

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2503695  
BY BRIGHTWAKE LTD TO REGISTER THE TRADE MARK**

**EPISIL**

**IN CLASS 5**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 98948  
BY CAMURUS AB**

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**IN THE MATTER OF Application No 2503695  
By Brightwake Ltd to register the trade mark**

**EPISIL**

and

**IN THE MATTER OF opposition thereto under No 98948 by Camurus AB**

### BACKGROUND AND PLEADINGS

1. On 1<sup>st</sup> December 2008, Brightwake Ltd ('Brightwake') applied to register the mark EPISIL in class 5. The goods for which registration is sought, following amendment, is as follows:

**Class 5:**

Non-medicated wound dressings, all comprising a carrier sheet of synthetic plastics material bearing a skin contact layer of silicone gel.

2. The application was allocated number 2503695 and was published in the Trade Marks Journal on 13<sup>th</sup> February 2009 and on 9<sup>th</sup> April 2009 Camurus AB ('Camurus') lodged an opposition against the goods specified above.
3. Camurus has opposed on the basis of sections 5(1) and 5(2)(a), citing the following earlier mark:

Mark. Filing and registration dates	Goods and services relied upon under section 5(1) and 5(2)(a)
CTM 7299639  EPISIL  9 <sup>th</sup> October 2008 12 <sup>th</sup> April 2011	<b>Class 5</b> Pharmaceutical preparations for local treatment of pain associated with oral mucositis that is administered through a device, none of the aforesaid goods in relation to gynaecological pharmaceutical preparations or hygienic products related thereto

	<p><b>Class 44</b></p> <p>Medical services; veterinary services; consultancy relating to medicines, none of the aforesaid services in relation to gynecological pharmaceutical preparations or hygienic products related thereto.</p>
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4. In its statement of case, Camurus say the respective marks are identical and the respective goods are either identical or similar to those of Brightwake, leading to a likelihood of confusion. I should at this point explain that the statement of case and certain of Camurus's evidence was directed to the respective specifications existing at the time those materials were filed. Subsequently, both parties' specifications have been limited substantially, and consequently the main focus of my evidence summary and submissions will be the revised specifications as set out above.
5. Brightwake filed a counterstatement denying that there is a likelihood of confusion. Although it did not expressly concede the respective marks are identical it nonetheless denied the goods were either identical or similar; a position it maintains in respect of the revised specifications as above.
6. Evidence and submissions were filed by both parties which I shall summarise below and take into account in my decision. No hearing was requested and so I give my decision based upon a careful reading of the papers.

**Opponent's evidence in chief**

7. This takes the form of a witness statement dated 11<sup>th</sup> September 2009 by Helen Thomas-Peter, an attorney with Walker Morris, acting for the opponent. At the time this was filed the opponent's specification read : "pharmaceutical and veterinary preparations" in class 5 and "medical services; veterinary services; consultancy relating to medicine" in class 44. The applicant's specification read : "Medical, surgical and veterinary wound dressings; semi-permeable adherent wound dressings; atraumatic wound dressings" in class 5.
8. The specifications were plainly much broader than they are now and so the evidence is largely redundant, but purely for the record exhibit HTP1 comprises a selection of medical and veterinary dictionary references

intended to show that 'wound dressings' can take the form of 'pharmaceutical preparations'. Exhibit HTP2 comprises a selection of prints from internet retailers also showing the relationship between wound dressings and pharmaceutical preparations and that they are sold to the same consumers through the same retail outlets. On the site, [www.yourableshop.co.uk](http://www.yourableshop.co.uk), a product called "Jason Stop-It Wound Concealer" is sold which is a spray on powder that forms a scab over a cut or graze. On the site, [www.hilditch.com](http://www.hilditch.com), spray on wound dressings, pads, bandages and antiseptics can be found.

9. Exhibit HTP3 comprises extracts from the web sites of the "well known" products SAVLON and ELASTOPLAST showing pharmaceutical preparations such as wound washes, antiseptic sprays, spray on plasters and healing gels being sold alongside sticking plasters.

