

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2150015
BY RIGEL PHARMACEUTICALS, INC
TO REGISTER THE MARK RIGEL IN CLASSES 5 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 49657
BY EFAMOL LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2150015
by Rigel Pharmaceuticals, Inc
to register the Mark RIGEL in Classes 5 and 42**

and

**IN THE MATTER OF Opposition thereto under No 49657
by Efamol Limited**

DECISION

1. On 4 November 1997 (but claiming an International Priority date of 5 May 1997) Rigel Pharmaceuticals, Inc applied to register the mark RIGEL for the following specification of goods and services

Class 5:

Pharmaceuticals for use in the treatment of viral diseases, cardiovascular and inflammatory diseases, and cancer, all for dispensing by prescription only.

Class 42:

Research and consultancy services in the fields of medicine, pharmacy and surgery; research and development of technologies and scientific data in the field of new drug development for others.

2. The application is numbered 2150015.

3. On 13 April 1999 Efamol Limited filed notice of opposition to this application. They say they are the holders of Plant Breeders Right No. 6347 for a variety of *Oenothera* (evening primrose) known as RIGEL. Oil derived from the plant is used to supplement the diet and, it is said, may assist in the treatment of viral diseases, cardiovascular diseases, inflammatory diseases and cancer. The particular variety of *Oenothera* covered by the Plant Breeders Right is said to be shown to produce a high percentage of gamma linolenic acid, this being the main beneficial ingredient. To date these plants are only grown in China under licence from the opponents. Additionally one of the companies associated with the opponents conducts research and consultancy services for the opponents involving evening primrose oil from the plant RIGEL and other varieties. Objection is said to arise as follows

(i) under Section 3(1)(c) in that the mark would designate a characteristic of the goods

if products bearing the mark applied for contained evening primrose oil derived from the plant

- (ii) under Section 3(3)(b) in that the public would be deceived if products bearing the mark did not contain evening primrose oil derived from the plant
- (iii) under Section 5 having regard to the rights conferred on the opponents under the Plant Breeders' Right provisions.

4. The applicants filed a counterstatement in which they make no admissions as to the opponents' claims and deny the specific grounds of objection. They offer two comments in particular on the position. The first to the effect that "The Mark of Application Number 2150015 (the opposed application) is sought to be registered in respect of specific pharmaceuticals and research and consultancy services. The identification of such products and services with the name of a plant does not inevitably associate such goods and services with products derived from that plant"; and the second to the effect that "any rights enjoyed by the opponent in the name RIGEL are restricted to the particular plant variety in respect of which the Plant Breeders' Right No. 6347 was granted". It is denied that the goods and services of the application are identical or similar to any covered by the Plant Breeders' Right.

5. Both sides ask for an award of costs in their favour.

6. Both sides filed evidence. The matter came to be heard on 3 April 2002 when the applicants were represented by Ms H Mensah of Counsel instructed by Lloyd Wise and the opponents by Ms F Clark of Counsel instructed by Miller Sturt Kenyon.

Opponents' evidence

7. The opponents filed a statutory declaration by Petra Herkul who describes herself as an authorised signatory of Efamol Ltd. She exhibits the following

- A - a copy of Plant Breeder's Right certificate No. 6347
- B - copies of publicity material relating to the derivation of evening primrose oil and the extraction process used
- C - a copy of the introduction of a bibliography of published papers relating to the application of the constituents of evening primrose oil along with a report published in "Chemistry in Britain" discussing the efficacy of evening primrose oil in treating diseases
- D - copies of publicity material and packaging for some of the products containing evening primrose oil

- E - a copy of a statutory declaration filed in a separate action (involving a different applicant) giving information on sales and promotional activities under the EFAMOL brand
- F - a report promoting the opponents' research and plant breeding programme
- G - a report on the technical examination of the RIGEL variety of Oenothera
- H - a report discussing the increase in beneficial ingredients which can be extracted from the plant variety RIGEL compared to other evening primrose varieties (the actual exhibit does not correspond to this description)
- I - product packaging referring to Efamol's plant varieties and the higher concentration of beneficial constituents that can be obtained as a consequence

8. Ms Herkul concludes that "members of the public, having had over twenty years of awareness, readily accept the concept of taking evening primrose oil either in the form of a pharmaceutical product or an OTC product to assist in a variety of complaints and diseases. Moreover, members of the public are also aware that the beneficial constituents vary from one source to another and that the best evening primrose plants are those bred by Efamol. Following the use of the Rigel variety, I verily believe that members of the public would be confused by the use of the mark RIGEL in connection with products, or any research being undertaken, as being those connected with my company."

Applicants' evidence

9. The applicants filed a witness statement by Sarah Kate Szell who exhibits the results of various dictionary searches which suggest that the only definition of the word RIGEL is that it is the name of a star.

10. That concludes my review of the evidence.

The grounds of opposition

11. At the hearing a considerable amount of time was devoted to a detailed review and analysis of the provisions relating to plant varieties and associated names in the following statutes

- Plant Varieties and Seeds Act 1964
- Plant Varieties Act 1997
- The Plant Breeders' Rights Regulations 1978
- Plant Breeders' Rights (Oil and Fibre Plants) Scheme 1980
- The Plant Breeders' Rights Regulations 1998

The relevant provisions are considered in detail below.

