

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2167713
BY JOHNSON & JOHNSON TO REGISTER A TRADE MARK IN CLASS 29

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 49112
BY UNIGATE DAIRIES LIMITED

DECISION

Introduction

1. This is an appeal to the Appointed Person by Johnson & Johnson (“the Applicant”) against a decision of Mr Landau, the Hearing Officer acting for the Registrar, dated the 7th September 2001. In that decision the Hearing Officer upheld the opposition by Unigate Dairies Limited (“the Opponent”) to trade mark application number 2167713 by the Applicant to register the trade mark CALCIMILK in Class 29 in respect of “lactose enzyme dairy products”.
2. So far as relevant, the opposition was based on section 5(2) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The objection under section 5(2) was founded upon the earlier registration by the Opponent of the trade mark CALCIA under number 1277706 in respect of “milk and milk products; edible oils and fats; dairy products; all included in Class 29”. The Opponent

contended that the earlier trade mark was registered in respect of identical goods to those the subject of the application and that the marks themselves were so similar as to be likely to cause confusion, contrary to section 5(2) of the Act. The objection under section 5(4)(a) was founded upon the assertion by the Opponent that the earlier trade mark enjoyed a substantial and significant reputation in the United Kingdom and that the use of CALCIMILK would be likely to result in passing off.

3. The parties did not appear before the Hearing Officer. He arrived at his decision after considering all the papers. He concluded that the objection under section 5(2) must be upheld in the light of the fact that identical goods were involved and that, taking all factors into account, the respective trade marks were so similar as to be likely to cause confusion. As to the objection under section 5(4)(a), the Hearing Officer considered that the Opponent could be in no better position under this provision than under section 5(2) and accordingly he did not find it necessary to reach a conclusion.

The Appeal

4. On the 12th October 2001 the Applicant gave notice of appeal to an Appointed Person. The matter came on for a hearing before me on the 23rd April 2002. The Applicant was represented by Mr Ashley Roughton, instructed by D Young & Co. The Opponent was not represented. At the hearing the Applicant accepted that I should follow the approach set out by Pumfrey J in *Reef* [2002] RPC 19.

Section 5(2)(b)

5. The Applicant accepted that the Hearing Officer properly directed himself as to the law. In particular the Hearing Officer properly took into account the guidance provided by the European Court of Justice (“the ECJ”) in *Sabel v Puma* [1997] ECR I-6191, *Canon v MGM* [1998] ECR I-5507, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819 and *Marca Mode CV v Adidas AG* [2000] ETMR 723. The Applicant contended that, having stated the legal principles correctly, the Hearing Officer fell into error by applying them incorrectly. The Applicant focused on the following two paragraphs of the decision:

“In a comparison of the respective trade marks it is necessary to consider them in their entirety. The MILK element of the application in suit is of itself not a distinctive element. However, consumers do not normally indulge in the salami slicing approach to trade marks. They see them in their entirety. The CALCI element will bring to mind calcium, I believe, and consequently the consumer is likely to rely upon what may be considered small differences to differentiate between products which could contain calcium. Visually and phonetically the respective trade marks in their entirety have obvious differences at their ends. I, of course, in considering the respective trade marks, take into account that the beginnings of words are usually more important than the endings, in terms of public recognition and recall (Tripcastroid 42 RPC 264 at page 279).

However, it is also necessary to consider normal and fair use of the opponents’ trade mark. This, of course relates to such use of the trade mark as registered; not any actual use that has been demonstrated. The trade mark CALCIA is clearly used in relation to milk. The specification of the registration includes milk. The goods of the application in suit encompass milk and milk products. I can readily envisage that in oral use, and perhaps in written use - the shopping list, the note left for the milkman - that the consumer will refer to CALCIA milk. Clearly in such a context the respective trade marks are very similar. Indeed it would require the most circumspect of consumers to differentiate between the respective trade marks in such use. It is difficult to envisage how, even taking into account the weakness of

the CALCI element, that in such a context the respective trade marks could be considered not to be similar.”