### **Applicant's evidence in chief**

10. This comprises a witness statement dated 13<sup>th</sup> November 2009 from Stephen Anthony Jones, a trade mark attorney with AdamsonJones, acting for the applicant. He disputes that wound dressings can be regarded as pharmaceutical preparations. Exhibit SAJ03 comprises a page from the website of the Medicines and Healthcare products Regulatory Agency (MHRA) which divides its scope of responsibility into four categories, 'Medicines' being one and 'Devices' another. 'Dressings' are included under the term 'devices', and are thus, he says, not 'pharmaceutical preparations'.
11. Exhibit SAJ04 comprises a print from Camurus's own website describing its EPISIL product as a treatment for oral mucositis, a severe side effect of chemotherapy or radiotherapy. It is described as a 'local treatment of pain' which is:

"administered as a lipid based liquid on the intra-oral mucosal surfaces and transforms to a strongly bioadhesive FLUICRYSTAL (rtm) film that mechanically protects the sensitised and sore epithelium of the oral cavity".

12. Mr Jones says pharmaceutical preparations contain a pharmaceutically active substance; they are used for the therapeutic and pharmacological treatment of a disease. In contrast, wound dressings are medical devices, used to facilitate healing of a wound; they do not seek to provide a cure for the underlying cause of that wound.

### **Applicant's further evidence**

13. This takes the form of a further witness statement dated 17<sup>th</sup> May 2011 from Mr Jones. By this time his client's specification had been further limited to

reflect the specification now presented, and in particular the limitation to “wound dressings .... bearing a skin contact layer of silicone gel”. He says such dressings are significantly more costly than conventional dressings given the silicone content which is soft and comfortable and does not adhere to moist wound surfaces, thus allowing removal without the trauma of conventional dressings. He says silicone dressings would be particularly suitable for the treatment of more serious wounds, ulcers and burns.

14. Exhibits SAJ05 – SAJ08 are intended to demonstrate that silicone dressings are specialised, with limited application in respect of serious wounds, ulcers and burns, and accordingly, sales of such a product are directed at the healthcare industry, and exclusively for application by healthcare professionals. Exhibit SAJ05 comprises pages from SMITH & NEPHEW’s website in relation to its product BIOBRANE, which is described as having advantages for the ‘healthcare professional’, including wound visualisation and a silicone barrier decreasing the risk of infection. Exhibit SAJ06 comprises pages from SMITH & NEPHEW’s website in relation to its product ALLEVYN. These pages include precautions in the use of ALLEVYN and instructions as to how to apply, including that ‘aseptic technique is always applied when cutting the dressing’. Such a technique, says Mr Jones, requires a relatively high level of medical competence according to WIKIPEDIA, although this WIKIPEDIA reference is not put in formal evidence. Exhibit SAJ07 comprises pages from MÖLNLYCKE’s website in relation to its product MEPITEL, and finally, exhibit SAJ08 comprises pages from MÖLNLYCKE’s website in relation to its product MEPILEX, described as ‘atraumatic to the wound and surrounding skin on removal’, and as promoting patient comfort during wear.

### **Opponent’s further evidence**

15. This takes the form of a further witness statement dated 17<sup>th</sup> June 2011 by Ms Thomas-Peter, an attorney, as I have said, acting for the opponent. She refutes any suggestion by Brightwake that wound dressings are not for the treatment of pain per se. Exhibit HTP01 is an information sheet by Steve Thomas, Director of Surgical Materials Testing Laboratory in Wales who says that soft silicone dressings are suitable for “almost all indications where it is important to prevent trauma to the wound and the surrounding skin and pain to the patient”, also that silicone products may have a “role in the treatment of diabetic foot”. Whilst dressings do not necessarily have any pharmaceutical capacity to alleviate pain they do appear to have a role in the management of pain by, for example, being more gentle to remove than conventional dressings, says Ms Thomas-Peter.
16. Although Brightwake says silicone dressings are more expensive than conventional dressings, Ms Thomas-Peter says it does not follow that the end user of the product would inevitably be healthcare professionals, having

a high level of medical competence. Exhibit HTP02 comprises a page from [www.boots.com](http://www.boots.com), showing the ALLEVYN product referred to by Mr Jones, as being available online from BOOTS for £9.18.

