

O/122/12

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION 1033324
IN THE NAME OF BSN MEDICAL GmbH IN RESPECT OF THE MARK**

EPIGRAFT

IN CLASS 5

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 72147
BY MILLET INNOVATION (Société Anonyme)**

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**IN THE MATTER OF International registration 1033324
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BACKGROUND

1. On 8th April 2010, the UK was notified by WIPO of an international trade mark registration in respect of which it had been designated in accordance with the provisions of the Protocol to the Madrid Agreement. The details of the mark are as follows:

Holder: BSN Medical GmbH ('BSN')

Mark: EPIGRAFT

Class 5

Tapes and bandages for dressing purposes; dressing material; wound coverings

Date of international registration: 3rd February 2010

Date of protection in the UK: 3rd February 2010

Priority date: 31st August 2009 (Germany)

2. The designation was published in the Trade Marks Journal on 7th May 2010, and on 7th July 2010 Millet Innovation (Société Anonyme) ('Millet') lodged an opposition against it in respect of the goods specified above.
3. Millet has opposed on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of The Trade Marks Act 1994 ('the Act'). In relation to the grounds under section 5(2)(b) and 5(3) it cites the following trade mark:

Mark. Filing and registration dates	Goods relied upon
<p>CTM 3929858</p> <p>EPITACT</p> <p>12th July 2004 (IC date 22 June 04 France)</p> <p>17th March 2006</p>	<p>Class 5</p> <p>Pharmaceutical preparations for medical purposes based on silicone gels; balms and creams for medical purposes and in particular antiperspirant foot cream; effervescent bath salts and tablets for medical purposes; materials for dressings; pre-cut or uncut orthopaedic dressings; pharmaceutical and veterinary preparations, namely patches impregnated with active substances.</p> <p>Class 10:</p> <p>Medical, orthopaedic and podological apparatus and instruments; orthopaedic articles, in particular orthopaedic articles for the correction of foot and toe deformations, orthopaedic articles for the prevention of pressure sores, orthopaedic articles for the prevention and reduction of pressure and rubbing of the feet, orthopaedic articles impregnated with active substances, orthopaedic articles based on silicone gels, elastic sheaths and bandages for orthopaedic use, orthopaedic pads, orthopaedic soles and half-soles, orthopaedic hosiery, orthopaedic slippers and footwear.</p>

4. In its statement, Millet says the dominant and distinctive element of BSN's mark is the prefix 'Epi' which is identical to its own mark, and thus the respective marks are, overall, similar. Visually, both are in standard characters and have the common letters 'E-P-I' and also end with the same letter '- T'. The length of both marks is closely similar. Phonetically, the number of syllables in each mark is the same; the first syllable being strictly identical and the last sound, '-ACT', is very similar to '-AFT'. Conceptually, the respective marks must be considered as invented words without specific meaning. The respective goods in class 5 are identical to its own in the same class and its class 10 goods are either identical or similar. Overall there is a likelihood of confusion.
5. Under section 5(3), Millet says the use/registration of BSN's mark would take unfair advantage of its own mark, which has been used since 2003 and has accrued a substantial reputation. Specifically, BSN has deliberately chosen a

mark similar to its own to take advantage of its reputation without having to go to the cost of advertising its products. Such use/registration by BSN would also be detrimental to the distinctive character and repute of its mark because it dilutes its distinctiveness and will tarnish the reputation derived under it. Specifically, a consumer will make an assumption that the applicant's products derive from the opponent; as such and if they are of lesser quality, the consumer will make an assumption that the opponent's quality is also reduced.

