

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2151957  
BY GROUP CHAUVIN  
TO REGISTER A TRADE MARK IN CLASSES 9 & 10**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 48477  
BY ALCON PHARMACEUTICALS LIMITED**

**AND IN THE MATTER OF AN APPEAL  
TO THE APPOINTED PERSON  
BY THE OPPONENT  
AGAINST THE DECISION OF MR. M. FOLEY  
DATED 12 DECEMBER 2001**

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**DECISION**

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**Introduction**

1. This is an appeal against a decision of Mr. M. Foley, the Hearing Officer acting on behalf of the Registrar, dated 12 December 2001 in which he rejected an opposition against UK Trade Mark Application No. 2151957 in the name of Group Chauvin (“the Applicant”) for 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 date of UK Trade Mark Application No. 2151957 is 26 November 1997 but it claims Paris Convention priority from a French filing for the same mark made on 6 June 1997 under No. 97681397.

2. On 30 April 1998, Alcon Pharmaceuticals Limited (“the Opponent”) filed notice of opposition against Application No. 2151957 based on earlier rights in two UK Trade Mark Registrations namely:

UK Reg. No.	Date	Mark	Class	Goods
1473804	20.08.91	ACRYSOF	10	Intraocular lenses; all included in Class 10
1556942	20.12.93	ACRYPAK	10	Intraocular lenses; all included in Class 10

The grounds of opposition were stated in general terms to be:

- (a) In view of the goodwill and reputation enjoyed by the Opponent in ACRYSOF and ACRYPAK, registration of Application No. 2151957 offends section 3 of the Trade Marks Act 1994 (“the TMA”) in that ACRYLIOS is incapable of distinguishing goods of the Applicant and/or is of such a nature as to deceive the public as to the origin of the goods.
  - (b) Registration of Application No. 2151957 is contrary to section 5 of the TMA because of similar earlier trade marks in the registered proprietorship of the Opponent.
3. The opposition was heard on 26 February 2001 when it became clear and was accepted by the Applicant that the grounds of opposition relied upon by the Opponent comprised sections 3, 5(2)(b) and 5(3) but not section 5(4)(a) of the TMA. In his written decision of 12 December 2001, Mr. Foley rejected all three grounds of opposition. The Opponent’s appeal is directed only against the Hearing Officer’s decision under section 5(2)(b).
  4. At the hearing of the appeal, the Opponent was represented by Mr. Christopher Morcom QC, instructed by Venner, Shipley & Co. Mr. Thomas Mitcheson, instructed by Frank B. Dehn & Co., appeared as Counsel for the Applicant. Messrs. Morcom and Mitcheson directed me that the appeal is by way of review only. The Hearing Officer’s decision was based on a multi-factorial assessment and I should show a real reluctance to interfere in the absence of a distinct and material error of principle (*Bessant v. South Cone Inc. (REEF)* [2002] EWCA Civ 768, 26 May 2002). I find it instructive first to consider the evidence that was adduced by the parties for and against the opposition under section 5(2)(b) of the TMA.

### **Evidence of the Opponent**

5. The evidence in support of the opposition consisted of the statutory declarations of Guido Koller and Christopher Charles Weatherly dated 12 and 17 February 1999 respectively. Mr. Koller is the General Manager of the Opponent based in Hunenberg, Switzerland. He states that the Opponent is engaged in the research, manufacture and merchandising of lenses, lens solutions and ophthalmic surgical products and has been operating internationally for many years. ACRYSOF was first used in the UK in 1993 and following test marketing in 1993 – 4, the value of sales of products under