12. The opponents approach the matter in two ways. Firstly under Section 3(1)(c) and 3(3)(b) of the Trade Marks Act 1994 they say that RIGEL is the name given to a variety of the plant species oenothera (evening primrose). Hence they contend that registration and use of RIGEL as a trade mark in relation to the goods and services applied for would be indicative of a characteristic thereof (and deceptive if not). Secondly it is argued that the opponents have an earlier right under Section 5(4) of the Act. More specifically Ms Clark indicated that her client's case rested on sub paragraph (b) rather than (a). For reasons which are not clear to me the opponents have not sought to test the matter under Section 3(4) of the Trade Marks Act (which prohibits registration if or to the extent that use of a mark would be prohibited in the UK by any enactment or rule of law) and which might have been thought to offer a more direct route to the issues that underpin this case. Section 3(4) is not, therefore, dealt with in this decision though I should record that Ms Clark reserved her right to ask for an amendment to the pleadings in this respect.

13. The Section 5(4)(b) and Section 3(1)(c) and 3(3)(b) objections which are dealt with below might be said to offer different perspectives on what is essentially the same issue. The earlier right provisions of Section 5 approach the matter from the point of view of the registration of the plant variety name itself whereas Section 3 looks at it in terms of the possible consequences of the existence of a plant variety right on Trade Mark law.

The Trade Mark law

14. The relevant provisions of the Trade Marks Act are

Section 3(1)

"3.-(1) The following shall not be registered -

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive

character as a result of the use made of it."

Section 3(3)

"(3) A trade mark shall not be registered if it is-

- (a) contrary to public policy or to accepted principles of morality, or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or services)."

Section 5(4)

"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
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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."

The Plant Varieties law - General

15. The existence of the opponents' Plant Breeders' right was not disputed at the hearing. At the time that right was obtained (19 April 1996) the relevant statute was the Plant Varieties and Seeds Act 1964 (the 1964 Act) and regulations made under that Act, in particular the Plant Breeders' Rights (Oil and Fibre Plants) Scheme 1980 (the 1980 Scheme).

Section 5(1) and 5(7) of the 1964 Act read:

"5.-(1) The Ministers may by regulations under this section provide for the selection of names for plant varieties which are the subject of applications for plant breeders' rights and for the keeping of a register of the names so selected."

and

5.-(7) In this section the expression "name" includes any designation, and references to plant varieties as being within the same class are references to them as being within the same class being either-

- (a) a class consisting of all plant varieties of the species or groups prescribed by any one scheme under this Part of this Act, or
- (b) any other class of plant varieties prescribed for the purposes of this subsection by any such scheme."

16. General provisions covering the selection of names for plant varieties are laid down in Regulation 18 of the Plant Breeders' Rights Regulations 1978. The 1980 Scheme designates in Schedule 2 "species of which plant varieties are prescribed for the purposes of Section 5(7)

of the Act" and includes at Part II of the Schedule 'Oenothera L' which is the Class covering the opponents' variety.

17. Part 1 of the 1964 Act along with a number of the Schedules thereto has since been repealed by the Plant Varieties Act 1997 (the 1997 Act). The latter has a commencement date of 8 May 1998 that is to say after the filing date of the trade mark application in suit. The 1997 Act now applies by virtue of Section 40 which deals with the application of Part 1 to existing rights as follows

"(1) Subject to the following provisions of this section, this Part of this Act applies in relation to existing rights as it applies in relation to plant breeders' rights granted under this Part of this Act.

(2) (not relevant)

(3) (not relevant)

(4) In this section, "existing rights" means plant breeders' rights granted under Part 1 of the Plant Varieties and Seeds Act 1964 which are exercisable on the coming into force of this Part of this Act."

18. In line with the course of submissions at the hearing I will concentrate primarily on the provisions of the 1997 Act but will refer to and set out comparable or relevant provisions of the preceding statute and associated Regulations as and when necessary.

19. Plant Breeders' rights are granted to breeders who have developed or discovered varieties of plants which meet the qualifying criteria of being distinct, uniform, stable and new. The holder of the right is entitled to prevent third parties from exploiting the variety concerned save with his (the holder's) authority. The granting of a right involves the conferring of a monopoly and is in recognition of the effort, resources and skill deployed by the breeder in developing the new variety. The monopoly, as with most if not all statutory monopolies, brings with it certain obligations and rights. It is not necessary to rehearse the full scope of the provisions contained in the 1997 Act but I note that they cover inter alia the application system (Section 3), conditions for the grant of rights (Section 4), protected variety provisions dealing with the scope of protection afforded (Section 6), exhaustion of rights provisions (Section 10), duration of the right (Section 11), transmission/assignment (Section 12), remedies for infringement (Section 13), compulsory licences (Section 17), selection and registration of names (Section 18), duty to use registered name (Section 19), improper use of registered name (Section 20) and cancellation (Section 22).

20. A number of the above provisions played an important part in submissions at the hearing and will be set out in full in due course.

The Section 5 objections

21. I will deal first of all with the objections under Section 5(4) because it draws out the relevant

provisions of the Plant Varieties statutes and sets the background to the case. Section 5(4) requires an opponent to be the proprietor of an 'earlier right'. Ms Clark indicated at the hearing that she considered the opponents had a stronger case under sub paragraph (b) than (a). I think that must be the case. If the opponents do not succeed under (b) they are unlikely to fare better under (a) on the basis of the evidence before me.

22. Ms Mensah's submissions on behalf of the applicants went to the scope of the protection afforded by Section 20 of the 1997 Act, a point which I will come to in due course. But it was also her view that the Plant Varieties Acts did not give general rights in a name. It was the plant variety that was the subject of protection. The use of the name is closely tied to the plant variety.