6. Under section 5(4)(a), Millet says that given its use in the UK since 2003, it has built up a substantial reputation and goodwill under its EPITACT mark, such that it could bring an action in passing off against BSN in light of the respective marks' close similarities.
7. BSN filed a counterstatement denying the grounds of opposition.
8. It denies the respective marks are similar, overall, or visually, aurally and conceptually. Visually, it says its mark is applied in a stylised font. Aurally, it says the marks would be pronounced differently and, for example, the 'A' of '-GRAFT' would be pronounced differently to the 'A' of '-ACT'.
9. It submits that the element 'EPI' is a common prefix amongst a large number of registered marks co-existing in the market place for the same or similar goods to those of the parties. These marks appear to be owned by different proprietors. A search of the UK register for such marks in classes 5 and 10 reveals in the region of 200 marks, many of which have the same syllable count and a number of the same letters.
10. Conceptually, it says that by virtue of the fact that the consumer will pay closer attention to the endings '-GRAFT' and '-TACT', these elements, which are stand-alone dictionary-defined words connoting different conceptual meanings, render the respective marks conceptually different.
11. It puts the opponent to proof as regards its claimed similarity and identity of the goods.
12. All factors considered it denies there is a likelihood of confusion under section 5(2)(b).
13. Under section 5(3), it denies, firstly, similarity of the marks, but also any, or sufficient, reputation in the opponent's mark or that any of the heads of damage under section 5(3) would arise. Specifically, for such damage to arise there would have to be a change of economic behaviour of the average consumer which it denies and in respect of which it puts the opponent to proof.

14. Under section 5(4), it denies that any claim for passing off would prevent its use of the mark. It puts the opponent to proof of its claim that it has used its mark since 2003 and that it has any, or sufficient, goodwill to found any such claim in passing off. It also denies the marks are similar enough to form the basis of any misrepresentation.
15. Evidence by both parties has been filed which insofar as it is evidence of fact, I shall record below.
16. The opponent has also filed submissions dated 24th May 2011 which I understand the applicant to argue should be ruled inadmissible. Plainly, Rule 20 of The Trade Marks Rules 2008 ('TMR') provides for both evidence of fact and submissions, depending on the nature of the grounds of opposition pleaded and marks or signs relied upon. As such, I will take the submissions into account as submissions only, but insofar as they may purport to stray into areas of fact then they must be inadmissible in accordance with rule 64 TMR.
17. Both parties filed concluding submissions but neither requested to be heard, and so this decision is made after a careful reading of the papers on file.

The opponent's evidence

18. This takes the form of a witness statement dated 4th July 2011 from Damien Millet, Chairman of Millet. He says the company is an innovation company based in France specialising in the development, manufacture and distribution of pharmaceutical and cosmetic products. The company distributes its products under the EPITACT brand, including two lines, EPITACT PODOLOGIE (offering podiatry foot care products such as treatment for aches and pains, callus, corns, damaged nails), and EPITACT DERMATOLOGIE, comprising finger fissures, anti-bedsore and anti-scar treatments. It is also engaged in the field of research and development of silicone gels for sale under its own brands as well as for industrial clients as part of formed partnerships. The company's website is at www.milletinnovation.com and Exhibit 1 comprises the homepage which is in French.
19. He says the company first adopted the trade mark EPITACT in January 1996 and it has been used continuously in relation to the goods of its specification. Although the company commenced use of its mark in France in 1996, it has, since that date, become widely established and renowned in many countries. Exhibit 2 comprises promotional material including: an advertisement in an Italian magazine dated 5th December 2010; an advert in a German magazine dated 17th May 2011 and what appears to be an in-house magazine or catalogue, published in French and edited by Mr Millet dated January 2005.

20. Exhibit 3 comprises company literature, including an order form and delivery note to a firm based in the UK called Padeol Business Services in Bedford ('Padeol'), all intended to show the range of the opponent's products and promotion undertaken in the UK. Products include: dressings, paddings, cushions, creams and lotions for the treatment of foot ailments. It is unclear whether these products are for sale directly to the public. One of the order forms is described as an "Order form for professional 2003" and the heading on another says "EPITACT, Podiatrists' partner". The company's products are also advertised in a wholesale catalogue called the Batten –Edwards 2Treat Feet 'Podiatry Consumables Wholesale Catalogue 2005'.

