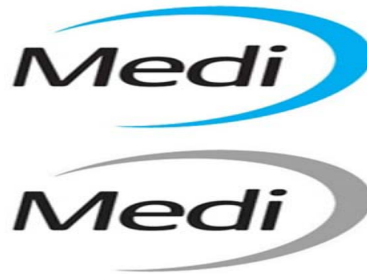


O/041/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2523252
BY AAH PHARMACEUTICALS LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS**



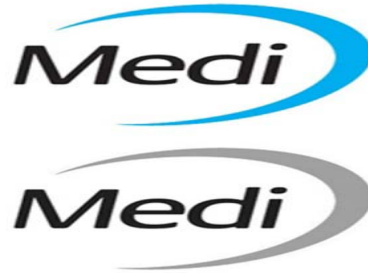
IN CLASSES 3, 5 AND 10

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 100180 BY
3M COMPANY**

BACKGROUND

1) On 11 August 2009 AAH Pharmaceuticals Limited (hereinafter the applicants), applied to register the following series of two trade marks:



2) In respect of the following goods:

In Class 3: Personal hygiene products; personal care products; toiletry products; preparations for use in the bath and shower; cleaning, polishing, scouring and abrasive preparations; soaps; essential oils, cosmetics, creams, hair lotions; barrier creams and lotions; hair shampoos; hair conditioners; deodorants; after sun, sun block, sun tan and bronzing creams, lotions and substances; dentifrices; non-medicated toilet preparations; preparations for use before, during or after shaving; cotton sticks and cotton wool for cosmetic purposes; parts and fittings for all the aforesaid goods.

In Class 5: Pharmaceutical, medical and sanitary preparations and products; medicines; analgesic medicines, anti-inflammatory medicines; antiseptics, medicated dermatological preparations for the treatment of infections and other diseases of the skin; medicated creams and lotions; medicated barrier creams and lotions; antiseptic preparations for wound care; sponge cloths and sponges for healing wounds; plasters, materials for dressings; first aid kits and first aid supplies; adhesives for use with ostomy appliances; preparations for destroying vermin; preparations for the diagnosis of pregnancy; tissues impregnated with pharmaceutical lotions; absorbent sanitary articles for use by incontinent people; petroleum jelly for medical purposes; medicated toilet preparations; parts and fittings for all the aforesaid goods.

In Class 10: Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; ostomy apparatus and devices, including ostomy bags, pouches, clips and seals; stoma bags and medical aids for stoma care; urinary drainage bags, pouches, clips and seals; wound closure devices; flow monitors; supportive bandages; blood pressure monitors; nebulizers for medical use; pulse meters; medical diagnostic equipment; disposable gloves; parts and fittings for all the aforesaid goods.

3) The application was examined and accepted, and subsequently published for opposition purposes on 20 November 2009 in Trade Marks Journal No.6812.

4) On 15 March 2010 3M Company (hereinafter the opponent) filed a notice of opposition, subsequently amended. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Number	Mark	Filing and Registration Date	Class	Specification
CTM 6503379	MEDIPORE	11.12.07 / 18.12.08	5	Wound dressings in the form of tapes.

b) The opponent states that the marks are similar and that the following goods of the applicant's specification are similar to the goods for which the opponent's mark is registered. In Class 3: Personal hygiene products; personal care products; toiletry products; barrier creams and lotions; non-medicated toilet preparations; and all of the Class 5 goods. The mark in suit therefore offends against Section 5(2)(b). The original statement of grounds also included opposition under Section 5(3) & 5(4) but these were quickly dropped and an amended statement of ground filed.

c) In addition the opponent contends that "The mark MEDI is a commonly used prefix with respect to medical goods. The applicant is attempting to monopolise the MEDI term for medical goods by applying for a mark where the dominant element is the word MEDI, The semi-circle device element in the Applicant's mark is scarcely distinctive and will be irrelevant when the mark is referred to orally." The opponent therefore contends that the mark in suit offends against Section 3(1)(b) of the Act. All of the goods applied for are opposed.

d) Further, "The word MEDI is descriptive of medical products or services" and so offends against section 3(1)(c) of the Act. All of the goods applied for are opposed.