23. Both Counsels' submissions raise a number of important issues which seem to me to require me to decide

- whether a right can be said to exist in the name of a plant variety
- whether such a right can in principle form the basis for an objection under Section 5(4) of the Trade Marks Act
- if so whether the scope of the opponents' right means they should succeed in this particular case.

Taking these points in turn

Can a right be said to exist in a plant variety name?

24. The provisions relating to selection and registration of names are now to be found in Section 18 of the 1997 Act which reads

"18 Selection and registration of names

- (1) The Ministers may by regulations-
 - (a) make provision for the selection of names for varieties which are the subject of applications for the grant of plant breeders' rights,
 - (b) make provision about change of name in relation to varieties in respect of which plant breeders' rights have been granted, and
 - (c) make provision for the keeping of a register of the names of varieties in respect of which plant breeders' rights have been granted.
- (2) Regulations under subsection (1) above may, in particular-
 - (a) make provision enabling the Controller to require an applicant for the grant of plant breeders' rights to select a name for the variety to which the application

- relates,
- (b) make provision enabling the Controller to require the holder of plant breeders' rights to select a different name for the protected variety,
 - (c) prescribe classes of variety for the purposes of the regulations,
 - (d) prescribe grounds on which the registration of a proposed name may be refused,
 - (e) prescribe the circumstances in which representations may be made regarding any decision as to the name to be registered in respect of any variety,
 - (f) make provision enabling the Controller-
 - (i) to refuse an application for the grant of plant breeders' rights, or
 - (ii) to terminate the period for which a grant of plant breeders' rights has effect,

If the applicant or holder fails to comply with a requirement imposed under the regulations,

- (g) make provision for the publication or service of notices of decisions which the Controller proposes to take, and
- (h) prescribe the times at which, and the circumstances in which, the register may be inspected by members of the public.

(3) The Controller shall publish notice of all entries made in the register, including alterations, corrections and erasures-

- (a) in the gazette, and
- (b) in such other manner as appears to the Controller to be convenient for the publication of these to all concerned.

(4) For the purposes of subsection (1) above, the variety in respect of which plant breeders' rights are granted is the protected variety."

25. The 1997 Act was not the statute in force at the time the opponents' right was granted. Naming of plant varieties was provided for in Section 5 of the 1964 Act. It is not necessary to reproduce the full provisions but Section 5(1) contained a comparable provision enabling regulations to be made for the selection of names and plant varieties and for the keeping of a register. Regulations covering 'Selection of Names for Plant Varieties' can be found in The Plant Breeders' Rights Regulations 1978. By virtue of Regulation 21 (Revocation, savings and supplemental provisions about names) of the Plant Breeders' Rights Regulations 1998 (made under and applicable to the 1997 Act) Regulation 18 of the 1978 Regulations has been saved subject to certain amendments which do not directly affect the current proceedings.

26. Further provisions relating to names can be found in Sections 19 and 20 of the 1997 Act. Under Section 19, where a name is registered, a person may not use any other name in selling, offering for

sale or otherwise marketing propagating material of the variety in question and that obligation to use the name continues to apply after the period for which the grant of these rights has effect (Section 19(2)).

27. Section 20 deals with 'Improper use of registered name' and is of importance to this case. It reads

"(1) If any person uses the registered name of a protected variety in offering for sale, selling or otherwise marketing material of a different variety within the same class, the use of the name shall be a wrong actionable in proceedings by the holder of the rights.

(2) Subsection (1) above shall also apply to the use of a name so nearly resembling the registered name as to be likely to deceive or cause confusion.

(3) In any proceedings under this section, it shall be a defence to a claim for damages to prove that the defendant took all reasonable precautions against committing the wrong and had not, when using the name, any reason to suspect that it was wrongful.

(4) In this section-

"Class" means a class prescribed for the purposes of regulations under section 18 (1) above,

"registered name", in relation to a protected variety, means the name registered in respect of it under section 18 above."

28. A comparable provision existed under the 1964 Act and can be found in Section 5(6) as follows

"(6) If, where a name is registered under this section for plant variety, any person uses that name, or a name so nearly resembling it as to be likely to deceive or cause confusion, in selling or offering or exposing for sale-

- (a) reproductive material or a different plant variety within the same class, or
- (b) where under paragraph 1 of Schedule 3 of this Act plant breeders' rights in the first-mentioned plant variety have been extended to material other than reproductive material, that other material from a different plant variety within the same class,

the use of the name shall be a wrong actionable in proceedings by the holder of the rights; but it shall be a defence to a claim for damages in any such proceedings to prove that the defendant took all reasonable precautions against committing a wrong of the kind alleged and had not when using the name any reason to suspect that it was wrongful."

29. It will be apparent from the above provisions that names are important within the overall scheme of the Plant Varieties Act. Applicants are required to select a name and the Controller has certain powers over the choice of name. Once registered the name becomes the unique identifier for the particular variety and the right holder is obliged to use it. The duty to use the

name continues to apply after the period for which the grant of rights has ceased to have effect. Misuse of the name carries certain sanctions.

30. Whilst I accept Ms Mensah's submission that it is the plant variety itself that is the primary subject of the right I do not think it is right to say that no right attaches to the name. The misuse of a name is a 'wrong actionable in proceedings by the holder of the rights'. That seems to me to create a specific right of action in respect of the name additional to but distinct from the right in respect of the plant variety itself.

