

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2005290
BY ZIMMER INC.
FOR REGISTRATION OF A MARK IN CLASS 10**

and

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 44381
BY
ACUFEX MICROSURGICAL INC.**

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20 **BACKGROUND**

On 14 December 1994 Zimmer Inc. of Indiana, United States of America, applied to register the trade mark 'ECOFIX' in Class 10 in respect of:-

25 Surgical, medical apparatus and instruments; orthopaedic articles; orthopaedic apparatus, devices and instruments, external fixation devices; parts and fittings for all the aforesaid goods.

30 On 10 April 1996, Acufex Microsurgical Inc. of Massachusetts, United States of America, filed notice of opposition to this application. This company has now merged with others and is now Smith & Nephew, Inc. of Memphis, United States of America. The grounds of opposition are, in summary;

- 35 (i) under Section 3(1)(a) in that the trade mark is not capable of distinguishing the goods of the applicant from those of other undertakings
- 40 (ii) under Section 3(1)(b) and (c) because the trade mark is devoid of any distinctive character and consists exclusively of signs or indications which may serve in trade to designate the kind, quality or other characteristics of the goods for which it is sought to be registered
- 45 (iii) under Section 3(3)(a) and (b) in that the trade mark would be contrary to public policy or accepted principles of morality and is of such a nature as to deceive the public
- (iv) under Section 3(6) in that the application was made in bad faith
- 50 (v) under Section 5(2)(b) in that the mark is similar to the opponents earlier trade mark, and that the goods for which the trade mark is sought to be registered are identical or similar to the goods of the earlier trade mark such that there exists a likelihood of confusion.

5 At the date the notice of opposition was filed, the opponents' earlier trade mark was the subject of an application for registration filed, before the application in suit. This earlier trade mark had been registered by the time the matter came to be heard and details of the opponents registration are shown below:

10	NO.	MARK	GOODS
15	1542886	ENDOFIX	Surgical and medical apparatus and instruments; materials and apparatus for ligament and joint fixation; parts and fittings for all the aforesaid; all included in Class 10.

20 The opponents ask that the application be refused in the exercise of the Registrar's discretion. This particular request must necessarily fail since under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse a trade mark which is not barred from registration by one or other of the substantive provisions of the Act.

25 The applicants filed a counterstatement denying these various grounds of opposition.

30 Both parties subsequently filed evidence in these proceedings and the matter came to be heard on 1 April 1998. At the hearing the applicants were represented by Mr J G Holdcroft, of Graham Watt & Co., their Trade Mark Attorney. The opponents were represented by Mr D G Minto, of Eric Potter Clarkson, their Trade Mark Attorney.

Opponents Evidence

35 This consists of a Statutory Declaration dated 18 October 1996 from Mr Stephen Philip Gilholm of Smith & Nephew Group Research Centre. He states that he is the trade Mark Agent at Smith & Nephew Group Research Centre, York, and that he is acting on behalf of Acufex Microsurgical Inc. (now Smith & Nephew Inc.).

40 He goes on to state that the opponents are the proprietors of registration No. 1542886 for the trade mark ENDOFIX in Class 10 the details of which are set out above. The products sold by the opponent under this trade mark include a bio-absorbable interference screw for internal ligament and joint fixation and instrumentation for the insertion of such screws. He exhibits at SPG-1 an extract from the opponents' USA sales brochure depicting such products as sold by
45 the opponent.

Mr Gilholm states that the applicants' trade mark consists of the terms ECO and FIX. The prefix ECO, he says, clearly identifies goods as being "environmentally friendly" in nature, for example biodegradable. He exhibits at SPG-2 a copy of page 410 of Chambers Twentieth Century Dictionary published by W & R Chambers Limited where ECO is defined as, inter
50 alia, a prefix denoting something concerned with the environment as in ecology. From the

5 description of goods applied for under the applicants' trade mark, and from his knowledge of
the applicants business, Mr Gilholm believes that the product intended to be sold under the
applicants trade mark will be an external surgical fixation device for orthopaedic use. Such
devices, he believes, are not generally biodegradable nor do they possess any other
"environmentally friendly" properties. Therefore, the applicants trade mark would be of such
10 a nature as to deceive the public and accordingly is not capable of registration under Section
3(3) (b) of the Trade Marks Act 1994.

