“The benefits of the traditional injection treatment can now be utilised in a much safer, non-invasive treatment, which can be used in the home – **for astonishing results**..... Transformulas BotoMask® can also prolong the time between traditional injection treatments”.*

The message suggests that the BotoMask product is as effective as an injection treatment and is complementary with injection treatments. The overall inference I believe that customers would take away from the message is that the BotoMask product is part of a comprehensive cosmetic system which could include an injection treatment. I think that customers would be likely to associate references to “traditional injection treatments” with BOTOX® products rather than any other competitor because of the similarity between BotoMask and the trademark BOTOX®.”

28. Ms Williams states that she is aware that many of Allergan’s BOTOX® customers have made or received enquiries about “BotoMask”, which she states, makes it clear that they believe this product to be associated with the BOTOX® product, and/or with Allergan. She adds that she recently received a telephone call from a physician in Greece asking her if Allegan sold “Botomask” and is aware that many of the Allergan product specialists in the UK have had similar enquiries, or their customers have had similar enquiries.

29. Ms Williams is aware of numerous web sites that are selling “BotoMask” and making “confusing claims” about this product. Examples of print outs from such websites are at Exhibit JW2 to her statement e.g. www.acounts.biz/beauty.htm -

“BotoMask (as seen on GMTV) - £60.00

This luxury facial is a needle free alternative to traditional Botox treatments at just a fraction of the cost. The mask contains the active ingredient of Botox but is applied to the skin in the form of a mask. The results are dramatic and noticeable lines, wrinkles and crows feet are instantly smoothed out in just one hour. The mask is then removed with serums and toners to reveal bright fresh skin”.

30. Ms Williams concludes by submitting that the respective marks are similar and that both the name of the “BotoMask” product and the way the product is being sold is creating confusion in the public’s mind.

31. Mr Howick’s witness statement is dated 19 February 2004. Mr Howick is a partner in Carpmaels & Ransford, the applicant’s professional advisors in these proceedings.

32. Mr Howick states that his firm has filed opposition and invalidation proceedings against a number of UK and European Community applications or registrations that contain the prefix BOTO for cosmetic goods in Class 3, or beauty and skin treatment services in Class 44. He goes on to provide examples. In relation to the current proceedings, Mr Howick’s firm did not receive any response to a request to cease all trade in the mark and the application for invalidation proceeded.

33. Ms Irving’s statement is dated 10 March 2004. She is a State Registered Nurse and Clinical Director of the Cheshire Image Clinic.

34. Ms Irving explains that her clinic employs nurses who go to over eighty beauty salons around the country to carry out aesthetic medical treatments, including injections of the applicant’s BOTOX product.

35. Ms Irving recalls a visit she made on 20 October 2003 to the Acacia Nail and Beauty Salon in Bury, a salon which carried out cosmetic treatments but no treatments involving injections of BOTOX. She states that an individual came into the salon and asked a member of staff, Sarah McDonald about BOTOX treatment. Ms Irving recollects the following reply:

“We don’t do BOTOX – we do the BOTOXMASK”

and she adds that the salon stocked “BotoMask”.

36. Dr Glancey’s statement is dated 16 February 2002. She is a medical doctor and practitioner who has recently been practicing in the cosmetics field.

37. Dr Glancey explains that many cosmetic products have recently come onto the UK market, aimed at people who wish to improve their appearance by removing wrinkles. She states that this has followed a significant increase in awareness of the effect of injecting Botulinum Toxin Type A to remove wrinkles and skin irregularities and that the best known branded product of this nature is BOTOX. Dr Glancey goes on to say that the marketing of cosmetic creams or treatments which claim to remove wrinkles is often carried out with reference to the effects of Botulinum Toxin Type A and that the perception of the general public is that such cosmetic products have the same effect as the well known BOTOX treatment, which is carried out by injection.

38. Dr Glancey states that patients approaching her for a consultation generally fall into two categories; they either ask for advice, or ask to be treated with a particular product of which they are aware. She adds that the popular press and magazines frequently carry features, advertisements or promotional copy suggesting that cosmetic products will achieve the same effect as the BOTOX treatment, but without injection.