17. She says both parties' products are for the treatment of lesions or open wounds to the skin. In particular, both can be used for the treatment of ulcers whether in the mouth (as in the case of oral mucositis) or on the leg, as in the case of diabetic leg ulcers.
18. The argument that the applicant's product is a medical 'device' is countered by the fact that the opponent's product is administered by a device in the form of an aerosol spray.
19. Exhibit HTP04 is a selection of photos taken in the BOOTS store in Leeds on 3<sup>rd</sup> June 2011, which are intended to show that the two competing EPISIL products are likely to be sold through the same retail outlets and in a similar position within the store. Photo 1 is a panoramic view of the store, said to show treatments for mouth ulcers and cold sores on the right hand display unit and first aid products, including dressings and bandages, on the shelves to the left. It is however not clear from the photo that this is the case. Photos 2,3,4 and 5 are from the dressings and bandages shelf, showing gel dressings, and emergency burn sprays and spray sanitisers alongside conventional dressings. Photos 6 and 7 are from the other aisle and show treatments for toothache, sore mouths, cold sores and mouth ulcers. These products have a different type of dispenser but the same purpose, she says. Also on the mouth care shelves, she says, were cold sore treatments using gel based dressings closely similar to those of the applicant's specification.
20. Exhibit HTP05 shows cold sore treatments sold alongside conventional wound dressings on the internet, the site being [www.healthcare4all.co.uk](http://www.healthcare4all.co.uk). This shows the product COMPEED, a cold sore patch, being sold alongside conventional wound dressings. There are two other sites also exhibited, one being [www.medtrade.co.uk](http://www.medtrade.co.uk) which sells hydrocolloid cold sore pads which reduce pain and itching, these being sold alongside blister dressings, spray on plasters, scar treatment and burn care treatments.
21. Ms Thomas-Peter says cold sores are essentially viral blisters which ooze matter, hence the need for gel based dressings. Exhibit HTP06 is an extract from the website [www.biofact.ie](http://www.biofact.ie) which describes an EPISIL absorbent dressing, being I assume the applicant's product, as suitable for, amongst other things, blisters. There is every possibility, she says, that the applicant's product could be "adapted for use with cold sores and appear on the same shelf as other mouth care products".
22. She observes that oral mucositis is a side effect of chemotherapy and radiotherapy that manifests itself as soreness and ulcers in the mouth. The

treatment of such a symptom may be with 'off the shelf' products or prescription drugs and devices. Exhibit HTP07 is a pamphlet entitled "Guidelines for the prevention and management of mucositis issued by Surrey, West Sussex and Hampshire Cancer Network NHS". This refers to the use of commercial mouth washes and mouth ulcer treatments, such as BONJELA, as a way to manage oral pain in the first and second lines of severity. These are available from high street chemists. Third line treatment is by opiates, presumably on prescription and fentanyl patches. Exhibit HTP09 shows such a fentanyl transdermal patch and these, she says, are similar in appearance to gel dressings. Treatment may also include a product called GELCLAIR which is a gel rinsed around the mouth and which provides a protective layer over the sore areas. This product is classified as a medical device as is the applicant's wound dressing.

## **DECISION**

### **Section 5(1) and 5(2)(a)**

23. The opposition is founded upon Section 5(1) and 5(2)(a) of The Trade Marks Act 1994 ("the Act"). This reads:

**5. - (1)** A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

(b) .....

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

24. Camurus's mark was filed on 9<sup>th</sup> October 2008 and registered on 12<sup>th</sup> April 2011. It is therefore an earlier mark in accordance with Section 6 of the Act. Moreover, given its date of registration is within 5 years of the publication of the application, it is not subject to proof of use requirements.

### ***Comparison of the marks***

25. Whilst Brightwake does not appear to concede the point, it is beyond dispute that the respective marks are identical.

