

TRADE MARKS ACT 1994
and
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF APPLICATION NO M684466
IN THE NAME OF DR ROBERT WINZER PHARMA GMBH

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 70073 IN THE NAME OF
ALCON PHARMACEUTICALS LIMITED

**TRADE MARKS ACT 1994 and
The Trade Marks (International Registration) Order 1996**

**IN THE MATTER OF application No M684466
in the name of Dr Robert Winzer Pharma GmbH**

And

**IN THE MATTER OF opposition thereto under No 70073
in the name of Alcon Pharmaceuticals Limited**

Background

On 4 November 1997, Dr Robert Winzer Pharma GmbH registered the trade mark HPMC - Ophtal under the Madrid Union, designating the United Kingdom as a country to which protection was sought to be extended.

The trade mark is protected in Class 5 in respect of the following goods:

Pharmaceutical products.

On 3 September 1998, Alcon Pharmaceuticals Limited filed notice of opposition to this application. The grounds of opposition are in summary:

- 1. Under Section 1 & 3(1)(a)&(b)** Because the mark applied for does not satisfy the requirements of these sections of the Act and is devoid of any distinctive character as a whole.
- 2. Under Section 3(1)(c)** Because the mark applied for consists exclusively of signs or indications which may serve in the trade to designate the kind, quality or other characteristics of the goods specified.
- 3. Under Section 3(1)(d)** Because the mark applied for consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.
- 4. Under Section 3(4)** Because the mark does not comply with this section of the Act and its use would be prohibited by rule of law.
- 5. Under Section 3(6)** Because the application was made in bad faith.

The applicants filed a Counterstatement in which they admit that in the relevant trade sector, HPMC is an acronym for Hydroxypropylmethylcellulose. They deny all of the grounds on which the opposition is based.

Both sides request that costs be awarded in their favour.

Both sides filed evidence in these proceedings. The matter came to be heard on 5 March 2001, when the applicants were represented by Ms Jacqueline Reid of Counsel, instructed by Kilburn & Strode, their trade mark attorneys, the opponents filed written submissions in lieu of attending.

Opponent's evidence

This consists of a Statutory Declaration dated 2 March 1999, and comes from Guido Koller, General Manager of Alcon Pharmaceuticals Limited, a position he has held for five years. Mr Koller confirms that he is authorised to make the declaration and that he is readily conversant with the English language.

Mr Koller begins by noting that in their counterstatement the applicants accept that HMPC is an acronym for Hydroxypropylmethylcellulose (which Mr Koller says is itself a generic pharmaceutical name) and is used in the relevant trade sector, which he interprets to mean that the applicants are admitting that the acronym HPMC is descriptive of, and non-distinctive for products consisting of or containing Hydroxypropylmethylcellulose. Mr Koller goes on to assert that by virtue of its positioning at the beginning of the mark, that it is in capitals and separated from the other element, that the element HPMC is arguably the essential feature of the applicant's mark.

Mr Koller goes on to refer to exhibit APL1 which consists of printed matter which clearly establishes that HPMC is used as an acronym for Hydroxypropylmethylcellulose in relation to ophthalmic/pharmaceutical preparations, and was so well before the relevant date in these proceedings. As the applicants have already admitted this to be the case I see no need to summarise the exhibit in detail.

Mr Koller next goes to the element consisting of the word OPHTAL, which he says is virtually identical and confusingly similar to the word OPHTHAL and a clear and direct reference to, or an abbreviation of ophthalmology, or other ophthal prefixed dictionary terms relating to the eye. He gives his reasons why OPHTAL and OPHTHAL are likely to be confused, namely, the difficulty in their spelling, that OPHTAL means OPHTHAL and is the standard prefix for words concerning ophthalmology in the French language. Mr Koller refers to exhibit APL2 which consists of extracts from reference works detailing French words having OPHTAL and English words having OPHTHAL as a prefix but in neither case as a word or abbreviation in its own right. He gives his view as to what he considers the mark as a whole to mean, drawing the conclusion and that it consists entirely of signs or indications which serve in the trade to designate the goods of the application.