39. Dr Glancey finds that patients are misled by product names which are similar to BOTOX as BOTOX is so well known and patients are confused into thinking there is a connection. She states that one such similar name is BOTOMASK.

40. Dr Saleh's statement is dated 23 March 2004. He is a medical practitioner and has been practicing as a doctor with the Transform Medical Group (Transform).

41. Dr Saleh explains that patients come to Transform either by recommendation, or having seen advertisements in the media and he has consultations with some of these patients. He goes on to say that for skin treatments such as wrinkles or furrows, there are various treatment options, such as injection of a Botulinum Toxin Type A product, the best known of which is BOTOX, or the possible alternative of a dermal filler.

42. Dr Saleh states that he has noticed a proliferation of facial creams or other topically applied facial products on the UK market in recent times and he recalls seeing a product called BotoMask for the first time at an exhibition in Manchester in October 2003. Dr Salah states that, since then, he has had patients asking him if BotoMask is the same as BOTOX without injections, and whether the product has BOTOX in it. In Dr Salah's view the name BotoMask generates a connection in the mind of the patient with the well established BOTOX product.

REGISTERED PROPRIETOR'S EVIDENCE

43. The registered proprietor's evidence consists of a witness statement dated 7 July 2004 by Graham Robertson Stephens. Mr Stephens is a director of FCLS (Group) Limited, a company providing corporate and trade mark law services to the accounting and legal professions.

44. Mr Stephens explains that on 24 July 2002, Ms Sharon Tussie, a partner in the accountancy firm Tussies, requested that his company register the trade mark BOTOMASK. Ms Tussie advised that the proprietor would be herself, as her client, a director and majority shareholder in Transformulas International Limited, was the true Beneficiary of BOTOMASK but was in the process of a divorce and it was thought expedient from an asset perspective to put the application in Ms Tussie's name. The application was made in Class 3 as the BOTOMASK product is essentially a beauty product without surgical or invasive applications.

45. Mr Stephens states that following registration of the mark, Ms Tussie began to receive telephone calls and faxes from an individual purporting to be the proprietor of Allergan in California demanding cessation of use of the BOTOMASK mark. Mr Stephens describes these actions as harassment but states that following contact with the applicant's agents in which he requested that such communications end, no further contact was made.

46. Mr Stephens asserts that Transformulas International Limited has a worldwide reputation for the supply and application of beauty treatments and have invested considerable sums in the development of the BOTOMASK product. He adds that they have conducted extensive research and attached at Exhibit GRS01 to Mr Stephen's statement is a copy of the Assessment of Business Enterprise's report, dated 12 February 2003 as to the suitability of the product for sale and distribution in Europe. Mr Stephens goes on to refer to Exhibits

GRS02 and GRS03 to his statement which are copies of evaluations of two clinical trials undertaken in France.

47. Finally, Mr Stephens states that on 15 January 2004 Ms Tussie advised him that an error had been identified on the Transformulas International Limited marketing literature which indicated that the BOTOMASK product contained a BOTOX related ingredient, which is incorrect. The product contains no such ingredient and all Transformulas marketing and product literature has been amended accordingly.

APPLICANT'S EVIDENCE IN REPLY

48. The applicant's evidence in reply consists of a witness statement dated 7 September 2004 by Susan J Hinchey. Ms Hinchey is Corporate Trade Mark Manager of Allergan Inc. (the applicant company).

49. Ms Hinchey refers to the contacts made with Ms Tussie and goes on to provide details of such contacts. She denies harassment and states that she behaved professionally and sought a constructive dialogue.

50. Ms Hinchey points out that the claim to a worldwide reputation for the supply and application of beauty treatments on behalf of Transformulas International Limited is not supported by the evidence.

51. This concludes my summary of the evidence filed in this case.

PRELIMINARY ISSUE

52. At the hearing Mr Stephens attempted to introduce new evidence relating to the registration in France, by "partners" of Transformulas, of the trade mark BOTODERM, together with an unattached statement, which, he asserted, demonstrated that BOTO prefixed products had been traded in France since 1999. He submitted that as prior trading in France had taken place, it was in order to register in the UK.