31. I do not think I should unduly limit the opponents' ability to rely on such a right. The precise scope of that right is considered separately below.

Can such a right form the basis for an objection under Section 5(4)(b) of the Trade Marks Act?

32. Section 5(4)(b) operates by way of exception and particularisation. The rights that are specifically excepted are those already provided for in subsections (1) to (3) of Section 5 and paragraph (a) of Section 5(4). The particularised rights which can found an action under the Section are under the law of copyright, design right or registered designs. Section 5(4) implements the optional provisions of Article 4(4) of First Council Directive 89/104. The latter also operates by way of particularisation. It is in my view to be inferred that the legislators did not intend the particularised items to be an exhaustive list of the rights that can be considered.

33. The sidenotes to Section 5 indicate that the Section is dealing with 'Relative grounds for refusal of registration' as opposed to the 'Absolute grounds for refusal of registration' to be found in Section 3. Section 20 of the Plant Varieties Act 1997 (and prior to that Section 5(6) of the 1964 Act) gives the holder of a plant variety the right to take action against third parties for misuse of the name. I see no reason, therefore, why I should limit the construction to be placed on Section 5(4)(b) so as to debar the opponents from placing reliance on it.

Is the scope of the opponents' right sufficient to allow them to succeed?

34. Counsels' submissions at the hearing were based primarily on the provisions of the 1997 Act. Section 6 deals with the scope of plant breeders' rights as follows

"6 Protected variety

(1) Plant breeders' rights shall have effect to entitle the holder to prevent anyone doing any of the following acts as respects the propagating material of the protected variety without his authority, namely-

- (a) production or reproduction (multiplication),
- (b) conditioning for the purpose of propagation,
- (c) offering for sale,

- (d) selling or other marketing,
- (e) exporting,
- (f) importing,
- (g) stocking for any of the purposes mentioned in paragraphs (a) to (f) above,
and
- (h) any other act prescribed for the purposes of this provision.

(2) The holder of plant breeders' rights may give authority for the purposes of subsection (1) above with or without conditions or limitations.

(3) The rights conferred on the holder of plant breeders' rights by subsections (1) and (2) above shall also apply as respects harvested material obtained through the unauthorised use of propagating material of the protected variety, unless he has had a reasonable opportunity before the harvested material is obtained to exercise his rights in relation to the unauthorised use of the propagating material.

(4) In the case of a variety of a prescribed description, the rights conferred on the holder of plant breeders' rights by subsections (1) and (2) above shall also apply as respects any product which-

- (a) is made directly from harvested material in relation to which subsection (3) above applies, and
- (b) is of a prescribed description,

unless subsection (5) below applies.

(5) This subsection applies if, before the product was made, any act mentioned in subsection (1) above was done as respects the harvested material from which the product was made and either-

- (a) the act was done with the authority of the holder of the plant breeders' rights,
or
- (b) the holder of those rights had a reasonable opportunity to exercise them in relation to the doing of the act.

(6) In this section-

- (a) "prescribed" means prescribed by regulations made by the Ministers, and
- (b) references to harvested material include entire plants and parts of plants."

35. Broadly speaking the protection thus offered extends to

- (i) propagating material (Section 6(1))
- (ii) harvested material (Section 6(3))

(iii) products made from harvested material (Section 6(4))

36. Section 20 (set out above) deals with improper use of a registered name. It does so in terms which create an actionable wrong "If any person uses the registered name of a protected variety in offering for sale, selling or otherwise marketing material of a different variety within the same class" (my emphasis).

37. The key question, which was the subject of important submissions at the hearing, is the construction to be placed on the word 'material' in the context of Section 20.

38. The applied for goods in this case (setting aside the Class 42 services for present purposes) are pharmaceutical products in Class 5. Such goods do not fall within (i) above. Nor is it suggested that they come within (ii). However, it is not, I think, disputed that they could fall within (iii) as being products made directly from harvested material.

39. Ms Mensah focussed on the provisions of Section 6(4) of the 1997 Act and invited me to conclude that these provisions only come into play in the context of a 'variety of a prescribed description'. By virtue of Section 6(6) prescribed means 'prescribed by regulations made by the Ministers'. Her submission was that no regulations had been made under this provision so the opponents could not benefit from it in terms of applying a wide interpretation to the term material in Section 20.

40. Ms Clark on the other hand noted that Section 20 did not itself limit the construction to be placed in the term 'material'. It is not for instance, limited to 'propagating material'. She invited me to place a purposive interpretation on the Section and to ascribe a broad meaning to it, that is to say encompassing products made from harvested material.

41. The other provision in the 1997 Act which I should briefly refer to at this point is Section 10 which deals with exhaustion of rights and which does define material for the purposes of the Section as follows

"(4) In this section, "material", in relation to a variety, means-

- (a) any kind of propagating material of the variety,
- (b) harvested material of the variety, including entire plants and parts of plants, and
- (c) any product made directly from material falling within paragraph (b) above."

42. It seems to me that in considering the extent of the protection afforded by Section 20 it is useful and necessary to consider the nature of the right and how the law has developed from the 1964 Act to the 1997 Act. Section 4(1) of the 1964 Act sets out the nature of the rights under that Act

"4.-(1) Subject to this Part of this Act, the holder of plant breeders' rights in a plant variety shall have the exclusive right to do, and to authorise others to do, as follows-

- (a) to sell the reproductive material of the plant variety;
- (b) to produce the reproductive material of the plant variety in Great Britain for the purpose of selling it; and
- (c) in the circumstances described in Schedule 3 to this Act, to exercise the other rights there specified,

and, subject to this section, infringements of plant breeders' rights shall be actionable at the suit of the holder of the rights, and in any proceedings for such an infringement all such relief, by way of damages, injunction, interdict, account or otherwise, shall be available as is available in any corresponding proceedings in respect of infringements of other proprietary rights."