Mr Gilholm goes on to explain that in order to provide evidence of the risk of confusion
between the applicants' trade mark and the opponents' trade mark a survey was carried out by
15 sending a questionnaire to orthopaedic surgeons who it is believed are the main users of the
applicants' goods. 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 all sent
did not bear any indication of the name Acufex Microsurgical Inc., or any other associated
20 companies. A copy of the letter and questionnaire is at exhibit SPG-3.

Mr Gilholm goes on to relate details of the survey. The total number of questionnaires sent
out was 50. The surgeons who received the questionnaire were situated in England, Scotland
and Wales. Of the 50 questionnaires sent out, 27 questionnaires were returned. Of the 27
25 returned questionnaires, 8 were not completed as the respondents were not active in the
relevant field. At exhibit SPG-4 are the answers to the completed questionnaires received
from the surgeons. Of the 19 surgeons who responded to the questionnaire, 47% of
respondents indicated that they considered the opponents' trade mark and the applicants' trade
mark to be similar in appearance and 53% of respondents stated that they would expect
30 products sold under the opponents' trade mark and the applicants' trade mark to originate
from the same manufacturer. This leads, in Mr Gilholm's view, to the conclusion that use and
registration of the applicants' trade mark would inevitably lead to confusion with the
opponents' trade mark, given that the goods covered by the opponents' trade mark and those
of the applicants' trade mark are either identical or similar.

35 Mr Gilholm goes on the state that of the 19 surgeons who responded to the questionnaire 84%
of respondents were aware of a manufacturer or distributor that supplied both internal and
external surgical fixation devices. This therefore indicates to him that there is a very high
likelihood of association of the opponents' trade mark and the applicants' trade mark.

40 Mr Gilholm goes on to exhibit SPG-5, which is a copy of an extract from the 1993
Orthopaedics Product Catalogue of Smith & Nephew Richards Inc. which depicts external
fixation devices and instruments of the type he believes the applicants intend to sell under their
trade mark.

45 **Applicants Evidence**

This consists of Statutory Declarations from Mr James Gerald Holdcroft and Mr Richard
David Lockhart Harris-Jones.

50 The Statutory Declaration by Mr Richard David Lockhart Harris-Jones is dated 2 April 1997.

5 Mr Harris-Jones states that he is a surgeon and physician in private practice with consulting rooms in Harley Street. He qualified as MB., BS. from St Bartholomews Hospital, London in 1973, and FRCS., Edinburgh in 1981. Mr Harris-Jones states that he has a special interest in orthopaedic medicine.

10 Mr Harris-Jones goes on to state that he has read the Statutory Declaration of Mr Stephen Philip Gilholm and its exhibits. He agrees with Mr Gilholm when he implies in paragraph 4 of that declaration that it is not an important feature of external surgical fixation devices for them to be biodegradable or otherwise environmentally friendly. Mr Harris-Jones comments that he was made aware of the trade mark ECOFIX before he was presented with Mr Gilholm's
15 declaration and it did not occur to him that the term ECO could have the implication of ecological in the context of external surgical fixation devices, the nature of which instruments are very familiar to him from his professional experience. Mr Harris-Jones goes on to state that the 'ecological' implication of the term ECO does not seem to him to be particularly apt for surgical equipment generally. He admits that there is a disposal requirement for surplus
20 products such as surgical cement or replaced prosthesis but these are matters of minor significance compared with the necessary functional features as dictated by therapeutic requirements. The suffix FIX in his view clearly has descriptive allusions and is entirely non-specific. He would certainly not expect trade marks having this suffix in common necessarily to emanate from the same source.

