

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION **m** 2044296
BY
DALLAS BURSTON HEALTHCARE LIMITED
TO REGISTER THE TRADE MARK

DUONEBS

AND
IN THE MATTER OF OPPOSITION BY
BY
BOEHRINGER INGELHEIM KG
THERE TO UNDER OPPOSITION **m** 45187

DECISION

Dallas Burston Healthcare Limited, Victors Barns, Hill Farm, Brixworth, Northamptonshire, NN6 9DQ applied on 11 November 1995 to register DUONEBS for goods in Class 5: 'Pharmaceutical preparations and substances.'

5 Boehringer Ingelheim KG have opposed the application, basing their opposition on these sections of the Act:

! s 5(2) in that the Applicants' mark is similar to the Opponents' earlier mark and is to be registered for similar goods;

10 ! s 5(4)(a) because use of the Applicants' mark is liable to be prevented by the law of passing-off;

The Opponents own the registrations in the Annex. Another mark, DUOCAPS, was cited in the counter statement, but its application was withdrawn on 3 November 1997 and is not considered further in these proceedings.

15 A counter statement is provided by the Applicants denying the grounds of opposition. Both Opponents and Applicants ask for their costs. A Hearing was held on 17 August 1999 with Mrs Heal, instructed by C J Tillbrook & Co., acting for the Applicants, and Mr Speck, instructed by Urquhart Dykes & Lord, acting for the Opponents.

I do not intend to review the evidence in detail. Rather I will refer to that I consider relevant to the grounds pleaded.

20 The first ground is based on s 5(2)(b). This states:

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

(a) ... ,

25 (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.'

By virtue of s 6(1), the Opponents marks listed in the Annex are earlier trade marks.

This section of the Act partially implements Article 4(1)(b) of the Directive. In the BALMORAL¹ Decision Mr Geoffrey Hobbs QC, acting as the Appointed Person, when interpreting the expression ‘a likelihood of confusion on the part of the public’ referred to the following extract from the SABEL v PUMA² Case:

5 ‘Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on
the part of the public. In that respect, it is clear from the tenth recital in the preamble to the
Directive that the appreciation of the likelihood of confusion depends on numerous
elements and, in particular, on the recognition of the trade mark on the market, of the
association which can be made with the used or registered sign, of the degree of similarity
10 between the trade mark and the sign and between the goods or services identified. The
likelihood of confusion must therefore be appreciated globally, taking into account all
factors relevant to the circumstances of the case. That global appreciation of the visual,
aural or conceptual similarity of the marks in question must be based on the overall
impression given by the marks, bearing in mind, in particular, their distinctive and dominant
15 components. The wording of Article 4(1)(b) of the Directive - “there exists a likelihood of
confusion on the part of the public” - shows that the perception of marks in the mind of the
average consumer of the type of goods or services in question plays a decisive role in the
global appreciation of the likelihood of confusion. The average consumer normally
perceives a mark as a whole and does not proceed to analyse its various details. In that
20 perspective, the more distinctive the earlier mark the greater will be the likelihood of
confusion. It is therefore not impossible that the conceptual similarity resulting from the
fact that the two marks use images with analogous semantic content may give rise to a
likelihood of confusion where the earlier mark has a particularly distinctive character, either
per se or because of the reputation it enjoys with the public.’

25 Mr Hobbs than went on to construct the following query:

‘The tenth recital to the Directive and these observations of the Court of Justice indicate
that an objection to registration under Section 5(2) of the Act should be taken to raise a
single composite question: are there similarities (in terms of marks and goods or services)
which would combine to create a likelihood of confusion if the ‘earlier trade mark’ and the
30 sign subsequently presented for registration were used concurrently in relation to the goods
or services for which they are respectively registered and proposed to be registered?’

Considering the marks at issue, this query can be recast as:

¹Trade Marks Act 1994: In the matter of Application no. 2003949 to register a trade mark in class 33 in the name of *ROSEMOUNT ESTATES PTY LIMITED*; Decision of the Appointed Person, 18 August 1998 (unpublished).

²European Court of Justice in Case C-251/95 *SABEL BV v PUMA AG* [1998] RPC 199.

‘Are there similarities between DUONEBS and COMBINEB, ATRO-NEB or DUOVENT (including visual, aural and conceptual), and the goods or services they specify, which would combine to create a likelihood of confusion in the mind of the average consumer if they were used simultaneously taking into account the distinctiveness of COMBINEB, ATRO-NEB or DUOVENT on the market?’

