

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO 2204156
IN THE NAME OF MOHAMMED ASLAM
AND
IN THE MATTER OF OPPOSITION THERETO UNDER NO 51383
BY NORBROOK LABORATORIES LIMITED**

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**IN THE MATTER OF Trade Mark Application No. 2204156
in the name of Mohammed Aslam**

AND

**IN THE MATTER OF Opposition thereto under No. 51383
by Norbrook Laboratories Limited**

BACKGROUND

1. On 27 July 1999, Mohammed Aslam applied for the trade mark GLUCOLYTE in respect of "Pharmaceutical preparations for medical use". The trade mark was examined, accepted and published. On 7 September 2000, Norbrook Laboratories Limited filed a notice of opposition. The grounds of opposition are as follows:

- (a) Under section 5(2)(b) of the Act. The opponent is the registered proprietor of the trade mark GLUTALYTE which is registered for identical or similar goods, thus registration would result in a likelihood of confusion on the part of the public.
- (b) Under section 5(4)(a) of the Act as the opponent has been using the trade mark GLUTALYTE in the United Kingdom since 1998 and thus could prevent use of the applicant's trade mark under the common law tort of passing off.

2. The applicant for registration filed a counterstatement in which the grounds of opposition are denied. He says that the name GLUCO-LYTE was in use at the time of the application for the trade mark GLUTALYTE and that the registration of the trade mark GLUTALYTE was accomplished by the permission of Cupal Ltd, the owners of the trade mark GLUCO-LYTE.

3. Only the opponent filed evidence in these proceedings. In accordance with Trade Marks Registry practice, I reviewed the case and advised the parties that, in my view, it was not necessary for a Hearing to be held to decide the matter. The parties were however reminded of their right to be heard. In the event, neither party requested a Hearing or filed written submissions in lieu.

4. Acting on behalf of the Registrar, and after a careful study of the papers, I give this decision.

Opponents' Evidence

5. This consists of two Statutory Declarations. The first is from Mr Martin Murdock, the Financial Director of the opponent company and dated 19 March 2001. Mr Murdock explains that he has been employed by the company since 31 October 1988 and is authorised and

competent to make this declaration on its behalf. The following relevant information is contained in this declaration:

- The opponent is the registered proprietor of UK Trade Mark Registration No 2161785, GLUTALYTE in class 5 which is registered in respect of “veterinary preparations and substances; chemical preparations for veterinary purposes”.
- The opponent has traded in goods under the trade mark GLUTALYTE in the United Kingdom since November 1998.
- The product sold under the trade mark GLUTALYTE is a powder which is a dietetic feed source of predominantly electrolytes and easily absorbable carbohydrates. On dissolution in water it provides a high energy, electrolyte replacement solution, with added glutamine. It is highly palatable so that it will be willingly ingested by the recipient, thereby providing a readily available nutritional source of highly digestible ingredients, to help stabilise water and electrolyte balance in the recipient animals during periods of convalescence. Such periods of convalescence may include recovery following surgery or diarrhoea and other life threatening conditions such as haemorrhage etc. GLUTALYTE can also be administered, for example, to horses to replace lost electrolytes which have been greatly depleted through the vigors of competition, where the animals can rapidly be depleted of body fluids through excessive sweating and exertion.
- Since 1998 the gross sales of the product sold under the trade mark GLUTALYTE in the United Kingdom are approximately £40,000 per annum. The unit price for each box of sachets vary depending on the size of the animal it is to treat. Generally, the unit price is in the range of £12.00-£15.00 (per box of 8 sachets).
- The product sold under the trade mark has been advertised and promoted throughout the United Kingdom, Europe and the rest of the world and the approximate amount spent annually on advertising and promotion has not been less than £20,000.
- GLUTALYTE comprises the prefix GLUTA to represent the addition of Glutamine in the product and LYTE meaning soluble.
- The product sold under the trade mark is not a prescription only medicine (POM) and is therefore available to the general public and so can be sold through any retail store.

6. The second Statutory Declaration comes from Fiona Allison Watson Fife, dated 19 March 2001 who is a European Trade Mark Agent with Fitzpatrick's Limited, the agents for the opponent. She provides a view on the similarity of the respective trade marks but the facts I derive are as follows:

- In response to paragraph 2 of the applicant's counterstatement that “GLUCO-LYTE was in use at the time of the GLUTALYTE application and the registration of trade mark GLUTALYTE was accomplished by permission of Cupal Ltd, the owners of trade mark GLUCO-LYTE”, Ms Watson states that this is expressly denied by the

opponent. The trade mark in use at the time was CUPAL-GLUCOLYTE (registration number 1289787), which was on the register at the time of the opponent's application for GLUTALYTE. Even though the mark CUPAL-GLUCOLYTE was distinguishable from the opponent's application for GLUTALYTE, the Examiner still considered that the marks were sufficiently similar such that consent was required from Cupal Ltd in order to allow the opponent's application to proceed to grant. Thus consent was obtained and GLUTALYTE progressed unopposed to registration.

