

TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No B1490272
BY PAUL HARTMANN AG
TO REGISTER A TRADE MARK
CLEAR SITE ADVANCED GEL TECHNOLOGY & DEVICE
IN CLASS 5

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 30584
BY T.J. SMITH & NEPHEW LIMITED

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BACKGROUND

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On 10 February 1992, NDM Acquisition Corp. of 3040 East River Road, Dayton, Ohio, 45439, USA applied under the Trade Marks Act 1938 for registration of the trade mark shown below:

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Clear Site
ADVANCED GEL TECHNOLOGY

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In respect of:

30 “Dressings for wounds, all incorporating a moisture - absorbent gel; components of the aforesaid dressings; all included in Class 5”.

The application form also contains the following disclaimer: -

35 Registration of this mark shall give no right to the exclusive use, separately of the words ‘clear’ and ‘site’ and no right to the exclusive use of the words ‘Advanced Gel Technology’.

40 On 11 April 1996 this mark was assigned to Paul Hartmann AG, of Paul-Hartmann-Strasse, 89522 Heidenheim, Germany.

On 17 August 1994, T.J. Smith & Nephew Limited, filed notice of opposition to the application. The grounds of opposition are in summary:

45 1) The trade mark CLEAR SITE ADVANCED GEL TECHNOLOGY, applied for in respect of “Dressings for wounds, all incorporating a moisture - absorbent gel; components of the aforesaid dressings; all included in Class 5”. is neither adapted to

distinguish, nor is it capable of distinguishing, in relation to the goods for which it is to be registered. It therefore offends against Sections 9 and 10 of the Trade Marks Act 1938.

5 2) The opponents are the registered proprietors of the twelve trade marks, detailed at annex A. The trade mark in suit so nearly resembles the opponents' marks that registration would offend against Section 12(1) of the Trade Marks Act 1938.

10 3) The opponents believe that they are the sole proprietors to have used and registered trade marks in the UK containing the suffix SITE in relation to wound dressings. The trade mark in suit is in respect of such goods and because of the similarity of the marks the trade mark is liable to deceive or cause confusion and so offends against Section 11 of the Trade Marks Act 1938.

15 4) The applicants cannot claim to be using or to have had a bona fide intention to use the mark applied for at the date of registration. Registration would therefore offend against Section 17(1) of the Trade Marks Act 1938.

20 5) Registration of the trade mark in suit would interfere with the opponents' legitimate business activities and would be damaging to their trading position in general. The application should therefore be refused in accordance with the Registrar's discretion under Section 17(2) of the Trade Marks Act 1938.

25 The applicants filed a counterstatement denying all the grounds of opposition. The applicants also ask the Registrar to exercise his discretion in their favour and both sides seek an award of costs in their favour. Both sides filed evidence in these proceedings and the matter came to be heard on 16 June 1999, when the applicants were represented by Mr Ashmead of Kilburn & Strode, Trade Mark Attorneys. The opponents were represented by Mr Buchan of Eric Potter Clarkson, Trade Mark Attorneys.

30 By the time this matter came to be decided the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in this decision are references to the provisions of the Trade Marks Act 1938 (as amended) unless
35 otherwise indicated.

OPPONENTS' EVIDENCE

40 The opponents filed two statutory declarations. The first, dated 11 August 1995, is by Mr David John Ollis, the Financial Director and Company Secretary of the opponents. Mr Ollis states:

45 "The opponents, trading as Smith & Nephew Medical Limited, sell a wide range of woundcare products throughout the UK and worldwide. These products are sold generally to hospitals and/or community care clinics. These products include, inter alia, the following: OPSITE, OPSITE IV, OPSITE FLEXIGRID, OPSITE Spray, INTRASITE Hydrocolloid, and INTRASITE Gel."