the mark in the period to 1998 exceeded £3 million. However, as the Hearing Officer noted approximately two thirds of these sales were attributable to a period after the relevant date (6 June 1997). Mr. Koller cites advertising expenditure of £82,000 per annum promoting ACRYSOF products together with a further £500,000 over a period of three years separately spent on promotion by the British arm of the Opponent. Although types of advertising by the parent are specified (journals/magazines, demonstration samples, detail materials, leave behind items) no details as to the timing, placement and geographical coverage of advertising are provided. Samples of stickers, brochures and promotional materials are exhibited to Mr. Koller's declaration at APL2. Three of these samples clearly originate from the British arm of the Opponent and one appears to have been included in the British Medical Association's Journal of 1997. Otherwise the pages of APL2 are undated bar the last, which is dated after the relevant time. A quote from a consultant ophthalmic surgeon at St. Thomas' Hospital taken from Ocular Surgery News indicates that ACRYSOF lenses were in use in the UK in 1995. Finally APL2 quotes the following statement by Robert Lehman MD at the AcrySof International Symposium, San Diego, California, 1992: "There is something about the quality of their vision which has generally made patients prefer the AcrySof eye ...".

6. I do not understand the Opponent to challenge the Hearing Officer's finding that: "... 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 [ACRYSOF] warrants an exceptional penumbra of protection". Moreover the Opponent accepts that no use was shown of the mark ACRYPAK. However, Mr Morcom takes issue with Mr. Foley's statement that (emphasis added):

"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)* ..."

Mr. Morcom makes two points:

- (a) The evidence did indeed show use of different fonts for ACRY and SOF but it also contained several examples of use of both elements of the mark in the same lettering. In any event, normal and fair use of ACRYSOF would include plain lettering in upper or lower case and typeface is irrelevant to oral use.
- (b) The Applicant's specifications are not limited to acrylic goods. (Nor for that matter are the Opponent's.)

It is not possible to discern from the decision whether the Hearing Officer took these considerations into account but he did state that: "oral similarity may also have some part to play".

7. The Opponent's second statutory declaration came from Christopher Charles Weatherly of Venner, Shipley & Co., trade mark attorneys for the Opponent. Mr. Weatherly exhibits a search of the UK Trade Marks Register (including international (UK) and Community marks) as evidence that the Opponent was the sole proprietor of ACRY- prefixed marks in Classes 9/10 for ocular lenses at the filing [sic – priority] date of the application in suit. Mr. Morcom criticised the Hearing Officer for ignoring that fact. However, enhanced distinctive character for the ACRY- element of the Opponent's marks cannot be presumed from the state of the Register alone since what matters is public recognition of that element as indicating goods of the Opponent in the market place (*The Infamous Nut Company's Trade Mark Ltd's Trade Mark Application*, SRIS O/411/01). There was no evidence of use by the Opponent of ACRYPAK. Further, the Opponent's use of ACRYSOFF in connection with intraocular lenses at the relevant date was insufficient to give rise to enhanced distinctive character in the ACRY- element of the mark or indeed ACRYSOFF as a whole. In short, Mr. Morcom's criticism is misplaced.

### **Evidence of the Applicant**

8. The evidence in answer to the opposition consisted of a statutory declaration of Annick Biglione dated 14 June 1999. Mr. Biglione is a Member of the Board of the Applicant, a position that he has held since 1991. He describes the Applicant as: "a large French company who have been involved in all aspects of research, manufacture and development of optical products, particularly lenses, for many years". Thus, the Applicant and the Opponent are engaged in virtually the same businesses (see paragraph 5 above). It seems that this coincidence may have escaped the Hearing Officer's attention in his review of the evidence.
9. Mr. Biglione states that acrylic materials have been used in the manufacture of intraocular lenses for many years and exhibits journal articles in support. The first, published in *Brit. J. Ophthal.* (1974) 58, 718 describes a test carried out at the Bristol Eye Hospital, Bristol involving 53 cataract extractions with simultaneous insertion of an iris-supported intraocular acrylic lens designed by a scientist called Federov. The authors report problems of corneal oedema and cystoid macular oedema and conclude: "we find it hard to adopt an unduly optimistic or pessimistic attitude towards these controversial devices". The second article is written by a Canadian ophthalmologist and published in *Can J Ophthalmol* – vol. 25, no. 5, 1990. The author compares the effectiveness of two proprietary viscoelastic agents in intraocular lens implantation surgery. The type of intraocular lens used in the trials is not specified. The third article was contributed to *Science*, Vol. 198, November 1997 by the Departments of Ophthalmology and Materials Science and Engineering at the University of Florida. They observed the cell damage that that occurs during cataract surgery using acrylic intraocular lenses and describe a method of prevention whereby a hydrophilic polymer interface is interposed between contacting tissue and the surfaces of the materials used. The Hearing Officer held that the Opponent's evidence had failed to establish that the ACRY- prefix was common or generic to the trade for intraocular lenses or other optical products. I agree with that finding. Mr. Biglione also supplies dictionary entries relating

