TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3019986
BY COLONIS PHARMA LIMITED TO REGISTER THE TRADE MARK

ACETINE

IN CLASS 5

AND IN THE MATTER OF OPPOSITION
THERETO UNDER NO 401332
BY GLAXO GROUP LIMITED

Background and pleadings

1) Colonis Pharma Limited ("the applicant") applied to register the mark ACETINE in the UK on 29 August 2013. It was accepted and published in the Trade Marks Journal in respect of the following list of goods in Class 5:

> *Pharmaceutical preparations; medicines for humans; mucolytic agents; preparations including mucolytic agents; anti-mucolytics; dietetic substances adapted for medical use; sanitary preparations for medical purposes; plasters, materials for dressings; nutritional supplements included in class 5 for humans and/or for animals; vitamins; minerals and mineral salts, all included in class 5; none of the aforesaid goods being ACE inhibitors or muscle relaxants and none of the aforesaid being for the prevention or treatment of cardiovascular diseases or disorders.*

2) Glaxo Group Limited ("the opponent") oppose the mark on the basis of Sections 3(1)(b) and (c) and also Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The Section 3 pleadings are based upon the premise that the word ACETINE is not distinctive for goods in Class 5 and refers to its use in patent documents (copies provided with the Form TM7) and a definition for the word "acetin" from the website www.encyclopedia2.thefreedictionary.com/acetin where it is described as "[a] thick, colorless, hydroscopic liquid with a boiling point of 158 C, made by heating glycerol and strong acetic acid, soluble in water and alcohol, used in tanning, as a dye solvent and food additive, and in explosives. Also spelled acetine."

3) The Section 5(2)(b) grounds are on the basis of the opponent's earlier registered UK mark, the relevant details of which are shown below:

> 689485
>
> ANECTINE
>
> Filing date: 2 June 1950
>
> **Class 5:** *All goods included in Class 5.*

3) The opponent relies on this earlier mark insofar that its specification includes *pharmaceuticals* and claims use in the same. It submits that the respective marks are very similar and the respective goods are identical or similar.

4) The applicant filed a counterstatement denying the claims made. It puts the opponent to proof of use. Detailed submissions are provided, but I will not detail them here, but I will refer to them as necessary in my decision.

5) Both sides filed evidence and a hearing was requested. This took place before me on 28 January 2015, with the opponent represented by Ms Imogen Wiseman of Cleveland and the applicant by Mr Anthony Gallafent of Gallafents LLP.

Opponent's Evidence

6) This consists of a witness statement by Ms Joanne Green, authorised attorney of the opponent. Ms Green provides the following evidence in support of the claim that the applicant's mark is descriptive in respect of pharmaceutical products:

- The word ACETINE is defined as "a mixture of various acetyl derivatives of glycerol. Used in dyeing, either in a neutral form, or in one containing about 20 percent acid" (see extract from Chemical Synonyms and Trade Names, 6th edition at Exhibit JG1). At Exhibit JG5 is an extract from www.freedictionary.com showing that "acetin" has a similar definition;

- The same extract from www.encyclopedia2.thefreedictionary.com/acetin as provided with the counterstatement is provided at Exhibit JG2. It includes a statement that "acetin" is also known as "acetine";

- Exhibit JG3 consists of dictionary and Internet extracts and abstracts from the Chemical Abstracts Registry database. The purpose of these is to demonstrate that it is common for the suffixes "in" and "ine" to be interchangeable for names of medical substances and chemical compounds. These include: Caffein/Caffeine; Chlorin/Chlorine; Creatin/Creatine; Dentin/Dentine; Glycerin/Glycerine; Thyroxin/Thyroxine and Phenacetin/Phenacetine;

- Exhibit JG4 is an extract from the online database of prescription and generic drugs, www.mims.com Malaysia. A search conducted for the word "acetine" produced one hit: Acetin, categorised as a "cough & cold preparation". I note that the reference is from the Malaysia version of MIMS and, further, that only one manufacturer of Acetin is recorded;