53. On behalf of the applicant, Mr Mellor resisted the introduction of the new evidence and added that, in any event this evidence would not be of assistance in these proceedings as the position in France would not assist consideration of the situation in the UK.

54. I rejected this application to file new evidence because:-

- (i) no satisfactory explanation was put forward for the delay in filing this evidence;
- (ii) no application had been made for leave to introduce this evidence prior to the commencement of the Hearing, despite Mr Stevens having filed a skeleton argument;
- (iii) allowing it to be introduced during the course of the Hearing would have resulted in the applicant justifiably feeling that it had been "ambushed" with new information to which they should have been given a chance to respond in evidence;

- (iv) allowing the introduction of such evidence would therefore have likely required an adjournment of the hearing; and most importantly,
- (v) the evidence was not of such a nature as to have any real practical impact on the outcome of these proceedings, as the information relating to the situation in France would not demonstrate how the relevant UK customer for the goods would perceive the position in the ordinary course of trade within the relevant jurisdiction – the UK.

55. In all the circumstances, the proposed introduction of the new evidence could not be justified.

56. I now turn to the decision.

DECISION

57. Firstly I go to the ground of opposition based upon Section 5(2) of the Act, which reads as follows:

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

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

58. An earlier right is defined in Section 6, the relevant parts state:

"6.-(1) In this Act an "earlier trade mark" means –

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

59. I take into account the 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.

60. It is clear from these cases that:

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

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*.

61. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection for such a mark. The applicant has filed evidence relating to the reputation of its BOTOX trade mark. It was common ground at the Hearing that the BOTOX trade mark has a significant reputation, in particular in relation to pharmaceutical preparations for the treatment of wrinkles.

62. The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchen QC sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C. in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion.”

63. In the present case it seems to be that the applicant’s BOTOX trade mark is fully distinctive in an inherent context, notwithstanding its reputation. On the basis of reputation and inherent distinctiveness it is entitled to a wide penumbra of protection and I shall take this into account for the purposes of this decision.

64. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must compare the mark in suit and the applicant’s registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods within the respective specifications.

65. The evidence shows that the registered proprietor has used its BOTOMASK trade mark in respect of a cosmetic face mask for fading lines, lessening wrinkles and rejuvenating the skin. While the registered proprietor claims a reputation in the BOTOMASK mark this is not substantiated by the evidence filed in these proceedings.

66. The evidence filed by the opponent (see paragraphs 16 to 20 of this decision) demonstrates that the proprietor has claimed in its leaflets accompanying the product that its product contains Botulinum Toxin, the same substance found in the now popular Botulinum Toxin injections ie the product sold under the BOTOX trade mark. Furthermore, it is promoted as an alternative to injection treatments, for example the leaflet states:

“the benefits of the traditional injection treatment can now be utilised in a much safer, non-invasive treatment, which can be used in the home-for astonishing results”.

67. Furthermore the BOTOMASK product packaging states that:

“it can also be used to prolong the time between courses of traditional injection treatments”.

68. The above clearly shows that the BOTOMASK product has been sold and promoted as an alternative or adjunct to Botulinum Toxin injections. In light of this, it is perhaps not

totally surprising that third parties, including those in the trade, have promoted BOTOMASK as an alternative traditional BOTOX treatment.

69. Somewhat extraordinarily, the BOTOMASK product never contained Botulinum Toxin and the proprietor seeks to explain its earlier promotional activities as a mistake. However, the fact remains that prior to the relevant date for these proceedings the proprietor was promoting its product as a direct alternative or adjunct to Botulinum Toxin injections such promotion was successful in that third parties including the trade, offered it directly as an alternative or adjunct to the BOTOX product. I shall take the proprietor's use of its mark into account.

70. I now go to a comparison of the goods specified within the mark in suit, with those of the applicant.

71. In determining whether the services covered by the registration are similar to the goods covered by the earlier trade mark I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (pages 296, 297) as set out below:

“the following factors must be relevant in considering whether there is or is not similarity:

- (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 services;
- (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 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 the 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.”

