

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2029053  
BY MR ZEF EISENBERG  
TO REGISTER A TRADE MARK IN CLASS 5**

**AND**

**IN THE MATTER OF OPPOSITION NO. 44692  
THERE TO BY UPJOHN LIMITED**

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**thereto by Upjohn Limited**

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**BACKGROUND**

20 On 2 August 1995 Mr Zef Eisenberg applied under Section 32 of the Trade Marks Act 1994  
to register the trade mark PROGAIN in Class 5 in respect of:-

nutritional products, protein/carbohydrate preparations; all adapted to increase body  
weight, as a meal replacement or for the provision of energy/calories.

25 On 5 June 1996, Upjohn Limited of Eldon Street, London EC2M 7LH, filed notice of  
opposition to this application. The grounds of opposition are, in summary:-

- 30 (a) registration of the application would be contrary to the provisions of Section  
3(6)
- (b) the opponents are the registered proprietors of trade mark Nos. 1301862 and  
1409180 and registration of the application would be contrary to the provisions  
of Section 5(2)
- 35 (c) registration of the application would be contrary to the provisions of Sections  
5(3) and 5(4).

The details of the trade mark registrations relied upon in respect of the above are as follows:

40	<b>NO.</b>	<b>MARK</b>	<b>SPECIFICATION</b>
	1301862	PREGAINE	Preparations included in Class 3 for the hair and for the scalp.
45	1409180	REGAINE	Dermatological preparations included in Class 5 for topical application to the scalp.

The applicant filed a counterstatement in which he denies all of these grounds.

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5 Both sides filed evidence in these proceedings and the matter came to be heard on 10 December 1997. At the Hearing, the opponents were represented by Mr R A Blum of Gill Jennings & Every, their trade mark agents. The applicant, Mr Zef Eisenberg, appeared in person.

10 **Opponents Evidence**

The opponents evidence, filed under the provisions of Rule 13(3), consists of a Statutory Declaration by Mr Graham Lee dated 11 November 1996. Mr Lee is the Finance Director of Upjohn Limited and makes the declaration on their behalf on the basis of his own knowledge and information obtained from the records of the company.

Mr Lee states that his company has been using the trade mark REGAINE since April 1988 and the trade mark PREGAINE since December 1988. REGAINE is used on a preparation for the treatment of thinning hair (alopecia) principally in men. It was first available on prescription but has been available without prescription, ‘over the counter’ since 1995. The trade mark PREGAINE is used on a shampoo for use in conjunction with the preparation sold under the trade mark REGAINE. The shampoo has always been sold without restriction.

Annual sales figures for goods sold under the two trade marks are set out below:-

<u>Year</u>	<u>Trade Mark</u>	<u>Amount</u> £	<u>Year</u>	<u>Trade Mark</u>	<u>Amount</u> £
1988	REGAINE	1,685,146	1988	PREGAINE	45
1989	“	1,937,800	1989	“	2,107
30 1990	“	1,480,944	1990	“	30,043
1991	“	1,370,971	1991	“	23,698
1992	“	1,366,293	1992	“	38,146
1993	“	1,280,070	1993	“	28,225
1994	“	1,167,203	1994	“	51,396
35 1995	“	1,465,876	1995	“	38,199
1996	“	1,600,220	1996	“	60,915

The annual amount spent advertising and promoting the product sold under the PREGAINE trade mark is set out below:

<u>Year</u>	<u>Amount</u>
1988	-
1989	-
45 1990	23,900
1991	12,146
1992	1,931
1993	1,006
1994	603
50 1995	401

5 Mr Lee goes on to explain that REGAINE is the only pharmaceutical preparation to have any appreciable effect on checking advancing baldness and, as a result, has generated a great deal of public interest. Thus the trade mark REGAINE and its associated trade mark PREGAINE have, in his view, become well known trade marks. In some countries, for example, in the USA, his company uses ROGAINE and PROGAINE in place of REGAINE and PREGAINE  
10 for the same products respectively. ROGAINE and PROGAINE are also, in his view, well known marks.

