

1 TRADE MARKS REGISTRY

Room A2
Harmsworth House
13-15 Bouverie Street
London, EC4Y 8DP

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Tuesday, 13th August 2002

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B e f o r e:

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MR. G. HOBBS, QC
(Sitting as the Appointed Person)

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In the Matter of the TRADE MARKS ACT 1994

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and

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In the Matter of Trade Mark application No. 2225044
in the name of ALLIMAX

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in Class 5 of Health Perception (UK) Limited

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and

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Opposition No. 51248 thereto by
Almirall-Prodesfarma, S.A.

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and

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An appeal to the Appointed Person under Section 76 of the
Trade Marks Act 1994 against the decision of Mr. D W Landau
acting on behalf of the Registrar, dated 29th April 2002.

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(Computer-aided Transcript of the Stenograph Notes of
Marten Walsh Cherer Ltd., Midway House,
27/29 Cursitor Street, London, EC4A 1LT.

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Telephone No: 0207 405 5010. Fax No: 0207 405 5026.)

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MS. HELEN THOMAS-PETER (Wildbore & Gibbons) appeared on behalf of
the Appellant.

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MR. DAVID WILKIE (Health Perception UK) appeared on behalf of the
Respondent.

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D E C I S I O N
(as approved by the Appointed Person)

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1 THE APPOINTED PERSON: On 8th March 2000 Health Perception UK

2 Limited applied to register the word ALLIMAX as a trade mark
3 for use in relation to "compositions for medicinal purposes
4 containing substances obtained from plants, vitamins
5 combinations, minerals, amino acids, enzymes and herbal
6 preparations" in class 5.

7 The application was in due course opposed by
8 Almirall-Prodesfarma S.A. under section 5(2)(b) of the Trade
9 Marks Act 1994 on the basis of its earlier community trade
10 mark ALMAX registered under number 387175 in respect of "a
11 special pharmaceutical product used for neutralising gastric
12 hyperacidity" in class 5.

13 The applicant filed a counter statement maintaining
14 that the opposition should be rejected. The counter
15 statement was supported by a declaration of truth and
16 accuracy it stated:

17 "1. The application in suit is for registration of
18 the trade mark 'Allimax' for the following goods in
19 class 5:

20 'Compositions for medicinal purposes containing
21 substances obtained from plants, vitamins
22 combinations, minerals, amino acids, enzymes and
23 herbal preparations'.

24 2. Allimax is an extract of the active ingredient in
25 garlic, namely allicin and is sold in the UK as a food

1 supplement. It is not a pharmaceutical product. The
2 goods covered by the opposition in suit are not
3 identical or similar to the goods covered by our
4 registration.

5 3. The mark Almax is not similar in presentation or
6 sound to Allimax.

7 4. Almax is a digestive aid and classed as a
8 pharmaceutical agent. It is licensed for sale as such
9 in Spain and Korea. Almax is classed as a medicine,
10 Allimax is classed as a food supplement.

11 5. We have applied for the trade mark 'Allimax' for
12 the UK market only. Almax is not available in the UK.

13 6. Almax is not listed in any UK directories of
14 pharmaceutical agents (ref. MIMS September 2000) and
15 as such is not available in the UK.

16 7. Since Almax is not available in the UK, we cannot
17 see how this would lead to any confusion on the part
18 of the public or cause any conflict. The copy on the
19 pack (enclosed) of Allimax clearly shows that this
20 product is a garlic supplement.

21 8. We therefore refute the statement that 'the
22 representative goods are identical or similar and
23 there is a likelihood of confusion on the part of the
24 public, which includes the likelihood of association
25 with the opponent's earlier registered mark.'"

1 The packaging referred to in paragraph 7 showed use of the
2 word Allimax as a trade mark in relation to capsules of
3 garlic extract. It carried the statement "100 percent
4 Allicin yield to help maintain a healthy heart and
5 circulation".

6 The opponent's evidence in support of the opposition
7 appeared to confirm that there had been no use of the cited
8 earlier trade mark outside of Spain. It was contended that
9 the goods of interest to the applicant were either identical
10 or similar to those covered by Community Registration No.
11 387175.

12 However no evidence of the kind envisaged in paragraphs
13 22 and 23 of the judgment of the European Court of Justice in
14 Case C-39/97 Canon KK v Metro-Goldwyn-Mayer Inc. [1998] ECR
15 I-5507. was adduced in relation to the question of
16 similarity. Moreover the points specifically raised in
17 paragraphs 2 and 4 of the counter statement were not
18 commented upon.