Mr Koller refers to the applicant's claim to have used the mark within the United Kingdom pharmaceutical trade, commenting on the opponent's lack of any knowledge of their products,

and that the use in any event is insufficient to have given the mark a secondary meaning. He refers to the trade marks detailed in the applicant's counterstatement dismissing these as irrelevant because they are different in their presentation and degree of descriptiveness. Mr Koller explains that the allegation of bad faith (Section 3(6)) is based on the premise that the applicants are attempting to unlawfully monopolise descriptive or generic terms, and that they do not have a bona fide intention of using the mark on all of the goods covered by the application.

Mr Koller goes on to say that the bringing together of two descriptive elements does not create an invented word or conjure up any new meaning. He says the mark clearly refers to ophthalmological products containing HPMC which is the extent of the intended use by the applicants, and that use in relation to any other goods would in any event cause deception. Mr Koller concludes his declaration by summarising the opponent's conclusions on the mark and the likely consequences should the application be registered.

Applicant's evidence

This consists of a Statutory Declaration dated 17 June 1999 and comes from Gary Holt, Managing Director of Vision.net Limited, a position he has held since 1996. He confirms that he has access to the records of the company, and that the contents of his declaration come either from these records or from his own knowledge.

Mr Holt says that his company is the United Kingdom distributor of the ophthalmological product known as HPMC-Ophtal, sales of which commenced in January 1997. He describes the product, confirming that it is used as an intra ocular injection to aid surgery and is available in two form; HPMC-Ophtal H and HPMC-Ophtal L. Exhibit GH1 consists of product profiles for both versions and a copy of the packaging for HPMC-Ophtal L.

Mr Holt lists the locations within the United Kingdom where the HPMC-Ophtal product has been sold. He gives details of the turnover/unit sales for the years 1997 through to 1999, and the events at which his company has promoted HPMC-Ophtal. Mr Holt says that promotion has also been through mailings to, and interviews with, medical practitioners specialising in ophthalmology.

Mr Holt comments on the mark applied for, saying that it is his belief that HPMC is the standard abbreviation within the pharmaceutical trade for Hydroxypropylmethylcellulose, and as such is descriptive of this chemical compound. He goes on to say that the mark derives its distinctiveness from the suffix OPHTAL and gives the reasons why he considers this element to be the most striking part of the mark, inter alia, referring to 6 registrations that his company has obtained for marks incorporating OPHTAL as a suffix separated by a hyphen from a descriptive element. Mr Holt explains the meanings of each of the descriptive elements although does not provide any corroborative evidence. Details of the registrations are shown as exhibit GH2.

Mr Holt challenges the assertion by Mr Koller that OPHTAL is a clear and direct reference to, or an abbreviation of ophthalmology or related terms, commenting that none of the reference works shown in exhibit APL2 or any of the other evidence actually relates to OPHTAL. He

refers to the applicant's registration for OPHTAL and HPMC-Ophtal obtained in Germany, details of which are shown in exhibit GH2, and to examples of the use made of the marks in that country, sales of OPHTAL commencing in 1996, and HPMC-OPHTAL in 1997. Mr Holt goes on to refer to tab 5 of exhibit GH2 which consists of two decisions issued by the French Patent Office (the decisions are in French and no translation provided), and to exhibit GH3 which consists of a schedule and registration documents relating to registrations obtained by the applicants in countries (other than the United Kingdom) for marks incorporating OPHTAL.

Mr Holt says that the distinctiveness of OPHTAL is further proven by the applicants having obtained two Community Trade Mark registrations for the marks OPHTAL, HPMC-Ophtal and HYA-Ophtal in Class 5. Details of these registrations are shown at tab 8 of exhibit GH2. He refutes the assertion that the applicants are seeking to monopolise HPMC and is only trying to register a mark which is a member of their "OPHTAL" family of marks and which they have legitimately used. He concludes his declaration by asserting his belief that the distinctive element OPHTAL is capable of distinguishing the applicant's goods.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

In their written submissions sent in lieu of attending the hearing, the opponents withdrew the ground under Section 3(6). That leaves the grounds as being under Section 1(1), Section 3(1)(a)(b)(c) & (d) and Section 3(4). Turning first to the grounds under Section 1(1) and Sections 3(1)(a), (b), (c) and (d) of the Act. Those sections read as follows:

- 3.(1)** The following shall not be registered -
- (a) signs which do not satisfy the requirements of section 1(1),
 - (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 rendering of services, or other characteristics of goods or services,
 - (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

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.

