

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application**

**No 2046913 by The Boots Company PLC**

5 **to register a trade mark in Class 5**

**AND IN THE MATTER OF Opposition thereto**

**by Sandoz Limited under No 45494**

10 **DECISION**

On 30 November 1995, The Boots Co. Plc applied for registration of the trade mark ALLERFREE in respect of pharmaceuticals preparations and substances in Class 5.

15 On 26 September 1996, Sandoz Ltd of Switzerland filed notice of opposition. The grounds of opposition are as follows:-

(i) The trade mark applied for is similar to earlier registered trade mark ALLER-EZE which is registered in respect of identical goods in the name of the  
20 opponent. Registration of the applicant's mark would therefore be contrary to Section 5(2) of the Trade Marks Act 1994 because use of the mark applied for would be likely to cause confusion.

(ii) By virtue of the opponent's use of the trade mark ALLER-EZE, registration of  
25 the trade mark ALLERFREE would be contrary to Section 5(4) of the Trade Marks Act 1994.

(iii) The application should be refused in the exercise of the Registrar's judgement  
and/or discretion.

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The Registrar has no discretion under the new law to refuse an application which meets the

requirements for registration. The only admissible grounds of opposition are therefore under Sections 5(2) and 5(4) of the Act.

The applicant denies these grounds of opposition. Both sides ask for an award of costs.

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The matter came to be heard on 8 January 1999 when the applicant was represented by Mr R A Blum of Gill Jennings and Every, Trade Mark Agents, and the opponent was represented by Ms Margaret Morris of Boots Trade Mark Department.

10 The opponent's evidence takes the form of a statutory declaration dated 6 May 1997 by Christopher Kelly who is the company secretary of Intercare Products Ltd, a wholly owned subsidiary of the opponent. Mr Kelly states that the opponent is now known as Novartis AG following a merger between Sandoz Ltd and Ciba-Geigy AG. Mr Kelly says that the opponent has a reputation under the mark ALLER-EZE gained by long usage. In Mr Kelly's opinion  
15 this reputation adds to the likelihood of confusion on the part of the public. Mr Kelly explains that the trade mark ALLER-EZE has been used as a trade mark by Intercare Products Ltd, as permitted users of Sandoz Ltd, since 1984. He provides sales figures for each of the years from 1984 through to 1996. These show that in every year since 1985 (bar one), the  
20 ALLER-EZE. The average sales were around £600,000 per annum.

Exhibit B to Mr Kelly's declaration consists of samples of packaging showing how the mark is used. It is evident from this that the mark has been used in relation to a pharmaceutical product which is intended to treat people who suffer from allergies. Mr Kelly also provides  
25 figures for annual advertising expenditure for the ALLER-EZE product. These figures indicate that the opponent spent £170,000 promoting goods under the trade mark in 1993. In 1994 this figure rose to £491,000 before dropping back to £328,000 in 1995. Mr Kelly continues:-

30 "Attached hereto and marked Exhibit C is a page from the February 1997 Chemist & Druggist price list. From perusal of this page it will be seen that there are only three

product lines employing trade marks with the prefix ALLER-. One is the range of ALLER-EZE pharmaceutical products, the second is the ALLERAYDE range, which is a range of anti-allergy bedding articles, and the third is the ALLERGAN range of lens care products. Thus ALLER-EZE is currently the only ALLER- prefix trade mark used for pharmaceutical products for the control of allergy.

Finally I must add that the ALLER-EZE products are sold over the counter without a doctor's prescription hence the chance of confusion is greater."

10 The applicant's evidence takes the form of a statutory declaration dated 12 August 1997 by Ian Alexander Hawtin, who is the company secretary of The Boots Company Plc. Mr Hawtin provides evidence of 23 other registrations of trade marks in Class 5 with the prefix ALLER-. However, the most relevant parts of his evidence are as follows:-

15 "The use of the same prefix by different manufacturers for over-the-counter (OTC) pharmaceutical products is common. There is now shown to me and marked "IAH1" copies of pages from The Guide to OTC Medicines of April 1997 showing the co-existence of products within the same therapeutic categories with the prefixes:

20           INFA  
              MIGRA  
              PARA  
              IBU  
              REGU  
25           SEN

MIGRA is a particularly relevant example, as this prefix denotes a strong link with migraine as ALLER does with allergy.

30 These examples show that when purchasing over-the-counter medicines, customers can distinguish between products even though the trade marks may contain a common

syllable. They do this with or without the assistance of pharmacy staff, despite the fact that products may have the different active ingredients."

5 Mr Hawtin accepts that the opponent has used the trade mark ALLER-EZE and that it is recognised by a "small but significant proportion of the public."