6. The Applicant argued that the Hearing Officer fell into error here in a number of respects. First, and perhaps most importantly, it was contended that the Hearing Officer had no basis, in evidence or otherwise, to conclude that in considering a normal and fair use of the Opponent’s trade mark, the consumer would refer to “CALCIA milk”. It was contended that it was only after reaching this erroneous conclusion that the Hearing Officer decided that the respective trade marks CALCIMILK, on the one hand, and CALCIA, in the expression “CALCIA milk”, on the other hand, were very similar. The Applicant submitted that there was nothing in the evidence to suggest that a normal and fair use would involve the use of the descriptive word “milk” after the brand name CALCIA.

7. I am unable to accept this criticism of the reasoning of the Hearing Officer. The ECJ made clear in *Sabel* that the likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. Similarly, *Lloyd* establishes that in order to assess the degree of similarity between the marks concerned the court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking into account the category of goods or services in question and the circumstances in which they are marketed. In my judgment the Hearing Officer properly considered the aural and visual similarity of the marks in issue and reasonably came to the conclusion that in oral use, and

perhaps in written use, consumers would refer to “CALCIA milk”. It seems to me this is a perfectly natural expression for a consumer to use in seeking to specify, identify or clarify the particular goods which he or she is seeking to buy. I agree with the Hearing Officer that in this context the respective trade marks are very similar. I also agree with him that they are so similar as to be likely to cause confusion.

8. Secondly, the Applicant criticised the Hearing Officer for splitting up each of the marks into two elements and then attaching undue importance to the first element in each case, namely “CALCI”.
9. I do not believe that this criticism is justified. The Hearing Officer sought to identify the similarities between the marks bearing in mind their distinctive and dominant components. He noted that the “CALCI” element would bring to mind calcium and that consequently the consumer would be likely to rely upon what might be considered to be small differences to differentiate between products. He also noted that visually and phonetically the respective trade marks had obvious differences in their ends. Certainly in the context of this case, I believe that he properly concluded that the beginnings of the words were likely to be more important than the endings, in terms of public recognition and recall and so constituted the dominant components of the marks.
10. The Hearing Officer was further criticised for failing to give due weight to the observations of the ECJ in *Sabel* that where the earlier mark is not especially

well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.

11. I do not believe that the Hearing Officer fell into error in this respect. To my mind the Hearing Officer had very much in mind that the conceptual similarity between the marks was only one of the factors that he had to consider. Further, in considering the conceptual similarity he had in mind that this was to some extent descriptive in that it would bring to mind calcium. Consequently he concluded that consumers would be likely to rely upon relatively small differences to differentiate between the products. He also noted the visual and phonetic differences between the respective trade marks. Nevertheless, having taken into account all these matters he concluded that there was a risk of confusion because consumers would be likely to refer to the Opponent's trade mark in the expression "CALCIA milk". In concluding that the respective trade marks were confusingly similar, I do not believe that he was attaching undue importance to the conceptual similarity between the marks. On the contrary, to my mind he reached his conclusion primarily in the light of the aural and visual similarities between the marks. In my judgment he was right so to do.

12. Finally, the Applicant contended that the Hearing Officer wrongly failed to attach sufficient importance to the distinctive character created by the combination of elements in the mark CALCIMILK, which combination of elements could not be found in the earlier trade mark CALCIA. I agree with

the second part of this analysis, so far as it goes. However it ignores a consideration of normal and fair use of the Opponent's trade mark and, in particular, the oral and written use of it in expressions such as "CALCIA milk". Once this consideration is taken into account then, like the Hearing Officer, I believe that the marks are indeed so similar as to be likely to cause confusion.

Section 5(4)

13. The ground of objection under section 5(4) adds nothing to the ground of objection under section 5(2) of the Act. I do not therefore find it necessary to consider it further.

Conclusion

14. In my judgment the Hearing Officer rightly found that the objection under section 5(2) of the Act was made out. Accordingly I dismiss the appeal. I order the Applicant to pay to the Opponent the sum of £635 as a contribution towards the costs of this appeal, such sum to be paid on the same basis as ordered by the Hearing Officer.

DAVID KITCHIN QC

29TH April 2002