- Exhibit JG6 is an extract from the Chemical Abstracts Registry. It shows that acetin has a "unique registry number" 26446-35-5 and 81 English language abstracts are provided from patent/literature references and Ms Green states that these show use of Acetin, in the context of its use in disease therapy. In fact only 14 of the 81 abstracts refer to "acetin" alone. A further 30 illustrate "acetin" being used as a suffix in the alternative name for the same substance, "monoacetin". Ms Green draws attention to the following abstracts that are reproduced at Exhibit JG7 together with *Wikipedia* entries for the same and she claims they illustrate use of international non-proprietary names that incorporate the suffix "acetin":

    - PHENACETIN is described on Wikipedia as a pain-relieving and fever-reducing drug, banned in the US in 1983. It has been an ingredient of a number of named proprietary products;

    - TRIACETIN is described on Wikipedia as an artificial chemical compound commonly used as a food additive and as an excipient in pharmaceutical products.

- Further extracts from the Chemical Abstracts Registry are provided at Exhibit JG8 to support the claim that there are a number of other substances whose names contain the element ACETIN, such as Herbacetin, a naturally occurring antioxidant found in various plants, and Diacetin, used as a plasticiser, softening agent and solvent;

7) In addition, Ms Green provides the following evidence regarding the scale of use of the opponent's mark:

- It has been used in the UK since September 1997;

- Confidential market share figures expressed as a percentage of the Suxamethonium (muscle relaxant) market. For each year of a five year period ending in September 2013 these were [redacted] and [redacted] respectively;

- Confidential Exhibit JG14 provides the following turnover figures for each year of the five years ending December 2013. These are £[redacted], £[redacted], £[redacted], £[redacted] and £[redacted] respectively;

- Exhibits are provided showing how the mark is used on packaging (Exhibit JG10), on the vials/ampoules themselves (Exhibit JG10), patient information leaflets (Exhibit JG11) and on third party websites including the NHS (Exhibit JG12);

- Example invoices are provided at Exhibit JG13 and Ms Green states that the goods bearing the mark are sold to 380 pharmacies, prisons and healthcare centres in the UK.

Applicant's Evidence

8) This takes the form of two witness statements, the first by Mr Gallafent who is a trade mark attorney and a member of Galafents LLP, the applicant's representative in these proceedings. Mr Gallafent's statement consists wholly of submissions and I need not summarise them here, but I will keep them in mind when making my decision.

9) The second witness statement is by Mr Stephen Jeremy Martin, Chief Executive Officer of the applicant. He points out that the 6th edition of Chemical Synonyms and Trade Names relied upon by Ms Green, extracts of which are provided in a number of her exhibits, was published in 1968. This is illustrated in Mr Martin's Exhibit SJM-1 that consists of two extracts from www.amazon.com and www.amazon.co.uk where the publication is offered for sale. Both indicate a 1968 publication date.

10) Mr Martin states that the reference in the 1968 edition was not retained in later editions and at Exhibit SJM-2 he provides copies of relevant pages from, what he believes is the most recent edition, the 11th edition, published in 1999. The closest entry appears to be for "acetin blue" that is described as "[s]olutions of indulines in acetins (ascetic esters of glycerol)".

11) Mr Martin observes that the ACETINE mark is not present in this 11th edition and suggests that this clearly shows that it is not a descriptive word.

12) To counter the single dictionary entry provided by Ms Green at her Exhibit JG2, Mr Martin provides extracts from other online reference sources at Exhibit SJM-3. These sources are www.dictionary.com, www.meriam-webster.com, www.wiktionary.org, www.vocabulary.com, www.encyclo.co.uk, www.mondofacto.com and www.thesciencedictionary.org. All provide a definition for acetin, but none suggest that ACETINE is an alternative spelling of acetin and there is not a separate entry for ACETINE.

13) To refute the information provided in Ms Green's Exhibit JG3, Mr Martin states that the words CHLORIN and CHLORINE are not interchangeable. At Exhibit SJM-4, Mr Martin provides the relevant pages from the Merck Index (14th Edition, 2006) to illustrate. The only entry for CHLORIN is for "chlorin e_6" and a different entry for "Chlorine". Mr Martin states that these two compounds are very different.

14) Mr Martin states that it is well known in the field of pharmaceuticals that very similar words are used which have very different meanings.