25 Mr Harris-Jones further states that the prefix ENDO, as used in the opponents trade mark ENDOFIX, is descriptive as meaning internal in the present context and he exhibits at RHJ-1 an extract from Dorland's Illustrated Medical Dictionary Twenty-fifth Edition 1974 consisting of the title page and page 515 showing the entry for the prefix ENDO. He also exhibits at
30 RHJ-2 another extract from Dorland's Illustrated Medical Dictionary Twenty-fifth Edition 1974 consisting of the title page and page 492 showing the entry for the prefix ECTO. Mr Harris-Jones states that the term ECTOFIX would imply to him an external surgical fixation device, which is the product shown in Mr Gilholm's exhibit SPG-1. Therefore if the applicants trade mark had included the word ECTO and thus the respective trade marks use
35 ENDOFIX and ECTOFIX they would, in his view, be direct and precise conceptual opposites.

The Statutory Declaration by Mr James Gerald Holdcroft is dated 7 April 1997. He states that he is a Chartered Patent Attorney and a Registered Trade Mark Agent and acts in the matter of this opposition for the applicants, Zimmer Inc.

40 He goes on to state that he has read the declaration of Mr Harris-Jones which stems from an interview carried out with Mr Harris-Jones at 17 Harley Street, London W1 on 23 January 1997. At the interview, Mr Holdcroft states that he was most careful not to lead Mr Harris-Jones and posed his initial questions without giving any background information beyond
45 informing him that the business concerned related to trade marks with a focus on orthopaedic equipment. He was also careful, he says, not to lead when posing subsequent questions.

Mr Holdcroft goes on to state that Mr Harris-Jones agreed at the end of the interview that he had not gleaned from the line of questioning any idea as to which side Mr Holdcroft was
50 acting for and he confirms that he obtained Mr Harris-Jones' reaction to ECOFIX and ENDOFIX before showing him any part of Mr Gilholm's declaration.

5 Mr Holdcroft concludes that he has read the Statutory Declaration of Mr Stephen Philip Gilholm and that he does not agree with the conclusions drawn by the declarant in the matter of the results of the survey.

10 Finally, Mr Holdcroft exhibits at JGH-1 a trade mark search report dated 23 January 1997, commissioned by himself. This purports to show the state of the trade mark register in relation to trade marks in Class 10 which either have the prefix ECO, or ENDO or the suffix FIX.

Opponents' Evidence in Reply

15 This consists of a Statutory Declaration dated 22 October 1997 by Mr John David Hobbs of Smith & Nephew Group Research Centre, York. He states that he is a Chartered Patent Agent and a Registered Trade Mark Agent, and Director, Group Patents and Trade Marks for the Smith & Nephew Group of companies, one of which is the successor in trade and title to
20 Acufex Microsurgical Inc., Massachusetts, United States of America. He states that on 30 November 1996, the opponents were one of a number of companies within the Smith & Nephew Group which merged to form a new entity, namely Smith & Nephew, Inc., a Delaware corporation, of Memphis, Tennessee, United States of America (which company has
25 now been recorded as the proprietor of, *inter alia*, UK Trade Mark Registration No. 1542886 ENDOFIX. At all relevant times he has been duly authorised and entitled to act for and on behalf of the opponents and its successor in trade and title (Smith & Nephew, Inc.)

30 He goes on to state that he has read and considered the Declarations of Mr Richard Harris-Jones and Mr James Holdcroft which were filed in evidence on behalf of Zimmer Inc. First of all, says Mr Hobbs, Mr Harris-Jones emphasises the descriptive character of the prefix ENDO-, but appears to discount the significance and aptness of the ECO- prefix in relation to surgical fixation devices, and then goes on to make the point that he would not expect all trade marks with the suffix -FIX to be in common ownership. Significantly, however, Mr Harris-Jones
35 does not provide any specific comment or information as to whether he considers ECOFIX and ENDOFIX to be confusingly similar, and/or as to whether he would expect products sold under the trade marks in question to emanate from the same source.

40 Mr Hobbs goes on to comment that Mr Holdcroft, in his declaration, disagrees with the conclusions reached by Mr Gilholm regarding the response to the questionnaires sent out by Mr Gilholm. However, says Mr Hobbs, Mr Holdcroft provides no explanation, reasons or justification for the fact that he disagrees with Mr Gilholm's conclusions. Therefore the observations in this regard are unsupported and have no relevance or force.

