IN THE MATTER OF APPLICATION NUMBER 2151957
IN THE NAME OF GROUP CHAUVIN
TO REGISTER A TRADE MARK IN CLASSES 9 & 10

AND

IN THE MATTER OF OPPOSITION THERETO BY
ALCON PHARMACEUTICALS LIMITED

IN THE MATTER OF application number 2151957
in the name of Group Chauvin
to register a trade mark in Classes 9 & 10

And

In the matter of opposition thereto by
Alcon Pharmaceuticals Limited

Background

On 26 November 1997, Group Chauvin filed an application to register the trade mark ACRYLIOS in Classes 9 and 10 in respect of the following goods:

Class 9	Contact lenses
Class 10	Artificial eyes; intraocular prosthesis; surgical and medical apparatus and instruments for use in the ophthalmic field.

The application claimed a priority under the Paris Convention of 6 June 1997 based on a filing in France.

On 30 April 1998, Alcon Pharmaceuticals Limited filed notice of opposition in which they say they are the proprietors of the following registered trade marks.

Number	**Mark**	**Class**	**Specification**
1473804	ACRYSOF	10	Intraocular lenses; all included in Class
1556942	ACRYPAK	10	Intraocular lenses and holders therefore; all included in Class 10

The grounds of opposition are in summary:

1. Under Section 3	because the mark is not capable of distinguishing the goods of the applicant from those of the opponent and is of such a nature so as to deceive the public as to the origin of the goods.

2. Under Section 5 because the opponent are the registered proprietors of similar earlier trade marks.

The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides request that an award of costs be made in their favour.

Both sides filed evidence in these proceedings. The matter came to be heard on 26 February 2001, when the applicants were represented by Ms Jessica Jones of Counsel, instructed by Frank B Dehn & Co, their trade mark attorneys, and the opponents by Mr Paul Kelley of Venner Shipley & Co, their trade mark attorneys.

Opponent's evidence

This consists of two Statutory Declarations. The first is dated 12 February 1999 and comes from Guido Koller, General Manager of Alcon Pharmaceuticals Limited. Mr Koller confirms that he is fully conversant with the English language and that the information in his Declaration is from his personal knowledge or has been taken from the records of his company to which he has full access.

Mr Koller refers to, and sets out details of the trade marks relied upon in these proceedings. He recounts his company becoming aware of the application in suit and to the instructions given to their trade mark attorneys. He says that the respective marks are visually and phonetically similar, and that this similarity is compounded by the fact that they do not have a recognisable meaning other than as trade marks.

Mr Koller continues saying that his company has been using the trade mark ACRYSOF in the United Kingdom since 1993. He says that sales from that date have exceeded £3,125,000, and he refers to exhibit APL1 which sets out the turnover by year from 1993 as follows:

1993	£3,300
1994	£605
1995	£84,500
1996	£313,500
1997	£923,000
1998	£1,898,000

Mr Koller says that the relatively low figures for 1993 and 1994 reflect that this was a test marketing period during which sales did not take place. He says that his company has sold its products under the mark ACRYSOF throughout the United Kingdom.

Mr Koller says that his company has spent approximately £82,000 per annum advertising products under the trade mark ACRYSOF, which he breaks down as follows:

Journal/magazine advertising	£12,000
Demonstration samples	£40,000
Detail materials	£25,000
Leave behind items	£5,000

saying that in addition, the British arm of his company, Alcon UK spends in excess of £500,000 on the promotion of the ACRYSOF product via their sales force.
Mr Koller goes on to refer to exhibit APL2, which consists of examples of brochures and advertising materials for an acrylic intraocular lens sold under the name ACRYSOF, the letters ACRY being in block capitals, SOF in a form of handwritten script. The earliest use that can be attributed to the United Kingdom dates from August 1995.

Mr Koller notes that the application seeks registration in respect of the same or similar goods for which their marks ACRYSOF and ACRYPAK are registered, and that this is a highly specialised market. He says that his company are the proprietors of the only marks with the ACRY prefix that have been registered in respect of ocular lenses or similar goods, and that he considers there to be a real risk of confusion, particularly given the use and reputation that the opponents have acquired. He comments that there were alternative names that the applicants could have chosen for their product, and concludes that they have elected to use ACRYLIOS to play on the similarity with his company's mark.

The second Statutory Declaration is dated 17 February 1999 and comes from Christopher Charles Weatherly, a Registered Trade Mark Attorney and partner in the firm of Venner Shipley, the opponent's representatives in these proceedings.

