TRADE MARKS ACT 1938 (AS AMENDED) AND TRADE MARKS ACT 1994

IN THE MATTER OF THE APPLICATION No 1556480 BY STAFFORD-MILLER LIMITED TO REGISTER A MARK IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO UNDER No 43561 BY AMERICAN HOME PRODUCTS CORPORATION

TRADE MARKS ACT 1938 (AS AMENDED) AND TRADE MARKS ACT 1994

IN THE MATTER OF THE Application No 1556480 by Stafford-Miller Limited to register a mark in Class 5

and

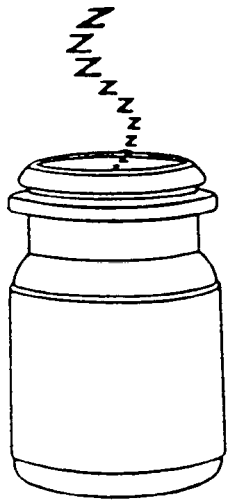
IN THE MATTER OF Opposition thereto under No 43561 by American Home Products Corporation

DECISION

On 13 December 1993 Stafford-Miller Limited, of Welwyn Garden City, Hertfordshire, applied to register a mark in Class 5, in respect of:-

> "Pharmaceutical, veterinary and sanitary preparations and substances; pharmaceutical preparations and substances, all for dental care; medicated mouthwashes; medicated chewing gum, dental products; disclosing tablets; disinfectants; cleaning materials impregnated with disinfectant; somnolents and soporifics; medicated preparations and substances, all for causing drowsiness and acting as an aid to induce sleep; all included in Class 5."

The application is numbered B1556480. The mark is in the form of a device of a container from which are emerging a number of representations of the letter Z, as shown below:-



The applicants disclaim exclusive rights in the letter Z and the device of a container.

On 23 November 1995 American Home Products Corporation, of New Jersey, USA filed notice of opposition to this application. The grounds of opposition are, in summary:-

(i) under Sections 9 and 10, in that the mark is neither distinctive, nor capable of distinguishing, and

(ii) under Section 17 and 68, in that the device is not a trade mark and its registration would unfairly hamper other legitimate traders.

The opponents ask that the application be refused in the exercise of the Registrar's discretion, and an award of costs be made, in their favour.

The applicants filed a counterstatement denying these grounds. They ask the Registrar to accept the application and award costs in their favour.

Only the opponents filed evidence in these proceedings and the matter came to be heard on 4 February 1998. At the hearing the applicants were represented by Dr Heather Lawrence, of Counsel, instructed by Messrs Marks & Clerk. The opponents were represented by Ms Jessica Jones of Counsel instructed by Messrs D Young & Co.

I should mention at this point that this case is one of two closely related sets of proceedings. The other, (opposition No 43557, in respect of B1556477) was not consolidated with this case, but was heard at the same time. The evidence filed is virtually the same in both cases, but the marks differ to some extent. I am therefore issuing separate decisions in respect of these two sets of proceedings; it follows, however, that the wording of these two decisions will be the same at all points where the considerations and the findings are the same.

Opponents' evidence

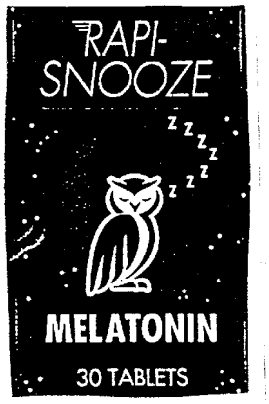
This comprises of a Statutory Declaration by Ms Joanna Hill, of Maidenhead, Berkshire.

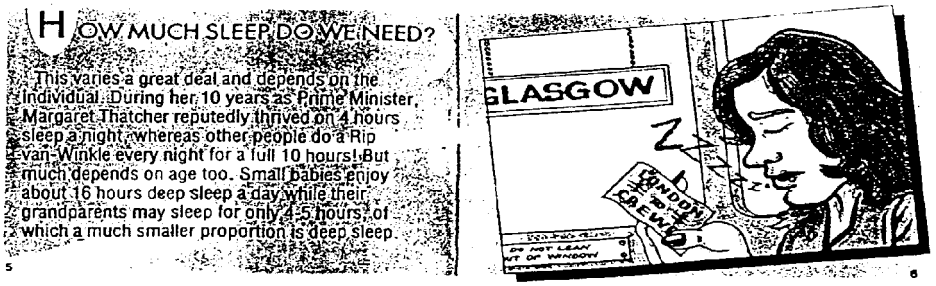
Ms Hill states that she is an Assistant Product Manager of Whitehall Laboratories Limited, an English company. The opponents, American Home Products Corporation, are the parent company of Whitehall Laboratories Limited.

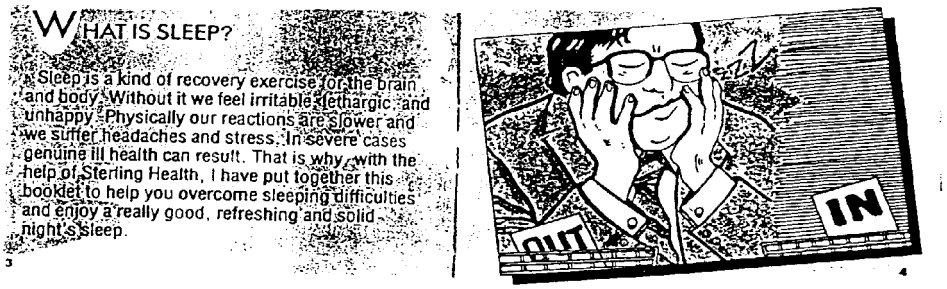
Ms Hill goes on to state that she is aware that the applicants have applied to register a device, a pattern made up of a number of representations of the letter Z emerging from a container. She exhibits samples of packaging produced by other manufacturers in the pharmaceutical field which feature similar "Z" devices; these comprise a photocopy of the external packaging for RAPI-SNOOZE melatonin tablet, which is an unlicensed product containing melatonin produced by Medi-Naturals, and a leaflet "Understanding Sleep" which was an in-pack insert for HEDEX headache tablets (produced by Sterling Health). It will be noted says Ms Hill, that both materials feature use of similar "Z" devices to those covered by Trade Mark Application No B1556477.

