

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2167713
BY JOHNSON & JOHNSON
TO REGISTER THE TRADE MARK CALCIMILK
IN CLASS 29**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 49112 BY UNIGATE DAIRIES LIMITED**

TRADE MARKS ACT 1994
IN THE MATTER OF Application No 2167713 by Johnson & Johnson
to register the trade mark CALCIMILK in class 29
and

5 **IN THE MATTER OF Opposition thereto under No 49112**
by Unigate Dairies Limited

Background

10 1. On 26 May 1998 Johnson & Johnson of New Brunswick, New Jersey, USA applied to register the trade mark **CALCIMILK** for the following goods:

class 29: lactose enzyme dairy products.

15 2. On 22 October 1998 UNIGATE DAIRIES LIMITED of London filed notice of opposition to this application.

20 3. The opponents state that they are the registered proprietors of United Kingdom registration no 1277706 of the trade mark **CALCIA** which is registered in respect of "milk and milk products; edible oils and fats; dairy products; all included in class 29". They state that their trade mark enjoys a substantial and significant reputation in the United Kingdom.

25 4. The opponents claim that the respective trade marks are similar and encompass identical or similar goods; consequently registration of the application in suit would be contrary to Section 5(2) of the Act. The opponents claim that use of the application in suit is liable to be prevented by the law of passing off; consequently registration of the application in suit would be contrary to Section 5(4)(a) of the Act. The opponents claim that insofar as the goods encompassed by the respective trade marks are dissimilar use of the application in suit would take unfair advantage of, or be detrimental to the distinctive character or repute of the earlier trade mark; consequently
30 registration of the application in suit would be contrary to Section 5(3) of the Act. The opponents claim that the application in suit was made in bad faith and so its registration would be contrary to Section 3(6) of the Act. They request that the application in suit should be refused and that an award of costs be made in their favour.

35 5. The applicants filed a counterstatement denying the above grounds.

6. Both parties filed evidence. They both agreed that a decision could be made on the basis of the papers filed. Consequently a decision will be taken from a careful study of the papers.

40 7. Acting on behalf of the Registrar I duly give the following decision.

Opponents' evidence

45 8. The opponents' evidence consists of a statutory declaration dated 3 March 2000 by John Adsell, who is the Commercial Director of the opponents.

9. Mr Adsell states that the trade mark **CALCIA** has been in use since February 1987 in respect

of calcium enriched milk. He states that the product is sold through both the opponents' milk rounds and through third parties. He states that the turnover figures of the previous three years were:

5	1996/97	15,600 litres
	1997/98	23,844 litres
	1998/99	17,727 litres

He states that gross sales of the product in those years were:

10	1996/97	£1,404,000
	1997/98	£2,145,960
	1998/99	£1,595,430

15 10. Mr Adsell is unable to give figures for promotional and advertising expenditure in relation to goods sold under the opponents' trade mark.

11. Mr Adsell states that the product is unique and that he is not aware of any other calcium fortified milk on the United Kingdom market.

20 **Applicants' evidence**

12. The applicants' evidence consists of a statutory declaration dated 25 October 1999 by Michael J. Ryan Jr, who is the applicants' Assistant Secretary.

25 13. Mr Ryan states that in August 1996 the opponents' acquired the business of Lactaid, Inc. He states that Lactaid Inc. is the proprietor of the lapsed United Kingdom registration no 1257066 of the trade mark CALCIMILK. He states that registration no 1257066 has an earlier filing date than the opponents' registration and that it co-existed upon the Register with the
30 opponent's trade mark until 15 July 1994 when it lapsed. He states that by acquisition of Lactaid, Inc. the opponent has a clear entitlement to claim proprietorship of the trade mark CALCIMILK and he, therefore, denies the allegation that the application was made in bad faith.

35 14. Mr Ryan states that the Registry did not cite any of the respective trade marks against one another and, therefore, he is advised that the Registrar does not consider them confusingly similar.

40 15. Mr Ryan states that the prefix "CALCI" is a clear and obvious reference to the word "calcium". He states that this is demonstrated by the meanings of the words calciferous, calcify, calcine and calcite. He states that because of the descriptive nature of the prefix "CALCI" he does not consider that one trader can monopolise it.

45 16. Mr Ryan also states that in comparing the respective trade marks in their entirety he does not consider that they are similar.

Opponents' evidence in reply

17. The opponents' evidence in reply consists of a statutory declaration dated 28 April 2000 by Iain Charles Bremner, who is the Technical Information Manager of the Unigate Group of Companies.

18. Mr Bremner states that he consulted the following data bases:

- Food science and technology articles ("FROSTI")
- Food marketing data ("FOMAD")
- New United Kingdom product launches and imports ("FLAIRS")
- UK news items from non-scientific and non-trade newspapers and magazines ("FOSCAN").