43. Schedule 3 to the Act referred to in Section 4(1)(c) (prior to its repeal) reads as follows:

" **PLANT BREEDERS' RIGHTS IN SPECIAL CASES**

Sale of cut blooms, fruit, etc.

1.-(1) If it appears to the Ministers that, in the case of any species or group of plant varieties, plant breeders will not receive adequate remuneration unless they have control over the production or propagation of the plant variety in Great Britain for the purpose of sales of cut blooms, fruit or some other part or product of plants of the variety, and that the control will be of substantial benefit to the plant breeders, they may by a scheme under Part I of this Act provide that, as respects any plant variety of the species or group prescribed by the scheme, plant breeders' rights shall include the exclusive right to do, and to authorise others to do as follows, that is to produce or propagate the variety for the purpose of selling such parts or products of the variety as may be prescribed by the scheme.

(2) A scheme conferring any such rights may also provide that plant breeders' rights shall include the exclusive right to do, and to authorise others to do, as follows, that is to sell the parts or products of the variety in relation to which the rights are extended in so far as they are obtained by the seller from plants of the variety which the seller has himself produced or propagated.

(3) References in this paragraph to parts or products of a plant variety include references to whole plants of that plant variety."

44. Professor W R Cornish's book on Intellectual Property (Fourth Edition, Sweet & Maxwell) has this to say in relation to the protection of plant varieties

"A3-07 The rights given by the 1964 Act were deliberately limited in ways which sought to curb the right-owner's power to make monopoly profits. Two principles were accordingly adopted:

- (1) the rights should extend only to the marketing of reproductive

material (seed, tubers, cuttings, etc.) intended for reproduction and not for consumption (for example grain for milling);

- (2) farmers and others should not have to procure a licence to make their own seed and other materials from their previous crop. The exclusive right accordingly covers selling reproductive material and producing it for purposes of sale. Only exceptionally - where plant breeders will not otherwise receive adequate remuneration - may a scheme extend the exclusive right so as to cover producing or propagating the variety for the purpose of selling cut blooms, fruit and some other parts of the product."

45. The rights arising under the Act appear, therefore, to have been circumscribed. A footnote to the last sentence of the above passage referring to Section 4(1)(c) and Schedule 3 indicates "This has been done e.g. in the case of roses, chrysanthemums and carnations."

46. Kerly's Law of Trade Marks and Trade Names (Twelfth Edition) indicates at 20-10 (dealing with Plant Variety Names)

"Once such a name is registered, it is an actionable wrong (actionable, that is, by the holder of the breeders' rights concerned) to sell reproductive material of any other variety of plant in the same class under that name or a confusingly similar name."

47. A footnote referring to 'reproductive material' indicates that "This phrase has a special meaning which may vary from scheme to scheme; for roses, for instance, it includes bushes sold for the production of cut flowers."

48. The conclusion I draw from this is that plant variety rights, as with any statutory monopoly, were intended to be limited in scope. On the basis of the documentation available to me it seems that the 1964 Act extended to reproductive material and, by virtue of Schedule 3, to harvested material and products of plants but only where Ministers make provision by means of a specific scheme. It is not suggested that *oenothera* were ever made the subject of such a scheme.

49. Section 6 of the 1997 Act brings harvested material within the area of automatic protection but it makes products made directly from harvested material subject to prescription by regulation. That in my view is consistent with a legislative intention not to unduly extend the statutory monopoly save where particular circumstances justify such a course and can be specifically provided for.

50. A footnote to the 1997 Act indicates "Regulations under this Section. Up to 1 June 1998 no regulations had been made under this section." Nor is it suggested that any regulations have been made since that date relevant to the issue before me. In the circumstances I am not persuaded that a purposive approach to Section 20 supports a wider interpretation of the term 'material'. Further I can see no reason why I should import the wider meaning of Section 10 into Section 20. Section 10 may simply be drafted so as to make provision for exhaustion of rights in relation to products

made from harvested material in the event that regulations are made at some future date.

51. It follows that I regard the protective provisions of Section 20 as extending to use of the name RIGEL in respect of propagating material and harvested material of the variety but not products made from the harvested material. On that basis the scope of the opponents' earlier right does not enable them to succeed under Section 5(4)(b) in respect of the applied for goods. The opposition must also fail in this respect insofar as the Class 42 services are concerned, these being at a yet further remove.

The Section 3 objections

Background

52. The objections here are under Section 3(1)(c) and 3(3)(b) on the basis that the word RIGEL may serve to indicate a characteristic of the goods and services or in the alternative would be deceptive if used on products which did not derive from the evening primrose plant. Submissions at the hearing largely centred on the Section 3(1)(c) objection. The descriptiveness/deceptiveness objections are really no more than opposite sides of the same coin.