72. Whilst I acknowledge that in the view of the CANON-MGM judgment by the European Court of Justice (3-39/97) the *Treat* case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in *TREAT*) are still relevant in respect of a comparison of goods.

73. The applicant's and proprietor's goods are both intended to reduce or remove wrinkles on the face. They have the same purpose or use. Furthermore, the customer is the same ie those members of the public who wish to mitigate the effects of aging by reducing/renewing wrinkles. While the physical nature of the products differ – BOTOX is a prescription only injection, whereas BOTOMASK is a cosmetic face cream – they would be available through

the same channels eg beauty clinics. In addition, as the evidence makes clear, they are either alternatives and thus in competition, or the BOTOMASK cream could be used in adjunct to the BOTOX injection and thus be a complementary product. In my view the goods on which the respective marks have been used are closely similar.

74. In my considerations I must not lose sight of the fact that the specification of the mark in suit, in addition to “non-surgical beauty products” and “cosmetics” – (being goods upon which the BOTOMASK mark is used and which include cosmetic beauty creams to reduce/remove wrinkling), also includes “soaps, perfumery and essential oils”.

75. The applicant’s BOTOX registrations include “pharmaceutical preparations for the treatment of wrinkles”. On the basis of notional, fair use such goods could be in the form of creams, oils or even soaps. Furthermore, on the basis of notional, fair use the proprietor’s soaps and essential oils could be cosmetic skin care or skin improvement products intended to reduce aging effect on the skin. These respective goods would share essentially the same purpose or use and the customer would be those members of the public looking to care for and/or improve the appearance of their skin. While the nature of the products would differ, in that one is a prescription product and the other generally available, the respective goods could be available through the same outlets eg beauty clinics or pharmacists, where the cosmetic product could well be an “off the shelf” alternative or complementary product to the pharmaceutical product. In my view, the proprietor’s “soaps” and “essential oils” are to some degree similar to the applicant’s “pharmaceutical preparations for the treatment of wrinkles”.

76. The proprietor’s specification also includes “perfumery” which Collins English Dictionary defines as “perfumes in general”. I cannot see that “perfumery” would include goods similar to that of the applicant given that the purpose of “perfumery” is merely to impart a pleasant scent to the user.

77. I now go to a comparison of the respective marks.

78. The applicant submits that the proprietor’s BOTOMASK mark has been derived from its BOTOX trade mark. However, there is no direct evidence on this point. The proprietor has pointed to a number of possible origins for the prefix BOTO, including that of a River Amazon dolphin and a surname. I do not find the above submissions of any real assistance and it is my view that the relevant customer in these proceedings will perceive both BOTOMASK and BOTOX as invented words in their totalities, albeit that the suffix MASK in the word BOTOMASK is descriptive in relation to beauty or face masks comprising cosmetic creams. The issue before me is whether there is a likelihood of confusion on the part of the public and the derivation of the respective marks is by no means the key. It is the likely perception of the relevant public on a global appreciation that will decide this ground.

79. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. However, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in my comparison, reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how the marks would be perceived by customers in the normal course and circumstance of trade. I must bear this in mind when making the comparisons.

80. At the hearing Mr Mellor concentrated his comparison of the mark in suit with the applicant's earlier registrations, UK No 2255853 and European Community No 1999481, for the word BOTOX (solus). I agree that these registrations represent the applicant's strongest case and for practical purposes I shall limit my comparisons of the marks accordingly.