Mr Lee states that the products sold under the REGAINE and PREGAINE trade marks are not prescription items. He believes therefore that the public could be confused through the  
15 use by the applicant of his PROGAIN trade mark in view of the use and established reputation of his company's trade marks. In his view the respective trade marks are confusingly similar and the respective goods could very well be sold through the same retail outlets. In addition, Mr Lee exhibits the containers in which his company's products are sold under the REGAINE and PREGAINE trade marks. He believes that these containers could very easily be confused  
20 with the containers in which the applicant's product is sold.

### **Applicant's Evidence**

The applicants evidence consists of a Statutory Declaration by Mr Zef Eisenberg dated 28  
25 February 1997. Mr Eisenberg states that, in his view, the goods sold under his trade mark are not the same or similar to those sold under the trade marks of the opponents. His product is a high fibre food supplement intended to help users gain weight whilst the opponents products are external/topical hair preparations which are intended to lead to increased growth of hair on the scalp. He points out that the opponents goods are clearly marked "for external use only",  
30 to reinforce the point.

Mr Eisenberg exhibits a large container in which, he states, the food supplements sold under his trade mark PROGAIN are sold. He compares this with the small containers in which the opponents shampoo and hair treatment preparations are sold. He takes the view that goods  
35 sold under his trade mark would not be confused with the goods of the opponents. He adds finally that, in his view, the respective trade marks do not look alike or sound alike.

### **Opponents Evidence In Reply**

40 In response to the applicant's evidence filed under the provisions of Rule 13(5) the opponent filed evidence under the provisions of Rule 13(6). This consists of a further Statutory Declaration by Mr Graham Lee dated 1 July 1997.

Mr Lee declares that despite the statements in Mr Eisenberg's declaration that the respective  
45 products would not be confused, the goods covered by the application could be sold in retail outlets in packaging identical to his company's PREGAINE (and presumably REGAINE) product. Mr Lee goes on to state that he does not believe that any confusion between the respective trade marks will be avoided by the statement on his company's products that they are for external use only because, having once mistaken the trade marks, customers will not  
50 notice this additional wording. He points out that although his company's REGAINE product started out as a pharmacy medicine it is now sold 'over the counter' and therefore the

5 opportunities for confusion are considerable. In particular, he says, ‘over the counter’ products are ordered orally by reference to the mark alone and so at the time of ordering the goods, confusion could result from use of the marks alone, irrespective of the packaging, additional text and the like.

10 That concludes my review of the evidence and with this in mind I turn to consider the grounds of opposition.

These are found in Sections 3(6), 5(2), 5(3) and 5(4). The first of which reads as follows:-

15 **3(6)** A trade mark shall not be registered if or to the extent that the application is made in bad faith.

As far as the ground of opposition based upon Section 3(6) is concerned, I do not consider that any evidence has been filed by the opponent which supports the allegation that the application for registration of the trade mark was made in bad faith. I therefore find formally  
20 that the opposition based upon Section 3(6) of the Act fails.

I go on, therefore, to consider the grounds of opposition based upon Section 5 which reads as follows:

25

**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,  
30 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,  
35

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

40 **5(3)** A trade mark which-

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,  
45

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier  
50 trade mark.

- 5           **5(4)** A trade mark shall not be registered if, or to the extent that, its use in the  
United Kingdom is liable to be prevented-
- 10           (a) by virtue of any rule of law (in particular, the law of passing off)  
protecting an unregistered trade mark or other sign used in the course  
of trade, or
- 15           (b) by virtue of an earlier right other than those referred to in subsections  
(1) to (3) or paragraph (a) above, in particular by virtue of the law of  
copyright, design right or registered designs.
- A person thus entitled to prevent the use of a trade mark is referred to in this  
Act as the proprietor of an “earlier right” in relation to the trade mark.

20 The term ‘earlier right’ is defined in Section 6(1) of the Act, the relevant provisions of which  
state:

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

- 25           (a) a registered trade mark, international trade mark (UK) or Community  
trade mark which has a date of application for registration earlier than  
that of the trade mark in question, taking account (where appropriate)  
of the priorities claimed in respect of the trade marks,
- 30           (b) .....

