

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2248161 BY  
THE HEALTHY FORUM LIMITED TO REGISTER A MARK  
IN CLASSES 3, 5, 16, 29, 30, 32 AND 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 52183  
BY SANOFI-SYNTHELABO**

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**BACKGROUND**

1. On 10 October 2000, The Healthy Forum Limited Ltd of Fenstanton, Cambridgeshire, applied to register the following trade mark in Classes 3, 5, 16, 29, 30, 32 and 35.



2. The application was accepted and was published together with the following clause:

“The applicant claims the colour green as an element of the mark”

for the following specifications of goods:

**Class 3**

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils; cosmetics, hair lotions; dentifrices.

**Class 5**

Pharmaceutical, veterinary and sanitary preparations; feminine hygiene products; dietetic substances adapted for medical use; health food supplements for persons with special dietary requirements; health food supplements made principally of vitamins; health food supplements made principally of minerals; food for babies; materials for dressings; dental wax; disinfectants.

### **Class 16**

Disposable nappies.

### **Class 29**

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces, eggs, milk and milk products; edible oils and fats.

### **Class 30**

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder, salt, mustard, vinegar, sauces, condiments; spices.

### **Class 32**

Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and juices; syrups and other preparations for making beverages.

### **Class 35**

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase these goods in a retail food store.

3. On 23 February 2001, Sanofi-Synthelabo of Paris, France, filed notice of opposition. They are the proprietors of registration No: 2223962 which is registered in Class 5 in respect of the following trade mark:

**sanofi~synthelabo**  
**Because health matters**

They go on to frame their objections as follows:

“4. The trade mark the subject of the application principally consists of the generic term “health matters” and is not, therefore, capable of distinguishing the goods of the applicants from those of other undertakings within the meaning of Section 1(1) of the Trade Marks Act 1994. Thus, the trade mark the subject of the application should be refused in respect of all classes in accordance with Section 3(1)(a) of the Trade Marks Act 1994.

5. Further or in the alternative, the trade mark the subject of the application principally

consists of the generic term "health matters" and is, therefore, devoid of any distinctive character and should be refused in respect of all classes in accordance with the provisions of Section 3(1)(b) of the Trade Marks Act 1994".

6. Further or in the alternative, the trade mark the subject of the application consists exclusively of signs or indications which may serve, in trade, to designate the intended purpose of the goods for which the mark is applied i.e. goods and services which are important for a person's health and well being. Accordingly, the trade mark the subject of the application should be refused in respect of all classes in accordance with the provisions of Section 3(1)(c) of the Trade Marks Act 1994.

7. Further or in the alternative, the trade mark the subject of the application is visually, phonetically and conceptually similar to the opponents' trade mark and is proposed to be registered in respect of identical or similar goods in Class 5 to those for which the earlier trade mark is registered and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark. Accordingly, the trade mark the subject of the application should be refused in accordance with Section 5(2)(b) of the Trade Marks Act 1994".

4. On 27 March 2001, the applicants filed a counterstatement in which they admit the existence of the opponents' earlier registration. Other than to refer to two other registrations, both of which are said to include the words HEALTH MATTERS, the counterstatement is, in effect, a denial of the various grounds.

5. Both parties filed evidence and both seek an award of costs.

6. In accordance with the Trade Mark Registry's practice, I reviewed the case and informed the parties that I did not consider it necessary for an oral hearing to be held in order that the matter could be disposed of. The parties agreed that a decision could be taken on the basis of the pleadings and evidence filed. Having considered all of this material I give the decision set out below.

## **DECISION**

### **The Evidence**

7. The opponents' evidence consists of two Witness Statements; the first dated 21 May 2001 is accompanied by two exhibits and represents the opponents' evidence-in-chief. The second dated 2 October 2001 is accompanied by one exhibit and represents the opponents' evidence-in-reply; both are by Sophie Bodet who is the Deputy Director of the Trade Marks Department of Sanofi-Synthelabo. The applicants filed a Witness Statement dated 4 July 2001 accompanied by two exhibits; this is by Cavan Bickell who is the Chief Executive Officer of The Healthy Forum Limited. I do not intend to summarise these Witness Statements and exhibits. Having carefully read all the material provided, it consists principally of the parties' respective views on the registrability (on both absolute and relative grounds) or otherwise of the application in suit. Any relevant facts from the evidence I use and refer to below.

8. I begin by considering the grounds of opposition based on Sections 3(1)(a), 3(1)(b) and 3(1)(c) of the Act.

Section 3(1)(a), (b) and (c) of the Act read as follows:

3.-(1) The following shall not be registered -

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,"

9. Section 3(1)(a) refers to Section 1(1) of the Act which states:

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

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

10. In essence I think the opponent's case is that, while the application in suit comprises a composite trade mark, the application consists principally of the words HEALTH MATTERS (which they say is a generic term) and that the remaining device element present in the trade mark is insufficient to enable the trade mark in totality to qualify for registration under Sections 3(1)(a), (b) and (c) of the Act. Thus the opponents' case relies upon two propositions, both of which must be demonstrated. Firstly, that the words HEALTH MATTERS are descriptive and secondly that, bearing in mind that the trade mark also contains a device element, that the trade mark in totality does not meet the necessary requirements, because the device element is insufficient to give the trade mark the distinctive character required to justify registration.