15) Mr Martin refers to European Medicines Agency (EMEA) Guidance, ICH Topic M4Q of CPMP/ICH/2887.99 July 2003 that all drug names should normally be referenced by the International Non-Proprietary Name (INN) or suitable pharmacopoeial names. Mr Martin points out that the name ACETINE, rather than the name "acetin" that appears to be used in the necessary reference books such as British Pharmacopeia. He also observes that according to information obtained from the Merck Index (Exhibit SJM-5), acetin (in fact the abstract relates to "Monacetin") appears to be for use in he manufacture of smokeless powder, dynamite and as a solvent for basic dyes and in tanning leather. Mr Martin states that if acetin was to be used in a pharmacological context that an individual INN name would be required/used and not the name acetin. He submits that as a result there would be no confusion between acetin and ACETINE for pharmacological usage.

16) Mr Martin refers to the Zenrx Research online database (www.zenrx.org) of pharmaceutical products. He provides a list of 32 names of compounds and 124 brand names beginning with the prefix ACE. He states that ACE is a common acronym for Angiotensin Converting Enzyme used in the treatment of cardiovascular disease and in a more general sense means top-notch, first rate, superb or excellent.

17) Mr Martin also provides a list of 48 names of compounds and 150 brand names that end in the suffix TINE. Similarly, he provides a list of 52 compounds and over 470 brand names ending in the prefix TIN.

DECISION

Section 3(1)(b) and (c) of the Act

18) The relevant parts of Section 3(1) 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 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,

(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."

19) I will begin by considering the pleadings based upon Section 3(1)(c) of the Act. The case law under section 3(1)(c) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

"91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

> "33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).
>
> 36. … due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).
>
> 37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more

characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (Koninklijke *KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

> 49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.
>
> 50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art. 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

20) Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*, provided the following relevant comments regarding the interplay between Section 3(1)(b) and Section 3(1)(c) 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*.)."

21) It is clear from the above guidance that if a mark is entirely descriptive of characteristics of goods, it will also be devoid of any distinctive character under section 3(1)(b) for those goods. The opponent's pleaded case is that the applicant's mark is descriptive. There is no alternative pleading that if I find the mark not to be descriptive that it is, nonetheless, devoid of distinctive character for other reasons. In light of this, the pleadings based upon Section 3(1)(b) and Section 3(1)(c) will stand or fall together. Therefore, I will consider the pleading based only upon an analysis of whether the mark is descriptive under Section 3(1)(c).

22) The opponent's case can be summarised as being that the term ACETINE is descriptive of a chemical compound, or in the alternative, ACETIN is descriptive of a chemical compound and the word ACETINE is another recognised name for the same and therefore, the word ACETINE is descriptive.

23) Firstly, I consider if the word ACETIN is descriptive. The main evidence in support of this contention consists of extracts from the Chemical Abstract Registry. It is pointed out that ACETIN has its own "unique registry number" 26446-35-5. Eighty one references are provided, many being obtained from patent applications. Fourteen of these references use the name ACETIN, a further thirty use the name "Monoacetin" and the remainder name the substance using one of its alternative names that does not include the word ACETIN either alone or in combining form. Mr Gallafent submitted that whilst the Chemical Extracts Registry is a huge and well respected source, it does not show any uses of ACETINE and the 14 references for ACETIN is too insignificant in the context of the 85 million extracts that are available at this source and indicates that it is not used very often.

24) It is clear from the 81 extracts that the substance identified by the unique registry number 26446-35-5 is used in some very specialised applications, many in the field of medicine and pharamceuticals. The fact that there are 81 references out of 85 million does not change this. The opponent's case is somewhat compromised, by the fact that the substance has eight alternative names. However, I do not see this as being fatal to its case. Clearly, ACETIN is one of the names by which the substance is recognised and it is used descriptively.