53. By way of background I should say that the Registry has long had a practice in relation to varietal names. Under the preceding Trade Mark law (the 1938 Act) it was the practice in appropriate circumstances to require a condition of registration that words appearing in a mark would not be used as a varietal name or part thereof. Conditions of registration are no longer available. The Registry's current practice is set out in the Addendum to Chapter 6 of the Work Manual and is to the effect that varietal names cannot be registered as trade marks because the name of a generic strain of plant cannot be a trade mark. Examiners are instructed to object under Section 3(1), 3(3) and 3(4) of the Act to Class 31 applications for marks consisting wholly or substantially of varietal names for plants, seeds, cereals, fruit, vegetables and flowers. The guidance indicates that the objections raised can be overcome by excluding the specific plant variety (that is to say excluding it from the specification of goods). It will be noted from this that the objection only relates to names (words), is not taken in respect of goods in Classes other than 31 (and only certain goods within that Class) and does not arise at all in relation to services.

54. The only authority I am aware of bearing directly on the issue of plant varietal names is Wheatcroft Brothers Ltd's Trade Mark [1954] RPC 43. However that case involved rectification of the register in respect of a number of words as trade marks for rose plants rather than goods or services at one or more remove. The Wheatcroft case does not, therefore, assist directly in determining the issue before me.

55. Ms Clark summarised the opponents' position as follows in her skeleton argument

"Oil from the Rigel variety of evening primrose is regarded as being particularly suitable for use in dietary supplements and pharmaceuticals (see Herkul, paras 3 and 4). It is a particularly productive and high quality source of gamma linoleic acid ("GLA"), which is a

component of cells and precursor of prostoglandins, which regulate many bodily functions. It can be taken to assist in the treatment of a number of diseases including cardiovascular diseases, inflammatory diseases and cancer (see Herkul, para 4 also exhibits "B" and "F"). Proprietary products including GLA from this source include EPOGAM, EFAMAST and EFAGUARD CARDIO, some of which are only available on prescription. In addition, further pharmaceutical preparations have been under development for use in the treatment of patients suffering from pancreatic, upper gastrointestinal and other cancers (see Herkul, exhibit "D", page 2).

If and in so far as it may not have been recognised as such by members of the relevant trade or public as at the date of the applications in issue here (which is not accepted), then it will come to serve as such in future by reason of the matters set out above: see Windsurfing [1999] ETMR 585 (ECJ)."

56. Thus it is said the word RIGEL cannot serve to indicate the trade origin of goods and services within the specification applied for because it is wholly descriptive of the characteristics of the plant variety and evening primrose oil could be used in the applicants' pharmaceutical products. It should, in Ms Clark's submission, remain free for use in relation to products derived from and services associated with the RIGEL variety of evening primrose.

57. Ms Mensah also referred me to the Windsurfing Chiemsee case for the general approach to Section 3(1)(c). She also referred me to a number of other cases that have been before the European Court of Justice, the Court of First Instance or the UK Courts. Probably the most relevant one for present purposes is Procter & Gamble Company v OHIM (Baby-Dry), [2002] ETMR 22. I will come to these cases below.

58. Her submissions were to the effect that RIGEL has no meaning, and indeed is distinctive, in relation to the goods and services that are the subject of the application; that the relevant sector of the public has not been educated to understand that RIGEL means or refers to a variety of evening primrose plant; and that "even if RIGEL is accepted as the name of an evening primrose, the evidence does not establish that it is so usually used or so closely associated with prescription pharmaceuticals for the treatment of viral diseases, inflammatory diseases or cancer which is what the specification states; such that the understanding on seeing RIGEL used in connection with such goods would be - - it is an ingredient in this particular medicine or it possesses the characteristics alleged to be attributed to the RIGEL variety." Thus it is suggested that RIGEL is not a word that needs to be kept free and the opponents' legitimate needs are amply catered for by Section 11(2), a point rebutted at some length by Ms Clark by reference to Mr Hobbs QC's decision in "Cycling IS" Trade Mark, 0-561-01 (see in particular his reasoning in paragraphs 40 to 42 of the decision).

59. The Windsurfing Chiemsee case, on which both sides rely, was concerned with indications of geographic origin but the guidance is capable of wider application. I am aware that, following the ECJ's more recent judgment in Baby-Dry, there may be some uncertainty as to the continuing applicability of the need to keep descriptive signs or indications free for use within the framework of Community law. The issue is currently the subject of an Advocate General's Opinion in the

Postkantoor case (Koninklijke KPN Nederland NV v Benelux Merkenbureau), case C-363/99 and will presumably result in such clarificatory guidance as the ECJ considers necessary in due course. In the meantime I propose to approach the matter on the basis that the judgment in Windsurfing Chiemsee reflects the fact that Article 3(1)(c) of the Directive deals with signs or indications which may serve in trade to designate characteristics of the goods or services; that this implies some assessment of the extent to which signs or indications are likely to be so required even if they do not already fulfil that function; and that this is not inconsistent with the ECJ's ruling on the general scope of Article 7(1)(c) of the Community Trade Mark Regulation (Article 3(1)(c) of the Directive) in Baby-Dry.

It was held as follows in Windsurfing Chiemsee

- "31. Thus, by virtue of Article 3(1)(c) of the Directive, the competent authority has to assess whether a geographical name in respect of which application is made for registration as a trade mark designates a place which currently, in the eyes of the circles concerned, presents a link with the category of products concerned or whether it is reasonable to envisage that such a link may be established in the future.
32. In order to assess whether, in the latter case, this geographical name is such, in the eyes of the circles concerned, as to designate the origin of the category of products concerned, it is appropriate, more particularly, to take account of the extent of the knowledge which the latter have of such a name and of the characteristics of the place which it designates and of the category of products concerned."