That concludes my review of the relevant evidence.

10 I will deal first of all for the ground of opposition under Section 5(2) of the Act. Section 5(2) gives effect to the provisions of Article 4(1)(b) of Council Directive No 89/104EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks. It provides that:-

"A trade mark shall not be registered if because -

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(a) it is identical with an earlier trade mark and is to registered for goods or services similar to those which the earlier trade mark is protected, or

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(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."

25 The correct approach to the interpretation of the expression "a likelihood of confusion on the part of the public" as used in Article 4(1)(b) and Section 5(2) was considered by the European Court of Justice in case C/251/95 Sabel BV v Puma AG (1998) RPC 199. The way in which the presence or absence of a "likelihood of confusion" should be assessed was identified in paragraphs 23 and 24 of the Judgment of the Court as follows:

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"The likelihood of confusion must therefore be appreciated globally, taking account of

all factors relevant to the circumstances of the case. That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - 'there exists a likelihood of confusion on the part of the public' shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. In that perspective, the more distinctive the earlier mark the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public."

Both marks are registered or proposed to be registered for pharmaceutical preparations. The likelihood of confusion therefore falls to be determined primarily by reference to the similarity of the marks, taking account of any evidence of reputation of the earlier trade mark and any other relevant factors. Before me, Mr Blum, who appeared for the opponent, argued that:

- (i) there is an overall similarity between the marks at issue both to the eye and to the ear;
- (ii) both marks consist of a prefix which was recognisable as a shortening of the word allergy and a suffix which describes or alludes to the relief of symptoms - there was therefore a strong conceptual similarity between the marks;
- (iii) bearing in mind that the goods at issue were over-the-counter products, there was a real risk of confusion through imperfect recollection of the earlier trade mark (in this respect I was referred to the INADINE case 1992 RPC 421);

(iv) the state of the register was not relevant except to the extent that there was evidence of use in the marketplace of other trade marks with similar characteristics;

5 (v) the applicant's mark was "stealing the idea" of the earlier trade mark and even if the applicant's primary contention that there was a likelihood of confusion of the public was wrong, the public would nevertheless associate the two marks and view the later trade mark as the Boots version of the established product.

10 For her part Ms Morris contended that:

(i) the mark ALLER-EZE is not a highly distinctive one, but is composed of a combination of elements which allude to the nature of the goods;

15 (ii) the prefix ALLER has a high degree of descriptiveness for anti-allergy preparations;

(iii) the opponent cannot claim any monopoly in this prefix - numerous marks are registered for goods including anti-allergy preparations and could legitimately  
20 be put into use on them;

(iv) the public are used to distinguishing between OTC medicines with an identical prefix indicating a therapeutic property;

25 (v) the opponent has shown use of their mark but has not produced any evidence of a likelihood of confusion;

(vi) in terms of the overall visual similarity of the marks the presence of a hyphen in  
30 the earlier mark will help to avoid any confusion with the later mark.

In the Sabel judgement (referred to above) the European Court of Justice held that:-

5           “The criterion of likelihood of confusion `which includes the likelihood of association with the earlier mark’ contained in Article 4(1)(b)..... is to be interpreted as meaning that the mere association which the public might make between two trade mark as a result of their analogous semantic content is not, in itself, a sufficient ground for concluding that there is a likelihood or confusion within the meaning of that provision”.

10       In the light of that judgement it appears to me that the applicant’s secondary concern, that the public may associate the marks in the sense of viewing the applicant’s mark as the Boots ‘own brand’ version of the opponent’s product, is irrelevant. It is clear that the opponent can only succeed under Section 5(2) of the Act if they could show that there is a likelihood of either direct confusion between the marks or ‘association’ arising from a mistaken belief that the  
15       respective marks, although different, indicate goods with a common trade origin.

          It was well established under the old law that the presence of other similar marks on the register was of no assistance to either party in an opposition unless there was evidence that some of those marks were in use (see Beck, Koller and Co. Ltd’s Application 1947 64 RPC  
20       76). I have no doubt that the position is the same under the new law. The only evidence of use in the marketplace of trade marks with a ALLER- prefix comes from the copy of a page from the February 1987 edition of Chemist and Druggist exhibited to Mr Kelly’s declaration. This suggests that ALLER-EZE was, at that date, one of only three trade marks in use in the UK with a prefix ALLER. It appears to have been the only one in use on products for the  
25       treatment of allergies. At the hearing, Ms Morris accepted that the list in question was an accurate source of information relating to trade marks in use in the UK for pharmaceutical products available through the wholesale market. It was pointed out however, that the list did not include those trade marks that were in commercial use on ‘own brand’ products. I am therefore prepared to accept that, with the possible exception of ‘own brand’ products, the  
30       opponent’s trade mark was the only mark in use in the UK, in February 1997, with the prefix ALLER, on pharmaceutical products for the relief of allergy symptoms. There is nothing to

suggest that the position would have been any different at the date of application.