21. Approximate UK turnover figures are provided as follows:

2010	22 831 Euros
2009	27 245 Euros
2008	26 751 Euros
2007	25 102 Euros
2006	50 971 Euros
2005	158 497 Euros
2004	269 004 Euros

22. Mr Millet says sales literature has been distributed in the UK, including mail order selling catalogues. Advertisements, have been placed in the national press, including YOURS, SAGA and CHOICE magazines up until 2005 and trade (including podiatry) exhibitions are attended. He also says the sales team from 2001-2005 was the company called Padeol, based in Bedford.

23. Advertising figures in the UK are provided as follows:

2004	81 562 Euros
2003	227 603 Euros

24. Mr Millet confirms that EPITACT products were supplied throughout the UK by Padeol. From 2005, the EPITACT brand has been sold through different commercial partners (distributors to podiatrists and individual consumers), as follows:

PODIACARE – The New Hall, Bath Road Bedford
AC MEDICAL – Teignmouth, Devon
DL TOWNEND SON & SANDY Ltd – Huddersfield
BAILEY INSTRUMENTS – Manchester
JUST CARE GROUP – London
HELP THE AGED- London
BATTEN EDWARDS – Milton Keynes.

25. I should also record that, annexed to submissions on behalf of Millet, there are a series of print outs from the internet showing various UK websites selling EPITACT products. I cannot, however, take these into account as they have not been provided in the proper format, which would have been as exhibits to a witness statement.

Applicant's evidence

26. This takes the form of a witness statement dated 17th August 2011 from Emil Billbäck, Group Director of BSN. He says his company is a global medical devices company and is a leading supplier of casting, bandaging, wound care and compression stockings, with a number of well-known brands. Its new brand, EPIGRAFT, was created for a new range of innovative wound covering and dressing products.

27. He exhibits three online dictionaries at EB-1, showing that the prefix 'EPI' has, contrary to the opponent's position, a meaning in relation to the goods. The dictionary MedicineNet.com defines 'EPI' as a "prefix taken from the Greek that means "on, upon, at near, over, on top of, toward, against, among"". The Merriam-Webster dictionary also says 'EPI' is a prefix for, eg 'upon' as in 'epiphyte', 'besides', as in 'epiphenomenon', 'attached to', as in 'epididymis', 'over', as in 'epicentre', 'outer', as in 'epiblast', and 'after', as in 'epigenesis'. It says it is Latin, from Greek, meaning on, at, besides or after.

28. Finally, Oxford Dictionaries Online says 'EPI' is a prefix meaning 'upon' as in 'epigraph', 'above' as in 'epicontinental' and 'in addition' as in 'epiphenomenon'. It also says the word is from the Greek, 'EPI', meaning 'upon', 'near to', or 'in addition'.

29. The remainder of his witness statement comprises a critique of Mr Millet's evidence and so I shall not record it here but take into account in due course.

Opponent's evidence in reply

30. This comprises a further witness statement, dated 1st December 2011, from Damian Millet. He says there is potential for confusion as the applicant is engaged in braces and footcare products (the area of specific concern to his company) and this is shown by such products on the applicant's website as: FLA Softpoint® Heel Cushion, FLA HealWell® AFO splint and FLA PressureLite® Diabetic insoles. This comprises exhibit DM1.

31. He says, as regards his submission that the prefix 'EPI' is the most distinctive and dominant element of the respective marks, that he is not aware of any other party within the EU, or within the UK specifically, using a trade mark with the prefix, 'EPI', in the field of foot care products. Exhibit DM2 comprises extracts from websites intended to show the absence of use of the prefix,

'EPI,' amongst foot care products, including on pharmacy/chemist and supermarket websites. As is clear from these printouts, the brands SCHOLL and COMPEED are especially prominent and as Mr Millet acknowledges, these are the main competitors in the UK.