7. That concludes my review of the evidence in so far as I think it necessary.

DECISION

8. I consider first the ground of opposition based upon section 5(2)(b) of the Act. Section 5(2)(b) states as follows:

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

- (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.”

9. An earlier right is defined as follows:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

10. I am satisfied that the opponent's trade mark is an earlier right on the basis of the above and go on to consider matters against the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

11. Firstly on the basis of notional and fair use of the applicant's and opponent's trade marks, I regard the respective specifications of goods (pharmaceutical preparations for medical use and veterinary preparations and substances; chemical preparations for veterinary purposes) as

being identical, or at least similar. Neither side has suggested otherwise at any stage. The matter rests therefore on a comparison of the trade marks themselves.

12. In order to decide whether there is a likelihood of confusion, I must have regard to visual, aural and conceptual similarities between the trade marks and consider these in the context of who the relevant public is likely to be. As neither party has specified that their products are prescription only products (certainly there is nothing in either sides specifications which indicate any limitation on the way in which products falling into the specification might be sold), I must therefore conclude that the relevant public may be medical professionals and the public at large; that the products may be dispensed through a pharmacy or by a doctor or veterinary surgeon or that they may be purchased over the counter in a specialised (pharmacy) or non-specialised environment.

13. The opponents submit that the trade marks GLUCOLYTE and GLUTALYTE are visually very similar, both having an identical prefix (GLU) and suffix (LYTE), the only difference being the middle two letters (CO and TA respectively).

14. I consider first the distinctive character of the earlier trade mark. Though GLUTA and LYTE have practical connotations - the products sold under the trade marks are likely to contain glutamine or have soluble properties, the trade mark has a degree of invention and as such is inherently distinctive. But I do not consider that the use made by the opponent of their trade mark adds to its distinctiveness. The sales figures are not significant, not least because they are not put into the context of the market. The promotional figure seems to cover all markets. I am unable therefore to give that information much if any weight.

15. What we have here are two trade marks GLUCOLYTE and GLUTALYTE each of three syllables with the first and last being identical. And in my view the first and last syllables are strong, both from a visual and aural standpoint. Thus the middle two letters (syllable) will be obscured by them. This is particularly so because it is unlikely that anyone will seek to analyse the details within the trade marks, or that they will have the opportunity to compare the trade marks side by side.

16. From a conceptual stand point too there may be some who will give the applicant's trade mark the same practical connotation as the opponent ie. that the products sold under it contain glutamine and are soluble, but I doubt that most would. As far as the general public are concerned the trade marks will be invented words. Thus there is nothing of a conceptual nature which detracts from the similarity found in the visual and aural comparison.

17. Looking at the trade marks from a visual, aural and conceptual stand point therefore I reach the view that they are very similar.

18. Having considered matters in the round - the identity or similarity of the goods; the similarity of the trade marks, visually and aurally; the likely customers for the goods in question, I find that the trade marks GLUCOLYTE and GLUTALYTE are similar trade marks within the meaning of Section 5(2)(b) of the Act and the opposition under that head, therefore succeeds.

19. As I have decided that the opposition succeeds under section 5(2)(b) and the opponent is in no better position under section 5(4)(a) than under section 5(2)(b), I need not go on to consider this ground in detail, but I offer the following view.

Section 5(4)(a) states:

- (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”

20. The requirements for this ground of opposition are found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD* Trade Mark [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

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

21. As alluded to above, I do not consider that the evidence provided by the opponent establishes that they have the necessary goodwill or reputation to found an action for passing off. In *SOUTH CONE* [2002] RPC 19 Inc v Jack Bessant & Others Mr Justice Pumfrey said:

“As Mr Hobbs QC said in *WILD CHILD* Trade Mark [1998] RPC 455 the registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. The second question follows: how cogent must the evidence be upon which the registrar should act in upholding an opposition on this ground?

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

services supplied; and so on.

28 Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

22. In this case the first leg of the classic trinity is not met and this ground under Section 5(4)(a) fails.

23. As the opponent has been successful, they are entitled to a contribution towards their costs. I order the applicant to pay them the sum of £1100. 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 21st day of August 2002

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