18. He states that he conducted a search of the above data bases with the aim of ascertaining whether they contained any information about the marketing of CALCIMILK, and whether there were any milk, milk drinks or other beverages distributed in the United Kingdom (apart from the opponents' trade mark CALCIA) being marketed under a name which comprised or incorporated the name CALCIA or CALCI or a derivative of either.

19. My Bremner states that as the result of his search he could find no use of CALCIMILK within the United Kingdom. He also states that he can find no use of CALCIA or CALCI within the United Kingdom in relation to milk, milk drinks or other beverages, other than that by the opponents.

Applicants' submissions

20. The applicants state that the evidence filed by both parties indicates that the prefix "CALCI" designates the substance calcium. Consequently, they do not consider that "CALCI-" can be monopolised by any one trader. They contend, therefore, that the respective trade marks are not similar.

21. The applicants question whether the sales of the CALCIA product are substantial, taking into account the volume of milk sales within the United Kingdom. They also observe that the only evidence of promotion of the trade mark is an announcement of the opponents' in-house magazine concerning the launch of the CALCIA product in 1987. The applicants state that they contend that the evidence of the opponents substantiates that the latter's trade mark enjoys a reputation as claimed.

22. The applicants also submit that the packaging example supplied by the opponents shows that the trade mark CALCIA is used in conjunction with the Unigate house mark. They contend, therefore, that the opponents have not demonstrated any reputation in the trade mark CALCIA simpliciter.

23. The applicants again deny the accusation that the application in suit was made in bad faith and also comment that the respective trade marks previously co-existed on the United Kingdom Trade Marks Register.

5 **Decision**

24. The grounds of opposition pursued by the opponents are those under sections 5(2), 5(3) 5(4)(a) and 3(6) of the Trade Marks Act 1994. The relevant provisions read as follows:

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

Section 5:

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

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

20 (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 (3) A trade mark which -

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

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

35 (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-

(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....

40 25. The term 'earlier trade mark' is defined in section 6 of the Act as follows:

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

45 (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."

26. I will consider now the opponents' ground of opposition under section 5(2). The respective trade marks are not identical, therefore, this ground of opposition needs must be under section 5(2)(b).

5 In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

10 (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;

15 (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.

20 (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;

25 (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;

30 (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;

35 (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;

40 (h) further, 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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;

45 (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

27. In the instant case “lactose enzyme dairy products” of the application in suit are specific dairy products so must be included in the general term “dairy products” of the earlier registration. The respective goods are, therefore, identical.

5 28. The trade marks to be compared are:

Earlier registration:

Application in suit:

CALCIA

CALCIMILK

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Both trade marks commence with CALCI. The parties have argued as to the significance/weight that should be given to this element. The applicant has argued that this element is effectively acting as a descriptor of the goods - goods that include calcium. No argument has been put forward that the goods encompassed by the respective specifications could not include calcium. Indeed the actual use of the earlier registration demonstrates that it has been used in relation to milk with added calcium. The opponents have argued that their product is unique - that there is no calcium fortified milk upon the market. Even if this were the case it would not per se negate the descriptive nature of CALCI. In fact the opponents’ evidence in reply contradicts this assertion. In exhibit IB2, for example the following extract from the FOMAD data base is present:

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“The first speciality products to be developed tended to be those containing extra calcium, such as Calcia from Unigate and Vital from Express Dairies..”

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In another reference from the FOMAD data base the following is stated:

“both Express and Unigate dairies are launching a new type of milk. The new milks are both calcium enriched”

30

There are other references to calcium enriched milks which are not the goods of the opponents in the exhibits to the evidence in reply.

I, therefore, discount the claim that the opponents’ product is unique within the United Kingdom.

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The applicants have based their argument that CALCI is a non-distinctive element upon the basis that various dictionary words which relate to calcium begin with these words i.e. calciferous, calcify, calcine and calcite.

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The opponents counter by furnishing evidence to demonstrate that CALCI is not a beginning that is actually used as parts of trade marks in relation to the relevant goods. I have no reason not to accept the validity of the evidence that has been presented in relation to this matter.

45

That CALCI is not used in other trade marks is not proof that it would not bring to the mind of the average consumer calcium. I consider that calcium is an element that is widely known to the public and that its dietary importance is also well know. I assume, after all, that it is because of its well known dietary importance that the opponents and others produce calcium enriched products. Taking into account the nature of the respective goods, and this must take into account

the full spectrum of the opponents' specification - not just the goods upon which it is used - I am of the opinion that the average consumer is very likely to relate the beginning of the word to calcium.