25) Having concluded that ACETIN is used descriptively, I next consider whether ACETINE is an alternative, interchangeable name. Here the evidence is rather thin on the ground. Notably, the Chemical Abstracts Registry does not list it as an alternative name. The opponent relies upon a 1968 edition of Chemical Synonyms and Trade Names and a 2003 entry appearing on the website thefreedictionary.com. Mr Gallafent criticised the fact that these two exhibits relate to old references and he also pointed to the applicant's own evidence where the latest version (dated 1999) of Chemical Synonyms and Trade Names no longer includes a reference to ACETINE. The opponent's evidence, whilst it does lend some support that ACETINE was a recognised alternative name for the substance also known as ACETIN, I find it is insufficient. In particular, I find it significant that an updated edition of Chemical Synonyms and Trade Names no longer carries the name. This would suggest that at some time in the past the names ACETINE and ACETIN may have been interchangeable, but the average consumer of the current time is unlikely to be

aware of this. Therefore, the evidence fails to illustrate that the names ACETINE and ACETIN are used interchangeably.

26) However, this is not the end of the matter because the opponent also provides evidence to support its submission that it is common practice that substance names ending in "-tin" are often interchangeable with the same word ending in "-tine". To this end, the opponent has provided dictionary extracts that illustrate that Caffein/Caffeine, Chlorin/Chlorine, Creatin/Creatine, Dentin/Dentine, Glycerin/Glycerine, Thyroxin/Thyroxine and Phenacetin/Phenacetine are all examples of substances with such interchangeable suffixes.

27) In his witness statement, Mr Martin criticises this evidence by providing his own evidence to support his view that the words CHLORIN and CHLORINE are not interchangeable. His Exhibit SJM-4, providing an extract from the Merck Index actually illustrates that "chlorin e_6" is a different compound to "Chlorine". This may be so, but it is not clear to me that "Chlorin" and "chlorin e_6" are the same and that, by deduction "Chlorin" and "Chlorine" are different. In the absence of further explanation this evidence does not have the effect of discrediting the opponent's evidence on this point. Further, the Chlorin/Chlorine reference is only one of a number of examples referred to by the opponent and the other examples are unchallenged by the applicant.

28) Mr Martin has also advanced an argument that if ACETIN was to be used in a pharmacological context that an individual INN name would be required/used and not the name ACETIN and, consequently, there would be no confusion between ACETIN and ACETINE in respect of pharmacological usage. I reject this argument because the similarity between the words may still lead to both being perceived as descriptive of the same compound regardless of whether they are INN names or not.

29) Taking the evidence into account this leads me to conclude that the mark at issue will be perceived as being descriptive of the substance sometimes called ACETIN. Mr Gallafent submitted that in the medical field there is greater than average care taken when spelling words, and consequently the letter "e" at the end of the mark is important. In light of the potential for "-in" and "-ine" endings to be interchangeable, I do not agree. Even if the medical professional notices the addition of the letter "e", he/she is likely to assume it is merely an alternative spelling of ACETIN.

30) Having regard to all of the above, I conclude that the mark ACETINE may serve in trade to designate a substance present in pharmaceutical preparations and other preparations listed in the applicant's specification, namely:

> *Pharmaceutical preparations; medicines for humans; mucolytic agents; preparations including mucolytic agents; anti-mucolytics; dietetic substances adapted for medical use; nutritional supplements included in class 5 for humans and/or for animals; vitamins; minerals and mineral salts, all included in class 5; none of the aforesaid goods being ACE inhibitors or muscle relaxants and none of the aforesaid being for the prevention or treatment of cardiovascular diseases or disorders.*

31) Whilst the opposition was against all of the applicant's goods, no evidence or submissions have been in respect of *sanitary preparations for medical purposes; plasters* or *materials for dressings.* Certainly there is nothing before me to suggest that these grounds of opposition should extend to such goods. I find that the opposition based upon Section 3(1)(b) and (c) of the Act fails in respect of these goods.

32) In light of this finding, Mr Gallafent's auxillary request to limit the applicant's specification by the removal of the broad terms *pharmaceutical preparations* and *medicines for humans* does not assist. The remaining goods could also be in the form of, or include as a major constituent, the substance ACETIN.

33) In summary, the opposition based upon Section 3(1)(b) and Section 3(1)(c) is acceptable in respect of the goods listed in paragraph 30, above, but fails in respect of the remaining goods. However, in case I am found to be wrong and for reasons of completeness, I will also consider the grounds based upon Section 5(2)(b) of the Act, beginning with the issue of proof of use.