Section 1(1) in turn reads:

1-(1) In this Act “trade mark” means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

There is no suggestion that the mark is not represented graphically so the objection relates to the inherent capacity of the mark to distinguish the applicants' goods. In this respect I have regard to *Canon Kabushiki Kaisha v Metro-Goldwyn -Mayer Inc* (1999) FSR 332 in which it was said:

“...according to the settled case-law of the court, the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all goods bearing it have originated under the control of a single undertaking which is responsible for their quality.”

I begin by looking at how the law stands. In the case of *Phillips Electronics NV v Remington Consumer Products Ltd* (1999 23 RPC 809), Aldous LJ considered the scope of Section 3(1) saying:

“The more a trade mark describes the goods, whether it consists of words or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is WELDMESH, whereas WELDED MESH would not be. The former, despite its primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The latter has no such alteration. Whatever the extent of use, whether or not it be monopoly use and whether or not there is evidence that the trade and public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader’s mesh from another trader’s mesh.

The requirement under section (Article) 3(1)(b) is that a mark must have a distinctive character to be registrable. Thus it must have a character which enables it to be distinctive of one trader’s goods in the sense that it has a meaning denoting the origin of the goods.”

In the *Bach and Bach Flower Remedies* trade marks case (2000 RPC at 526) Morritt LJ said:

“The question is whether or not the word BACH had, by 1979, acquired such a meaning as to be incapable, without more, of affording the requisite distinction. If it

had then section 1(1) is not satisfied, the word BACH cannot be a capricious addition so that registration of the sign would be in breach of paragraph (a); if it had not then the word BACH is an addition to the word FLOWER REMEDIES which is “capricious” because it is not purely descriptive, so that both the expression BACH FLOWER REMEDIES and the word BACH are capable of affording the necessary distinction. Accordingly I accept the submission that it is both permissible and necessary in considering the application of paragraph (a) to determine the meaning of the word as used at the time of the application for registration. I do not understand Aldous LJ in *Phillips v Remington* in the passage I have quoted to have been considering the relevance of use to the meaning of the word.

The usage in question must be by those engaged in the relevant trade or activity. Normally that will be the usage of the average consumer of the goods in question as described in *Lloyd Schufabrik* (European Court of Justice, *Lloyd Schufabrik Meyer v Klijsen Handel BV* 1999 ETMR 690). Obviously the evidence on the question is not limited to those who are consumers or end-users but may extend to others concerned in the trade such as manufacturers, wholesalers and retailers.”

It is not disputed that HPMC is a well known acronym for Hydroxypropylmethylcellulose and that both the acronym and its meaning are used in the relevant industry in respect of the goods of the application. The question, therefore, is whether the element OPHTAL as it appears in the mark, or whether the combination HPMC-Ophtal can perform the function of a trade mark.

In their statement of case the opponents assert that OPHTAL is the phonetic equivalent of the word OPHTHAL, which they say is a suffix for ophthalmology. In the Declaration by Guido Koller they expand upon this claiming that OPHTAL to be:

virtually identical to and certainly confusingly similar to OPHTHAL being different only in respect of the second letter H, and is a clear and direct reference to ophthalmology or other ophthal prefixed dictionary terms, all being related to the eye.

visually and phonetically negligibly different to OPHTHAL.

likely to be construed as a mis-spelling of OPHTHAL

OPHTHAL in the French language and the standard prefix for French words concerning ophthalmology.

visually the equivalent of the word descriptive abbreviation OPHTHAL.

Whilst there is evidence that HPMC is used in the trade in relation to the goods of the application, there is nothing to show that OPHTAL, (or OPHTHAL) either on its own or in combination with HPMC is so used or has such a descriptive meaning as in *WELDED MESH* so as to be incapable of registration. Consequently I can see no foundation in the grounds under Section 1(1), Section 3(1)(a) and Section 3(1)(d) and I dismiss these grounds accordingly.