32. Exhibit DM3 comprises a presentation prepared by his company for the UK market showing the range of products under the EPIGRAFT brand and their sales and market penetration in France, Belgium and Italy. It says EPITACT is the number one in France, Belgium, Switzerland and Italy within the 3 bigger segments of the foot care market: plantar pains, bunion and corns. The presentation also shows that the company uses another brand name, EPITHELIUM 26 (registered at OHIM), alongside EPITACT and this is to designate a patented silicone gel which impregnates the cushions, tubes or bandages for greater comfort. From this, Mr Millet contends that the prefix 'EPI' is very important to his company and is used across a range of foot care products acting as a unique identifier.
33. The remainder of his witness statement explains the importance of the UK market to the company and its efforts in promoting the brand on television and in publications in France, Belgium and Italy. The target market, he says, is likely to be elderly women. He then says the following:
- “UK consumers *will* [my emphasis] learn about the EPITACT products from various sources including product advertisements placed in magazines such as YOURS, SAGA and also through a recommendation from a podiatrist or the like. Going forward my company will promote the goods through other publications such as MY WEEKLY, TAKE IT EASY, THE LADY and THE PEOPLE'S FRIEND as well as through TV campaigns..... “.
34. Use of the future tense suggests that any such advertising and promotion as may have happened in the past in the UK is, from the company's perspective, assuming it has happened at all, on a much smaller scale than that which is intended in the future. It may also be the case of course that Mr Millar is not a native English speaker and I may be being presumptuous about reading too much into his exact wording but it is fair to record that the actual evidence (by which I mean dated copies of adverts) of widespread advertising the UK, as compared to France, Belgium and Italy, is sparse.
35. I should record that BSN's position is that the entirety of Millet's evidence in reply ought to be ruled inadmissible on the basis that it is not evidence in reply but ought to have been submitted as evidence in chief. I prefer at this point to have recorded the content of the evidence insofar as it is factual and, in the body of my decision below, to assess its weight, if any. I note that regardless of its admissibility, in any event BSN denies any relevance to the

question before me, and in particular, that it proves that 'EPI' is not a commonly used term for the opponent's goods.

DECISION

Section 5(2)(b)

36. The first ground of opposition is founded upon Section 5(2)(b) of the Act. This reads:

5. - (1).....

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

(a)

(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.

37. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

38. Plainly, Millet's mark is an earlier mark under the Act with a date of registration less than 5 years prior to the relevant date of the international designation, being 7th May 2010.¹ This means it is not susceptible to proof of use requirements.

39. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the

¹ Under Art 3(3)(g) of The Trade Marks (International Registration) Order 2008, the meaning of 'publication' (used in Section 6A (1) (c) of The Trade Marks Act 1994) in relation to designations under the Madrid system, is the date of publication in the Journal of the details of the international registration.

European Union (“CJEU”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods

40. This is a notional comparison based on the goods as set out in the specifications and not what the parties may actually trade in. The respective goods and services are as follows:

BSN's goods	Millet's goods
<p>Class 5</p> <p>Tapes and bandages for dressing purposes; dressing material; wound coverings</p>	<p>Class 5</p> <p>Pharmaceutical preparations for medical purposes based on silicone gels; balms and creams for medical purposes and in particular antiperspirant foot cream; effervescent bath salts and tablets for medical purposes; materials for dressings; pre-cut or uncut orthopaedic dressings; pharmaceutical and veterinary preparations, namely patches impregnated with active substances.</p> <p>Class 10:</p> <p>Medical, orthopaedic and podological apparatus and instruments; orthopaedic articles, in particular orthopaedic articles for the correction of foot and toe deformations, orthopaedic articles for the prevention of pressure sores, orthopaedic articles for the prevention</p>