Proof of Use

34) At the hearing, Mr Gallafent conceded that there had been use of the opponent's mark, but argued that this was only in respect of *muscle relaxant for use during anaesthesia and/or a muscle relaxant to reduce the intensity of muscular contractions associated with pharmacologically or electrically induced convulsions*. Ms Wiseman criticised such a narrow definition but conceded that a specification of reduced scope is needed to reflect the use shown. Ms Wiseman suggested *pharmaceutical preparations for use as muscle relaxants*. In light of these submissions, and as confirmed by both sides at the hearing, there is common ground between the parties as to what goods use has been shown, but they dispute what would be acceptable wording to reflect such use.

35) In deciding this point, I have regard for the guidance of Mr Justice Arnold (as he now is) in his judgments as The Appointed Person in *Nirvana Trade Mark BL* O-262-06 and *Extreme Trade Mark BL* O-161-07 where he comprehensively examined the case law in this area. His conclusion in *Nirvana* was that:

> "(1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].
>
> (2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].
>
> (3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].
>
> (4) In arriving at a fair specification, the tribunal should strike a balance

between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

36) I also keep in mind the guidance of the General Court ("GC") in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 ("*Aladin*") where it stated at paragraph 43, "the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods ... as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered".

37) Finally, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as Appointed Person summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

38) My view is that Ms Wiseman's suggestion is consistent with the guidance referred to above and identifies the CATEGORY of goods that the opponent's product belongs to, rather than the precise goods as Mr Gallafent's suggested wording does. Therefore, for the purposes of considering the issue of likelihood of confusion, I will consider the opponent's earlier mark insofar as it covers only *pharmaceutical preparations for use as muscle relaxants*. Such a specification reflects the category of goods that the opponent's goods exemplify.

Section 5(2)(b)

39) Sections 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

40) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

41) In the judgment of the Court of Justice of the European Union ("the CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> "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 intended purpose and their method of use and whether they are in competition with each other or are complementary".

42) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity also included the respective trade channels through which the goods or services reach the market.

43) As I identified in paragraph 38 above, I will restrict my consideration of similarity to a subset of goods where the opponent has demonstrated use, namely *pharmaceutical preparations for use as muscle relaxants*. I will consider similarity between these goods and those of the applicant that represent the opponent's best case, namely, [p]harmaceutical *preparations ... none of the aforesaid goods being ACE inhibitors or muscle relaxants*. If the opponent does not succeed against these goods in terms of whether there is a likelihood of confusion, then it will not be successful against any other of the applicant's goods. The presence of the exclusion in the applicant's specification results in the respective goods not being identical. In terms of similarity, Ms Wiseman submitted that the respective goods still have the same nature, both being pharmaceutical preparations that can be offered in a variety of forms, the same purpose, namely the treatment of human health and/or hygiene problems, the same users, namely patients and medical professionals, and the same channels of trade, namely hospitals, medical centres, pharmacies and health centres. I agree with most of this analysis, but not that the respective purpose is the same. By virtue of the exclusion in the applicant's specification, the respective goods cannot be for the same purpose. That said, I acknowledge that they could be used to treat similar or closely related conditions or to bring about similar but not identical effects upon the human body.

44) Taking account , of all of the above I conclude that the respective goods share a good deal of similarity.

Comparison of marks

45) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the

average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

46) It would be wrong, therefore, to artificially dissect the marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

47) The respective marks are shown below:

Opponent's mark	**Applicant's mark**
ANECTINE	ACETINE

48) Both marks consist of a single word and consequently, the distinctive character of each mark resides in their entirety.

49) Visually, Mr Gallafent submitted that because of the different lengths of the respective marks and that the letters CE and NEC are not in same order, then the marks have no similarity of appearance. Whilst I acknowledge these differences, I do not agree that the marks share no visual similarity. They both begin with the letter "A" and both end in the letters "TINE". Further, they are similar in length, but not as Mr Galafent claimed, the same. Ms Wiseman submitted that both marks contain the letters A, C, E, T, I, N and E and as such the later mark is contained within the earlier mark. To my mind, this is a mis-characterisation. It is more accurate to say that the letters of the applicant's mark are contained in the earlier mark, but the mark itself is not contained in the mark. Having regard for all of this, I conclude that the marks share a medium level of visual similarity.