5 “The trade mark OPSITE has been used continuously in the UK and elsewhere since 1972 up to the present day. In 1972 an incise drape was launched into the UK market under the trade mark OPSITE. Subsequent products were launched under the trade mark OPSITE, into the UK, and other markets, in particular OPSITE Wound Dressing was launched, in 1979; OPSITE IV was launched in 1980, and OPSITE FLEXIGRID was launched in 1989”

10 “The trade mark INTRASITE has been used continuously in the UK and elsewhere since 1987 up to the present day. In 1987 INTRASITE Hydrocolloid was launched in the UK. Also, in 1987, the opponent sold a hydrogel woundcare product under the trade mark SCHERISORB. In 1988, outside the UK, the trade mark SCHERISORB was dropped and the trade mark INTRASITE was used on the hydrogel product. In 1992, the SCHERISORB mark was dropped in the UK and INTRASITE was introduced”.

15 “The total hospital sales worldwide of products bearing SITE suffixed marks for the sum of the previous five years in monetary terms was £10,586,850”.

20 “The total hospital sales worldwide of products bearing SITE suffixed marks for the sum of the previous five years in unit terms was 8,076,942”.

25 “In January 1992 the applicants were in negotiations with the opponents to ascertain whether the opponents would act as their distributors. The applicants have no UK sales force. Thus at the time of filing the present application, the applicants had no intention of selling the product themselves in the UK and at least in January 1992 had not appointed a distributor or registered user in the UK”.

30 Mr Ollis then provides a number of exhibits, DJ01 - DJ09 which show the use of the marks OPSITE, OPSITE FLEXIGRID, INTRASITE Gel, and OPSITE IV. These show the various trade marks being used on the relevant products and also promotional literature. Opsite is shown as a film for use as a wound dressing whilst Intrasite is shown as a gel for use as a wound dressing. In all the exhibits the marks are shown either in capital letters or with only the first letter and the S of Site in capitals eg IntraSite, OpSite.

35 The second statutory declaration is by Mr Stephen Philip Gilholm, dated 11 August 1995. Mr Gilholm is the trade mark agent at Smith & Nephew Group Research Centre at York. He states that “I am acting on behalf of T J Smith & Nephew Ltd (hereinafter referred to as the opponent) trading as Smith & Nephew Medical Ltd”. He states:

40 “The opponent considers that they have a monopoly in trade marks which are entered on the UK Trade Marks Registry for goods covering woundcare products wherein the trade marks possess the suffix SITE”.

45 Mr Gilholm then exhibits, at SPG1, a search which he carried out on the Marquesa Trade Marks Database on 4 October 1993. This shows that the opponents are the only registered proprietors of trade marks with the suffix SITE, in relation to woundcare products. Mr Gilholm also provides a copy of the British Formulary of Woundcare Management, at exhibit SPG2, which lists woundcare products sold in the UK. This booklet is dated November 1990 and shows the

opponents as the only company trading in woundcare products which have the suffix SITE.

5 Finally at SPG3 & 4, Mr Gilholm exhibits a survey undertaken sent out to 26 nurses specialising in woundcare, throughout the UK. He states that “The questionnaire was sent out under a covering letter and accompanied by a stamped addressed envelope for the return of the questionnaire. The questionnaire, the covering letter, the stamped addressed envelope and the envelope in which they were sent did not bear any indication of the name T J Smith & Nephew or any other company.” Copies of the letters etc. are exhibited and back up this statement.

10 The questionnaire regarding CLEAR SITE was sent out in June 1993, whilst the PIN-SITE questionnaire was posted in January 1995. The questionnaires were the same except for the substitution of PIN-SITE for CLEAR SITE, with one exception. In the case of PIN-SITE the questionnaire began by asking respondents whether from their experience as a medical practitioner they were aware of the term “pin site”. A similar question was not asked in the
15 CLEAR SITE questionnaire. The questions asked if the respondent was aware of the wound care products OPSITE and INTRASITE and whom they originated from. They also asked if the respondent would expect the wound care product CLEAR SITE / PIN-SITE to originate from the same company as OPSITE and INTRASITE.

20 Mr Gilholm states that of the 26 questionnaires sent out 17 were returned. Of these sixteen replies “eleven (64.7%) of respondents expected that if they encountered a woundcare product named CLEAR SITE they would consider it to originate from the same company as the woundcare products OPSITE and INTRASITE”.