Mr Weatherly refers to his being aware of the opponent's trade mark registrations for the words ACRYSOF and ACRYPAK, and he refers to the results of a search of the Trade Marks register which shows the opponents to be the sole proprietors of ACRY prefixed marks registered in classes 9 and 10 for ocular lenses, and that this was the case at the relevant date. He goes on to say why he believes the respective marks to be confusingly similar, making reference to the identical ACRY prefix, their similar appearance and pronunciation, that they are invented words which he considers will result in only partial recall, and that the goods are similar.

Applicant's evidence

This consists of a Statutory Declaration dated 14 June 1999 from Annick Biglione, a Board Member of Group Chauvin, a position he has held since 25 March 1991. Mr Biglione says that he has general responsibility for the applicant's legal affairs and that he makes the statements from his own knowledge and belief.

Mr Biglione says that the applicants are a large French company that has been involved in all aspects of the research, manufacture and development of optical products, particularly lenses, for many years. He says that his company already has a registration for KELIOS registered in Classes 9 and 10 for contact lenses and lenses (intraocular prosthesis) for surgical implantation, and that ACRYLIOS is seen as an addition to this portfolio.

Mr Biglione says that intraocular lenses for implantation into the eye by surgical procedure are in the nature of prosthesis, and have been available for over forty years. He continues saying that like contact lenses, these intraocular lenses have increasingly been made of transparent plastic material which for many years has primarily been of acrylic polymers known as acrylic resins. By way of illustration he refers to exhibit AB1, which consists of an extract from the British Journal Ophthal 1974 relating to the treatment of eye defects by use of an iris supported intraocular acrylic lens, an extract from the Canadian Journal of Ophthalmology dating from 1990 on the same subject, and an extract from the November 1997 edition of Science referring to acrylic lenses.

Mr Biglione says that acrylic polymers have been used for a considerable number of years to produce products transparent to light, and he refers to two well known trade marks that are used on products known as acrylic glasses, referring to exhibit AB2 which consists of pages from Collins English Dictionary relating to these trade marks. Mr Biglione says that optical clarity is a feature of many types of acrylic polymer, and he refers to the search by Christopher Weatherly noting the results included marks such as ACRYVISION, ACRYLITE, ACRYLUME and an abandoned application for ACRYLENS that were all applied for in relation to products involving the use or passage of light. Mr Biglione says that these trade marks along with those of the opponents and his own company's were evidently derived from the word acrylic and the use of ACRY or ACRYL suggests or is intended to indicate that acrylic materials are used in their manufacture. He highlights that the opponent's advertising has the words "soft acrylic IOL" underneath the trade mark ACRYSOF, which he notes is split to highlight the ACRY and SOF portions.

Mr Biglione says that intraocular lenses are highly specialised and that those purchasing them or the surgeons using them will take extreme care to ensure that they have the correct goods. He says that the advertisements shown by the opponents as exhibit APL2 are full of medical language and acronyms and would require a high degree of professional training to be understood or to influence the person reading them. He notes that part of the exhibit is a page from the British Medical Journal, which is read by professionally skilled persons who, he considers, would recognise any ACRY mark as indicating or suggesting the presence of acrylic material and that they would be able to distinguish marks such as ACRYSOF and ACRYLIOS.

Mr Biglione considers the origin of the remainder of exhibit APL2 to be unclear and that some are clearly from after the relevant date. He says that Mr Koller does not indicate whether the amount he gives for advertising is his current budget, or the amounts used in

earlier years, nor how the money said to have been spent by the British arm of the opponents in promoting ACRYSOF was used.

Mr Biglione explains that the applicants derived the name ACRYLIOS by adding ACRY or ACRYL to denote the goods are made of acrylic, with the suffix coming from their KELIOS trade mark. He refutes the suggestion that there was any intention of playing on the similarity with the opponent's ACRYSOF or ACRYPAK marks.

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

Decision

At the hearing Mr Kelley said that he did not intend to pursue the ground under Section 5(4)(a), but also, that he wished to argue that the mark applied for was contrary to Section 5(3). Ms Jones felt that she was in a difficult position because this was, in effect, a new ground for which she had not prepared. After discussion Ms Jones agreed that I should hear the submissions and consider the ground. That leaves the opposition as based on Section 5(2)(b), Section 5(3) and Section 3.