to Perspex and Plexiglas and comments on Mr. Weatherly's trade mark search; both are irrelevant to the issues on appeal.

### **Merits of the appeal**

10. Mr. Morcom says that his criticisms of the Hearing Officer's decision under section 5(2)(b) are encapsulated in Mr. Foley's concluding paragraph:

“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”.

Mr. Morcom submits that Hearing Officer did find relevant confusion but mistakenly set the standard the Opponent was required to reach under section 5(2)(b) at the higher level of deception for passing off. Mr. Morcom sought to illustrate his point by reference to Lord Upjohn's speech in *BALI Trade Mark* [1969] RPC 472 at 496:

“What, then, is the test? This must necessarily be a question of fact and degree in every case. I am content in amplification of the test laid down by Evershed, J. to take the test as in effect laid down by Romer, J. in *Jellinek's Trade Mark* (1946) 63 RPC 59 at page 78.

It is not necessary in order to find that a mark offends against section 11 to prove that there is an actual probability of deception leading to passing off or (I add) an infringement action. It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the court has to be satisfied not merely that there is a possibility of confusion; it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the register”.

In response, Mr. Mitcheson relied upon a passage from *RALEIGH International Trade Mark* [2001] RPC 202 at 210. Having stated section 5(2) of the TMA (art. 4(1)(b) of Directive 89/104/EEC), Mr. Geoffrey Hobbs QC sitting as the Appointed Person continued:

“It was noted in the Opinion delivered by Advocate General Jacobs on January 27, 2000 in Case C-425/98 *Marca Mode CV v. Adidas AG* [2000] ETMR 561 that the objection set out above is differently expressed in different language versions of the Directive, with the English version referring to a “likelihood” of confusion, the Dutch version referring to the “possibility” of confusion and most other versions referring to the notion of a “risk” or “danger” of confusion.

Nevertheless, for the reasons given in his Opinion, the Advocate General maintained that the objection could not succeed in the absence of genuine and properly substantiated likelihood of confusion. That view of the matter was accepted by the European Court of Justice in paragraphs 33 *et seq.* of its judgment delivered on June 22, 2000 [2000] All ER (EC) 694”.

11. I agree with Mr. Morcom that the Hearing Officer expressed his conclusion under section 5(2)(b) of the TMA in apparently contradictory terms. However, I find neither passage referred to me by Counsel very helpful as an aid to interpretation. Lord Upjohn in *BALI* was dealing with the old law under section 11 of the Trade Marks Act 1938, as amended. Mr. Hobbs in *RALEIGH* was describing the outcome of the reference to the Court of Justice of the European Communities (“ECJ”) in *Marca Mode* where the Netherlands Hoge Raad asked whether likelihood of confusion could be presumed merely because of the high distinctive character of the earlier mark, in particular, gained through use in the marketplace. In the present case, it is accepted that neither of the Opponent’s earlier marks is entitled to a wider penumbra of protection by virtue of acquired distinctiveness through use.
12. In *Sabel BV v. Puma AG*, Case C-251/95 [1997] ECR I-6191, the ECJ identified (at para. 16) two types of confusion that would constitute “likelihood of confusion” within art. 4(1)(b) of the Directive (section 5(2) TMA): (i) where the public confuses the sign and the mark in question (likelihood of direct confusion); and (ii) where the public makes a connection between the proprietors of the sign and those of the mark and confuses them (likelihood of indirect confusion or association). Subsequently the ECJ confirmed in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*, Case C-39/97 [1998] ECR I-5507 (at para. 29):

“Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of article 4(1)(b) of the Directive ...”.