50) Aurally, both marks consist of the three syllables. The opponent's mark is likely to be pronounced AN-EK-TINE or AN-EK-TEEN, whereas the applicant's mark is likely to be pronounced AA-SEE-TINE or AA-SEE-TEEN . The first two syllables are different but the last syllable is the same. This creates some similarity, but only a low level.

51) Conceptually, on the assumption that my findings under Section3 are wrong, the applicant's mark will be perceived as having no meaning as will the opponent's mark. Therefore, there is no conceptual similarity.

Average consumer and the purchasing act

52) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97.*

53) In *Mundipharma AG v OHIM*, Case T-256/04, the General Court accepted that there were two groups of relevant consumers for a pharmaceutical product, professional users and the general public. Mr Gallafent referred me to the guidance provided by the GC in *Armour Pharmaceutical Co. V. OHIM*, T-483/04 that the level of attention is influenced by the therapeutic indications of the goods in question and that where such goods are prescription medicines the level of attention is greater because they are prescribed by a physician and subsequently checked by a pharmacist who then delivers them to the consumer. I agree with this approach.

Distinctive character of the earlier trade mark

54) In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

55) Ms Wiseman submitted that the opponent's mark is of high inherent distinctive character. I agree. It consists of an invented word whose distinctive character is not diluted by any allusion or similarity to a common dictionary word. Ms Wiseman also submitted that Ms Green's evidence demonstrates an enhanced level of distinctive character because of the use made of the mark. Once again, I agree. The use shown is not large in terms of turnover, but the market share figures demonstrate that the mark is likely to be well known in the specific area of pharmaceuticals.

Likelihood of confusion

56) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

57) Ms Wiseman acknowledged that by virtue of the relevant public being healthcare professionals and patients and the fact that healthcare professionals are likely to be involved in the purchasing process as intermediaries, is not in itself a reason to find no likelihood of confusion. Further, Ms Wiseman submitted that whilst the emphasis is on the health professional, the fact that there is also information provided online for the ultimate end user illustrates that there are opportunities for confusion with patients who may look up the wrong drug if confused. I acknowledge this point, but in the first instance the consumer (whether a medical professional or patient) must still be confused. It is not merely enough that there are opportunities for confusion. Confusion must also be likely. It is my view that confusion is not likely. In reaching this conclusion, I take account that consumers of some pharmaceutical products deploy a good deal of care and attention (see paragraph 53 above). The respective goods share a good deal of similarity, and the respective marks share a medium level of visual similarity, a low level of aural similarity and no conceptual similarity. When factored into to global appreciation test that I must conduct, I conclude that the consumer, both specialist and not, will be able to differentiate the marks. I find that there is no likelihood of confusion.

58) The grounds based upon Section 5(2)(b) fail.

Summary

59) The opposition succeeds based upon Sections 3(1)(b) and 3(1)(c) in respect of the following list of goods:

> *Pharmaceutical preparations; medicines for humans; mucolytic agents; preparations including mucolytic agents; anti-mucolytics; dietetic substances adapted for medical use; nutritional supplements included in class 5 for humans and/or for animals; vitamins; minerals and mineral salts, all included in class 5; none of the aforesaid goods being ACE inhibitors or muscle relaxants and none of the aforesaid being for the prevention or treatment of cardiovascular diseases or disorders.*

60) The grounds based upon Section 3(1)(b) and Section 3(1)(c) of the Act fail in respect of the remaining goods, namely: *sanitary preparations for medical purposes; plasters* or *materials for dressings.*

61) In case I am wrong in these findings, I have gone on to consider the grounds based upon Section 5(2)(b), but I have found that the opposition would not succeed in this respect.

COSTS

62) The opponent has been mostly successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I keep in mind that both sides filed evidence and a hearing was held. I award costs on the following basis:

Preparing a statement and considering the counterstatement	£300
Opposition fee	£200
Evidence	£700
Preparing for, and attending hearing	£800
Total:	**£2000**

63) I order Colonis Pharma Limited to pay Glaxo Group Limited the sum of £2000 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 11th day of March 2015

Mark Bryant
For the Registrar,