45 As far as the trade mark search report exhibited by Mr Holdcroft is concerned, Mr Hobbs accepts that there are registrations in the UK in respect of goods in Class 10 of numerous trade marks with the prefix ECO- or the prefix ENDO-, and of a number of trade marks with the suffix -FIX. He expresses the view that the search report does not provide evidence that the opposition to the registration of the trade mark in suit is unjustified or without foundation.

5 He points out that investigations of this nature cannot and do not, take account of any arrangements or agreements which affect the use of the registration of trade marks which may in many respects be similar, or of any other factors which may be relevant to the registration of particular trade marks.

10 **DECISION**

I deal first of all with the Grounds of Opposition founded upon Section 3 of the Act, the relevant provisions of which are set out below:

15 **3.(1)** The following shall not be registered-

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

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

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

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

40 (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Section 1(1) of the Act to which Section 3(1)(a) refers states:-

45 **1.(1)** In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

50 The opponents have supplied a dictionary definition of the term ECO and they submit that when cojoined with the term FIX (in relation to surgical fixation devices) then, because such

5 devices are not generally biodegradable (or possess any other environmentally friendly
property) the applicants' trade mark is one of such a nature as to deceive the public. At the
Hearing, Mr Minto also submitted that the trade mark was devoid of any distinctive character
and that the applicant had applied to register the trade mark in bad faith. This was because the
applicant could not claim to be the proprietor of the trade mark having applied for registration
10 of the trade mark knowing that there were other confusingly similar trade marks already on
the register. This was a reference to the trade mark search exhibited by Mr Holdcroft.

15 First of all, the Trade Mark Registry's Work Manual, at chapter 6, contains an Addendum
which sets out the Registry's practice in relation to various types of trade marks. In relation
to the term ECO, the Addendum states:

A combining form which is defined in Collins English Dictionary as denoting "ecology"
or "ecological" and which is widely used in relation to the study of the environment or
environmentally "friendly" products. Object under Section 3(1)(c) when appropriate.

20 It seems to me, that in relation to orthopaedic fixation devices, which I understand consists of
pins or screws which are attached to broken bones etc. or attached to rigid fixing devices, then
the term ECO or ecological must be fanciful. I can see no reason why anyone would expect
any of these pins, rods or screws to be biodegradable or to have any ecologically friendly
25 properties. Indeed, Mr Gilholm, on behalf of the opponent, who purports to know something
of this area of trade, says that he would not consider them to be environmentally friendly. If
that is the case then the trade mark is not one which is likely to deceive the relevant public
which in this case is part of the medical profession who use such devices. Also the term ECO
when combined with the term FIX is in my view a trade mark which is not devoid of
30 distinctive character. It consists of two unrelated terms which do not consist exclusively of a
sign or indication which serves any purpose in the particular trade (orthopaedic surgery). In
the circumstances, the grounds of opposition based upon Section 3(1)(b), (c) and Section
3(3)(b) are all dismissed.

35 No evidence, in my view, has been submitted to support the grounds of opposition based upon
Section 3(1)(a) or Section 3(6). The trade mark is a sign (a word) which is capable of being
represented graphically and, in view of my findings above, is capable of distinguishing the
goods of the applicant from those of other traders. Also, the mere fact that an individual has
undertaken a search of the trade mark register and found on it trade marks which may be
40 similar to the one the subject of their proposed application can not render that individual liable
to the allegation that the subsequent application was made in bad faith. The Trade Marks Act
1994 clearly recognises that identical trade marks for the same or similar goods may co-exist
(See Section 5(5) and the comments on behalf of the opponent by Mr Hobbs). Therefore I
consider the submissions made by Mr Minto on these points to be without substance.

45 I go on to consider the grounds of opposition based upon Section 5, the relevant provision of
which is set out below:

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

50 (a) it is identical with an earlier trade mark and is to be registered for goods

5 or services similar to those for which the earlier trade mark is protected, or

- (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,

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

15 The meaning of an earlier trade mark (insofar as it is relevant in this case) is set out in Section 6(1)(a) of the Act which states:

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

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- (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.

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The opponents have filed details of a survey carried out by them in order to provide evidence to the Tribunal showing the risk of confusion between the applicants’ trade mark and the opponents’ trade mark. In essence to seek to show that the applicants trade mark ECOFIX is confusingly similar to the opponents’ trade mark ENDOFIX. I should at this point state that the parties did not dispute the fact that the goods covered by the respective trade marks were the same or similar and therefore the only matter I needed to determine is indeed whether or not the trade marks are similar.