The first matter I consider is whether the applicant’s goods are identical or similar to those  
covered by the opponents registrations. In considering this matter I take account of the  
comments of Jacob J in the TREAT decision 1996 RPC 296 lines 31-46 and page 297 line 1-5  
which read as follows:-

- 35           “Thus I think the following factors must be relevant in considering whether there is or  
is not similarity:
- 40           (a) The respective uses of the respective goods;
- (b) The respective users of the respective goods;
- (c) The physical nature of the goods;
- 45           (d) The respective trade channels through which the goods reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively  
found or likely to be found in supermarkets and in particular whether they are,  
or are likely to be, found on the same or different shelves;

50

5 (f) The extent to which the respective goods are competitive. This enquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors”.

10 Insofar as the respective uses of the goods is concerned the opponents goods are for the direct application to the scalp for the treatment of the medical condition known as alopecia, or for use in that connection. The applicant’s goods are food supplements intended to be taken orally with the aim of increasing body weight. It seems to me that preparations for application to the skin for the treatment of a medical condition are not the same as preparations used as a  
15 food supplement with the aim of increasing body weight. I therefore conclude that the respective uses of the applicant’s and the opponents’ goods are different. The respective users of the goods could, of course, be the same people. I can well imagine that there may be individuals who wish to seek to change their physical appearance by seeking to treat their alopecia and at the same time increase their body weight. The respective users of the goods  
20 could therefore be the same.

The physical nature of the goods at issue in this case are, it seems to me, different. The preparation for the treatment of alopecia would appear to be available in liquid form and sold ‘over the counter’ in bottles; the shampoo also appears to be sold in liquid form in bottles or  
25 similar containers whereas the nutritional products of the applicant are all sold in powder form. Therefore, on the basis of the information before me the physical nature of the actual goods sold under the applicant’s trade mark is different from the physical nature of the opponents goods. However, I note that there is no restriction in respect of the specification attached to the application (or to the opponents’ registrations) such as to ensure that the  
30 physical nature of the respective goods will remain dissimilar.

It does not seem to me that either of the opponents goods or the applicant’s goods are ones which one would call ‘self-serve’ consumer items and even if they were, it is doubtful if they would be found on the same shelf of, or indeed in the same section of, any supermarket. It  
35 therefore follows that the respective goods are not in competition. Whilst it could be said that both the preparations for the treatment of alopecia and the nutritional products of the applicant are both intended to change and perhaps enhance the appearance of an individual it could hardly be said that one was in competition with the other. I therefore believe that the respective goods serve a very different purpose and although I have no evidence before me to  
40 suggest that the trade would classify the respective goods under similar headings.

In the light of my comments against the tests laid down by Mr Justice Jacob where I consider that there are significant differences between the uses of the respective goods, the physical nature of the goods and therefore their purpose, I have reached the view that, on balance, the  
45 goods the subject of this application for registration are not the same or similar to the goods covered by the opponents existing registrations.

In the event that my finding as regards similar goods might be held to be wrong I go on to compare the respective trade marks themselves and in doing so I take account of the guidance  
50 provided by Parker J. in PIANOTIST Co. Ltd’s application (1906) 23 RPC 774 page 777 lines 26 et seq which reads as follows:-

5 You must take the two words. You must judge of them, both by their look and by  
their sound. You must consider the goods to which they are to be applied. You must  
consider the nature and kind of customer who would be likely to buy those goods. In  
fact, you must consider all the surrounding circumstances; and you must further  
10 consider what is likely to happen if each of those trade marks is used in a normal way  
as a trade mark for the goods of the respective owners of the marks. If, considering all  
those circumstances, you come to the conclusion that there will be a confusion - that is  
to say, not necessarily that one man will be injured and the other will gain illicit benefit,  
but that there will be a confusion in the mind of the public which will lead to confusion  
15 in the goods - then you may refuse the registration, or rather you must refuse the  
registration in that case.