25
APPLICANTS’ EVIDENCE

This consists of a statutory declaration, dated 17 May 1996, by Mr James Cartmell. He states:

30 “I was formerly Vice President of NDM Acquisition Corp. and of its successors in business. I am currently an employee of Conmed Corporation of which NDM Inc. is a wholly owned subsidiary. NDM Inc. is in turn the successor in interest to New Dimensions in Medicine Inc. New Dimensions in Medicine Inc. was the surviving corporation when NDM Acquisition Inc. merged with and into MEI Diversified INC. I
35 am familiar with the company’s marketing of products, the trade marks’ PIN-SITE and CLEAR SITE ADVANCED GEL TECHNOLOGY & device. I have detailed knowledge of the commercial affairs of this business and I am authorised to make this declaration on behalf of the company. I will refer hereafter to both NDM Acquisition Corp. and its successors in business as NDM save where the context requires differentiation between
40 them. The information and statements made in this declaration are either from my own knowledge and recollection of the circumstances concerning use of the marks the subject of these oppositions, or taken from files of NDM, to which files I have had access as a consequence of my position”.

45 Mr Cartmell states that the applicants first began using the CLEAR SITE trade mark in the USA in June 1990. It was first registered with the US Patent office in April 1991. CLEAR SITE ADVANCED GEL TECHNOLOGY and device being registered in the USA in April 1994. He

states that the business in CLEAR SITE is “now quite substantial and has since its launch in the US sold a significant number of millions of dollars worth of wound care products”. Examples of the product packaging and promotional literature are provided (at exhibit JC2) and show clear use of the mark in suit. In these examples the S in Site is always a capital letter.

5

Mr Cartmell refers to discussions between the applicants and the opponents which took place in 1992. The objective was to get the opponents to act as distributors for the applicants’ products in the UK. According to Mr Cartmell, these negotiations broke down because the two parties were unable to agree on financial and economic terms for a business relationship. He also states that the two representatives from the opponents who took part in the discussions (Mr Dick & Mr Croxford) raised no objections to the mark in suit. Another party to the discussions, Metron Instruments, later became the applicants’ UK distributors.

10

Mr Cartmell states that these discussions and the sales of products under the CLEAR SITE mark in the USA show that the applicants had a bona fide intention of using the mark. He also states that NDM has sold its CLEAR SITE woundcare products to a “number of countries around the world”. The applicants have, he claims, obtained registrations for the mark in suit or in its singular CLEAR SITE form in, amongst others, South Africa, USA, Australia and Canada. Copies of the registration certificates are provided at exhibit JC3. Applications for both the singular and composite form of the mark are pending in a number of other countries according to Mr Cartmell.

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Mr Cartmell claims that the opponents have their OPSITE and INTRASITE marks registered in the USA, S Africa, Australia & Canada. At JC4 he exhibits copies of the opponents’ registration certificates for these countries. He refers specifically to the USA where both sides have used their marks for a number of years and yet Mr Cartmell claims that he is unaware of any confusion. He also points out that the opponents have not instanced any confusion in the USA, which he states would have aided their cause.

25

Mr Cartmell questions the statement made by Mr Gilholm for the opponents when it was claimed that “the opponent is the only company in the UK trading in wound care products under trade marks which bear the suffix SITE”. Mr Cartmell states that the applicants having been trading in the UK since 1994 under the CLEAR SITE mark, and that the opponents were aware of the applicants interest in the UK for their mark as a result of the earlier discussions.

30

35

That completes my review of the evidence.

40

DECISION

I first consider the grounds of opposition under Sections 9 & 10 which state:

9. -(1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the Register, it must contain or consist of at least one of the following essential particulars:

45

(a) the name of a company, individual, or firm, represented in a special or particular

manner;

(b) the signature of the applicant for registration or some predecessor in his business;

5 *(c) an invented word or invented words;*

(d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

10 *(e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c), and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.*

15 *(2) For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course*
20 *of trade from goods in the case of which no such connection exists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.*

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent which -

25 *(a) the trade mark is inherently adapted to distinguish as aforesaid; and*

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

30 *10. - (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection*
35 *subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.*

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

40 *(a) the trade mark is inherently capable of distinguishing as aforesaid; and*