5) On 18 May 2010, the applicant filed a counterstatement which basically denied the opponent's claims. They deny that the opponent's mark has an "enhanced distinctiveness" and put the opponent to proof thereof. They also file "state of the register" evidence showing that marks with a "medi" prefix are commonplace.

6) Both parties filed evidence, and both seek an award of costs in their favour. The matter came to be heard on 24 October 2011. At the hearing, the opponent was represented by Ms Bowhill of Counsel instructed by Messrs Taylor Wessing LLP; the applicant was represented by Mr Aikens of Counsel instructed by Messrs Sipara.

OPPONENT'S EVIDENCE

7) The opponent filed two witness statements, dated 1 December 2010 and 13 January 2011, by Joanna Victoria Gray the opponent's Trade Mark Attorney. Ms Gray is bilingual in English and Spanish, visits Spain regularly, has worked in a law firm in Spain and is therefore able to translate cases from Spanish to English. She provides the following exhibits:

- JVG1: An extract from Acronyms, Initialisms & Abbreviations Dictionary, 37th Edition [2007] which shows that "MEDI" is an abbreviation for, inter alia, "Medicine (DSUE)".
- JVG2: An extract from Yourdictionary.com which also shows that the word "MEDI" stands for, inter alia, Medicine.
- JVG3: A copy of an OHIM appeal decision R 692/2008-4 MEDI dated 1 October 2009 which refused the CTM MEDI under Art 7(1)(b) (equivalent to 3(1)(b)). At paragraph 12 it states: "Lastly, MEDI is the root of a great number of words which all refer to the medical sector such as medical, medicalization, medicalize, medicament, Medicare, medicate, medicinal, etc."
- JVG4: A copy of OHIM appeal decision R 475/ 2003-1 MEDIGEL where the board found that "MEDI" is a prefix equivalent to the term "medical".
- JVG5: Copies of CTM applications for marks containing the element "MEDI" which were refused by OHIM under 7(1)(b) and/or (c).
- JVG6: Print outs of three marks that contain "swoosh" device elements very similar to the instant case which were refused by the UKIPO.
- JVG7: Examples of device elements which the opponent believes are more distinctive than the swoosh element in the instant case yet were rejected by the UKIPO.

APPLICANTS' EVIDENCE

8) The applicant filed a witness statement, dated 10 May 2011, by Robert Norman Furneaux, the applicant's Trade Mark Attorney. In the main he provides submissions rather than actual evidence. He refers to Case C-329/02 SAT.2 in which the Court held:

"Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings."

9) He also refers to *Audi Ag v OHIM Case C398/08 P Vorsprung Durch Technik* in which the Court held that:

“However, while it is true – as was pointed out in paragraph 33 of the present judgment – that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that the mark is devoid of distinctive character.”

10) He comments upon the evidence provided by the opponent, stating that most of it is not on all fours with the instant case, that the marks are not similar to the instant mark, or that the circumstances were particular to the case and cannot be applied to the instant case. He provides the following exhibits:

- RNF1: Examples of UK and CTM “MEDI” applications that have been accepted for goods in Classes 3, 5 and 10. Where it is claimed the level of stylisation is said to be no greater than that of the mark in suit.
- RNF2: examples of MEDI marks which it is claimed act as a badge of origin. It is difficult to state for certain due to the scale of the exhibits and also the poor quality of some of the images, but most appear to have trade marks which would act as the badge of origin rather than the name of the product such as medi-swab, medi-scrub, medi-prep, medihoney, medi guard kids plaster etc.
- RNF3 & 4: Examples of marks accepted by the UK Registry which, in Mr Furneaux’s opinion have similar device elements to that in the instant mark.