Turning first to consider the ground under Section 3. The Statement of Case indicates that the opponents consider the mark applied for to be contrary to that section because of their rights in another mark. As far as I am aware, Section 3 of the Act is concerned with whether the mark itself has the capacity to distinguish, and is not concerned with any conflict with the rights owned by other traders which are catered for in Section 5 of the Act. Consequently, this ground is dismissed as being without foundation.

Turning next to the grounds under Section 5(2). That section reads as follows:

> **5.-(2)** 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 be registered for goods or services similar to those for 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
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> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

An earlier trade mark is defined in Section 6 of the Act as follows:

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

(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,

In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG,* paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG,* paragraph 23, 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 Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;

(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,* paragraph 23;

(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,* paragraph 23;

(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,* paragraph 17;

(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,* paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to 30 mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG,* paragraph 26;

(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,* paragraph 41; 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,* paragraph 29.

The applicant's mark ACRYLIOS and the opponent's marks ACRYSOF and ACRYPAK are clearly not identical, so the matter falls to be considered under subsection (b) of Section 5(2).

The opponent's earlier marks are registered in respect of intraocular lenses and holders for such goods. The application covers two classes. Class 9 seeks registration in respect of of contact lenses, which Ms Jones sought to persuade me were in a different retail market to intraocular lenses. The application is not limited in any way, so at least notionally, I do not agree that this is this the case, and I would consider contact lenses at the very least, to be similar goods to intraocular lenses.

Class 10 of the application covers intraocular prosthesis which in my view must include intraocular lenses. It therefore seems that my consideration in respect of the goods is limited to determining whether the remaining goods in Class 10, namely, artificial eyes, and surgical and medical apparatus and instruments for use in the ophthalmic field, are the same or similar, to intraocular lenses.

Turning first to the surgical and medical apparatus and instruments for use in the ophthalmic field. The dictionary references for "apparatus" and "instrument" indicate that these are words that describe items used in performing some task, which in this case would mean that the description would cover items such as may be used in medical diagnosis, inspection, ophthalmic surgical procedures, and the like, but would not cover intraocular lenses because such goods would not ordinarily be considered to be an item of "apparatus" or and "instrument.

In respect of the "artificial eyes" I look to the guidance of Jacob J. in the TREAT trade mark case (1996 RPC 281) in which he set out the following factors as being relevant when assessing the similarity of the respective goods or services:

(a) the respective users.

(b) the respective uses.

(c) their physical nature.

(d) the respective channels of trade through by which reach the market

(e) in the case of self-serve consumer items, whether they are or are likely to be found on the same or different shelves.

(f) the extent to which they are competitive (and whether they are in the same or different trade sectors.

The respective goods are highly specialised and in both cases are most likely will only be available to, or purchased by the medical profession, and in some cases, specialists within the ophthamological field. Although artificial eyes are implanted into the eye socket, this is not to correct a sight deficiency as is the case with an intraocular lens. They are different in their physical nature, and although it is possible that they may originate from the same manufacturer, and go through similar channels to the practitioner, they are not goods that I would say would generally be available other than on specific request, and given their clearly different uses, could not be regarded as being competitive or complimentary. With this in mind I have no difficulty in finding artificial eyes and intraocular lenses to be dissimilar goods.

The most that can be said about the marks ACRYLIOS, ACRYSOF and ACRYPAK is that they share a common prefix, namely ACRY, which is said to be derived from the materials from which the products are made, namely acrylic. The applicant's mark is all but the word ACRYLIC and I would say possibly has a stronger conceptual link to that material. There is no evidence that ACRY is a recognised abbreviation for acrylic, but I do not consider that there needs be for the suffix to convey this fact to the consumer. The evidence shows that acrylic has been used in respect of intraocular lenses for some considerable time and it seems likely to me that where, as in this case, the goods are highly specialised and the relevant consumer likely to be very well informed, the connection with acrylic will be known. Accordingly, if only to the limited extent that the mark may convey a connection with acrylic there must be some conceptual similarity

The marks ACRYSOF and ACRYPAK are distinctive marks, and although I consider the connection with acrylic is likely to be apparent to the relevant consumer, the marks will most likely be regarded as invented words. There is no evidence that ACRYPAK has been used so in respect of that mark there can be no added distinctiveness through use. The evidence shows that the opponents have used the mark ACRYSOF albeit with ACRY in plain type and SOF in larger, hand written script (which serves to highlight the connection with acrylic) although even allowing for the specialised nature of the goods the turnover that can be apportioned to the period prior to the relevant date is not so significant so as to be able to say that through the use made of it the mark warrants an exceptional penumbra of protection. Although figures relating to an expenditure on promotion have been given, without any details relating to how, when and where the money was spent they do not assist.

