

TRADE MARKS ACT 1994

THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF APPLICATION NO M684466 IN THE NAME OF DR  
ROBERT WINZER PHARMA GMBH

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 70073 IN THE  
NAME OF ALCON PHARMACEUTICALS LIMITED

## DECISION

### Introduction

1. This is an appeal to the Appointed Person by Alcon Pharmaceuticals Limited (“the Opponent”) against the decision of Mr Foley, the Hearing Officer acting for the Registrar, dated the 1<sup>st</sup> November 2001. In his decision the Hearing Officer dismissed the opposition by the Opponent to trade mark application number M684466 by Dr Robert Winzer Pharma GmbH (“the Applicant”) to register the trade mark “HPMC-Ophtal” in Class 5 in respect of pharmaceutical products.
2. So far as relevant, the opposition was based on section 3(1)(a), (b) and (c) of the Trade Marks Act 1994 (“the Act”).
3. The objections under section 3(1)(a) and (b) were founded upon the contention that the mark applied for was not capable of distinguishing the goods of one undertaking from those of other undertakings and was devoid of any distinctive character as a whole. The objection under section 3(1)(c) was founded under the contention that the mark applied for consisted exclusively of signs or indications which might serve in the trade to designate the kind, quality or other characteristics of the goods specified.

4. The Hearing Officer considered the evidence and concluded, as was not disputed, that HPMC is a well known acronym for hydroxypropylmethylcellulose and that both the acronym and its meaning are used in the relevant industry in relation to the goods of the application. He also took into account the contention of the Opponent that OPHTAL is the phonetic equivalent of the word OPHTHAL which, the Opponent contended, was a prefix for ophthalmology. Nevertheless, the Hearing Officer dismissed all of the grounds of objection. In summary he decided that the mark as a whole did have a distinctive character and would function as a badge of origin.

#### The Appeal

5. On the 29<sup>th</sup> November 2001 the Opponent gave Notice of Appeal to an Appointed Person. On the appeal the Applicant was represented by Ms Jacqueline Reid of Counsel, instructed by Kilburn & Strode. The Opponent was represented by Mr Christopher Morcom Q.C., instructed by Venner, Shipley & Co.
6. It was contended that the Hearing Officer fell into error in dismissing the grounds of objection under section 3(1)(a), (b) and (c) of the Act.
7. The objections under section 3(1)(a), (b) and (c) were each based upon the same facts. First of all, reliance was placed upon the accepted fact that HPMC is a generic pharmaceutical name and is well known in the relevant trade sector as standing for hydroxypropylmethylcellulose.
8. Secondly, it was submitted that the suffix “OPHTAL” was a trivial modification of “OPHTHAL”, which in turn had an obvious reference to the subject of ophthalmology and was widely used as a prefix for words in that field. Reference was made to English dictionaries and a French dictionary, which showed that “OPHTHAL” was used in the English and French languages as a prefix.

Section 3(1)(a)

9. The Hearing Officer found that while there was evidence that HPMC was used in the trade in relation to the goods of the application, there was nothing to show that OPHTAL (or OPHTHAL) either on its own or in combination with HPMC was so used, or that the trade mark had such a descriptive meaning as to be incapable of registration. The Hearing Officer observed that there was nothing to show that the trade mark had such a descriptive meaning as in WELDED MESH.
  
10. The Opponent submitted that on the evidence and indeed the Applicant's admission, HPMC was wholly non distinctive and plainly unregistrable. It was not a trade mark, and even if it were it had no distinctive character whatever. As regards OPHTAL, the similarity to the widely used designation OPHTHAL was obvious, as was accepted by the Hearing Officer. It was therefore submitted that the sign applied for was not, and would not be understood to be, a trade mark. It was also submitted that the Hearing Officer was wrong to draw the comparison with WELDED MESH. In the WELDMESH case [1966] RPC 220, the mark WELDMESH had been refused registration in Part A of the old register and was only allowed in Part B on evidence of distinctiveness, because of its obvious similarity to WELDED MESH.
  
11. I am unable to accept these submissions. Earlier in his decision the Hearing Officer referred to the judgment of the Court of Appeal in Philips Electronics v Remington [1999] RPC 809. In considering the scope of section 3(1)(a) Aldous L.J. said at 817:-

*"I do not believe that the fact that a trade mark has by use become such as to denote goods of a particular trader necessarily means that it is capable of distinguishing as required by section 1 (Article 2). I have already pointed out that use is relevant when deciding registrability under section 3(1)(b), (c) and (d), but not under section 3(1)(a) (see Articles 3(1)(a), (b), (c) and 3(3). That suggests that the capability of distinguishing depends upon the features of the trade mark itself, not on the result of its use. Thus a person who has had*

*monopoly use of a trade mark for many years may be able to establish that it does in fact denote his goods exclusively, but that does not mean that it has a feature which will distinguish his goods from those of a rival who comes into the market. The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is WELDMESH, whereas WELDED MESH would not be. The former, despite its primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The latter has no such alteration. Whatever the extent of the use, whether or not it be monopoly use and whether or not there is evidence that the trade and the public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader's welded mesh from another trader's welded mesh."*

11. I believe that it is clear that the Hearing Officer had well in mind this passage from the judgment of Aldous L.J. In my view the Hearing Officer properly considered whether or not the mark the subject of the application was capable of distinguishing and thereby acting as a trade mark. He asked himself whether the mark as a whole had such a descriptive meaning as to be incapable of registration. I agree with the Hearing Officer that the mark is capable of distinguishing the goods of one undertaking from those of other undertakings. The Hearing Officer was right to conclude there was no foundation in the ground of objection under section 3(1)(a) of the Act.