11. Taking Section 3(1)(a) first, it is now generally accepted that the test under this section establishes a low threshold. In the case of **AD 2000 Trade Mark** [1997] RPC 5 168, the Appointed Person, Geoffrey Hobbs QC stated that:

".... the requirements of section 1(1) are satisfied even in cases where a sign represented graphically is only "capable" to the limited extent of being "not incapable" of distinguishing goods or services of one undertaking from those of other undertakings. Such signs are not excluded from registration by section 3(1)(a). Section 3(1)(a) has the more limited effect envisaged by article 3(1)(a) of the Directive of preventing the registration of "signs which cannot constitute a trade marks" at the time when they are put forward for registration."

12. Furthermore, according to the **Opinion of Advocate General Ruiz-Jarabo Colomer in the Court of Justice of the European Community in Case C-299/99 Philips Electronics NV v. Remington Consumer Products Ltd** [2001] R.P.C. 38 page 754 paragraph 43 and 44, there is not a category of marks which are *incapable* of acquiring a distinctive character, that would not otherwise be excluded by Section 3(1)(b) and (c) of the Act. In my view there is no basis for the Section 3(1)(a) ground in respect of the trade mark at issue. I do not believe that the trade mark in suit is so hopeless that it fails under Section 3(1)(a) of the Act and this ground is dismissed accordingly.

13. I now go on to consider the grounds under Sections 3(1)(b) and (c) of the Act. In paragraph 6 of his Witness Statement (albeit in the context of the opponents' ground under Section 5(2)(b) of the Act) Mr Bickell says:

“.....I do not dispute that HEALTH MATTERS is a common non distinctive element between the two marks”

and:

“Confusion would not occur between non-distinctive generic terms, the term HEALTH MATTERS being in use by numerous traders in this area without any evidence of confusion. In this regard, I refer to Exhibit CJPB/1, a dialogue search of the term HEALTH MATTERS which illustrates the widespread use of the term, and the fact that it cannot be attributed to any one trader”.

14. Although I give little weight to the information provided in this exhibit (dated as it is 22 June 2001 ie. after the material date in these proceedings), it does no more than confirm my own view of the descriptive nature of the words HEALTH MATTERS in the context of a whole range of goods and services. It is of course also an admission on the part of the applicants that the words HEALTH MATTERS are descriptive; indeed the applicants rely on this fact in their defence to the opposition based on Section 5(2)(b) of the Act to which I shall return later in this decision.

15. My conclusion above on the words HEALTH MATTERS is, of course, not the end of the matter, in that the trade mark in suit also contains a device element which appears in the centre of the trade mark and between the words HEALTH and MATTERS . This device element comprises a circle (in respect of which the applicants have claimed the colour green as an element of the mark) below which is a geometric device. I am not aware that the device element has any signification or meaning in relation to the goods and services for which registration is sought. I note that other than to characterise the device element of the trade mark as “minimal” and “trivial” the opponents do not provide any evidence that the device element has any significance.

16. In reaching a conclusion on this point, I have regard to the comments of Jacob J in **British Sugar PLC and James Robertson and Sons Ltd** [1996] RPC 281, page 306, line 1 (the TREAT decision) in which he said:-

"Next, is "Treat" within s.3(1)(b)? What does devoid of any distinctive character

mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?"

17. Also, the recent judgement of the European Court of Justice (ECJ) in case C-383/99 P (**Procter & Gamble v OHIM**) - the "**BABY-DRY**" case. Here at paragraph 39 the ECJ said:

"39. The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics."

18. Considering the trade mark in suit as a whole, it seems to me that the device element present in the trade mark is sufficient to provide the trade mark with distinctive character. Having regard to the positioning and prominence of the device, it appears to me that the trade mark applied for is, in its totality, presented in a manner which distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics. The trade mark contains sufficient surplus or capricious addition to the words HEALTH MATTERS to justify registration. Consequently, the opposition based on Sections 3(1)(b) and (c) of the Act also fail.

19. That leaves the ground of opposition based on Section 5(2)(b) of the Act and relates to the Class 5 element of the application only. Section 5(2)(b) reads as follows:

**5.-** (2) A trade mark shall not be registered if because -

(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 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."

20. An earlier right is defined in Section 6 of the Act, the relevant part of which states:

**"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,”.

21. In my consideration of a likelihood of confusion, I take into account the guidance provided by the European Court of Justice (ECJ) in **Sabel BV v. Puma AG** [1998] R.P.C. 199, **Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc** [1999] E.T.M.R. 1, **Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.** [2000] 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* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, 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* page 224;
- (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* page 224;
- (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* page 7, 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* page 8, paragraph 24;
- (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* page 224;
- (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* page 732, 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* page 9 paragraph 29.

