

O-245-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2460800
BY OZONE UK LIMITED
TO REGISTER THE TRADE MARK**



IN CLASS 3

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 96252
BY OZONE LABORATORIES LIMITED**

BACKGROUND

1) On 9 July 2007, Ozone UK Limited applied to register the following trade mark:




2) In respect of the following goods:

Class 3: Soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershaves, cologne; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; preparations for the care of the scalp and the hair; shampoos and conditioners; hair colorants; hair styling products; toothpaste; mouthwash; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs.

3) Following examination, the application was accepted and published for Opposition purposes in Trade Marks Journal No. 6710 on 16 November 2007.

4) On 13 February 2008, Ozone Laboratories Limited, filed a notice of opposition. This consists of two grounds based upon section 5(2)(a) & 5(2)(b) of the Act, under which they rely on the following trade mark:

Trade Mark	Number	Date of designation in the EU	Date of protection in the EU	Goods
	818884 EC designation of an International registration	20.04.06	20.04.07	Class 5: Pharmaceutical, veterinary products; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth and dental wax. Class 10: Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.

5) The opponent contends that the only difference between the marks are so insignificant that they are identical, and that the goods are similar and so the mark in

suit offends against Section 5(2)(a). In the alternative the marks and goods are similar and so the mark in suit offends against Section 5(2)(b). I note that in its statement of ground the opponent refers only to its Class 5 goods and would appear to be relying on these goods alone in its opposition.

6) On 8 May 2008 the Applicant filed a counterstatement in which it accepts that the opponent is the proprietor of the registered mark as claimed. However, the applicant denies that the marks are identical or similar, claiming that the stylisation and device elements of both marks clearly distinguish them. The applicant contends that as the mark is a common word the manner of the presentation is important. They also point out that there are a large number of other marks consisting of or containing the word OZONE which have been registered. They state that OZONE is also used in over eighty registered Company names. They deny that the goods are similar. Further, they contend that OZONE is a common dictionary term which has the following meaning:

“A colourless gas with a chlorine-like odour, formed by an electric discharge in oxygen; a strong oxidising agent, used in bleaching, sterilizing water, purifying air etc” and “Informal. Clear bracing air, as found at the seaside.”

7) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard, but the applicant filed written submissions which I shall refer to as and when required in my decision.

OPPONENT’S EVIDENCE

8) The opponent filed two witness statements. The first, dated 9 December 2008, is by Diana Pennock Connolly the Managing Director of Findtech Ltd a company which provides information research services to the IP profession. She states that she is providing evidence as to the degree to which, at 9 July 2007, cosmetics, make up, lip care preparations, sun tanning preparations, sun protection preparations and skincare preparations were complementary to or competitive with pharmaceutical preparations. She provides the following exhibits:

- DC1: Consists of a large number of extracts from national and local newspapers and trade journals for the cosmetics industry. These date from July 1988 to October 2007. These represent a cross section of articles, all of which refer to cosmeceuticals. Broadly, these articles all refer to the narrowing of the gap between pharmaceuticals and cosmetics, be it anti aging cream or anti hair loss products.
- DC2: this is a summary of the contents of a market research report entitled “Cosmeceuticals UK” from Mintel International Group Ltd. It states:

“Cosmeceuticals is a relatively new but fast-growing sector within the cosmetics market. Although it is not recognised by the leading trade organisations, it has attracted numerous new brands. Many are unknown niche brands, backed by doctors, dermatologists and surgeons, who lend considerable weight and credibility to performance claims. At present, cosmeceuticals refer mainly to skin and bodycare products, but are

starting to move into new territories, including oralcare, haircare and nutraceuticals.”