Apart from the reference to the opponents being the only proprietors of "ACRY" prefixed

marks registered in respect of ocular lenses, I do not have any evidence that establishes this is the situation in the market. It would in my view have been helpful to know and consider the extent to which the prefix is used on other goods that the same consumer is likely to come into contact with, for if they are used to seeing the prefix ACRY on other goods it would in my view lessen the likelihood that they will consider other ACRY prefixed marks on the same or similar goods to come from the same source. There is, however, no such evidence.

Because of the nature of the goods, this is a case where expert evidence giving details of how the goods are selected, obtained and used would have been of assistance, but there is none, and I must therefore consider what would be the most likely scenario. The opponent's evidence indicates that intraocular lenses can be made of a number of different materials, for example, acrylic or silicone, which may be an influence in the selection of the product,. Given the apparent advantages of certain materials, and the potential risks involved with inappropriate usage, I consider it highly likely that the practitioner will exercise a high degree of care in selection. I cannot imagine that the goods will be obtained simply by the request to "order some acrylic intraocular lenses".

It seems to me that a practitioner who is likely to use the opponent's lenses will be well aware of the different products on the market, but is unlikely to obtain the lenses themselves, but will instead give oral, or more likely, written instructions to a person responsible for the procurement of supplies. Accordingly, I would say that the visual appearance of the marks would be of primary significance, but oral similarity may also have some part to play.

In this case each mark is composed of one word. It is long established that it is the beginnings of words that have the most significance, but that dictum must be taken in conjunction with the requirement that marks must be compared as a whole, and with regard to the dominance and distinctiveness of the elements of which they are composed. Although the marks have a common prefix, it is derived from a characteristic of the goods, a fact that I would say is likely to be obvious to the relevant consumer of the goods in this case, and I do not consider the ACRY prefix to be an overwhelming element of the mark.

Apart from the prefix, the words ACRYLIOS, ACRYSOF and ACRYPAK are visually quite different. The suffixes have a significant impact on their sound when spoken, particularly given that the mark applied for has three syllables and the opponent's marks have only two. It seems to me that if the opponents have a case it relies heavily upon the likelihood of there being confusion through imperfect recollection, but as I have already said, given the nature of the product and the knowledge and expertise of the relevant consumer who is likely to be even more observant and circumspect than the usual, this seems unlikely.

Taking the best view that I can on the evidence before me, and adopting the "global" approach advocated, I come to the view that the similarities may cause the consumer to momentarily pause and wonder whether the applicant's and/or their goods are in some way connected with the opponents, but I do not consider that they will be confused into believing that they are from the same source or are in some way linked. Accordingly, the ground under Section 5(2)(b) fails.

Finally, this leaves the ground under Section 5(3). That section reads as follows:

> **5(3)** A trade mark which -
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> **(a)** is identical with or similar to an earlier trade mark, and
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> **(b)** is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,
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> 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."

The opponent's registrations cited in the notice of opposition are earlier trade marks within the meaning of Section 6(1) of the Act (set out earlier). Although some of the goods included in the application are the same or similar to those within these registrations, the application also covers a range of goods which I would say are clearly different. However, I have already determined the respective marks to be neither the same nor similar, the consequence of which is that the earlier marks relied upon fail to meet the criteria for an objection under Section 5(3). Even if the respective marks had been similar I do not consider that the ground under Section 5(3) would have succeeded. In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039) Mr Simon Thorley QC sitting as a Deputy High Court Judge said:

> "What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants use of the sign is:
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> (a) without due cause; and
>
> (b) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."

The opponents have used the mark ACRYSOF for a number of years prior to the relevant date, but there is no evidence of the other mark, ACRYPAK having been used. I have no

evidence by which to gauge the size of the potential market for intraocular lenses and holders for such goods, but it seems to me that the turnover to the relevant date is not that significant, a fact acknowledged by Mr Koller who mentions that two of these years were used for test marketing and that no sales were effected. Setting aside the question of "due cause", I do not consider that at the relevant date the opponents have proved that they had established a reputation within the United Kingdom such that if the applicants were to use ACRYLIOS in respect of identical, let alone dissimilar goods, that the distinctive character or repute of their mark would suffer, or that any benefit will be derived by the applicants, and the ground under Section 5(3) fails 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 12th day of December 2001

Mike Foley
for the Registrar
The Comptroller General