In support of the proposition that the opponent's mark was only entitled to a small penumbra of protection, Ms Morris referred me to the judgement of Millett L. J in the Court of Appeal  
5 in relation to a case concerning *The European Limited v Economist Newspapers Limited*  
1998 FSR at 283. The gist of this judgement can be gleaned from the following sentence of  
Millett L.J.'s judgement on page 290:

10 "The more descriptive and the less distinctive the major feature of the mark, the less  
likelihood of confusion."

The marks at issue in that case were, on the one hand, the words THE EUROPEAN together  
with a mast head, and on the other hand, the words EUROPEAN VOICE. The goods at issue  
were printed publications for which the word EUROPEAN is, of course, highly descriptive. It  
15 appears to me that the marks at issue in this case can be distinguished from those before the  
Court of Appeal because the prefix ALLER, whilst obviously alluding to the nature of the  
goods, is not wholly descriptive in the same way as the word 'European'. And secondly, and  
perhaps more importantly, the opponent's case is not based simply upon the fact that the  
respective marks share the common element ALLER. Mr Blum made it clear that the  
20 opponent did not regard some of the other marks in use with an ALLER prefix as confusingly  
similar. He acknowledged that the opponent could have no complaint about the use of a mark  
such as ALLERGAN.

Even though the ALLER prefix of the opponent's mark cannot be regarded as wholly  
25 descriptive, nor can it be regarded as entirely arbitrary. Notwithstanding the evidence that it is  
the only mark in use in the UK with that prefix for allergy relief preparations, the presence  
of the common prefix ALLER would not, in itself, be sufficient to give rise to a likelihood  
of confusion. And, of course, the opponent can have no cause for complaint simply because  
another mark alludes to the relief of allergy symptoms.

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Nevertheless, I have come to the view that the combination of:

1. The common prefix ALLER;
2. The suffix of both marks consisting of a word (or in the case of EZE, an obvious misspelling of a word) which alludes to the relief of symptoms;
3. The marks being of similar length and both containing two letters E within the last three letters, including in both cases the final letter;

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- results in marks which are likely to create a similar overall impression in the mind of the average consumer of the goods.

I also bear in mind that the earlier trade mark has been in use in the UK for a substantial period of time and (as the applicant accepts) is likely to be known to a significant proportion of the relevant public. I have also taken account of the fact that both specifications (and the goods in respect of which the marks have actually been used or are proposed to be used) cover over-the-counter medicines including those which are bought for the relief of allergy symptoms. By their nature, such products are likely to be purchased intermittently.

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I accept that it is unlikely that an average consumer of the products with both trade marks before him or her (or with a clear recollection of the earlier mark) is likely to be confused. However, it was well established under the old law that allowance should be made for imperfect recollection of the earlier trade mark. I think that this approach is still valid under the new law. I find support for this proposition in the judgement of the European Court of Justice in the Sabel case referred to above. In particular, the guidance that the question of confusion must be based on the 'overall impression' given by the respective marks suggests that the average consumer of the products in question should not be assumed to have a photographic recollection of the earlier trade mark at the time he or she encounters the later mark. Because the marks create such a similar overall impression, it appears to me that the average consumer of this type of product, who has previously come across the opponent's

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mark and subsequently, at a later date, comes across the applicant's mark, could easily be forgiven for mistakenly believing that the product encountered on the later occasion is the same one that was encountered before. Taking account of all the relevant circumstances, I believe that there is a likelihood of confusion.

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I do not consider that the applicant's position would be any stronger if (somewhat artificially) the marks are considered in respect of goods within their respective specifications which are not anti-allergy products. For such goods the ALLER prefix would probably be wholly arbitrary and the visual similarities therefore even more likely to lead to confusion. For these reasons I find that the opposition under Section 5(2)(b) of the Act is successful.

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In the light of that finding I see no need to consider the further ground of opposition under Section 5(4) of the Act. Having taken account of the use of the earlier trade mark in my consideration under Section 5(2) of the Act, the result under Section 5(4) was unlikely to be any different.

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The opposition having succeeded the opponent is entitled to a contribution towards its costs, I therefore order the applicant to pay the opponent the sum of £750.

20 **Dated this 5 day of February 1999**

**ALLAN JAMES**

25 **for the Registrar**

**The Comptroller General**

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