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The opponents rely upon the survey to persuade the Tribunal that the trade marks ECOFIX and ENDOFIX are similar. However, Mr Holdcroft, at the Hearing, also used the results of the survey to seek to demonstrate that there were sufficient numbers amongst those surveyed who thought the trade marks were not similar and that the goods under the respective trade marks could emanate from different suppliers. Though the survey does not, in my view, meet all of the requirements set down by Whitford J in the RAFFLES case [1984] RPC 293. In particular, I have no indication of how or why these particular orthopaedic surgeons were chosen and I note that none of the parties have given evidence by way of Statutory Declaration in these proceedings. However, I bear in mind the comments of Lord Diplock in the GE Trade Mark Case [1973] RPC 297 where he said:-

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“My Lords, where goods are of a kind which are not normally sold to the general public for consumption or domestic use but are sold in a specialised market consisting of persons engaged in a particular trade, evidence of persons accustomed to dealing in that market as to the likelihood of deception or confusion is essential. A Judge, though he must use his commonsense in assessing the credibility and probative value of that evidence is not entitled to supplement any deficiency in evidence of this kind by giving evidence to his own subjective view as to whether or not he himself would be likely to be deceived or confused”.

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5 In this case, however, I do not believe that the evidence provided by the survey does provide
the basis on which I can rely to find for the opponent. I agree with Mr Holdcroft that there
are sufficient number of respondents who do not find the trade marks similar, or who consider
that the goods under the trade marks could be supplied by different manufacturers. Nor, I
add, am I persuaded that the evidence of Mr Harris-Jones on behalf of the applicant is without
10 flaw. In this case therefore I consider that I must apply the normal and traditional tests in
relation to the comparison of trade marks and reach my own view of the matter.

The established test for the comparison of trade marks is that set out by Parker J in
PIANOTIST Company's application [1906] 23 RPC 774 at line 26 et seq:

15 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
20 consider what is likely to happen if each of those 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 man 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
25 in the goods - then you may refuse the registration, or rather you must refuse the
registration in that case.

Also, in *Sabel BV v Puma AG* (1998) RPC at page 224, in relation to Article 4(1)(b) of the
first Council Directive of 21 December 1988, which corresponds directly with Section 5(2)(b)
30 of the Act, the European Court of Justice, in dealing with the issue of comparison of marks,
stated;

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,
35 in particular, their distinctive and dominant 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 overall
appreciation of the likelihood of confusion. The average consumer normally perceives
40 a mark as a whole and does not proceed to analyse its various details.

With this test and guidance in mind I consider the two trade marks. First of all, both have the
same suffix, the word FIX. I therefore have to determine whether when combined with the
terms ECO and ENDO the trade marks are similar. In my view they are not. First of all, each
45 of the terms ENDO and ECO have their own dictionary meanings and therefore it is unlikely
that anyone would view them and consider that the term ECO was the same or similar to the
term ENDO. In my view, too, they would be pronounced differently. Therefore both from a
visual and aural point of view the marks are, in my view, different. Nevertheless, I go on to
consider whether the nature of the goods sold under the trade marks are such as to render
50 possible similarity in the minds of the purchasers. The goods are medical equipment and in
particular orthopaedic fixation devices. These are only going to be purchased by National

5 Health Trusts or Private medical facilities on the basis of requests from orthopaedic surgeons. There will therefore be a great deal of care and deliberation behind their selection. Thus the possibility of confusion arising as a result of imperfect recollection must be negligible.

10 Taking account of all these considerations I find that the trade marks ECOFIX and ENDOFIX are not confusingly similar and therefore the opposition based upon Section 5(2)(b), on the basis of the opponents earlier registration, fails.

15 In the result the opposition has been decided in favour of the applicants who are therefore entitled to a contribution toward their costs. I therefore order the opponents to pay to the applicants the sum of £850.

Dated this 30 day of April 1998

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M KNIGHT
Principal Hearing Officer
For the Registrar
30 **The Comptroller General**

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