However, the ECJ has further ruled that the mere association the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion even where, as noted by Mr. Hobbs QC in *RALEIGH*, the earlier mark has particularly distinctive character (*Sabel* and *Marca Mode*).

13. The Hearing Officer directed himself as to the applicable law by reference to a list of factors to be taken into account when determining whether there exists a likelihood of confusion within the meaning of section 5(2)(b) of the TMA. The factors derive from the guidance provided by the ECJ in the cases already mentioned together with *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, Case C-342/97 [1999] ECR I-3819 and are well known. It is unfortunate that in the Hearing Officer’s decision the penultimate and end

factors were elided, so as to render the latter meaningless. The final three factors should read:

“(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*, 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;

(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*, paragraph 29”.

14. Nevertheless, Mr. Morcom conceded that the Hearing Officer had correctly directed himself as to the applicable law. In those circumstances, I believe that what the Hearing Officer was trying to say in his concluding paragraph was that the mere association the relevant public might make between the respective marks was insufficient to ground the Opponent’s objection under section 5(2)(b).
15. If that constituted the only instance where the Hearing Officer could be said to have fallen into error, I should have ignored it as a matter of expression. However, I am persuaded that the Hearing Officer erred in other respects (in no particular order):
  - (a) The opposition was based on two earlier trade marks: ACRYSOFF and ACRYPAK. ACRYPAK had not been used. Therefore, there can have been no family of marks argument. Where several earlier trade marks are relied upon in an opposition, section 5(1) – (3) requires each mark to be compared sequentially against the mark in suit (*ENER-CAP Trade Mark* [1999] RPC 362). The decision indicates that the Hearing Officer failed to do this. Moreover, in concentrating on what weight to afford the ACRY- prefix (see (b) below), the Hearing Officer devoted insufficient attention to comparing the marks as a whole. ACRYSOFF and ACRYLIOS bear more than a prefix in common. They also share the letters “S” and “O”, which when viewed overall increases their visual and oral similarities.
  - (b) There was no evidence to suggest that the ACRY- prefix was commonly used in the trade for ophthalmic products, which was accepted by the Hearing Officer. The Hearing Officer held that the ACRY- prefix might suggest to the relevant public that the goods were made of acrylic leading to conceptual similarity between the respective marks. The Opponent does not challenge the finding of conceptual similarity. However, the Hearing Officer went on to hold: “I do not

consider the ACRY prefix to be an overwhelming element of the mark”. I accept Mr. Morcom’s earlier point that the Applicant’s specifications are not limited to acrylic goods. I also accept his submission that a suggestive element in a mark may nevertheless be distinctive and should not be discounted when viewing the marks overall. In comparing ACRYSOFF, ACRYPAK and ACRYLIOS, the Hearing Officer said: “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 ...”. The Hearing Officer went on to state that the suffixes rendered the three marks visually and orally quite different, which indicates that he afforded little or no weight to the common ACRY- prefix in the marks as a whole.