OPPONENT’S EVIDENCE IN REPLY

11) The opponent filed a third witness statement, dated 12 July 2011, by Ms Gray who has provided evidence earlier in this case. She provides the following exhibits:

JVG8 and 9: Colour print-outs of various registrations exhibited by the applicant in black and white. Ms Gray points out that the colour has a very important effect on the overall impression of these marks.

12) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

13) I shall first consider the absolute grounds of opposition which read:

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

- (a) ...
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indication 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,
- (d)

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.”

14) I will first deal with the ground under Section 3(1)(c). In *Postkantoor* [2004] E.T.M.R 57 at paragraphs 97 and 98 the CJEU stated:

“97... A word must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned...

98 As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purpose of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

15) It is known from the guidance of the General Court (GC) that it is necessary to consider whether the relevant consumer will perceive a sufficiently direct and specific association between the mark and the relevant goods and services (see, for example, Case T-356/00 *Daimler Chrysler v OHIM (CARCARD)*, paragraph 25 and Case T-355/00 *DaimlerChrysler v OHIM (TELE AID)*, paragraph 28). Further, the GC has provided guidance on the type of marks prohibited by Article 7(1)(c) of Regulation No 40/94 (from which Section 3(1)(c) is derived). Marks that may serve in normal usage from the point of view of the intended public to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought are excluded from registration (Case C-383/99 *P Procter and Gamble v OHIM*, paragraph 39). Accordingly, a mark’s descriptiveness can only be

assessed by reference to the goods or services concerned and to the way in which it is understood by a specific intended public.

16) Other relevant case law of the CJEU is summarized below:

(i) The court in *Doublemint* went on to state:

“32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94 [the equivalent provision to Section 3(1)(c) in the Community Trade Mark Regulation], it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

(ii) In *Matratzen Concord AG v Hukla Germany SA*, (Case C- 421/04) the court stated:

“In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C- 218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

(iii) In *Ford Motor Co v OHIM*, Case T- 67/07:

“there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics”

17) The proviso to section 3(1) of the Act provides that if a trader can demonstrate that through the use made of it his mark has become sufficiently distinctive so that it does in fact serve as an indication of origin in the minds of the relevant public or a significant proportion thereof (see *Windsurfing Chiemsee* C-108/97) then registration may be granted. However, the applicant does not rely upon this exception and I only have the *prima facie* case to consider.

18) At the hearing the case against the mark in suit was that the dominant aspect of the mark is the word MEDI. This was said to be an abbreviation for the word “medicine” a

word which, in relation to the goods in the specification in Classes 5 and 10, is wholly descriptive. With regard to the goods in Class 3 it was contended that these can all be used for medicinal purposes and medicated varieties of all the goods in this class exist. Lastly, the opponent states that the applicant itself has provided evidence that MEDI is a common word that other traders in the field use as a prefix on a wide range of medical goods.

19) I note that the Registry Trade Mark Manual has the following entry:

“• MEDI

It is considered that the use of MEDI meaning ‘medical’ is well-known. Prima facie objections under section 3(1)(b) and(c) should be taken to any application consisting of MEDI plus a word which, as a whole, may be used in trade as a description in a medical context.”

20) I note that the applicant states that “marks with a “medi” prefix are commonplace” and indeed files both state of the register evidence as well as copies of internet sites to back the view that “MEDI” is a common prefix for Class 5 & 10 products. The applicant accepts that when used as a prefix the term “medi” could designate products of a medical or medicated nature. The applicant contends that its mark is not simply a word mark but is a device mark. It contends that the “swoosh” element takes it outside the ambit of Section 3(1)(c). It was also contended that the device prevents the word from being a prefix. At the hearing the following exchange occurred:

THE HEARING OFFICER: Just a quick question on that, I take it then that you fully accept that the word MEDI on its own is effectively unregistrable for medical products?