81. I go to a visual and aural comparison of the respective marks. As mentioned above, both marks comprise invented words but the suffix MASK in the mark in suit, is meaningful in relation to cosmetic masks for skin treatments ie the goods on which the proprietor has used its mark. In relation to such goods, the prefix BOTO is the dominant, distinctive element within the word BOTOMASK. While the marks must be considered in their totalities, it seems to me that the relevant public will readily identify that the word MASK is a descriptive element in relation to de-wrinkling treatments in the form of face creams and that this will effect their perception of the mark, when it is seen or heard. The dominant and distinctive prefix to the mark in suit ie BOTO shares the exact same first four letters of the applicant's five letter highly distinctive BOTOX mark. When the descriptive connotation of the suffix MASK is taken into account, it seems to me that there is obvious visual and aural similarity between the marks as a whole or in their totalities, in respect of goods where the word MASK is descriptive ie these goods on which the BOTOMASK trade mark has been used and which are encompassed in the terms "non-surgical beauty products" and "cosmetics" within the proprietor's specification of goods. In relation to those goods where the suffix MASK is not descriptive ie "soaps, perfumery, essential oils", the overall similarity between the respective marks is far less obvious and while some similarity exists (the respective marks share the same first four letters), there is reduced scope for confusion.

82. Next a conceptual comparison of the marks. As both marks comprise invented words they do not possess a clearly defined conceptual identity. However, both marks share the letters BOTO (the dominant distinctive element with the proprietor's mark). Accordingly, there is some conceptual similarity overall, given the highly distinctive nature of the applicant's BOTOX mark and the degree of commonality.

83. In my considerations as to the likelihood of confusion I must also take into account that the applicant has filed evidence which, it submits, shows confusion in the market place.

84. It seems to me that the evidence of Dr Glancey and Dr Saleh (paragraphs 36 to 42 of this decision refer) is essentially expert evidence giving their views as to whether the respective marks are likely to confuse the relevant public. I do not find such evidence to be of any great assistance and I bear in mind the following comments of Millet L J in *The European Limited v The Economist Newspaper Limited* [1998] FSR 283 at 29):

"The function of an expert witness is to instruct the Judge of those matters which he would not otherwise know but which it is material for him to know in order to give an informed decision on the question which he is called on to determine. It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the judge might otherwise be ignorant and which may be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinion whether the two signs are confusingly similar. They are experts in the market, not on confusing similarity In the end the question of confusing similarity was one for the judge. He was bound to make up his own mind and not leave the decision to the opinion of the witnesses".

85. The evidence of Ms Irving (paragraphs 33 to 35 of this decision refer) goes more directly to the point as it demonstrates an actual instance of confusion. However, one instance of confusion is by no means conclusive as to public perception as a whole.

86. The judgements of the European Court of Justice mentioned earlier in this decision make it clear that in my comparisons I must take into account the average customer for the goods, the category of goods in question and how they are marketed.

87. The customer for both the applicant's and proprietor's products are members of the public seeking to improve their appearance in the main by mitigating the effects of the human aging process. As shown by the evidence, the relevant goods are available through the same outlets eg beauty clinics, and the proprietor has promoted its product as an alternative or complementary treatment to the applicant's product, such promotion also being taken up by third parties with direct reference to the applicant's trade mark. While the respective products are likely to be purchased with a good degree of care, it does not follow that there will be no likelihood of confusion as all relevant circumstances must be taken into account.

88. On a global appreciation taking into account the relevant factors, I have come to the following conclusions:

- (i) the applicant's BOTOX trade mark is highly distinctive and is deserving of a wide penumbra of protection;
- (ii) on the evidence before me the applicants "pharmaceutical preparations for the treatment of wrinkles" are closely similar to the proprietor's cosmetic face cream which is encompassed within the descriptions "non surgical beauty products" and "cosmetics" within its specification of goods;
- (iii) there is some, much lesser, degree of similarity between the applicant's goods and the proprietor's "soaps" and "essential oils".
- (iv) there is no similarity between the applicant's goods and "perfumery";
- (v) the respective marks are closely similar in respect of goods where the suffix MASK (in BOTOMASK) is descriptive ie goods encompassed within "non surgical beauty products" and "cosmetics";
- (vi) in relation to those goods where the suffix MASK is not descriptive ie "soaps, perfumery, essential oils", the overall similarity between the marks is considerably reduced and there is less scope for confusion;
- (vii) while the nature of the goods means that the customer would be relatively discerning, the proprietor has promoted its goods as being an alternative or complementary treatment to the applicant's goods.