### ***The average consumer and nature of the purchase***

26. The assessment of who exactly the average consumer is in this case and the nature of acquisition and purchase is particularly important.
27. Brightwake's position is that its product is used exclusively by healthcare professionals having a high degree of medical competence. Theirs is a high cost product with, in general, specialised application for the treatment of serious wounds, burns and ulcers for example. Camurus's product is, in contrast, says Brightwake, a spray bottle containing a liquid, the administration of which utilises spray action by the (cancer) patient themselves who need not have any medical skill. Assuming the product to be a widely available product, Brightwake says the patient would most likely purchase the product, perhaps on the advice of a healthcare professional, and administer it themselves. At the point of administration, the patient would be fully conscious, unlike perhaps a patient being treated with Brightwake's product.
28. Camurus counters this by saying that silicone wound dressings are not necessarily as exclusive or as specialised as Brightwake may make out. Its evidence shows that at least one, ALLEVYN, is available from BOOTS online (Exhibit HTP02 from Ms Thomas-Peter's further witness statement). Moreover, contends Camurus, it is entirely feasible that such dressings may in future become more accessible as the cost drops and the advantages in terms of pain management are more widely appreciated.
29. Brightwake's position is not backed by any objective rule or regulation for example which may restrict access to, or application of, silicone dressings to healthcare professionals. Camurus plainly demonstrates that at least one silicone based wound dressing is readily accessible over the internet for £9.18 from BOOTS online. Clearly, silicone has certain advantages in terms of wound management; it is soft, comfortable and the dressing may be removed with minimum trauma and these advantages may well be more widely appreciated and applied. In consequence, I am not persuaded by Brightwake's position and do not accept the argument that its product (or products meeting its description) is *exclusively* for use by healthcare professionals with high medical competence, either now or in the future.
30. This leaves me with the position of having to decide how exactly the identities of the two sets of average consumers may overlap, and from that, of having to decide the nature of the purchasing act. Brightwake concede some overlap in terms of the identity of the average consumers by saying that healthcare professionals will (exclusively) be involved in access to their

product and *may* be involved in access to Camurus's product. I have already dismissed the argument that Brightwake's product is (and will only ever be) accessed by and administered by healthcare professionals.

31. I have no evidence on the question that Camurus's product is a prescription-only product. I do have evidence that oral mucositis is a condition, commonly arising from chemotherapy or radiotherapy, which presents on a spectrum of severity (Exhibit HTP07 to Ms Thomas-Peter's further witness statement, referred to in para 22 above). A lesser degree of severity can be treated by 'off the shelf' products, such as BONJELA, but as the severity increases, treatment would be by opiates and other prescription drugs, and finally, fentanyl patches. On balance, and especially given its specialised nature, I do not believe Camurus's product is likely to be sold 'off the shelf'. At some point, a healthcare professional (specifically, an oral cancer specialist but also including other healthcare professionals) is going to be involved as an intermediary, advising the patient or prescribing the treatment offered by Camurus's product, or products covered by that description.

32. Even if *both* parties' products had been exclusively prescription only, this of itself would not necessarily have prevented likelihood of confusion, but it could nonetheless at least be argued that intervention *only* by healthcare professionals and via pharmacies may have mitigated against likelihood of confusion.<sup>1</sup> It is plain however I have not been able to make the finding that both parties' products are, or may be in the future, available only through a process involving healthcare professionals as intermediaries. As I have said, products fitting Brightwake's specification are already available on the internet to the public without intervention or intermediaries.

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<sup>1</sup> In, eg Case C-412/05P (TRAVATAN) before the Court of Justice of the European Union it was held:

"56 In the present case, having regard to that case-law, the Court of First Instance was fully entitled to hold, which indeed is not disputed by any party in these appeal proceedings, that the healthcare professional at issue must be included in the relevant public for the purposes of the application of Article 8(1)(b) of Regulation No 40/94, the function of the trade mark as an indication of origin being also relevant to intermediaries who deal with the goods commercially in so far as it will tend to influence their conduct in the market (see, to that effect, Case C-371/02 *Björnekulla Fruktindustrier* [2004] ECR I-5791, paragraphs 23 and 25).