- (c) The Hearing Officer held that intraocular prosthesis (Applicant) and intraocular lenses (Opponent) covered identical goods. Furthermore, contact lenses (Applicant) and intraocular lenses (Opponent) were at least very similar goods. The Hearing Officer mentioned at paragraph (e) of his list of factors the *Canon* principle that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods. Whilst I am conscious that the duty to give reasons must not be turned into an intolerable burden (*REEF* per Robert Walker LJ at para. 29), I am unable to ascertain what role, if any, that finding of identity/near similarity of goods played in the Hearing Officer’s decision under section 5(2)(b). Likewise, the Hearing Officer’s conclusion that the relevant public would most likely regard ACRYSOFF and ACRYPAK as invented words. The distinctiveness of a mark, inherent or acquired, is another factor that may increase the likelihood of confusion within the meaning of section 5(2)(b) (*Sabel* and *Lloyd*).
- (d) I believe it clear from the decisions of the ECJ in *Sabel*, *Canon* and *Lloyd* that the tribunal is required to undertake a balancing exercise in order to determine a conflict under section 5(2) of the TMA (art. 4(1)(b) of the Directive). The tribunal must ask whether there is a likelihood of confusion among the relevant public in view of the degree of similarities between the marks and the goods and services, the reputation of the earlier mark and the likelihood of association that can be made with the earlier mark, which factors may operate interdependently. The Hearing Officer said that he had no difficulty in finding artificial eyes and intraocular lenses to be dissimilar goods despite evidence that:
- (i) The parties both operated in the same highly specialised fields.
  - (ii) Artificial eyes and intraocular lenses are both in the nature of prosthesis. Both are used in ophthalmic surgery by ophthalmic surgeons for implantation into the eye.
  - (iii) The channels of trade for the goods were most likely to be the same.



- (iv) One ophthalmic surgeon had referred to a human eye after implantation of the Opponent's lens as: "the AcrySof eye".

I believe that the Hearing Officer should have asked himself whether there was a likelihood of confusion within the meaning of section 5(2)(b) taking into account the above similarities. Instead, the Hearing Officer regarded it as determinative that intraocular lenses correct sight deficiencies whereas artificial eyes only restore appearance.

- (e) The Hearing Officer also appeared to dismiss surgical and medical apparatus and instruments for use in the ophthalmic field (Applicant) and intraocular lenses (Opponent) as dissimilar goods. He said:

"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 [sic] 'instrument'".

Mr. Morcom is correct that the issue was not whether intraocular lenses were apparatus or instruments. The task for the Hearing Officer was to assess the degree of similarity between the respective goods. The goods were for use in ophthalmic surgery, the users were ophthalmic surgeons, the channels of trade were most likely to be same and the goods were complementary (*Canon*). The Hearing Officer mentioned none of these points of coincidence.

- 16. In my view, the Opponent's best case resided with Registration No. 1473804 for ACRYSOFF in respect of intraocular lenses. I agree with the Hearing Officer that the relevant consumer is an ophthalmic surgeon but may also include hospital or medical assistants that are requested to obtain stocks or supplies. Given the nature of the goods in question, I believe it is fair to assume that such a consumer will exercise care in selection. Nevertheless, taking into account as detailed above:

- (a) the visual, oral and conceptual similarities between ACRYSOFF and ACRYLIOS;
- (b) the identity/similarities between the respective goods and, in particular, their uses the same highly specialised fields;
- (c) that ACRYSOFF is an invented word and that there was no evidence that ACRY- was commonly used by the trade to describe optical products;
- (d) the association that the relevant consumer might make between ACRYSOFF and ACRYLIOS;

I believe that there is a tangible risk that the consumer will believe that ACRYLIOS products originate from the Opponent, are further goods within

the Opponent's range or are produced by an undertaking that is economically linked to the Opponent.

### **Conclusion**

17. In the result this appeal succeeds and the opposition to Application No. 2151957 for ACRYLIOS in Classes 9 and 10 is upheld. Mr. Foley assessed the costs to be awarded to the successful party on opposition at £635. I direct that the Applicant pay the Opponent the sum of £635 in respect of the opposition and a further sum of £635 towards the Opponent's costs of this appeal, to be paid on the same basis as indicated by Mr. Foley.

Professor Ruth Annand, 30 October 2002

Mr. Christopher Morcom QC instructed by Venner, Shipley & Co. appeared as Counsel on behalf of the Opponent.

Mr. Thomas Mitcheson instructed by Frank B. Dehn & Co. appeared as Counsel on behalf of the Applicant.