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

45 *(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.*

As this application is for registration in Part B of the Register, the opposition under Section 9 is not relevant. Regarding the Section 10 opposition, Mr Buchan's submission at the hearing was based on the contention that the mark in suit is descriptive as the product is transparent, allowing the wound to be inspected without removing the dressing. He also claimed that if the dressing were medicated it could be said to "clear the site of debris, bacteria or whatever". The applicants accepted that the SITE part of the mark is descriptive in that the product is used to treat wound sites, but claimed that the mark overall was distinctive. The opponents also contended that the phrase was one which other traders might wish to use in advertising. I do not accept this argument as the words CLEAR and SITE are not naturally conjoined. In an advertisement one might state that "X brand clears a site of..." or even that it "keeps a site clear of ...". In my view the mark could also be seen as an allusion to the transparency in that it offers a clear view or sight of the wound. However, I do not accept that it is incapable of distinguishing the goods of the applicant. Further, the opponents filed no evidence in support of this ground of opposition to the mark in suit. The opposition under Section 10 therefore fails.

The next ground of opposition is under Section 12(1) of the 1938 Act. This reads as follows:

12. - (1) "Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:

(a) the same goods,

(b) the same description of goods, or

(c) services or a description of services which are associated with those goods or goods of that description."

The reference in Section 12 to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

Before moving onto consider the similarity of the marks it is necessary for me to clarify the relevance of the disclaimer of exclusive rights to the words in the application before me. A similar point arose in a decision of 24 December 1998 by Mr Geoffrey Hobbs QC, sitting as the Appointed Person in the case of Fountain Technologies Inc.'s Application, which as far as I am aware, has not yet been reported. He described the significance of a disclaimer in relation to an objection under Section 12(1) of the Act as follows:

".....similarities attributable to nothing more than the presence of a disclaimed feature could not support an action for infringement of the registered trade mark under the 1938 Act. The position appears to be no different under the trade Marks Act 1994: The European Limited, The Economist Newspaper Limited (1998) FSR 283 (CA).

It will be easy to suppose that the same consideration should apply for the purpose of determining whether registration is prevented by Section 12(1) on the ground that a mark

5 so nearly resembles a previously registered mark as to be likely to deceive or cause
confusion. However, the prohibition in Section 12(1) has been carried forward (with
modifications) from Section 6 of the Trade Mark Registration Act 1875 and it has long
been recognised that it renders marks ineligible for registration on a somewhat broader
10 basis than that upon which their use would be regarded as actionable in proceedings for
infringement. This has led to the prevailing view that objections under Section 12(1) are
not, in point of law, restricted to the residue that is left after disclaimers (applicable either
to the mark offered for registration or the mark previously registered) have been taken
into account. According to the prevailing view a disclaimed element must neither be
15 ignored nor given less significance than it deserves when due allowance has been made
for the degree to which it is not distinctive of the relevant goods or services. On this
approach to the matter similarities attributable to nothing more than the presence of a
disclaimed feature may be sufficient to sustain an objection under Section 12(1): Granada
TM [1979]RPC 303.”

20 The correctness of that approach was not argued before Mr Hobbs. I therefore intend to proceed
on the basis that the disclaimer of exclusive rights to the words “Clear”, “Site” and “Advanced
Gel Technology” do not, of themselves, prevent the opposition under Section 12(1) from
succeeding. However, in making my comparison of the respective trade marks I must take into
account the distinctiveness or otherwise of the various elements which make up the applicants and
opponents trade marks.

25 In addition to INTRASITE the opponent also has the marks’ OPSITE, OPSITE ONE STEP,
OPSITE FLEXIGRID, OPSITE FLEXIGRID & DEVICE, OPSITE I.V.1-STEP and OPSITE
I.V.3000 registered. In my view the marks OPSITE solus and INTRASITE provide the opponents
with their strongest case, and I will refer only to these two marks in my judgement.