	<p>and reduction of pressure and rubbing of the feet, orthopaedic articles impregnated with active substances, orthopaedic articles based on silicone gels, elastic sheaths and bandages for orthopaedic use, orthopaedic pads, orthopaedic soles and half-soles, orthopaedic hosiery, orthopaedic slippers and footwear.</p>
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41. BSN says there is no supporting explanation or evidence behind Millet’s claim that the respective goods are identical/similar. Absent such support, the claim must be rejected. Moreover, that since the respective marks are dissimilar (as the OHIM found in, eg EPIVIR/EPIGEN²), then any identity or similarity in respect to the goods will have no effect.
42. As to the first argument, the Appointed Person said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary. He also stated that the tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public. Given the nature of the goods in this case, I consider myself capable of analysing the specifications, as a matter of pure linguistics, with the aim of forming a view based on a self-evident basis.
43. As to the second argument, this invites me to close the proceedings down on the pre-emptive basis³ that any likelihood of confusion is impossible if the marks are dissimilar. Instead I intend to proceed to a full global assessment.
44. Millet’s goods in class 5 include “materials for dressings” and “pre-cut or uncut orthopaedic dressings”. Whilst identical terms are not used by BSN, the terms used are synonymous with those used by Millet. Tapes and bandages for dressings *are* materials for dressings and may be pre-cut or uncut and for orthopaedic use. I note further that it is not necessary that the

² See OHIM Opposition division decision 855/2000 *Glaxo Group Ltd v Cheminova Internacional SA*

³ UK cases tend to caution against pre-emptive findings in any event, see eg *eg Pinguino/Penguin* BL O/144/05 and *Mobis* BL O/20/07, in particular para 16. The danger with such pre-emption is said to be an undermining of the interdependency principle.

respective specifications must be co-extensive for a finding of identity.⁴ On that basis I find that the respective goods in class 5 are identical.

The average consumer and nature of the purchase

45. I need to assess who exactly the average consumer is and the nature of the acquisition and purchase of the respective goods.
46. Both parties' products are, broadly speaking, medical products. There is nothing to suggest they would *only* be available via the intervention of medical intermediaries, such as doctors, nurses or podiatrists. Such products are, as the evidence shows, available through pharmacies and supermarkets (both online and in a traditional retail context). In the circumstances I need to consider the prospect that consumers would access both parties' products through a variety of means, including normal retail channels and also via health intermediaries. The identities of the average consumer for each parties' goods will clearly overlap and will comprise both end users who will be members of the general public and health professionals.
47. In either case, a reasonable degree of circumspection will be exercised, either by the end user (the patient), or the end user in combination with the health professional. Although the respective products may not be of high value, they are nonetheless medical products used to treat specific problems.
48. On that basis I will need to factor into my overall assessment that the average consumer may be either the end user who purchases the products directly or healthcare professionals who may act as intermediaries, but in both cases at least a reasonable degree of circumspection will be deployed in their selection process.⁵

Comparison of the marks

49. The case law makes it clear I must undertake a full comparison of the marks, taking account of visual, phonetic and conceptual similarities and dissimilarities, from the perspective of the average consumer. Marks need to be considered in their totalities and taking account of overall impression, giving recognition to any distinctive and dominant elements.
50. The marks to be compared are as follows:

⁴ See, eg, BL O-269-04, *Galileo*, a decision of the Appointed Person, and *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*, a decision of the General Court (para 29 refers).

⁵ Authority for this can be found in, eg Case T-256/04 *RESPICORT*, a decision of the General Court.

BSN's mark	Millet's mark
EPIGRAFT	EPITACT

51. Visually, I need firstly to address the claim by BSN that its mark is registered in a stylised font. It is not. It is presented in plain block capitals and I note that the The international register, held by WIPO, records the mark in normal font with no indication as to particular stylisation and that is how I must regard the mark. There is then, nothing in the stylisation point. Both marks are of similar length and present as word-only marks, although neither are recognisable words in the English language. Both marks naturally break down into two component parts. They start with the prefix, 'EPI', and the final letter is 'T'. The suffixes are different '-the known word GRAFT' in BSN's mark and the known word '-TACT' in Millet's, although the letter 'A' is shared. Taking into account the I similarities and dissimilarities I find the respective marks to be visually similar only to a low degree.