19 The applicant filed no evidence in answer to that of
20 the opponent.

21 The opposition came on for hearing before Mr. D W
22 Landau acting on behalf of the Registrar of Trade Marks on
23 23rd April 2002. Shortly stated the question for
24 determination was whether, at the date of the application for
25 registration, there were similarities in terms of marks and

1 goods that would combine to create a likelihood of confusion
2 if the two marks were to be used concurrently in relation to
3 the goods for which they were respectively registered and
4 proposed to be registered. For that purpose there can be no
5 likelihood of confusion where it does not appear that the
6 public could believe that the goods covered by the two trade
7 marks come from the same undertaking or economically linked
8 undertakings (see paragraphs 26 et seq of the judgment in the
9 Canon case).

10 In a written decision issued on 29th April 2002 the
11 Hearing Officer concluded that the objection under section
12 5(2)(b) should be upheld in relation to the goods specified
13 in the opposed application for registration. He arrived at
14 that conclusion with a degree of reluctance because he was
15 not convinced that it reflected the commercial reality of the
16 applicant's situation. This prompted him to allow the
17 applicant a fall back position:

18 "32) However, I have reached the above decision with a
19 certain degree of reluctance. I am not convinced that
20 it reflects the reality of the situation. In his
21 counter statement the applicant indicated the specific
22 goods which he was interested in and even supplied a
23 copy of the packaging. In these circumstances I
24 consider it reasonable to consider whether an
25 appropriately limited specification would militate

1 against a likelihood of confusion. I obviously need
2 to consider any such specification within the
3 parameters of the specification as published. Basing
4 such a specification inside these two parameters it
5 would appear to me that the following would be
6 appropriate: 'garlic supplements, all being
7 compositions for medicinal purposes for the heart and
8 blood circulation'.
9 33) Based upon the above specification I consider that
10 the purposes of the goods will have a clear difference
11 and so also the users. Yes, the goods will be both
12 for a curative or palliative purpose but for clearly
13 different purposes. In my experience goods such as
14 garlic supplements do not appear on the same shelves
15 or in close proximity to pharmaceuticals. The goods
16 are certainly not in competition, one would not
17 substitute one set of goods for the other. I do not
18 consider that the respective goods are complementary,
19 there is no mutually dependant or symbiotic
20 relationship between them. Both sets of goods are
21 likely to be in tablet form for oral use but I do not
22 consider that this creates a high degree of similarity
23 between them. Taking into account the considerations
24 in Canon in relation to the similarity of goods I
25 consider that based upon the above specification that

1 the best that could be said for the opponent is that
2 there would be a very low degree of similarity between
3 the goods. A similarity so low that combined with the
4 fact that the signs are not identical that, on a
5 global appreciation, there would not be a likelihood
6 of confusion.

7 34) In drafting the above specification, which is a
8 somewhat unusual step, I take into account that
9 Article 13 of the Directive states that only those
10 goods for which there is an objection should be
11 refused and that the applicant was not legally
12 represented. It was also clear to me at the hearing
13 that Mr. Wilkie, not surprisingly, did not have a
14 clear understanding of the nature of the questions I
15 have to consider and the basis of the issue of
16 likelihood of confusion.

17 35) Consequent upon the above decision the applicant
18 should file within one month of the expiry of the
19 appeal period from the decision a form TM21 to
20 restrict the specification to 'garlic supplements, all
21 being compositions for medicinal purposes for the
22 heart and blood circulation'. If no form TM21 is
23 filed within the period set the application will be
24 refused in its entirety."

25 He nonetheless ordered the applicant to pay £1,100 as a

1 contribution towards the opponent's costs of the proceedings.

2 The opponent gave notice of appeal to an Appointed
3 Person under section 76 of the 1994 Act contending that the
4 Hearing Officer should not have allowed the application to
5 proceed to registration on the basis of the revised
6 specification identified in paragraph 35 of his decision.
7 The applicant did not appeal against the decision that the
8 mark in question was unacceptable for the unrevised
9 specification of goods.

10 In essence the opponent contends that the revised
11 specification of goods does not overcome the objection under
12 section 5(2)(b) for the reasons that the Hearing Officer gave
13 when upholding the objection in relation to the unrevised
14 specification.

15 Article 13 of Council Directive 89/104/EEC provides as
16 follows:

17 "Grounds for Refusal or Revocation or Invalidity
18 Relating to Only Some of the Goods or Services.
19 Where grounds for refusal of registration or for
20 revocation or invalidity of a trade mark exist in
21 respect of only some of the goods or services for
22 which that trade mark has been applied for or
23 registered, refusal of registration or revocation or
24 invalidity shall cover those goods or services only."

25 As I have indicated in a number of previous decisions, I

1 consider that the provisions of Article 13 are binding upon
2 the Registrar as the person whose task it is to implement the
3 Directive on behalf of the State in the United Kingdom.