- DC3: An article published in Market Europe in 2001 entitled “Cosmeceuticals Joins Nutraceuticals as a Growth Market”. This provides a table of the estimated size of the market in the UK for cosmeceuticals in the years 1995-1999. The magazine would appear to be American in origin and all the figure provided are in US \$. The article does not make it clear how these figures are derived at given that DC2 above states that leading trade organisations do not recognise cosmeceuticals. However, the table shows a rise from US\$430 million in 1995 to US\$ 652 million in 1999.
- DC4: This exhibit consists of various extracts from Key Note Ltd’s market research reports for the UK. The articles all mention cosmeceuticals.

9) The opponent’s second witness statement, dated 14 December 2008, is by Joane Claire Lazenby, the opponent’s Trade Mark Attorney. She provides the following exhibits:

- JCL1: Consists of copies of articles from newspapers and magazines dated May 2002- November 2003 relating to the use of the pharmaceutical preparation Botulinum toxin (Botox) for both medical treatments and also cosmetic purposes. Included in these articles is one about Boots offering Botox injections for cosmetic purposes to its customers.
- JCL2: Print outs from the Internet sites of the Cheshire Image Clinic and a Harley St practice, Glancey Medical Aesthetics. These offer cosmetic surgery, Botox and collagen injections and skincare treatments

APPLICANTS’ EVIDENCE

10) The applicant filed a witness statement, dated 12 March 2009, by Raymond Roy Prentice their Trade Mark Attorney. He states that he contacted the Department for Business Enterprise and Regulatory Reform (BERR) to enquire if pharmaceutical preparations and cosmeceuticals are regulated by the Medicines and Healthcare products Regulatory Agency and must comply with the Medicines and Medical Devices Regulation. He was referred to the Medicines and Healthcare products Regulatory Authority (MHRA). Mr Prentice contacted the MHRA who responded by stating that they did not recognise the term Cosmeceuticals but referred him to a website which deals with guidance as to what is a medicinal product. Copies of the above correspondence are at exhibits RRP1 & 2.

11) Mr Prentice then files a number of exhibits but does not bother to comment on their content or state why they are relevant. This is hardly surprising as most are not relevant to the case, but have presumably been included on a “never mind the quality feel the width” basis. I have therefore summarised those few aspects which I believe are relevant in these exhibits.

- Exhibit RRP4: This is a copy of the MHRA “Guide to What is a Medicinal product”. It provides the following definitions:

Cosmetic products:”The definition envisages that a cosmetic product may have a secondary preventative (but not curative) purpose. When deciding whether or not a product on the borderline between cosmetics and medicines is a medicinal product, the MHRA will apply the tests set out in directive 2001/83/EC. If a product falls within the definition of a cosmetic and within the definition of a medicinal product it will be classified as a medicinal product (*Delattre 1991, C-369/88*).”

Medicinal products: “17. Article 1 of Directive 2001/83/EC as amended defines a “medicinal product” as:

(a) “Any substance or combination of substances presented as having properties for treating or preventing disease in human beings: [“the first limb”]

(b) Any substance or combination of substances which may be used in or administered to human beings either with a view to restoring, correcting or modifying physiological functions by exerting a pharmacological, immunological or metabolic action, or to making a medical diagnosis” [“the second limb”]

- Exhibit RRP5: A copy of the MHRA website dealing with borderline products. This includes the following:

“A product which is for use only as a toilet preparation, disinfectant, food or beverage is not normally regarded as a medicinal product, and, therefore, does not require a marketing authorisation before being sold in the UK. Similarly, dietary supplements, containing such familiar substances as vitamins, amino acids or minerals, are generally subject to food safety and food labelling legislation rather than medicines control. However, should any of the above contain a pharmacologically active substance or make medicinal claims (claims to treat or prevent disease, or to interfere with the normal operation of a physiological function of the human body are regarded as medicinal). For example, a toothpaste would generally be considered as a cosmetic, but if it is marketed with claims to treat or prevent “sensitive” teeth or it contains an active ingredient known to have such an effect then it would fall within the definition of a medicinal product and be subject to medicines control. Bandages and other surgical dressings are not subject to the marketing authorisation procedures unless they are medicated and the curative effect of their medication is their primary purpose.”