52. Phonetically, BSN's mark will be pronounced 'EPI – GRAFT'; the 'A' in 'GRAFT' will be pronounced either with a long or short vowel sound. Millet's mark will be pronounced 'EPI-TACT'. The 'A' of 'TACT' has less scope to be pronounced as a long or short vowel sound and instead, will be pronounced as a short vowel sound Taking the similarities and dissimilarities into account I find the respective marks to be phonetically similar only to a low degree.

53. Conceptually, I do not accept that simply because these words are both made up then there can be no conceptual similarity, or that my finding has to be 'neutral'. Firstly, although I am required to view both marks as wholes, in such a case as this, the case law makes clear that it is legitimate to identify prefixes and suffixes in such marks which may have particular levels (or none at all) of distinctiveness or descriptiveness.⁶ Furthermore it is the case that the consumer may, when perceiving a verbal sign, break it down into elements which, for him or her, suggest a concrete meaning or which resemble words known to him⁷. Both these authorities, taken together, persuade me that any argument to the effect that the marks will not, under any circumstances, be broken down is incorrect. The circumstances of each case must be properly examined and the conclusions as to conceptual similarity may differ in relation to different average consumers.⁸

54. As far, firstly, as the healthcare professional is concerned, in my view they are more likely to see a clear conceptual meaning behind the mark EPIGRAFT,

⁶ See eg General Court case T-202/04 *ECHINAID*, paras 44- 46.

⁷ See *RESPICORT* (para 57) supra

⁸ See *RESPICORT* (para 58) supra

based upon the known prefix 'EPI' having the medical dictionary meaning set out in the evidence, and which a healthcare professional may be expected to know or be aware of, and 'GRAFT', as in 'skin graft'. The combination of the two meaning something which acts on or in close proximity to the skin, or performing the function of, or otherwise similar to, a graft.

55. In contrast, 'TACT' as in 'EPITACT' has no clear medical meaning (unlike GRAFT). Whilst it is a known word, its relevance to the goods for which it is registered will be far from clear. At best, it may be seen as having derived from 'CON-TACT' or 'TACT-ILE'. For the healthcare professional then, there is conceptual divergence, EPIGRAFT, as a totality, has clear derivation in relation to the relevant goods and EPITACT has none, save medical recognition of the prefix, 'EPI'.
56. In contrast, knowledge of medical dictionaries cannot necessarily be imputed to the end-user patient, as opposed to healthcare professionals. He or she is unlikely to be aware of the precise meaning of the prefix, 'EPI'. They may be aware that certain (medical) words begin with 'E-P-I', such as 'epilepsy' or epidermis but beyond that any knowledge will be vague at best. Nevertheless the suffix 'GRAFT' will in my view resonate with most as a well-known word in its own right, as in, eg 'skin graft'. No such conceptual meaning will arise with the word EPITACT, which is likely to present as an invented term. So, even for the end user patient, there will be some measure of conceptual difference.

Overall finding of similarity of marks, including distinctive and dominant elements

57. I need to bring my individual findings together in an overall assessment of similarity, bearing in mind any distinctive and dominant elements. Millet's position is that for the average consumer, the prefix 'EPI', is its most distinctive and dominant element (which it claims is unused by any other foot care product manufacturer in the UK), and this is shared by BSN's mark. BSN's position is that 'EPI' is not a distinctive element at all, being a (medical) dictionary recognised prefix and used in many other marks registered in class 5 or class 10 (of which there is no formal evidence, however).
58. Millet says, as fact, that it is the only foot care manufacturer in the UK using the prefix 'EPI' and it follows that the prefix 'EPI' is its most distinctive and dominant, or at least fanciful element. This is reinforced by the fact it is used in certain of its other brands, such as EPITHELIUM 26.
59. It is important to recognise, however, that this is a notional analysis, based on the goods of the respective specifications (which in Millet's case are not limited to foot care), rather than based upon what the parties' actually make, or for which they are responsible. Millet's evidence in reply, in as much as it

is limited to the area of foot care does not help since its actual specification is much broader. I will nevertheless address Millet's argument about 'family recognition' of the prefix 'EPI' in due course.