30 The established test for objections under Section 12(1) is set down in Smith Hayden & Co. Ltd’s
application [Volume 1946 63 RPC 101]. Adapted to the matter in hand the test may be expressed
as follows:

35 Assuming user by the opponents of their trade marks OPSITE and INTRASITE, in a
normal and fair manner for any of the goods covered by the registrations of those trade
marks, is the tribunal satisfied that there will be no reasonable likelihood of deception
amongst a substantial number of persons if the applicants use their trade mark CLEAR
SITE ADVANCED GEL TECHNOLOGY normally and fairly in respect of any goods
covered by the proposed registration?

40 It is accepted by both sides that the goods are similar if not identical.

I therefore move onto consider the marks themselves. For this purpose I take into account the
guidance set down by Parker J in Pianotist Co.’s application (1906 23 RPC 774 at page 777):

45 *“You must take the two words. You must judge of them both by their look and by their
sound. You must consider the goods to which they are to be applied. You must consider
the nature and kind of customer who would be likely to buy those goods. In fact, you must
consider all the surrounding circumstances: and you must further consider what is likely*

to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering, all those circumstances, you come to the conclusion that there will be a confusion - that is to say- not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

Given the descriptive nature of the last three words of the applicants' mark the average consumer would be likely to consider only the first words "CLEAR SITE" as the distinctive feature of the trade mark. Even so, it is apparent that the marks differ visually, the only similarity being the use of the word "SITE" in each mark. The use of a capital S in each of the marks was commented upon by Mr Buchan, who claimed that this aspect brought the marks closer together visually. Whilst it might be argued that this is the way in which the opponents use their marks on their packaging, the marks are registered with the full words in capital letters, and it is the registered formats which must be compared under this ground of opposition.

Each of the three marks, CLEAR SITE, OPSITE & INTRASITE, has an identical last syllable, SITE. The beginnings are clearly very different. It is accepted that the first syllable of a word is important for the purpose of distinction (see TRIPCASTROID [1925]RPC 264), and even allowing for the notion of imperfect recollection, I do not consider there is a real likelihood of aural confusion.

None of the marks has a dictionary meaning, although they all allude to medical applications.

Mr Buchan also placed great emphasis on the results of the survey. He stated that this showed that fifteen out of seventeen respondents when asked "Would you expect the wound care product CLEAR SITE to originate from the same company as OPSITE AND INTRASITE" responded "yes". However, in my view the survey is flawed in a number of areas. The questionnaire was sent to twenty-six nurses who it was said "specialised in woundcare". There is no indication of how these individuals were selected. Mr Buchan conceded at the hearing that there are "many thousands, if not tens of thousands" of wound or theatre nurses in the UK. Aside from these aspects of the survey the nature and positioning of the questions are such that it invited the respondents to speculate and elicited a response favourable to the opponents. The inclusion of the opponents' marks into the questionnaire may have influenced the respondents who instead of answering each question in turn, may have read the whole questionnaire prior to writing their responses. This would have affected their replies. With such a small statistical sample any inconsistency is magnified in its effect on the overall outcome.

I also note that the "relevant public" for these products would appear to be theatre or wound care nurses. These are highly trained professionals, used to dealing with products which have similar names. They are less likely to confuse products than the general public, or to be misled as to the trade origin especially in a specialist field.

Taking into account all of the factors and comparing the marks as wholes, I consider that the degree of similarity between the trade mark CLEAR SITE and the trade marks OPSITE and INTRASITE is insufficient to cause deception and confusion amongst a substantial number of persons. The opposition under Section 12 fails.

The next ground of opposition is under Sections 11 of the 1938 Act. This reads as follows:

5 *“11. - It shall not be lawful to register as a service mark or part of a service mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”*

10 The established test for this section is set down in Smith Hayden and Company Ltd’s application (Volume 63 1946 RPC 101) later adapted by Lord Upjohn in the BALI trade mark case (1969 RPC 496). Adapted to the matter in hand the test may be expressed as follows:

15 Having regard to the user of the opponents’ marks OPSITE / INTRASITE, is the tribunal satisfied that the mark applied for, CLEAR SITE, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

20 Under this heading I must consider the actual user of the opponents’ mark. It is stated that the opponents had used their OPSITE mark for approx. twenty years, and their INTRASITE mark for approx. five years at the relevant date, 10 February 1992. However, the sales figures provided refer to the world wide sales of products with the suffix SITE. It is difficult to gauge from this the user in the UK. The opponents also claim that they have a “family” of SITE marks. However, the only relevant use is of OPSITE and INTRASITE. The additions to these words do not affect the issue.