For ease of reference the respective trade marks are set out below:-

20	The Applicant's mark:	The Opponents' marks:
	PROGAIN	PREGAINE and REGAINE

25 Visually, I consider that there are significant differences between the applicant's trade mark  
and those of the opponents. First of all, the prefix is different in each case and the addition of  
the E at the end of the opponents trade marks has a significant visual impact. Therefore, a  
direct comparison of the trade marks would lead me to the view that they are not confusingly  
similar. However, I must also take into account imperfect recollection, see the ARISTOC  
LTD v RYSTA LTD case [1945] 62 RPC (page 72 line 46 to page 73 line 4)). In that respect  
30 I consider that the visual differences between the applicant's trade mark and the opponents  
REGAINE trade mark are such that even on the basis of imperfect recollection confusion  
between the two is unlikely to occur. However, the same does not apply in respect of the  
opponents other trade mark. I think that the visual differences between the applicant's trade  
mark PROGAIN and the opponents' PREGAINE trade mark are not sufficient to make it  
35 unlikely that confusion would not occur, on the basis of imperfect recollection.

40 Additionally, it appears to me that the pronunciation of the applicant's trade mark PROGAIN  
could be very similar to the pronunciation of the opponents trade mark PREGAINE. The first  
two letters of each are the same and each has the same suffix. Thus, the only difference in  
pronunciation results from the sound of a different vowel in each. This is not sufficient in my  
view to establish, that in oral use confusion will not occur between the applicant's trade mark  
and the opponents PREGAINE trade mark.

45 The same considerations do not apply to a comparison with the opponents trade mark  
REGAINE where the visual differences between that trade mark and the applicant's trade  
mark PROGAIN carry through into the pronunciation of the trade marks. The prefixes are  
visually and phonetically different, and have different meanings, (RE meaning 'about' and  
PRO meaning 'in favour of') added reasons to assume that they will not be pronounced the  
same. Thus I do not believe that confusion between these trade marks would occur even on  
50 the basis of imperfect recollection.

In summary, I find that the applicant's trade mark is not similar to the opponents REGAINE



5 mark but is similar to their PREGAINE trade mark. However, having already found that the goods covered by the applicant's trade mark are not the same or similar to the goods covered by the opponents registrations, I find that there does not exist any likelihood of confusion on the part of the public as between the applicant's trade mark PROGAIN and the opponent's registrations. I therefore dismiss the opposition based upon Section 5(2).

10

I turn now to consider the grounds of opposition based upon Section 5(3) of the Act. This provides for a trade mark which is identical with or similar to an earlier trade mark to be refused registration, even where the goods or services for which registration is sought are not similar to those for which the earlier trade mark is registered, and where the use of a later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark. The justification of this provision is presumably that a trade mark may become so well known in its own field that the use of an identical or similar mark in quite a different field could cause consumers, wrongly, to infer a trade connection - for example, to think that the owner of the earlier registered trade mark has diversified his activities, or has authorised someone else to use the trade mark. In this case, I have held that the goods covered by the application are not the same or similar to the goods covered by the opponents registrations and I note that this ground of objection can only apply in such circumstances. I must therefore consider whether the opponents' trade marks have such a reputation in the United Kingdom that applicant's trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of these earlier trade marks.

There are no established tests on which I can rely or to which I can refer for guidance. The question I must ask myself, therefore, is whether in use on the goods covered by the application the trade mark PROGAIN is likely to be detrimental to the distinctive character or reputation of the earlier trade marks.

First of all I do not consider that the level of use of a trade mark, by reference to the volume of sales, is the sole basis on which a judgement can be made as to whether or not a trade mark has a reputation, given the level of protection sought (and provided for) under Section 5(3) of the Act. For example, the volume of sales under a trade mark provides no indication of the total market for the goods (or services) concerned and therefore what those sales represent in terms of market share and therefore likely public recognition. Secondly, it is likely that a tribunal would wish to have before it some independent evidence from the trade or relevant consumers which sought to indicate or confirm that the reputation or public recognition claimed did exist in the trade mark and was such as to extend beyond the confines of the goods or services covered by the registration. Also, where possible or appropriate, there should be some fact or facts presented to support the claim that use by the other party is likely to be detrimental to the reputation of the registered trade marks.