22. The trade mark on which the opponents rely ie. No: 2223962 is registered and has a filing date of 29 February 2000. As such, it qualifies as an “earlier trade mark” within the definition of Section 6(1) of the Act.

**Comparison of goods - in respect of Class 5 only**

23. The opponents’ trade mark is registered in respect of:

Pharmaceutical and sanitary preparations; dietetic substances adapted for medical use

whereas the applicants’ trade mark in Class 5 is proposed to be registered for a specification of goods reading:

Pharmaceutical, veterinary and sanitary preparations; feminine hygiene products; dietetic substances adapted for medical use; health food supplements for persons with special dietary requirements; health food supplements made principally of vitamins; health food supplements made principally of minerals; food for babies; materials for dressings; dental wax; disinfectants.

24. In their counterstatement the applicants comment as follows:

“Whereas the applicant accepts that the goods within Class 5 which the application covers, are identical to those included in the opponents’ registration.....”

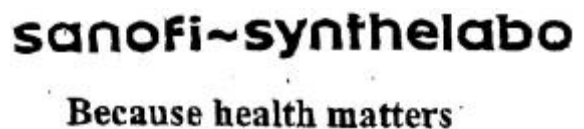
25. From the above, it is clear that it is common ground between the parties that the goods of the registration are wholly contained within the Class 5 element of the specification of the application. I approach the comparison of the trade marks with this in mind.

**Comparison of trade marks**

26. The trade marks to be compared are as follows:

**Applicants’ trade mark**

**Opponents’ trade mark**



27. Ordinarily, I would now go on to consider the respective trade marks from an aural, visual and conceptual standpoint in the context of the average consumer of the goods in question. However, from the above, it is clear that the only point of similarity between the respective trade marks are the words HEALTH MATTERS; in this regard, I note that both parties accept that these words are descriptive. In **The European Limited v The Economist Newspaper Limited** [1998] FSR 283, Millett L J said:

“Where descriptive words are included in a registered trade mark, the courts have always and rightly been exceedingly wary of granting a monopoly in their use”.

28. That comment seems to me to be particularly relevant to the circumstances of this case. It is not in dispute that the words HEALTH MATTERS appearing in both trade marks are entirely descriptive. Consequently, the public would not, in my view, look to these words appearing in the respective trade marks as indicators of origin; they would instead simply be seen as a reference to the sector of trade in which the parties operate. In their counterstatement the applicants point to the existence on the register of two other trade marks both of which include the words HEALTH MATTERS; these are No: 1389340 ABASHBOURNE HEALTH MATTERS (in Class 5) and No: 2029369 HEALTH MATTERS OHS and device (in Classes 9,16, 25, 35 and 42). In response to this, in her Witness Statement dated 21 May 2001, Ms Bodet comments as follows:

“Furthermore, the applicant includes in his Statement of Case in support of the application details of two further trade marks on the UK Register containing the elements HEALTH MATTERS. I do not understand how these two marks help the present application. UK trade mark registration no.1389340 ABASHBOURNE HEALTH MATTERS and UK trade mark registration no. 2029369 HEALTH MATTERS OHS do indeed contain the same generic elements HEALTH MATTERS but each of the marks contain other distinctive matter i.e. ABASHBOURNE and OHS in the same way that my company’s mark contains SANOFI-SYNTHELABO. It can therefore be said that the applicants’ trade mark is confusingly similar to all three earlier trade marks because it contains material that is common to all three, without containing anything phonetically or conceptually distinctive in its own right”.

29. While it is of course well settled that the state-of-the-register is, in principle, irrelevant - see the comments of Jacob J in this respect in **British Sugar PLC and James Robertson and Sons Ltd** that said, and with due respect to Ms Bodet, I think her comments reproduced above miss the point. All of the trade marks mentioned above by Ms Bodet contain distinctive matter in addition to the words HEALTH MATTERS. It is simply that the application in suit contains additional distinctive matter in the form of a device element as opposed to the words, letters or devices which appear in the other trade marks mentioned. In my view, it is the device element present in the application in suit which is the distinctive and dominant element and which will serve to indicate to the public the trade origin of the goods and services for which registration is sought. That device is different from the distinctive element of the opponents’ trade mark. I have no hesitation in concluding therefore, that this fact and the descriptive nature of the words HEALTH MATTERS, means that there will be no likelihood of confusion between the applicants’ and opponents’ trade marks amongst the average consumer of the goods for which registration is sought in Class 5. Consequently, the

opposition based on Section 5(2)(b) of the Act is dismissed.

30. The opposition having failed the applicants are entitled to a contribution toward their costs. I order the opponents to pay to the applicants the sum of £1100. This sum is 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 15 Day of February 2002.**

**M KNIGHT  
For the Registrar  
The Comptroller-General**