60. Millet continues that the precise meaning of 'epi' is obscure to the average UK consumer, and that as a prefix it does not have the same unambiguous quality as 'aqua', for example. It also says that where 'epi' appears in a word, such as 'epilepsy', for example, it is the overall meaning of the word 'epilepsy' that will be known, as opposed to any etymological meaning derived from the prefix, 'EPI'.
61. As I have said under my conceptual analysis, there are two sets of average consumers here; the healthcare professional for whom knowledge of the meaning of the prefix 'EPI' can be imputed, and the end user for whom it may not be safe to do so. In either case however, I reject Millet's submission that the prefix 'EPI' comprises 'the most distinctive or dominant element' within the respective marks. These are not 'epi', plus something else, marks. Not least, there is no visual separation or emphasis to the letters, E-P-I, from the remainder of the letters which together, form known words, TACT and GRAFT.
62. Even for the less familiar end user patient, words beginning with 'E-P-I', such as 'epilepsy' and 'epidermis', may well spring to mind in the medical sphere and this negates any argument that 'epi' is the stand out, distinctive element of either mark.
63. Taking all factors into account, that is to say visual, aural and conceptual findings and my finding that the letters 'E-P-I' do not stand out as the distinctive, dominant element in either mark, I find that the respective marks are, overall, similar only to a low degree.

Distinctiveness of the earlier mark

64. My discussion above leads me into a final assessment which must be done prior to an assessment of likelihood of confusion, namely, the distinctiveness of the earlier mark. A mark comprising an invented word, such as KODAK for example, will inevitably be very high on the scale of distinctiveness, whereas a known word which has a more obvious connection with the relevant goods or services will be lower on the scale of distinctiveness.
65. The earlier mark is not a known word. As far as healthcare professionals are concerned there will be recognition of the prefix but nothing more and for the end user patient there may be no recognition at all. In consequence I find that the earlier mark is inherently distinctive to a high, but not the highest, degree.

66. I need also to consider whether that degree of inherent distinctiveness is enhanced through use in the UK. As is clear from the authorities the fact that an earlier mark has been used on a significant scale is a factor which needs to be borne in mind in a likelihood of confusion assessment.⁹ That said, I am unable to conclude from the evidence that the earlier mark has been used on a significant scale in the UK. From 2007, the turnover figures are around 20,000 Euros. Although Mr Millet says the mark has been advertised in 'YOURS', 'SAGA' and 'CHOICE' magazines from 2005, no adverts from those magazines are actually produced and the evidence (referred to in para 32 above) is of promotion only in Italian, French and German publications (one of which appears to be 'in-house'), with an *intent* only to promote in the UK. In my view the evidence does not make the case for a significant scale of use. In any event, as the *STEELCO* authority referred to in my footnote makes clear, notwithstanding any enhanced distinctiveness, if a part of a mark merely conveys a descriptive or non-distinctive meaning, (as in the prefix 'EPI', which, if not being outrightly descriptive, is still, for some at least, a known prefix), then the case for likelihood of confusion is not advanced.

Global assessment under section 5(2)(b) - likelihood of confusion

67. At this point I need to remind myself of my various findings and bring them together in a global assessment taking, of course, into account, the doctrine of imperfect recollection, namely that consumers rarely have the opportunity to compare marks side by side.

68. I have found the earlier mark to be inherently distinctive to a high degree but without enhanced distinctiveness. I have found the respective marks to be similar to a low degree. I have observed that a reasonable degree of circumspection will be used in the purchase of these products and that there will be overlap in terms of the identities of the respective consumers. I have also found the respective goods to be identical. I must also remind myself that the nature of 'confusion', whether it be direct or indirect, for the purposes of section 5(2) does not include mere association in the sense of 'bringing to mind'.