45

In this case there has been no additional information supplied by the opponent in respect of the opposition based upon Section 5(3) other than turnover and advertising: I must therefore reach a view as best I can on what is available.

Clearly, the opponents have a reputation in their two trade marks in the United Kingdom. The volume of sales shown in the evidence for the goods sold under the trade marks confirms that

5 fact. It is also possible that the goods may be high profile in that baldness is a very important  
condition to a significant number of the public. That said, however, I am given no information  
about the market for the products and the share that the goods sold under the trade marks  
have obtained. Also, some of the goods sold under the registered trade marks are ‘over the  
10 counter’ preparations and goods sold under the trade mark REGAINE were available only on  
prescription for some time. Therefore the goods were not freely available for the whole  
period of user ie. they did not sit on a supermarket shelf where they could be seen and bought  
by the public at large. Nevertheless, the opponents have spent considerable sums of money on  
advertising but I am given no indication of where this took place e.g. in The Lancet to inform  
the medical profession or the national daily press to inform the public at large. Therefore, I  
15 have no basis on which to judge whether this advertising has contributed to the awareness of  
the trade marks in the minds of the public. Neither have I any independent evidence that the  
reputation of either the REGAINE or PREGAINE trade marks in relation to goods for the  
treatment of medical conditions of the scalp is such that either or both can be regarded as well  
known either by the public at large or a smaller or exclusive group which might, nevertheless,  
20 have come to regard the trade marks as well known.

On balance and on the basis of the limited information provided I do not consider that the  
claim by the opponents that their trade marks are well known is supported by the evidence  
before me. I go on, nevertheless, to consider whether the use by the applicant of his trade  
25 mark would take advantage of, or is likely to be detrimental to, the distinctive character of the  
opponents trade marks. The applicants PROGAIN trade mark, as I have already held, is not  
the same or similar to the opponents REGAINE trade mark but it is similar to the opponents  
PREGAINE trade mark. However, I do not consider that the applicant has taken advantage  
of the opponents trade marks in coining his trade mark nor do I consider that the applicant is  
30 going to use his trade mark on goods which are likely to cause offence to purchasers of goods  
under his own or anyone else’s trade mark. Similarly, I do not consider that registration of the  
applicant’s trade mark will effect the distinctiveness of the opponents registrations. In my  
view, the public will not associate the applicant’s trade mark with either of the opponents  
trade marks. In all of the circumstances, I do not believe that the use by the applicant of his  
35 trade mark does take advantage of, or is likely to be detrimental to, the opponents trade  
marks. The opposition based upon Section 5(3) is therefore dismissed.

Finally, I turn to the ground of opposition based upon Section 5(4). In order to determine  
whether the applicant would succeed in the passing off action I take account of the comments  
40 of Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd v Borden Inc. and others  
[1990] RPC 406 in which he stated in order to succeed in a passing off action a party must be  
able to show that it has a reputation in the trade mark at issue; that use of the trade mark by  
the other party would be likely to deceive or confuse the public and that the use of the trade  
mark by the other party would be likely to damage the owners business and goodwill.  
45

These are onerous requirements which I do not believe are fully satisfied in this case. An  
indication has been given of the level of sales and advertising which establishes that the  
opponents have a reputation in the United Kingdom in two trade marks for preparations for  
the treatment of alopecia. However, I have already held that use by the applicant of his trade  
50 mark on the goods covered by the application will neither confuse or deceive the public

5 because these are not the same as or similar to the goods of the opponent. There is no indication, particularly given my findings above, that there would be any damage to the opponents business. In the circumstances the opposition based upon Section 5(4) of the Act fails.

10 Having found that the opposition fails on all counts I order the opponent to pay to the applicant the sum of £600 as a contribution to his costs.

**Dated this 29 day of January 1998**

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25 **M KNIGHT**  
**For the Comptroller General**