89. On a global appreciation I have reached the following decisions on the Section 5(2)(b) ground:

- (i) the application for invalidity succeeds in relation to “non surgical beauty products” and “cosmetics” where, I believe, there is a likelihood of confusion;
- (ii) the application fails in relation to “soaps, perfumery, essential oils” where the considerably lesser degree of similarity between the respective marks and goods means that there is no likelihood of confusion to the relevant public.

Section 5(4)(a)

90. Next, the Section 5(4)(a) ground.

Section 5(4)(a) states:

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

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

91. The law on the common law of passing off is clearly set out by Geoffrey Hobbs QC, acting as the ‘Appointed Person’, in *Wild Child* [1998] 14 RPC 455:

“A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.C 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.”

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition of ‘passing off’, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the fact before the House.”

92. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action of passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective field of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

93. Thus, to succeed in a passing off action, it is necessary for the applicant to establish that at the relevant date (i) they had acquired goodwill under this mark, (ii) that use of the registered proprietor’s mark would amount to a misrepresentation likely to lead to confusion as to the origin of their services, and (iii) that such confusion is likely to cause real damage to goodwill.

GOODWILL

94. In my consideration under Section 5(2)(b) I found that the application has a reputation in relation to its BOTOX trade mark. I have no doubt that it possesses sufficient goodwill to launch a passing off action.

MISREPRESENTATION

95. While the applicant possesses a reputation, it seems to me that following the decision reached in relation to Section 5(2), the Section 5(4)(a) ground places it in no stronger position. There is no obvious stronger connection between those remaining goods which the applicant disputes and those goods for which the opponent possesses a reputation.

96. To succeed in relation to the relevant goods the applicant has to show that the relevant public will believe that these goods provided by the registered proprietor ie “soaps, perfumery, essential oils” are goods of the applicant.

97. I have already compared the applicant’s and registered proprietor’s trade marks and found them to be similar. It is well established that in the law of passing off there is no limitation in respect of the parties’ field of activity. Nevertheless the proximity of an applicant’s field of activity to that of the opponent is highly relevant as to whether the acts complained of amount to a misrepresentation.

98. In essence the question I have to address is whether the relevant public seeing the registered proprietor’s mark used on the remaining Class 3 goods (see above) would be likely to believe the goods were being offered by the opponent. In *Harrods v Harrodian School* [1997] RPC 697, Millet LJ stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services”.

99. In the recent case of *South Cone v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* 16 May 2001, HC 2000 APP 00617, Pumfrey J in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

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

Evidence of reputation comes primarily from the trade and the public and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

100. The applicant’s evidence going to confusion only relates to the proprietor’s face mask creams. I do not consider that the applicant has discharged the onus of showing that the necessary misrepresentation required by the tort of passing off will occur in relation to soaps, perfumery and essential oils. The application for invalidation under Section 5(4)(a) fails in relation to those goods.

Section 5(3)

101. Next, the Section 5(3) ground.

102. Section 5(3) of the Act, as amended, reads as follows:-

“5-(3) A trade mark which –

- (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, 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.”

103. Following my conclusions under Section 5(2) of the Act, it is only necessary to consider the applicant’s Section 5(3) ground in relation to goods for which I have found that there is no likelihood of confusion to the relevant public ie “soaps, perfumery, essential oils”.

104. The purpose and scope of Section 5(3) of the Act has been considered in a number of cases including *General Motors Corp v Yplon SA* [2000] RPC 572 (Chevy), *Premier Brands UK Limited v Typhoon Europe Limited* [2000] FSR 767 (Typhoon), *Daimler Chrysler v Alavi* [2001] RPC 42 (Merc), *C A Sheimer (m) Sdn Bhd’s TM Application* [2000] RPC 484 (Visa), and in *Intel Corporation v Kirpal Singh Sihra* [2003] RPC 44 (Intel).