MR. AIKENS: We would not go that far. What we are accepting is that the use of the word MEDI as a prefix is descriptive. From that point of view, if the word MEDI----

THE HEARING OFFICER: Sorry, I was a bit confused by your insistence that this is not a word mark, but a device mark. By doing that, it seems to me you are effectively saying that MEDI as a word is unregistrable for these categories of goods, surely, otherwise why would you place so much emphasis on the device?

MR. AIKENS: It would be pretty difficult, we accept, because if you try to register it as a word mark itself that would not prevent the word being used as a prefix. For that reason we would accept it would be very difficult to get that through.

THE HEARING OFFICER: You do not think that if you were to print a word after the swoosh, I think you are calling it, the average consumer would simply read through the swoosh as a prefix maybe?

MR. AIKENS: We say no because of the position of the swoosh. It certainly cannot be used in these two circumstances, MEDI cannot be used as a prefix in one word itself. So, for example, MEDIPORE is one word. MEDI has the first two syllables of that word. It also prevents the use of MEDI followed by a hyphen and

then another word which, if we actually go to the evidence, is how MEDI is used as a prefix commonly as well. From that point of view, it precludes the use of those two uses of the word MEDI as a prefix.

THE HEARING OFFICER: You are suggesting to me that if you put a hyphen on the right-hand side of the swoosh with another word that the average consumer would not see Medi as a prefix?

MR. AIKENS: We say that is simply not notional and fair use of that mark. The likelihood of a hyphen being used after that swoosh, we say, is not very high because of the positioning of the swoosh. How you normally use a hyphen is directly after the words that you are using as a prefix and then the suffix comes immediately afterwards without a space. Here you have a swoosh which occupies the space and then somewhere the hyphen would be. That is what we say. So the idea that somebody would use this mark and then followed by a hyphen and then followed by the suffix is not very high. Therefore, the effect of the swoosh is to prevent that use.

There is only one point I wanted to make on the law and that is the *Postkantoor* decision. The proposition that the law needs to ensure that certain signs can be freely used by all.

I do not understand the opponent to be saying that everyone should be free to use this specific device and they would be right not to say that, we say. The concern is about the word MEDI and the concerns specifically should be about, if there is a concern, it should be about the use of the word MEDI as a prefix. We accept that word MEDI should be free to be used by all as a prefix. We do not accept that this specific device should be free to be used by all.

We do take a point on the descriptiveness of the word MEDI by itself. As I say, we do accept that when used as a prefix, as the manual says, this is well known. We do not accept that when used by itself, it is necessarily descriptive. One of its possible meanings is descriptive of the goods that are in the specification, and we take three points on this. I just want to analyse the opponent's case on this in a little more detail.

We say, first of all, that the definitions provided come from the dictionary of slang and unconventional usage. The fact that this is unconventional means that not everyone would understand the word in this way and the way they rely on it is that MEDI itself is an abbreviation for the word "medicine." They have not cited a mainstream English (United Kingdom) dictionary and if they had, then their case would be a little stronger, but they have not.

THE HEARING OFFICER: What say you regarding the Registry's work manual definition and practice?

MR. AIKENS: Perhaps you would be so kind as to repeat it.

THE HEARING OFFICER: Yes, certainly. You will find that in our

work manual and it says, "It is considered that the use of medi, meaning medical, is well known." It does not say as a prefix. It simply says the word MEDI is a well known word which means medical.

MR. AIKENS: We say the fact that it means medical means that it is referring to the use of the word as a prefix because medical itself is an adjective. It is not a noun. They say that the word MEDI means medicine, which is a noun. So by itself it means medicine without anything more. We say that the meaning of what you have just read out in the manual MEDI equals medical means that something needs to come after it. We say, at best the word MEDI used by itself is allusive to medical and medicated products.