60. The following passage from the Baby-Dry case is also relevant and serves to indicate the approach adopted (Article 7(1)(c) of the Community Trade Mark Regulation is equivalent to Article 3(1)(c) of the First Council Directive and Section 3(1)(c) of the 1994 Act).

- "39. The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics."

61. The question that arises can, therefore, be said to be whether RIGEL serves in normal usage from the point of view of consumers/users of the goods/services applied for to designate a characteristic of those goods and services or whether it is reasonable to envisage that such a link may be established in future.

62. Unlike the circumstances of the case before the ECJ in *Baby-Dry* this is not a situation where there can be any doubt about whether RIGEL is the normal way of referring to the variety of the evening primrose plant concerned. It is the unique and generic identifier for the variety. If anyone wished to refer to pharmaceutical products by reference to this particular plant variety (as opposed to a brand name) RIGEL is the term that would be used. The question is, therefore, whether in this case the varietal name RIGEL in fact serves or may serve as an indication of the characteristics of products containing extracts from the plant.

(Somewhat different issues arise in relation to services. The primary issues though arise in relation to goods).

63. The applicants' Class 5 goods are pharmaceuticals for use in the treatment of a number of diseases. Their specification is qualified as being "all for dispensing by prescription only". For the purposes of the test set out above I regard the relevant class of consumers for such goods as being primarily those involved with prescribing and dispensing pharmaceutical products. That is to say general practitioners, pharmacists, hospital consultants and other medical professionals. The users of the Class 42 services are likely to be researchers, specialists based in hospitals or academic institutions and businesses wishing to avail themselves of the research, development and consultancy services offered.

64. I have outlined the opponents' evidence at the start of this decision. The few instances of RIGEL being used are

- the Plant Breeders' Rights certificate itself and pages from the Plant Varieties and Seeds Gazette showing publication of RIGEL along with five other varietal names for oenothera (Exhibit A)
- a Schedule of Plant Variety Rights held by the opponents corresponding to the six varietal names in the Gazette (Exhibit B)
- a page from a Development Review document referring to 'Rigel oil technology' and 'Rigel versions of Epogam and Efamast ...' (Exhibit D)
- a reference in a fax dated 24 October 2000 which is at Exhibit H. This document does not correspond to the reference in the covering statutory declaration which describes Exhibit H as a report. Also the source and circumstances of the fax are wholly unclear with the result that the document is of little assistance.

65. The only additional document is Exhibit G which is said to be a copy of the report on the technical examination of the variety by the National Institute of Agricultural Botany (MAFF), though the 'varietal denomination' box is actually empty.

66. The first two documents referred to above simply relate to the certification/registration process along with a listing of evening primrose plant varietal rights held by the opponents. The only item of potential assistance to the opponents in terms of establishing that RIGEL serves in trade to indicate a characteristic of the goods is the page from a Scotia Holdings Development Review document. Only page 10 appears to be exhibited. It is in itself undated and not placed in a trading context.

67. Ms Mensah characterised the above material as being internal documents by which I understand her to mean that they did not establish use of RIGEL in a commercial context such that there is third party recognition of the name. There is force to these submissions.

68. The position is, therefore, that there is no convincing evidence to support the claim that the name of the plant variety (RIGEL) has been placed before the relevant class of consumers in such a way that it serves to designate a characteristic of goods produced from or containing extracts from the plant variety.

69. On the other hand the Exhibits do contain examples of material - product packaging, explanatory and promotional leaflets - which give an indication as to how the opponents' products are promoted to consumers (the goods go to the nutritional supplements and the pharmaceutical products markets). The clear indications are that the products are sold by reference to

- brand names (e.g. Efamol, Epogam, Efamast etc)
- the fact that they contain evening primrose oil
- the fact that they contain gamma linolenic acid (GLA) as the main active ingredient

70. Two of the opponents' products, Epogam and Efamast, are pharmaceuticals for the treatment of atopic eczema and mastalgia respectively. The 'Introduction' and 'Summary' sheets in Exhibit D indicate that these products contain gamma - linolenic acid in the form of seed oil from "specially selected strains of the evening primrose *Oenothera spp*" but without mentioning specific varietal names. The Efamast packaging, also in Exhibit D, appears to pre-date the registration of RIGEL as a varietal name (the packaging has a 'use before Dec 1995' reference). There is no indication that later formulations of Efamast based on or incorporating oil derived from RIGEL versions of evening primrose have been promoted as such.

71. I conclude from the above that it has not been shown that RIGEL serves to designate a characteristic of the goods or services in question from the point of view of the average consumer.

72. If RIGEL does not at present serve to designate a characteristic of the goods from a consumer's point of view is it nevertheless "reasonable to envisage that such a link may be established in future"? Adapting the test suggested in paragraph 32 of *Windsurfing Chiemsee* (in relation to geographical names) to the circumstances of this case it is appropriate to take into account the extent of the knowledge of the consumer circles concerned, the characteristics of the name and the nature of the category of products concerned.

73. One view of the matter is that, because RIGEL is the unique identifier for a plant variety, it naturally lends itself to usage as a designation of a characteristic of goods within the scope of the specification applied for at least to the extent that they could consist of or contain extracts from the variety concerned. Support for that proposition can be drawn from Ms Clark's submissions that the RIGEL variety of evening primrose is grown for its purity and ability to act as a high grade source for GLA which is in turn considered to be efficacious in treating a wide variety of diseases including those referred to in the applicants' Class 5 specification. Thus it is said products containing extracts from the RIGEL variety of evening primroses will have attractions and qualities for consumers which may not be available from other competing products.