- Exhibit RRP9: A copy of a page from the Internet “Free Dictionary” which gives the following definition of the word Cosmeceuticals; “Cosmetic products that are claimed, primarily by those within the cosmetic industry, to have drug like benefits. Examples of products typically labelled as cosmeceuticals include anti-aging creams and moisturizers.” I note that it also goes onto state that the United States Food and Drug Administration does not recognise such a category as cosmeceuticals.

12) That concludes my review of the evidence. I now turn to the decision.

DECISION

13) The opposition is based upon Section 5(2)(a) and 5(2)(b) which read:

“5.-(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) 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.”

14) An earlier right is defined in section 6 of the Act, the relevant parts of which state:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,”

15) 15) In these proceedings the Opponent is relying on an International Trade Mark 818884 for which EU designation was applied for on 20 April 2006 and protection granted on 23 April 2007 and which qualifies as an earlier trade mark under the above provisions. It is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

16) I shall first consider the ground of opposition under Section 5(2)(a). Under this ground the marks have to be identical. In considering this issue I take note of the decision of the European Court of Justice (ECJ) in the *LTJ Diffusion S.A. v Sadas Vertbaudet S.A.* (case C-291/00) [2003] FSR 34 where at paragraphs 49-54 they stated:

“49. On the other hand, Article 5(1)(a) of the directive does not require evidence of such a likelihood in order to afford absolute protection in the case of identity of the sign and the trade mark and of the goods or services.

50. The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Article 5(1)(a) of the directive, cannot be extended beyond the

situations for which it was envisaged, in particular, to those situations which are more specifically protected by Article 5(1)(b) of the directive.



51. There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52. However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26).

53. Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by the average consumer.

54. In those circumstances, the answer to the question referred must be that Article 5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

17) The marks of the two parties are as follows:

Applicant's mark	Opponent's mark
	

18) The average consumer for the goods that the applicant is seeking to register the mark for must be regarded as the general public. The types of products in Class 3 are not purchased without some consideration as, in the main, these products are going to be used on the consumers body. The applicant's mark is for the plural form of the opponent's. This is a minor difference, but combined with the differences in form and font and the use of different devices in both marks they would not be regarded as identical by the average consumer. This would be the case even allowing for them being seen with a considerable time lag between and allowing for imperfect recollection. The ground under Section 5(2)(a) fails.

19) I now move to consider the ground of opposition under Section 5(2)(b). In reaching a decision I take into account the following cases: *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Matratzen Concord GmbH v. OHIM* [2004] ECR I-3657, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* [2005] ECr I-8551 and *OHIM v. Shaker di L. Laudato & C. Sas* [2007] ECR I-4259.

20) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

21) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

22) The opponent has shown no use of its mark. I have to consider whether the opponent's mark has a particularly distinctive character arising from the inherent characteristics of the mark. In my opinion, the opponent's mark OZONE is inherently distinctive for, broadly speaking, pharmaceutical products in Class 5.

23) I have already determined that the average consumer of the applicant's goods would be the average UK citizen. The opponent's goods in Class 5 vary between those purchased by the average UK citizen (food for babies, plasters) and those clearly aimed at professional medical personnel and veterinarians (veterinary products, dietetic substances adapted for medical use, material for stopping teeth and dental wax). Some, pharmaceutical products fall into both segments. In its statement of grounds the opponent did not refer to its Class 10 goods. I assume that this is because its strongest case is under its Class 5 goods.

24) I shall first consider the specifications of both parties which are as follows:

Applicant's specification	Opponent's specification
Class 3: Soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershaves, cologne; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; preparations for the care of the scalp and the hair; shampoos and conditioners; hair colorants; hair styling products; toothpaste; mouthwash; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs.	Class 5: Pharmaceutical, veterinary products; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth and dental wax.