105. The points which emerge from these cases are as follows:

- (a) ‘Reputation’ for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned with the products or services covered by the trade mark (paragraph 26 of the ECJ’s judgement in *Chevy*);
- (b) The provision is not intended to give marks “an unduly extensive protection” – there must be actual detriment or unfair advantage (not merely risks) which must be substantiated to the satisfaction of the national court or tribunal (paragraph 43 of the Advocate General’s Opinion in *Chevy* and paragraph 88 of Pumfrey’s J’s judgement in the *Merc* case);
- (c) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J in the *Typhoon* case);

(d) The stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (paragraph 30 of the ECJ's judgement in the *Chevy* case);

(e) Confusion as to the trade source of the goods or services offered for sale under the later mark is not a necessary condition for there to be detriment to the earlier mark, but is one form of detriment (paragraph 88 of Pumfrey J's judgement in the *Merc* case);

(f) Detriment can also take the form of making the earlier mark less attractive – tarnishing – or less distinctive – blurring (paragraph 88 of Pumfrey J's judgement in the *Merc* case), which may be easier to show if the type of goods in respect of which the later mark is to be used are of a type which would reflect negatively on the association the public currently makes between the earlier mark and the goods for which it has a reputation (paragraph 23 of Patten J's judgement in *Intel*);

(g) Unfair advantage can take the form of feeding on the fame of the earlier mark in order to substantially increase the marketability of the goods or services offered under the later trade mark (per G Hobbs QC in *Visa* at page 505, lines 10-17);

(h) Once an opponent has satisfied the basic tenets of Section 5(3), the burden shifts to the applicant to show that his use is not “without due cause”; an applicant will only have “due cause” if he can demonstrate that he is under such a compulsion to use the later mark that he cannot honestly be asked to refrain from doing so (per Neuberger J in *Typhoon* at page 791).

106. In the present proceedings, Section 5(3) is pleaded whether the respective goods are considered to be similar or dissimilar.

107. From my earlier findings in these proceedings it follows that I accept that the respective marks are similar, but that the degree of similarity is relatively slight in relation to goods where the suffix MASK (in BOTOMASK) is not descriptive ie the goods at issue here. Furthermore, in my earlier findings I concluded that there is some similarity between the goods for which the applicant possess a reputation and the proprietor's soaps and essential oils, but that there was no similarity between the applicant's goods and perfumery.

108. Turning to the issue of the applicant's repute in its mark, I have no doubt that its BOTOX trade mark is known by a considerable part of the public concerned with pharmaceutical preparations for the treatment of wrinkles and/or muscle spasms.

109. I now go to whether the applicant can be said to have established one or more of the adverse consequences envisaged in the Section. The applicant will need to show detriment or that unfair advantage has been taken of the distinctive character or repute of the BOTOX trade.

110. The nature of the test and the standard of proof required under Section 5(3) was recently considered by the Registrar's Hearing Officer, Mr Reynolds in the QUORN HUNT decision [2005] ETMR 11. His summary is as follows:

“60. In the Chevy case, the Advocate General said:

“43. It is to be noted in particular that Article 5(2), in contrast to Article 5(1)(b), does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: “takes unfair advantage of, or is detrimental to” (emphasis added). Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say, properly established to the satisfaction of the national court: the national court must be satisfied by evidence of actual detriment, or of unfair advantage. The precise method of adducing such proof should in my view be a matter for national rules of evidence and procedure, as in the case of establishing likelihood of confusion see the tenth recital of the preamble.”

61. More recently in *Mastercard International Incorporated and Hitachi Credit (UK) Plc*. Mr Justice Smith dealt with a submission by Counsel for the Appellant (on appeal from a Registry opposition decision) that Section 5(3) was concerned with possibilities rather than actualities. Commencing with the above passage from *Chevy*, the judge received the leading cases dealing with the point including observations by Pumfrey J in the *Merc* case and Patten J in *Intel Corporation v Kirpal Singh Sihra* [2003] EWHC 17 (Ch). He concluded that the Registry Hearing Officer had been right to conclude that there must be “real, as opposed to theoretical, evidence” that detriment will occur and that the Registry Hearing Officer was “right to conclude that there must be real possibilities as opposed to theoretical possibilities”.