25 The applicants do not accept the opponents’ argument that they have reputation in the word SITE. The opponents provided impressive sales figures for products sold world wide with the SITE suffix. It was not clear how much related to sales in the UK and whether the figures included sales of products other than those referred to in the statement of grounds of opposition. The word SITE is a highly descriptive term and is clearly one which other traders would seek to use as part of trade marks or in advertising. It should therefore be given less weight than distinctive elements when comparing marks, always bearing in mind the requirement, as set out in Erectiko v Erector Vol52 [1935] RPC136, to compare marks as wholes.

30 The applicants do not accept the opponents’ argument that they have reputation in the word SITE. The opponents provided impressive sales figures for products sold world wide with the SITE suffix. It was not clear how much related to sales in the UK and whether the figures included sales of products other than those referred to in the statement of grounds of opposition. The word SITE is a highly descriptive term and is clearly one which other traders would seek to use as part of trade marks or in advertising. It should therefore be given less weight than distinctive elements when comparing marks, always bearing in mind the requirement, as set out in Erectiko v Erector Vol52 [1935] RPC136, to compare marks as wholes.

35 Further, the opponents claim to have used INTRASITE as a mark for a hydrocolloid since 1987, and at exhibit SPG2 a booklet dated November 1990 shows the product listed. However, it has only been used on the gel product illustrated in the exhibits to Mr Ollis’s declaration “since 1992”. The relevant date for this application is 10 February 1992. Accordingly, given the vagueness of the use figures it is not clear to what extent INTRASITE had been used before the relevant date, but it appears that the use has been extended since 1992. The survey was undertaken in June 1993 and, even if it were considered reliable, would not have reflected the position at the relevant date.

40 The evidence filed by the opponents shows use of two marks ending in SITE on an uncertain scale, and there is insufficient evidence to support the assertion to have an existing “family” of marks. The opponents’ contention that there would be confusion through association is based on the premise of the existence of such a family of marks.

45

The use of a capital S in each mark was commented upon by Mr Buchan. However as the applicants' mark consists of two words the use of capital letters is not surprising. Prima facie the marks are clearly not confusingly similar and the opposition under Section 11 therefore fails.

5 The opponents have also claimed that the registration should be refused under Section 17(1) as
"the applicants cannot claim to be using or to have had a bona fide intention to use the mark
applied for at the date of registration". Section 17(1) reads as follows:

10 17. - (1) Any person claiming to be the proprietor of a trade mark used or proposed to
be used by him who is desirous of registering it must apply in writing to the Registrar in
the prescribed manner for registration either in Part A or in part B of the register.

15 The opponents have not challenged the applicants' evidence in this respect and there is no reason
to believe that the applicants applied to register a trade mark they did not intend to use. The
opposition under this Section therefore fails.

I do not intend to invoke the Registrar's discretion in favour of the opponents.

20 As the opposition has failed, the applicants are entitled to a contribution towards their costs. I
order the opponents to pay the applicants the sum of £835.

Dated this 17 Day of September 1999

25

30 George W Salthouse
For the Registrar
The Comptroller General

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ANNEX A

	Trade Mark	Registration number	Registration Date	Class
5	OPSITE	B1100940	1/9/78	5
	OPSITE	B1100941	1/9/78	10
	INTRASITE	1227717	5/10/84	5
	OPSITE	1254567	16/11/85	5
	OPSITE	1254568	16/11/85	10
10	OPSITE	B1267583	21/5/86	24
	OPSITE	1327601	21/11/87	10
	OPSITE ONE STEP	1369802	31/1/89	5
	OPSITE FLEXIGRID	1369854	14/1/89	5
	OPSITE FLEXIGRID (DEVICE)	1370641	20/1/89	5
15	OPSITE I.V. 1-STEP	1419306	30/3/90	5
	OPSITE I.V.3000	1435652	10/8/90	5

20