57 However, contrary to what the applicant claims, the fact that intermediaries such as healthcare professionals are liable to influence or even to determine the choice made by the end-users is not, in itself, capable of excluding all likelihood of confusion on the part of those consumers as regards the origin of the goods at issue."

33. The case law referred to in my footnote explains that one of the reasons why prescription only products, involving intervention and intermediaries in their prescription, are not immune from likelihood of confusion is that the role of the end-user patient as a relevant consumer cannot be ignored or excluded. In this case, the end –user patient of Camurus’s products (being an oral cancer sufferer) may still be engaged in, along with their healthcare professional, the selection, use and purchase of their product. Any decision to prescribe, administer and ultimately purchase such a treatment is not entirely and exclusively that of the healthcare professional. The end-user is fully engaged in, and may even influence the health professional in the process of selection, prescription and use of a product designed to alleviate symptoms of his or her oral cancer treatment
34. The net effect of these comments and the related case law is that I cannot say the purchase or acquisition of either parties’ respective products necessarily involves *only* healthcare professionals. Plainly there will be a group of the general public, under treatment with Camurus’s product, who may also wish to access wound dressing treatment of the kind offered by Brightwake. That group can do so without intervention or intermediary, evidently through BOOTS online, at least as far as ALLEVYN is concerned.
35. Moreover, and insofar as healthcare professionals may be involved in the administration or purchase of either or both parties’ products, these people are personally likewise not immune from, nor, in the performance of their role would they necessarily and inevitably render less probable the overall likelihood of confusion. Whilst the healthcare professional may possess a higher level of circumspection than even the end users of the medical products, whose level of circumspection must also be high, *both* groups must be taken into account in any assessment.
36. Given the very nature of these respective products, I think it reasonable to say that, whether involving the intervention of healthcare professionals or not, the process of selection of both parties’ products by all persons involved, will engage a high degree of circumspection, having regard for example to contra-indications, potential advantages and severity of condition.
37. These comments and observations will be fed into my further considerations below.

### ***Comparison of the goods and services***

38. In assessing the similarity of the goods and services , it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the goods and services in the respective

specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the Judgment:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature and their method of use and whether they are in competition with each other or are complementary.’

39. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.
40. Brightwake’s contention is that the respective parties’ products are not similar. It says the goods defined in Camurus’s specification are for oral use only. Its own products, as defined in its specification, are incapable of oral use; in particular as silicone gel is *hydrophobic* and incapable of sticking to the moist surface of the mouth and lips. Its goods could not conceivably ever be adapted for oral use. The gel like, or based, products to which Camurus refers in its evidence and submissions, such as BONJELA, or other cold sore and mouth ulcer treatments, ranging up to fentanyl treatment patches, are all composed of *hydrophilic* gel and are therefore capable of dissolving in or otherwise interacting with the oral environment.
41. It is clear, says Brightwake, that the respective goods have distinct purposes, ie oral pain relief and dressing skin wounds. This distinction is clearly understood by the general public and that public would not expect a wound dressing for use on the skin to be suitable for use in the mouth. Insofar as pharmacies may stock both products, they would, as revealed by Camurus’s own evidence, be stocked in clearly separate sections.
42. In contrast, Camurus says the distinction is not so clear cut. Both parties ‘treat’, in a broad sense, skin wounds, lesions, sores or blisters. Products matching Brightwake’s description may not only possess the function of a mechanical dressing, but may also have application in the ‘treatment’ of the underlying condition and associated pain, eg diabetic leg ulcers or blisters (see exhibits HTP01 and HTP06 to the further witness statement of Ms Thomas-Peter). Furthermore, says Camurus, products used in oral treatments of cold sores and mouth ulcers, for example, (and with which it seemingly links its own product) are all sold alongside gel based wound dressings, either in the traditional retail environment such as the high street chemists BOOTS or in an internet environment.
43. Moreover, says Camurus, case law is on its side. It says that in the case of BL O-290-05 (DERMAX) it was held by the registry that ‘dressing material