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There seems to me no question that the goods in question are either identical or very similar. The Applicants’ specification is either the same, or contained within the specifications of the Opponents’. Next, I do not regard the Opponents’ marks as being particularly distinctive. First, their reputation is modest. The evidence in their one Declaration by Mr Mark Shane Barrett (their marketing manager) points to small use of the COMBINEB and ATRO-NEB marks (less than £300K in 1994 and 1995) and more extensive use of the DUOVENT mark (around £4M in 1994 and 1995). Neither appears significant in the context of the pharmaceutical market. Second, the marks themselves are not particularly distinctive. I have decided this on the basis of the evidence, which leads me to conclude that the use of the terms DUO and NEBS, considered individually, are descriptive and commonplace. I wish to briefly review this evidence now.

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In the Applicants’ first Statutory Declaration, from Marianne Slattery (a professional assistant who works for their agents), searches on the Register have been performed for marks in Class 5 that contain the elements DUO and NEBS. There are a large number of marks that include these elements.

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At the Hearing Mrs Heal submitted that, following *SABEL v PUMA* and *CANON* as quoted above, I was required to take account of evidence from the market place **and** evidence of the state of the register, that is take ‘..account all factors relevant to the circumstances of the case..’ in reaching my decision. There was disagreement on this point. For the Opponents, Mr Speck said:

‘What those cases are saying .. is that well known marks may get extra protection. To work out well known or highly distinctive marks, you look at the market place. It has nothing to do with what may or may not have been allowed on the register and never used..’

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I tend to agree with him. I do not feel I can give the proliferation of the elements DUO and NEBS in marks on the register for Class 5 much weight. Mr Speck also stated that this evidence, some of which relating to marks registered in the 1930’s and none of which showed any evidence of use on the market, was irrelevant. He cited Jacob J from *TREAT*³:

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‘Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the

³*BRITISH SUGAR PLC v JAMES ROBERTSON & SONS LTD* [1996] RPC 9, 281, at 305.

register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration...I disregard the state of the register evidence.'

5 However, Ms Slattery in her Declaration for the Applicants also cross references the searches undertaken on the Registry with various pharmaceutical compendia, and stated:

'I have examined the pharmaceutical compendia:

a. British National Formulary (BNF), September 1997 edition, (a joint publication of the British Medical Association of Tavistock Square, London WC1 H WP and the Royal Pharmaceutical Society of Great Britain);

10 b. MIMS March 1998 edition (an independent publication intended as a prescribing guide for general practitioners, published by Haymarket Publishing services Ltd of 174 Hammersmith Road London W6 7JP); and

15 c. Chemist & Druggist Monthly Price List February 1998 edition for products branded with the marks identified by the Register search as aforesaid and find entries for:

DUOBAR (Scientific Hospital Supplies); DUOCAL (Scientific Hospital Supplies); DUOFILM (Stiefel);

DUODERM (Convatec);

20 DUOVENT (Opponents); STERINEB (Steripak Ltd); NEBCIN (King Pharms);

NEBUHALER (Astra);

VENTOLIN NEBULES (A & H);

CROMOGEN E B (Norton Healthcare); MEDINEB (Timesco);

PORTA-NEB (Medic -Aid).'

25 The presence of these products in these publications is enough, in my view, to show that DUO and NEB are common elements in the names of pharmaceutical products.

Further, it was claimed at the hearing, and in evidence, that DUO and NEB are descriptive. In the Statutory Declaration of Dr Dallas J Burston, for the Applicants, it is stated:

30 'By adoption of the -DUO- prefix, the Applicants have appositely signalled, to consumers, specifiers and suppliers, that the Applicants' product is for a compound preparation - such as for example, lpratropium and Salbutamol, as used in the treatment of respiratory conditions....Similarly, the NEBS suffix of the Applicants' DUONEBS mark also appositely signals a nebuliser, ventilator or bronchodilator appliance, for delivery of a bespoke atomised spray discharge. The -NEBS- element also appositely signals a preparation to be delivered by such appliances, for example, bronchodilators; corticosteroids and viscous
35 antibiotics for the treatment of respiratory conditions.'

This was not disputed by the Opponents and I accept that it is the case. (In passing, the Applicants claim that the elements together, though descriptive apart, form a valid mark. This was not questioned at the Hearing, and did not form a ground of opposition).