25) When carrying out the comparison of the specifications of the two parties I take into account the factors referred to in the opinion of the Advocate General in *Canon*; ETMR 1. In its judgement, the ECJ stated at paragraph 23:

“23. 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, their end users, their method of use and whether they are in competition with each other or are complementary.”

26) The applicant's specification consists of items to cleanse the body, mask or prevent body odour, condition and protect the body, and also items for applying such products. These can broadly all be referred to as cosmetics or applicators for cosmetics. The opponent's specification consists of pharmaceutical products. There

are clear differences between pharmaceutical and cosmetic products. At paragraph 11 earlier in this decision a definition of each was provided in the evidence. However, the evidence makes it clear that a product can be both pharmaceutical and cosmetic and that in such circumstances it falls under the rules and regulations governing pharmaceuticals. Also from the evidence, it is clear that the gap between the two sets of goods is becoming narrower with the use of pharmaceuticals such as Botulinum toxin purely for cosmetic purposes and also being administered on the high street in ordinary shops such as Boots. Cosmetic products are also making claims to restoring, correcting or modifying physiological functions. Although the term “cosmeceuticals” is not recognised by the relevant drug authorities in the USA or UK its use in so many journals, newspapers and magazines shows that the gap between the two sets of products is narrowing. Pharmaceuticals effectively come in two forms, those that are prescribed and those that are purchased over the counter. For both forms of drug the end user would be the average UK consumer. I accept that with prescription drugs the consumer has little say in the drug prescribed other than in exceptional cases. For this reason, when considering prescription drugs medical practitioners are considered the main consumer. However, the opponent’s specification covers all pharmaceuticals and so it is the average UK citizen who has to be considered as the consumer.

27) If the opponent’s specification were restricted to prescription drugs then they would not be in competition with the applicant’s cosmetic goods or even complementary. However, the specification is not limited in this manner and includes all pharmaceuticals. The evidence shows that the “gap” between pharmaceuticals and cosmetics is becoming increasingly blurred and that there are products which are classified as both. Although not officially recognised, the term cosmeceuticals has been coined for products which are at the very edge of being a pharmaceutical but yet remain a cosmetic. In such circumstances the specifications of the two parties could be in competition or complementary.

28) Given the above I conclude that there is a degree of similarity between the goods of the two parties.

29) I therefore turn to the marks of the two parties. For ease of reference I reproduce them below:

Applicant’s mark	Opponent’s mark
	

30) The opponent contended that the marks were very different. They refer to the “highly stylised font” of the applicant’s mark and the fact that it has a leaf. They compare this to the “blocked font” of the opponent’s mark and the fact that the letter

“O” in the middle of the opponent’s mark has its centre filled in. Further, they point out that the applicant’s mark is the plural version and that whilst the applicant’s mark appears within a stylised ring with only part of the word underlined, the opponent’s mark has a wave device in three colours underlining the whole of the mark.

31) I do not accept these contentions. There are obvious differences between the marks, in terms of the fonts used and the devices in each mark. However, the dominant element of both marks would, in my opinion, be seen as the words “OZONES” and “OZONE”. Whilst there are visual differences they do not outweigh the visual similarities of the dominant elements. Aurally the device elements do not feature and so the only difference is that the applicant’s mark is the plural version of the opponent’s mark. It is accepted that the endings of words can be slurred and allowance has to be made for imperfect recollection. Conceptually, the word ozone will be recognised as either something to do with the atmosphere as in “ozone layer” or will be thought of as a seaside breeze. It might be thought to refer to the smell of the product or even the fresh effect that it might bring. It therefore, has some meaning for cosmetics, but none for pharmaceuticals. Overall, to my mind the similarities between the marks far outweigh any differences.

32) Taking account of all of the above when considering the marks globally, I believe that there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore succeeds.

33) As the opponent has been successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £800. This sum 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 2008

**George W Salthouse
For the Registrar,
the Comptroller-General**