21) From this it is clear that the applicant accepts that the term MEDI should remain free for all to use yet it maintains that its device element of a "swoosh" prevents the use of a hyphen. They also state that if another word were placed on the other side of the "swoosh" then MEDI would not be seen as a prefix. To my mind this is abject nonsense. The device element that the applicant relies so heavily upon is non-distinctive and whilst it would not be overlooked by the average consumer given its size and positioning it would be ignored as being purely decorative. It does not act as a badge of origin and nor, in my view, does it prevent the use of a hyphen or the placement of another word which would have as its prefix the term "MEDI". The average consumer upon seeing the mark in suit at the relevant date used upon the good sought to be registered would view "medi" as a clear reference to medical/medicated and descriptive of the products.

22) I am aware of the caution expressed by Anna Carboni, sitting as the appointed person, in *CHORKEE* BL O-048-08 that just because a word has a dictionary meaning, caution should be exercised when assuming that the consumer will understand the word as having such a meaning. In the instant case however, there is evidence of its use in respect of goods in Classes 3, 5 and 10 to designate products of a medical/medicated nature, and as the applicant themselves accepted is a term that other traders use to designate that the product has medical/medicated properties. Consequently, the ground based upon Section 3(1)(c) of the Act is successful in respect of all the goods applied for.

23) Whilst this decides the issue I will go on to consider the ground under Section 3(1)(b). I take note of the comments of Ms Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM*, where she conveniently summarised the leading case law in respect of Section 3(1)(b) of the Act:

"7. It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs "a residual or sweeping-up function", backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd's Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is

entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Case C-363/99 *Koninklijke KPN Nederland BV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (*ibid.*).

8. When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question, who are deemed to be reasonably well informed, observant and circumspect: Joined Cases C-53/01 to C- 55/01 *Linde AG, Winward Industries Inc and Radio Uhren AG* [2003] ETMR 78 at [41].

9. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: Case C-329/02P *SAT. 1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance (“CFI”) has repeatedly referred to “a minimum degree of distinctive character” as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, Case T-34/00 *Eurocool Logistik GmbH & Co. KG v OHIM (“EUROCOOL”)* [2003] ETMR 4 at [39]; Case T-128/01 *Daimler Chrysler Corp v OHIM* [2003] ETMR 87 at [33]; Case T-320/03 *Citicorp v OHIM (“LIVE RICHLY”)* at [68]), the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM (“COMPANYLINE”)* [2002] ECR I-7561 at [20].

10. The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive / 7(1)(b) CTMR, which in the Court’s view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin: *SAT. 1 v OHIM* at [23]; Case C-37/03 P *BioID AG v OHIM* [2005] ECR I-7975 (ECJ) at [27].”

24) It is clear from the above guidance that if a mark is entirely descriptive of characteristics of goods or services, it will also be devoid of any distinctive character under section 3(1)(b). Consequently, as I have found that, in respect of the applicant’s goods, the mark in question is open to objection under Section 3(1)(c) of the Act, it follows that it is also open to objection under Section 3(1)(b) of the Act.

25) Section 3(1)(b) includes within its scope those marks which, whilst not designating a characteristic of the relevant goods will nevertheless fail to serve the essential function of a trade in that they will be incapable of designation origin. I therefore have to consider the matter from the perspective of the average consumer who will not analyse a trade mark in depth. The opponent's contention is the same as under Section 3(1)(c) in that the average consumer will see the mark in suit, when used upon the goods sought to be registered, as merely indicating that the goods are medicinal or medicated. They will not regard the "swoosh" as significant or as a badge of origin. To my mind the objection under Section 3(1)(b) is even stronger than that under 3(1)(c). The mark consists of a well known term which is in common use. It is combined with a device mark which the average consumer will view as non-distinctive. The ground of opposition under Section 3(1)(b) is successful.

26) As this determines the issue I do not need to consider the ground under Section 5(2)(b).

COSTS

27) The opponent has been successful and is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£250
Preparing evidence and considering and commenting on the other side's evidence	£600
Preparing for and attending a hearing	£800
Expenses	£200
TOTAL	£1850

28) I order AAH Pharmaceuticals Limited to pay 3M Company the sum of £1850. 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 2nd day of February 2012

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