If there is any substance to the grounds under Section 3(1) it is most likely to be found in Section 3(1)(c), and by extension, also under Section 3(1)(b). In the British Sugar Plc v James Robertson & Sons Ltd (TREAT) trade mark case, (1996) RPC 9, Mr Justice Jacob said:

“Next is “Treat” within Section 3(1)(b). What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent from use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character.”

The meaning of “devoid of any distinctive character” was addressed by Lord Justice Robert Walker in a recent appeal by Proctor & Gamble Limited in relation to their bottle marks ([1999] RPC 673) who commented as follows:

Despite the fairly strong language of s.3(1)(b), “devoid of any distinctive character” - and Mr Morcom emphasised the word “any” - that provision must in my judgement be directed to a visible sign or combination of signs which can by itself readily distinguish one trader’s product - in this case an ordinary, inexpensive household product - from that of another competing trader”.

In the Home Shopping case (unreported) Mr Simon Thorley sitting as the Appointed Person cited with approval the decision in the Proctor & Gamble case went on to say:

In my judgement, Mr McCall is placing too light a restriction upon Section 3(1)(b) when he suggests that a mere spark of distinctiveness is enough.

I am bound, and with respect, agree with the reasoning of Robert Walker LJ. One must have regard to the mark as a whole, and ask whether the combination of signs contained in the trade mark can by itself readily distinguish the products or services of one trader from those of another.

This approach is in accord with the European Court of Justice’s judgement in Windsurfing Chiemsee [1999] ETMR 585.

The visual similarity between OPHTAL and OPHTHAL is plain to see, and whilst there is also phonetic similarity, it is the first letter H that will be silent; the second letter H will have an effect on the pronunciation but this is a small distinction. But does this all matter? In The Eastman Photographic Materials Company Ltd’s application 15 RPC 476 (the Solio case) Lord Herschel said:

“If the word be an “invented” one, I do not think the quantum of invention is at all material. An invented word is allowed to be registered as a trade mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases.”

Consequently, if OPHTAL is a mere mis-spelling of an objectionable word, and that when used in combination with HPMC the whole is entirely descriptive, then the answer must be yes, the similarity would matter because the mark would not say, “these are the goods of...”, but rather “these goods are of this material or type.”.

The trade mark consists of an acronym, albeit directly descriptive of the goods of the application, and a word very close in appearance and sound to a prefix having some relevance to the goods of the application. Even accepting OPHTAL to be the equivalent of OPHTHAL, the trade mark is not an obvious description such as WELDED MESH. To derive its meaning requires a translation of the acronym HPMC into Hydroxypropylmethylcellulose, and relies upon recognising OPHTAL to be a prefix denoting something to do with ophthalmology.

The relevant consumer in this case is most likely to be a medical professional, well used to seeing the word ophthalmology (and other ophthal-prefixed words), and to whom the fact that OPHTAL is a mis-spelling is going to be quite apparent which in my view will alert them to the fact that the mark applied for is a badge of origin rather than a mere description. Whilst the mark cannot be said to be a particularly skilful or covert allusion to the goods and the consumer may well recognise its derivation and relevance to the goods, from the above case this does not prevent it from functioning as a badge of origin, particularly in the field of pharmaceuticals which, from my own knowledge, I know are often sold under brand names that refer to the function or constituents of the product. Whilst HPMC on its own must be considered incapable of distinguishing the goods in suit, I do not consider the mark as a whole to be so directly descriptive of a characteristic of the goods so as to be devoid of the distinctive character necessary to function as a badge of origin, and I dismiss the grounds under Section 3(1)(b) and 3(1)(c).

This leaves the ground under Section 3(4) of the Act. That section reads as follows:

3.-(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

There is nothing in the mark that would lead me to the view that registration would be contrary to any act or rule of law, nor any evidence to support such a claim. The question of the Community law seems to be adequately dealt with by the fact that the Community Trade Marks Office has accepted the mark for registration. Consequently, this ground requires no further consideration and is dismissed accordingly.

The opposition having failed on all grounds I order the opponents to pay the applicants the sum of £635 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 01 day of November 2001

**Mike Foley
for the Registrar
The Comptroller General**