74. That submission is not without its attraction. The difficulty with it is in establishing on the basis of

the evidence filed that there is in fact any reasonable probability of the plant varietal name being required for use as a designation of a characteristic of goods within the specification applied for.

75. Ms Clark pointed out that the opponents' plant breeders' right certificate is dated 19 April 1996 and the application under attack has a priority filing date of 5 May 1997. The suggestion is, I think, that the opponents may not have had time to fully develop the commercial marketing of products containing oil or other extracts from the variety. That submission might have carried greater weight if there were evidence after the material date that shed light retrospectively on the likelihood of the opponents' needing or wishing to refer to RIGEL in their dealings with consumers. However, I can find nothing in the evidence to suggest that this is the case. The overwhelming impression is that the opponents' products refer to the fact that they consist of or contain evening primrose oil and that such oil is one of the most effective sources of GLA.

76. It would have been open to the opponents to introduce evidence demonstrating by reference to the other products in their range that it is not uncommon to use plant variety names as a means of identifying characteristics of the goods. The opponents themselves have five other varieties of evening primrose registered under the Plant Varieties Act (although I note from Exhibit F that Efamol's plant research scientists are said to have tested over 2000 different types of evening primrose). There is no evidence to suggest that any of the names involved are used in marketing end products to consumers despite the evidence from Exhibit B that the names have been registered in the UK since 1982(2), 1984, 1986 and 1994 respectively. Nor has any evidence been brought forward to indicate practice in the trade or consumer awareness and expectation in the relevant product area which might lead to a different conclusion.

77. From my own knowledge I am aware that health food shops and chemists sell a variety of nutritional supplements etc. that are based on plant extracts. I am not aware that such products are commonly designated and promoted by reference to names of particular plant varieties (in addition that is to the species name) even if in practice particular plant varieties constitute the main active ingredient. I readily accept that my own impression may be wrong so far as products sold in the high street are concerned and I have no knowledge as to the position in the pharmaceutical products area - it is a point that might have benefited from evidence as to trade practices and by inference the extent to which the average consumer has been educated to expect reference to plant variety names on pharmaceutical products.

78. However, even in the absence of an established trade practice, if the RIGEL variety of evening primrose yielded significantly enhanced benefits over the many other varieties of evening primrose that have been developed, it would not be inconceivable that the opponents might wish to promote that fact.

79. There are some indications that they consider this to be the case. Thus the Development Review document (Exhibit D) refers to a pharmaceutical product "... based on Scotia's Rigel oil technology, which can deliver 80 mg of gamma-linolenic acid in one capsule, thereby halving the number of capsules that need to be taken on a daily basis."

80. Petra Herkul refers to the "vast increase in beneficial ingredients which can be extracted from the plant variety RIGEL compared to other evening primrose varieties." The product information sheet attached to the packaging at Exhibit I refers to "A major breakthrough - higher concentration of GLA means smaller capsules". There is, therefore, a suggestion that RIGEL based evening primrose oil offers important advantages over other competing products.

81. But these claims must be treated with a certain amount of caution. It is to be expected that any improvement in product quality/ performance/cost will be accompanied by a certain amount of marketing hype. More importantly the report (referred to as Exhibit H) which purportedly discusses the 'vast increase in beneficial ingredients' has not been filed in evidence and a seemingly unrelated document appears in its place. (It is not clear why the opponents have not sought to correct what I take to be an error in the compilation of the evidence). It is not clear, therefore, whether or to what extent RIGEL really does represent a step-change in terms of improvement in the yield of beneficial ingredients available from the plant. Furthermore although it seems to be suggested that the packaging at Exhibit I relates to a RIGEL based product (Ms Herkul refers to 'the plant variety' in paragraph 9 of her declaration) there is no reference to the plant variety name on the packaging or product information sheet. Nor have the opponents' claims been placed in a trade context by which I mean that there is no information as to whether the opponents' RIGEL evening primrose oil is not just an improvement on their own previous formulations but also a significant improvement in terms of other such products on the market.

82. The onus is on the opponents to make out their case. I have not found this an easy matter to determine but in the circumstances it seems to me that the only basis on which the opponents can succeed is if I interpret the guidance from the WINDSURFING case as meaning that the need to keep certain terms free for future use must be construed in the broadest possible sense. I do not regard the case as providing authority for such an approach. The test is not an abstract one but requires me to have regard to the reasonably foreseeable circumstances of trade in the light of consumer perception and trade practice. There is insufficient evidence to establish either that evening primrose oil made from the RIGEL plant variety is sufficiently superior to other forms to make it worthwhile educating the public of that fact (when it does not appear to be common practice generally in the trade to refer to plant varietal names) or that any link is likely to be established in future in the minds of consumers between the name RIGEL and the goods of the application in suit. It must also follow that there is even less likelihood of the objection being sustainable against the Class 42 services.

83. The opposition therefore fails under Section 3(1)(c) and 3(3)(b).

84. As the circumstances of this case are somewhat unusual I should perhaps put on record my view that, if in the event of an appeal, I was found to have taken too narrow a view of the position under Section 3 of the Act I consider that the position could be cured by the applicants amending their Class 5 specification with the addition of the words ";but not including any of the aforesaid goods consisting of or containing extracts from oenothera (evening primrose)."

85. As matters stand the applicants have been successful and are entitled to a contribution towards

their costs. I order the opponents to pay them the sum of £835. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of April 2002

**M REYNOLDS
For the Registrar
the Comptroller-General**