62. I should just add that, whilst the above extracts refer to real evidence of the claimed form of damage, these cannot necessarily mean that there must be actual evidence of damage having occurred. In many cases that come before Registry Hearing Officers the applicant’s mark is either unused or there has been only small scale and recent use. No evidence of actual damage is possible in such circumstances. I, therefore, interpret the above reference to mean that the tribunal must be possessed of sufficient evidence about an opponent’s use of its own mark, the qualities and values associated with it and the characteristics of the trade etc that it is a reasonably foreseeable consequence that use of the applied for mark will have the claimed adverse consequence(s).

63. Moreover, even if it is accepted that there will be damage it must be more than simply of trivial extent as is evident from the following passage from *Osis Stores Ltd’s Trade Mark Application* [1998] RPC 631:

“It appears to me that where an earlier trade mark enjoys a reputation, and another trader proposes to use the same or similar mark on dissimilar goods or services with the result that the reputation of the earlier mark is likely to be damaged or tarnished in some significant way, the registration of the later mark is liable to be prohibited under Section 5(3) of the Act. By ‘damaged or tarnished’ I mean affected in such a way so that the value added to the goods sold under the earlier trade mark because of its repute is, or is likely to be, reduced on scale that is more than de minimis”.

64. I note too the following from Mr Geoffrey Hobbs QC (sitting as a Deputy Judge) in *Electrocoin Automatics and Coinworld*:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.” (footnotes omitted)”.

111. The applicant’s evidence relating to the use and perception of the BOTOMASK trade mark goes to its actual use ie use in relation to facial creams, in particular anti-aging facial creams. No evidence has been filed on public perception to use of the mark of the goods now under consideration ie soaps, perfumery and essential oils. Accordingly, I have to form my own opinion on the issue taking into account the nature of the goods and the relevant customer.

112. The opponent’s relevant reputation, in the field of the treatment of wrinkles. While I can readily appreciate that its repute could extend to anti-wrinkling creams, I am far from convinced that the mark BOTOMASK would be associated by the relevant public as having any connection whatsoever with the BOTOX trade mark, in relation to use on soaps, perfumery and essential oils. The suffix MASK within the BOTOMASK mark is not descriptive in relation to such goods and as far as I am aware in general, “soaps, perfumery and essential oils” do not possess anti-wrinkling characteristics, are not generally promoted as possessing anti-wrinkling characteristics and are not generally perceived as possessing such characteristics. Certainly there is no evidence to the contrary.

113. Section 5(3) is not intended to have the sweeping effect of preventing the UK of any sign that is similar to a registered mark with a reputation. In my view it is by no means obvious or likely that the reputation or the distinctive character of the BOTOX trade mark would be effected by use of the BOTOMASK mark on soaps, perfumery or essential oils. The onus lies on the applicant and the onus has not been discharged.

114. The Section 5(3) ground fails.

SECTION 3(3)(b)

115. Finally, the Section 3(3)(b) ground. Section 3(3)(b) of the Act reads as follows:

“3(3) A trade mark shall not be registered if it is –

(a)

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

116. The applicant submits that the mark in suit breaches the above requirement because it contains the prefix BOTO which would deceive the public into believing the goods sold under the mark would contain Botulinum Toxin type A, whereas the goods contain no Botulinum Toxin type A.

117. Section 3(3)(b) is an absolute ground of objection which requires supporting evidence. There is no evidence to show that the word or prefix BOTO is indicative of the presence of

Botulinum Toxin type A and the assertion is not supported by dictionaries, works of reference or evidence of public perception.

118. There is nothing inherently deceptive about the word/prefix BOTO in relation to the goods specified by the registration and no evidence has been put forward to the contrary. I therefore dismiss this ground of invalidity.

OUTCOME

118. The application for invalidity has partially succeeded under Section 47(2)(a) of the Act and Section 47(5) of the Act applied. Consequently, “non surgical beauty products” and “cosmetics” are to be removed from the specification of the mark in suit, whose specification will be amended to read:

“Soaps, perfumery, essential oils.”

COSTS

119. As the application for invalidity has only been successful in part, I make no order as to costs in these proceedings.

Dated this 26th day of April 2005

**JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General**