Ms Hill goes on to state that it is her experience that a device combining several letters Z is commonly used in relation to pharmaceutical products which are designed to promote or assist sleep; as evidenced by her exhibits, she says. Ms Hill states that it is her opinion that it would not be appropriate to grant a registered monopoly in this type of device as a trade mark since this would hamper other legitimate manufacturers in this field who might wish to use such a device to indicate the sleep promoting qualities of their products.

Parts of her exhibits are reproduced below:-







As stated earlier, the applicants did not file evidence in response to this, and I therefore turn to consider the grounds of opposition.

The opponents object under Sections 9, 10, 17 and 68. The objection under Section 9, of course, can have no point since the application was made, and accepted, in Part B. The remaining sections, in so far as they are material to these proceedings, read as follows:

> "10. - (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration."

An application for registration is made under Section 17(1), which says:

> "17. - (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register."

For the purposes of Section 17, a trade mark is defined in Section 68, as follows:

> "68. - (1) In this Act, unless the context otherwise requires, the following expressions have the meanings hereby assigned to them respectively, that is to say -
>
> > "trade mark" means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section thirty-seven of this Act;..."

The opponents' case against this application is that it consists exclusively of a sign indicative of the intended purpose or effect of the goods (sleep); thus it is not a trade mark and so is incapable of distinguishing any traders goods from those of other traders. It seems to me that if this allegation is upheld, the opposition must succeed under all three sections. If it is not upheld, the opposition must fail under all three sections. I will therefore consider the case as a whole.

Dr Lawrence's case in support of the application, thorough and detailed as it was, may I think be summarised as follows:

1 Even if a part of a mark is non distinctive, the mark as a whole can be distinctive; in this case the mark is distinctive; it consists of much more than letter Z's; the Z's are of different sizes, they are rising out of a container and increasing in size as they go, forming a "swirl pattern" in the process.

2 The mark is quite different from either of the two examples in the opponents' evidence. Moreover, the headache leaflet was not even an example of trade mark use.

3 The area of protection sought was very limited (and could be limited still further).

4 Other traders were protected by the disclaimer.

5 Monograms consisting of three or more letters are acceptable in the prima facie case, according to Registry practice.

In support of her case Dr Lawrence took me through a number of decided cases. From Arthur Fairest Ltd's Application 68 (1951) RPC 197, she quoted Lloyd-Jacob J's words (lines 12-15 on page 206) "... a mark is not prevented from being a distinctive mark under Section 9(1)(e) because it includes amongst its integers an integer which in itself is not separately registrable". She cited Philip Morris Inc's Application [1980] RPC 527 to show that disclaimers afford protection to other traders. CHIN CHIN trade mark [1965] RPC 136 and MY MUMS COLA [1988] RPC 130 were cited as examples of well known expressions nonetheless being acceptable in Part B.

Against this Ms Jones pointed to the examples given in the opponents' evidence as confirmation of a well-known fact; in Ms Jones' submission the mark is an entirely conventional and commonplace indication of sleep. Its use by others shows that it is needed by others, as an apt and obvious symbol in relation to sleeping preparations. Words or signs thus needed should not be registered. Ms Jones contended that no amount of use could make this mark registrable, and she drew particular attention to the words of Mr Robin Jacob QC (as he then was) in COLORCOAT Trade Mark [1990] RPC 511 on page 517 lines 11 and 12: "Essentially the reason is that the privilege of a monopoly should not be conferred where it might require honest men to look for a defence."

In the course of these presentations Counsel, for both sides, took me through a number of other reported cases, all of which I considered very carefully. It appears to me, however, that this case is one to be tried essentially on its own facts. These facts are that the sign applied for is a straightforward representation of a container together with a conventional, and I believe much used, indication of sleep. The evidence shows that others use this sign on the packaging of drugs and on literature of a promotional/advisory nature pertaining to drugs. Dr Lawrence submitted that the problem could be dealt with by a restriction of the

specification and the imposition of a suitably worded disclaimer. I have considered these suggestions but have had to conclude that they would not overcome the objections to registration. Restriction of the specification so that it covered only products not meant to induce sleep would actually mislead the public, I believe. As to a disclaimer I can think of nothing which would achieve the desired protection of the interest of others and yet leave some residue of a mark to be registered.

In the result, therefore, I find that this mark is not capable of distinguishing the goods of one trader from those of another and accordingly the mark cannot be registered under the terms of Section 10. I also find that it is not a trade mark within the meaning of Section 68 of the Act.

There remains the matter of the Registrar's discretion. However, I do not feel that this can be exercised in favour of an application which so clearly has the potential to embarrass other honest traders, and accordingly I decline to make an exercise of discretion in this case.

The opposition having succeeded I order the applicants to pay to the opponents the sum of **£550** as a contribution towards their costs.

Dated this 9th day of March 1998

M J TUCK
For the Registrar
the Comptroller-General