and dressings for the treatment of wounds' were similar to 'pharmaceutical preparation and substances'. Likewise, in Case R 458/2006-4 before the OHIM Fourth Board of Appeal, a finding of similarity was made on the basis that the respective products, 'despite their different nature, all serve to heal the body, are provided through the same healthcare professionals and distribution channels and are often used in a complementary way'. The OHIM approach emphasises of course the multifactoral nature of the assessment of similarity.

44. Whilst I am not entirely persuaded by the argument that because both products 'heal the body' this is necessarily a telling factor in overall similarity as such a factor presents at a very high level of generality, particularly in a case such as this where both parties' specifications have been limited to a significant extent.

45. The first factor in my analysis of similarity is the nature, method of use and intended purpose of the parties' goods. I recall in this regard the description of Camurus's EPISIL product as being :

*"administered as a lipid based liquid on the intra-oral mucosal surfaces and transforms to a strongly bioadhesive FLUICRYSTAL (rtm) film that mechanically protects the sensitised and sore epithelium of the oral cavity". (my emphasis)*

46. Although Camurus's product may also have a pharmacological effect, the description above is strongly redolent of the effect of a dressing. A film or coating is produced which serves to mechanically protect the sensitised and sore epithelium. On the basis that Camurus's own product is, in effect, a paradigm illustration of a product which would be encompassed by the terms used in its own specification, I conclude that both parties' products are apt to treat skin wounds, lesions or sores in a protective fashion.

47. Further, on the question of nature, method of use and intended purpose, it is worth making the point here that, notwithstanding that Brightwake's own product may be (as also implicit in the wording of the specification) in the form of a traditional 'dressing', the expectations of the average consumer as to the nature of dressings in recent times have perhaps moved from traditional patches and gauze type 'devices' to sprays, gels and creams. The evidence from Camurus as to what is available from BOOTS shows this. Camurus's goods are similarly in the form of a spray and operate, as I have said, in a protective 'barrier' type fashion. This background cannot be other than relevant in terms of conditioning the expectations of the average consumer as to the nature, method of use and intended purpose of the parties' respective goods.

48. Finally, on the question of nature, method of use and intended purpose, I consider the fact that one product may be for oral application only is not reason enough in this case to render any distinction decisively clear to the average consumer, given my observations above. Even if the average consumer were to know that silicone is hydrophobic and not hydrophilic, knowledge which in any event cannot necessarily be imputed to that average consumer (especially if that consumer includes members of the public), both products are nonetheless used in the treatment (by which, I include pain relief) occasioned by skin wounds, lesions and sores. Given this common application in relation to the skin, whether that area of skin is found in the mouth or elsewhere on the body would not, in my opinion, have the decisive effect in terms of the nature, method of use and intended purpose of the respective goods urged on me by Brightwake.
49. Overall, I conclude then, that in terms of their nature, method of use and intended purpose, both parties' goods will inevitably share a degree of similarity which must be factored into my assessment of overall similarity.
50. This leads me then to other factors affecting overall similarity. Insofar as healthcare professionals are involved, the respective products will share those same distribution channels, and as I have said before, I include all types of healthcare professionals in this assessment.
51. Moreover, I think the evidence establishes that, in terms of their respective retail environments, dressings, including gel based dressings, are sold along with common mouth ailment treatments, such as for mouth ulcers or cold sores. They may not be on the exactly the same shelves in BOOTS or other similar retailers, but they are in reasonable proximity. In the internet environment the position of proximity is evident.
52. It could be argued perhaps that Camurus's product cannot be equated to the common mouth ulcer and cold sore treatments available from, eg BOOTS. Against that, the evidence on the treatment of oral mucositis (exhibit HTP07 to Ms Thomas-Peter's further witness statement, to which I have already referred in paras 22 and 31 above) clearly provides for a spectrum of severity, at the lower level of which, everyday products such as BONJELA can be utilised. Thus, I believe the linkage that Camurus makes in its evidence between its own product and treatments for common mouth ailments is a legitimate one.
53. Overall, and taking all factors into account, I find the respective parties' products to be similar to a moderate degree.
54. I should add at this point that Brightwake has offered to further limit its specification, should it be necessary, to include the limitation, "none of the

aforesaid goods being for oral use'. I will consider this offer under my consideration of likelihood of confusion below.