Section 3(1)(b)

12. The Opponent submitted that this was its strongest case. I agree. The Opponent focused particularly on the following paragraphs of the decision of the Hearing Officer:

*"The visual similarity between OPHTAL and OPHTHAL is plain to see, and whilst there is also phonetic similarity, it is the first letter H that will be silent; the second letter H will have an effect on the pronunciation*

*but this is a small distinction. But does this all matter? In The Eastman Photographic Materials Company Ltd's application 15 RPC 476 (the Solio case) Lord Herschel said:*

*“If the word be an “invented” one, I do not think the quantum of invention is at all material. An invented word is allowed to be registered as a trade mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases.”*

*Consequently if OPHTAL is a mere mis-spelling of an objectionable word, and that when used in combination with HPMC the whole is entirely descriptive, then the answer must be yes, the similarity would matter because the mark would not say, “these are the goods of...” but rather “these goods are of this material or type.”*

*The trade mark consists of an acronym, albeit directly descriptive of the goods of the application, and a word very close in appearance and sound to a prefix having some relevance to the goods of the application. Even accepting OPHTAL to be the equivalent of OPHTHAL, the trade mark is not an obvious description such as WELDED MESH. To derive its meaning requires a translation of the acronym HPMC into Hydroxypropylmethylcellulose, and relies upon recognising OPHTAL to be a prefix denoting something to do with ophthalmology.*

*The relevant consumer in this case is most likely to be a medical professional, well used to seeing the word ophthalmology (and other ophthal-prefixed words), and to whom the fact that OPHTAL is a mis-spelling is going to be quite apparent which in my view will alert them to the fact that the mark applied for is a badge of origin rather than a mere description. Whilst the mark cannot be said to be a particularly skilful or overt allusion to the goods and the consumer may well recognise its derivation and relevance to the goods, from the above case this does not prevent it from functioning as a badge of origin, particularly in the field of pharmaceuticals which, from my own knowledge, I know are often sold under brand names that refer to the function or constituents of the product. Whilst HPMC on its own must be considered incapable of distinguishing the goods in suit, I do not consider the mark as a whole to be so directly descriptive of a characteristic of the goods so as to be devoid of the distinctive character necessary to function as a badge of origin, and I dismiss the grounds under section 3(1)(b) and 3(1)(c).*

12. The Opponent submitted that here the Hearing Office fell into error by, in substance, reconsidering the ground of objection under section 3(1)(a) and failing to apply the true test under section 3(1)(b). In particular, it was submitted, the Hearing Officer failed to apply the correct approach as set out in Procter & Gamble Ltd's Trade Mark Applications [1999] RPC 673. In that case Robert Walker L.J. said at 680:-

*“Despite the fairly strong language of section 3(1)(b), “devoid of any distinctive character” – and Mr Morcom emphasised the word “any” – that provision must in my judgment be directed to a visible sign or combination of signs which can by itself readily distinguish one trader’s product – in this case an ordinary, inexpensive, household product – from that of another competing trader.”*

13. It was submitted by the Opponent that it was clear on the evidence that other traders use and will continue to use HPMC in relation to ophthalmic pharmaceutical products, and also that in conjunction with HPMC traders will need or may wish to use the OPHTHAL suffix. The effect of registration of the sign applied for would therefore be to enable the Applicant to interfere, or threaten to interfere, with such use.
14. In my judgment, the Hearing Officer arrived at the correct conclusion. OPHTAL is obviously a misspelling of OPHTHAL although, for my part, I rather doubt that misspelling would always be quite apparent to the relevant consumer. Moreover, I fully accept and agree with the observation of the Hearing Officer that HPMC on its own would be incapable of distinguishing the goods the subject of the application. Nevertheless, it is the mark as a whole which must be considered. There is no evidence that OPHTAL or, indeed, OPHTHAL is used in the trade as a suffix, let alone in the combination found in HPMC-Ophtal. In my judgment the mark HPMC-Ophtal is a sign which can by itself readily distinguish one trader’s product from that of another trader competing in this field. I agree with the submission of the Applicant that the mark in its entirety is an invented mark and that the perceptible differences between the combination of the elements

of the mark and the acronym HPMC and the word ophthalmology confers a distinctive character upon that combination of elements.

Section 3(1)(c)

15. The Hearing Officer rejected this ground of objection and in my judgment he was right to do so. The mark as a whole does not consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose, or other characteristics of the goods the subject of the application. This is not a mark which is the usual way of designating the goods in issue. Nor is it a mark which might serve in normal usage from the consumer's point of view to designate goods such as those in respect of which registration is sought. The mark does not consist of words which can fairly be viewed as a normal way of referring to the goods the subject of the application or of representing their essential characteristics in common parlance.

Conclusion

16. Accordingly, the appeal must be dismissed. I order the Opponent to pay to the Applicant the sum of £635 as a contribution towards its costs of this appeal. This sum is payable in addition to the sum awarded by the Hearing Officer in respect of the proceedings below.

DAVID KITCHIN QC

11th September 2002