69. At this point I should record that both parties rely upon case law to inform my decision. Millet draws my attention to the decisions of the registrar in VIROGONE/VIRKON¹⁰ and ZATAMIL/ZATAFLIT¹¹. For its part, BSN alerts me to a decision of the Spanish PTO dated 28th January 2011 between the same parties and involving the same trade marks which found for the holder of the international registration, and also to OHIM Opposition Division no 855/2000 EPIVIR/EPIGEN¹² which found visual and aural dissimilarity

⁹ See, eg BL O-268-04 *STEELCO*, a decision of the Appointed Person at para 17.

¹⁰ BL O-149-09

¹¹ BL O-029-09

¹² *Supra*, at para 40

sufficient to preclude likelihood of confusion and finally, SWEETEX/SWEETELA¹³ before the registrar which found the endings of the marks to be sufficiently and markedly different so that the overall impressions are capable of differentiation. Whilst I have noted these findings I cannot be bound by any of them as all are decided on their own relevant facts and circumstances.

70. Bearing all these factors in mind I find there will not be a likelihood of confusion. Whilst I am obliged to bear all factors in mind, the comparison of marks, and in particular the known prefix 'epi' plays a large part in my overall finding.
71. As to the submission that 'epi', instead of being perceived as a non-distinctive prefix, has acquired a 'family-like' status as far as Millet is concerned, this runs into the difficulty that here is just one other brand, EPITHELIUM 26, which contains the prefix 'epi'. It is unlikely that just two marks constitute a family. Moreover, the exposure of 'EPITHELIUM 26' on the UK market is far from clear from the evidence and it is essential for such a claim to run that the family of marks must be shown to be in actual use¹⁴. Finally, the common element is itself, a known (even if the precise meaning is not known, it is still a *recognised* prefix) prefix 'epi'.
72. Given my findings under section 5(2)(b) (which I do not consider to be borderline), I will not consider in detail the grounds under section 5(3) and 5(4). As regards section 5(3), Millet says its mark has the required reputation across the Community¹⁵. Even if this were the case, it would flounder at the stage that the consumer would be required to make a 'link'¹⁶ (calling to mind) between the respective marks. In my view, no such link would be made, given recognition of the prefix 'EPI' and the consequent low degree of similarity between the respective marks. Moreover, I can see no basis for the claim that unfair advantage has been taken by BSN. There is nothing to suggest, for example, that its choice of mark was in any way, 'deliberate'.
73. As regards section 5(4), any claim to the requisite goodwill would, if accepted, only reside in podiatry or foot care products, which is more narrowly focussed than the notional section 5(2)(b) claim, and so it is not necessary in this case, to consider in detail the claim based on section 5(4)(a). It would, in my view, have failed for the same reasons as the section 5(2)(b) claim.

Costs

¹³ BL O-340-10

¹⁴ See Case C-234/06P *IL PONTE FINANZIARIA*, before the Court of Justice of the European Communities ('CJEU').

¹⁵ See Case C-301/07 *PAGO INTERNATIONAL GmbH* [2010] ETMR 5 where reputation in Austria only was said to constitute reputation in the Community.

¹⁶ See Case C-252/07 *INTEL v CPM UK Ltd* before the CJEU

74. BSN medical GmbH has been successful in defending against this opposition and is entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither party sought a hearing. In the circumstances I award BSN medical GmbH the sum of £1100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Filing counterstatement and considering statement	£300
Filing and reviewing evidence	£500
Filing and reviewing submissions	£300

75. I order Millet Innovation (société anonyme) to pay BSN Medical GmbH the sum of £1100. The sum should 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 19th day of March 2012

**Edward Smith
For the Registrar,
The Comptroller General**