4 I am satisfied that it was within the Hearing Officer's
5 power to accept the application for registration with a
6 narrowed specification. I can readily conceive of
7 circumstances in which it would not be appropriate for a
8 hearing officer to reach a conclusion as to the acceptability
9 of a revised specification of goods or services without
10 giving the parties a chance to make representations and, if
11 appropriate, file evidence directed to the point. However, I
12 do not think that there was any procedural unfairness in the
13 way in which the Hearing Officer dealt with the matter in the
14 present case firstly because the nature of the particular
15 product of interest to the applicant had at all material
16 times been clear from the information provided in and with
17 the counter statement and secondly because the applicant had
18 for all practical purposes conducted the defence of its
19 application on the basis that it was proposing to use the
20 mark ALLIMAX only in relation to products of that nature.

21 In relation to the question whether the revised
22 specification of goods overcomes the objection under section
23 5(2)(b), it is not open to me to reverse the Hearing
24 Officer's decision, based as it was upon a multifactorial
25 assessment, unless I am satisfied that it involved an error

1 of principle or was clearly wrong: *Bessant v South Cone*
2 Incorporated [2002] EWCA Civ 763 (28 May 2002).

3 I recognise that the marks ALMAX and ALLIMAX are
4 similar to a degree that would require the goods marketed
5 thereunder to be significantly different for there to be no
6 real likelihood of confusion in the sense envisaged by the
7 Canon case.

8 I also recognise that the fact that different
9 compositions are marketed for different medicinal purposes
10 does not necessarily render such confusion unlikely.

11 However, there is no evidence relating to the critical
12 question of similarity of goods upon which I could properly
13 conclude that the Hearing Officer's assessment was flawed.

14 It is clear from his decision as a whole that he directed
15 himself correctly as to the law applicable to the objection
16 he was considering. I see no reason to suppose that he was
17 any less mindful of the factors relevant to the determination
18 of the objection under section 5(2)(b) when considering the
19 revised specification of goods, than he was when considering
20 the unrevised specification of goods. Moreover, the reasons
21 he gave for arriving at the decision he did appear to me to
22 be tenable notwithstanding his finding that the unrevised
23 specification was acceptable. I am not prepared to say that
24 he erred by allowing the application to proceed to
25 registration on the basis of the revised specification. That

1 decision appears to me to have been within the margin of
2 appreciation entrusted to the decision taker at first
3 instance in cases of this kind.

4 In the circumstances I consider that the appeal should
5 be dismissed.

6 Do you want to address me on the question of costs of
7 the appeal?

8 MR. WILKIE: What am I allowed to receive?

9 THE APPOINTED PERSON: First of all give me some indication of
10 how much preparation time may have been involved in your
11 getting ready for this hearing.

12 MR. WILKIE: It would have taken probably about two days work.

13 THE APPOINTED PERSON: Two solid days?

14 MR. WILKIE: In terms of going over notes and preparing in terms
15 of hours, I would have said about 14 hours.

16 THE APPOINTED PERSON: Have you had to travel?

17 MR. WILKIE: Yes, from Sandhurst.

18 THE APPOINTED PERSON: Near Woking.

19 MR. WILKIE: Yes.

20 THE APPOINTED PERSON: The kind of thing that happens is that it
21 is a rough and ready round figure assessment. Normally it is
22 done on the basis of what the person sitting where I am
23 sitting considers to be a fair and reasonable but not a full
24 amount of compensation for time spent. Is there anything you
25 would like to say on the question of costs?

1 MS. THOMAS-PETER: Only that it might be reasonable to take into
2 account the fact that Mr. Wilkie has not had to instruct
3 expensive trade mark attorneys or counsel in this case.

4 THE APPOINTED PERSON: Yes.

5 MR. WILKIE: In consideration I think my time is probably just as
6 valued as a managing director of a major company and I would
7 probably be charging just as much, if not more, in that
8 respect; so it has taken up a great deal of my time which I
9 would have spent otherwise.

10 THE APPOINTED PERSON: The hearing today was I think shorter than
11 the hearing in front of the Hearing Officer, was it not?

12 MS. THOMAS-PETER: Yes.

13 THE APPOINTED PERSON: There has been no question of evidence or
14 anything of that kind which was reflected on the award of
15 £1,100 in your client's favour below. What I am going to do,
16 it is a rough and ready figure, I will say that the opponent
17 should pay £275 as a contribution towards the costs of the
18 applicant in relation to the unsuccessful appeal. I leave
19 untouched the order for costs in the tribunal below. The
20 sensible thing would therefore seem to be for there to be a
21 set off of the one figure against the other and the net
22 balance to be paid in the opposite direction.

23 I think that covers everything. Thank you both for
24 your submissions.

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