5 With this background, I now turn to apply the ‘Hobbs’ test. It seems to me that confusion is unlikely. The only common elements of the marks at issue are non-distinctive and, at least, semi-descriptive. Even if this were not the case, I would hesitate to find the mark DUONEBS confusable with COMBINEB and ATRO-NEB. The first part of the marks are simply far apart phonetically. Visually, they are different too, particularly ATRO-NEB, which is hyphenated.

10 Turning to the Opponents’ final mark, DUOVENT, again the only similar elements in the marks are descriptive and likely to be taken so by consumers. Conceptually, the Applicants’ mark would suggest the method of delivery of the medicine - a compound preparation delivered by a nebuliser - the Opponents’ suggests the effect of their medicine - a compound preparation that ‘ventilates’. And finally, I do struggle to believe that -VENT would be
15 confused with NEBS on the basis of pronunciation. The first ground fails.

Turning to the next ground this is cited as s 5(4)(a) in the Statement of Grounds:

‘(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-

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

To succeed in a passing off action, it is necessary for the Opponents to establish that at the relevant date (11 November 1995): (i) they had acquired goodwill under their mark, (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their
25 goodwill.⁴

I concluded above that the reputation of the Opponents under their marks was small for COMBINEB and ATRO-NEB, and modest for DUOVENT. In his Declaration for the Opponents, Mr Barret states:

30 ‘The prefix DUO and the suffix NEB is very much associated with ... my company in relation to trade marks in general and in particular with those in the respiratory field and accordingly I believe that the overall impact of the trade mark DUONEBS indicates a connection with .. my Company.’

I do not accept this is the case on the basis of the evidence I have seen. In view of their relatively small sales for products under the COMBINEB and ATRO-NEB marks, I must
35 conclude that the goodwill associated with these marks is small. That associated with the DUOVENT mark is greater, and I conclude that the Opponents do have a degree of goodwill

⁴A fuller summary of the position can be found in WILD CHILD [1998] RPC 455, page 460.

under this name. However, following my conclusions above on the common use of the elements DUO and NEB, and the lack of confusability between the marks, I do not see how use of the DUONEBS mark will lead to misrepresentation, with any of the Opponents' marks. Mr Speck suggested at the Hearing that confusion as to trade origin could also occur if it was thought that the DUONEBS product was '...another one out of the same stable.' He cited the WAGAMAMA⁵ case and said '...that the RAJA MAMA/WAGAMAMA similarity was ... likely to cause in some members of the public with imperfect recollection a belief that they were ... from the same organisation.' The Opponents have two marks that use the NEB element, both representative of very modest goodwill, and one with the DUO element. This hardly bespeaks of a 'stable' of marks. Particularly in view of the widespread use of these elements in the names of pharmaceutical products, I cannot accept that occurrence of this type of confusion is credible. There are simply too many marks that use them for the public - or anyone else - to believe that they would be indicative of one source.

In the light of this, this ground of also fails, and the opposition fails.

15 The Applicants are entitled to an award of costs. I order the Opponents to pay to them £600.00

Dated this 3rd day of September 1999

Dr W J Trott
Principal Hearing Officer
20 **For the Registrar, the Comptroller-General**

⁵WAGAMAMA LTD. v CITY CENTRE RESTAURANTS PLC [1995] FSR, 713.

ANNEX

Mark	Number	Dates	Goods
COMBINEB	2019491	03.05.1995	In Class 5: Pharmaceutical preparations and substances. In Class 10: Medical apparatus and instruments, all for dispensing pharmaceutical preparations and substances; apparatus and instruments, all for the inhalation of pharmaceutical preparations; artificial respiratory apparatus and instruments; nebulisers; parts and fittings for all the aforesaid goods; containers, vials and ampoules, all for medical and pharmaceutical purposes.
ATRO-NEB	2019493	03.05.1995	In Class 10: Medical apparatus and instruments, all for the inhalation of pharmaceutical preparations; artificial respiratory apparatus and instruments; nebulisers; parts and fittings for all the aforesaid goods; containers, vials and ampoules, all for medical and pharmaceutical purposes.
DUOVENT	1079667	14.06.1977	In Class 5: Pharmaceutical, veterinary and sanitary preparations and substances; disinfectants (other than for laying or absorbing dust); and antiseptics.

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