55. I have not overlooked the fact that in its original statement of case Camurus alternatively argued that its services in class 44 are similar to Brightwake's goods. However, during the course of proceedings Camurus has offered no argument on this claim and focussed entirely on the similarity between the respective goods. Although this claim has not been formally removed from the proceedings it is fair to say that, by its own evidence and submissions, Camurus regard its best and preferred case to be represented by its goods rather than services. I agree with this and do not propose to further consider the question of similarity of Camurus's services in relation to Brightwake's goods.

### **Likelihood of confusion**

56. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is

permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

57. Before proceeding to bring all my findings together in an overall global assessment, I am required to make an assessment of the distinctive character of the earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK being the prime example.

58. EPISIL is, to my mind, highly distinctive for Camurus's products. It is conceivable the prefix 'EPI' may be seen by some (health professionals in particular) to relate to the skin, as in 'epidermis' or 'epithelium', but this is by no means inevitable. Beyond this somewhat tenuous reference point there is no obvious connection between the word EPISIL and the products sold or covered by the specification.

59. I find then that the earlier mark is inherently distinctive to a high degree. There is no evidence of use and so I cannot say this already high level of distinctiveness is enhanced through use.
60. At this point I need to remind myself of my various findings and bring them together in a global assessment taking, of course, into account, the doctrine of imperfect recollection, namely that consumers rarely have the opportunity to compare marks side by side.
61. I have found the earlier mark to be inherently distinctive to a high degree. I have found the respective marks to be identical. I have found the respective goods to be moderately similar. I have made observations on the identities of the average consumer to the effect that they do not necessarily involve only healthcare professionals and that there is overlap in those identities. Moreover, I have found that the average consumers will display more high levels of circumspection. This latter finding could, in certain circumstances, have operated to counter some of the other factors, but in this case, and especially as the marks are identical, in my view it does not provide an effective counter balance. Taking all these factors into account I find that there is likelihood of confusion under section 5(2)(a) of the Act, but in view of my finding in relation to the similarity of the goods, the case under section 5(1)(a) must fail.
- 62. The opposition therefore succeeds in its entirety under section 5(2)(a).**
63. At this point I should record that I have not factored in the alleged instance of actual confusion referred to in the opponent's submissions of 15<sup>th</sup> January 2010. Details as to this instance have not been provided.
64. Finally, I wish to consider the offer of further limitation of its specification by the applicant to exclude all goods for oral use. Such an offer tends to undermine Brightwake's position as, if it is correct that silicone is hydrophobic, such a further limitation would be redundant. That said, as my assessment of goods makes clear there are factors, such as the nature and intended purpose of the products themselves, distribution channels and proximity in traditional and internet retail environments which pull these products together in terms of their similarity. I have considered all the relevant factors in my similarity of goods assessment, and do not in this case believe that such a further limitation cures the issue by clearly separating the goods as far as the average consumer is concerned, especially given the conditioning I have spoken of in para 47 above. In the circumstances I do not believe the further limitation offered by Brightwake would allow the application to proceed.

## **Costs**

65. Camurus has been successful in its opposition and is entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither party sought a hearing. In the circumstances I award Camurus AB the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Statutory fee for filing opposition - £200  
Filing notice of opposition and considering counterstatement- £300  
Filing evidence and submissions and considering the applicant's evidence - £700

Total £1200

66. I order Brightwake Ltd to pay Camurus AB the sum of £1200. The sum should 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 4<sup>th</sup> day of October 2011**

**Edward Smith  
For the Registrar,  
the Comptroller-General**