5 In a comparison of the respective trade marks it is necessary to consider them in their entirety. The MILK element of the application in suit is of itself not a distinctive element. However, consumers do not normally indulge in the salami slicing approach to trade marks. They see them in their entirety. The CALCI element will bring to mind calcium, I believe, and consequently the consumer is likely to rely upon what may be considered small differences to differentiate
10 between products which could contain calcium. Visually and phonetically the respective trade marks in their entirety have obvious differences at their ends. I, of course, in considering the respective trade marks, take into account that the beginnings of words are usually more important than the endings, in terms of public recognition and recall (*Tripcastroid 42 RPC 264 at page 279*).

15 However, it is also necessary to consider normal and fair use of the opponents' trade mark. This, of course relates to such use of the trade mark as registered; not any actual use that has been demonstrated. The trade mark CALCIA is clearly used in relation to milk. The specification of the registration includes milk. The goods of the application in suit encompass milk and milk
20 products. I can readily envisage that in oral use, and perhaps in written use - the shopping list, the note left for the milkman - that the consumer will refer to CALCIA milk. Clearly in such a context the respective trade marks are very similar. Indeed it would require the most circumspect of consumers to differentiate between the respective trade marks in such use. It is difficult to envisage how, even taking into account the weakness of the CALCI element, that in such a
25 context that the respective trade marks could be considered not to be similar.

I consider, therefore, taking all factors into account, that the respective trade marks are similar. I have already decided that identical goods are involved. I must, therefore, find that there is a likelihood of confusion and the objection under Section 5(2)(b) is upheld.

30 29. I note that the applicants have based part of their denial of the allegations of the opponents on the basis that the respective trade marks previously co-existed on the Register. That two trade marks co-exist upon the Register proves very little other than that simple fact. If the applicants had shown that the respective trade marks had co-existed in the market place that could have a bearing on the situation. They have not done so. Consequently, the previous co-existence of the
35 trade marks upon the Register has had no influence on my consideration of the issues.

30. The opponents have claimed a reputation in respect of their earlier registration. Recognition of a trade mark can effect the issue of whether there is a likelihood of confusion. In the instant
40 case recognition will not affect the issue, as I have already found for the opponents. However, I will briefly comment on the evidence furnished in relation to the reputation.

The opponents have failed to supply any specific information in relation to the promotion of the trade mark. The only promotional use shown is from an in-house news letter; something by its
45 nature of which the public would not be aware. The figures for sales in 1998/1999 would for the most part post-date the date of filing of the application in suit. The actual volume of sales would not appear to be very great. No context is given to these figures as the opponents have not

advised of the sales volume of the milk market as a whole. However, taking into account that milk is a staple it is difficult to envisage that 15,600 or 23,844 litres per annum represents a great deal. It is also noted that the evidence shows use of the trade mark CALCIA in conjunction with the house mark Unigate. It is readily accepted that a brand name is often used in conjunction with a house mark. But if the opponents are claiming a reputation there is an onus upon them to demonstrate that the brand name simpliciter enjoys a reputation. Taking into account all the evidence presented I do not consider that it demonstrates that the trade mark CALCIA either enjoys recognition with the relevant public or a reputation. (It is also to be noted again that the evidence only shows use in relation to calcium enriched milk and not in relation to the whole gamut of the specification of the registration).

29 As the opponents have not established a reputation for the earlier registration the grounds of opposition under Section 5(3) must be dismissed. If the opponents had proved a reputation it would have been in respect of similar goods, all the evidence relates to calcium enriched milk, and so this ground of opposition would again fall.

30. I turn now to the grounds of opposition under Section 5(4)(a). I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case (1998) 14 RPC 455*. In that decision Mr Hobbs stated that:

"The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art. 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off".

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc [1990] RPC 341* and *Erven Warnink BV v J Townend & Sons (Hull) Ltd [1979] ACT 731* is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

31. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC.

5 It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed". the relevant date is therefore the date of the filing of the application in suit.

10 32. Misrepresentation is an essential component of the tort of passing off. This depends upon confusion and deception brought about by the use or proposed use of an indicia adopted by a defendant (in this case, applicants). I have already considered the likelihood of confusion in my findings under Section 5(2)(b). The opponents are in no better position under Section 5(4)(a) and cannot succeed to a greater extent. Consequently I need say no more about it.

15 33. I turn finally to the grounds of opposition under Section 3(6). The opponents have put forward neither argument nor evidence to substantiate their claim that the application in suit was made in bad faith. Consequently, as I have nothing before me to support or even explain the basis of this ground of opposition it must be dismissed.

20 33. As a result of the decision in relation to Section 5(2)(b) the opposition is upheld in respect of all the goods encompassed by the specification of the application in suit.

25 34. The opponents are entitled to a contribution towards their costs and I therefore order the applicants to pay them the sum of £635. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7 day of September 2001

30 **D.W.Landau**
For the Registrar
the Comptroller-General