

IN THE MATTER OF THE TRADE MARKS ACT 1994

AND IN THE MATTER OF TRADE MARK REGISTRATION NO 3130489
IN THE NAME OF CONJOINT SERVICES (SOUTH AMERICA) LIMITED

AND IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF
INVALIDITY CA501797 BY BRITANNIA PHARMACEUTICALS LIMITED

DECISION

Introduction

1. This is an appeal from the decision of the hearing officer dated 12 September 2018 whereby he held that the application for a declaration of invalidity of Trade Mark Registration No. 3130489 “BritanniaMed” in class 10 in the name of Conjoint Export Services (South America) Ltd (“Conjoint”) succeeded. The application, made under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), was based on the prior registration for United Kingdom Trade Mark No. 2043054 “Britannia” registered, inter alia, in class 10 for medical and surgical apparatus, instruments and products and an EU Trade Mark No. 5968286 “Britannia” registered for similar goods and services. Both of these prior marks were in the name of Britannia Pharmaceuticals Limited (“Britannia”).
2. The application also claimed that the mark had been applied for in bad faith, contrary to section 3(6) of the Act, on the basis that there was no bona fide intention to use the mark in the United Kingdom. There was some slight evidence that the mark was only proposed to be used for the export of goods to South America. After enquiry by the Registrar of Conjoint, it was stated on its behalf that it was intended also to affix the mark “BritanniaMed” to its products in the UK and elsewhere. In the event the hearing officer did not decide this ground, having held that the mark in issue was invalid under section 5(2)(b).

The decision

3. Because of the course this appeal has taken, it is unnecessary to set out the hearing officer's decision in detail. In summary, he reviewed the documents, it having been agreed that the matter should be determined on the papers, summarised the brief evidence on intention to use, outlined the legislation and case law and undertook a comparison of the goods and the marks. He held, as was plain, that there was identity of goods given that they encompassed goods of the earlier marks. He considered the nature of the average consumer and the level of distinctiveness of the mark, which he held to be ordinary. He went on to compare the marks, concluding that the overall impression of the registration in issue was of the same word as the prior registrations followed by the short word "Med" which the average consumer would interpret to be an abbreviation of "medical". He found that there was a high degree of visual, aural and conceptual similarity between the mark in issue and the prior marks and that there was, as a result, a likelihood of confusion.

The appeal

4. At the outset of the oral hearing of appeal, Mr Paul Wohanka, a director of Conjoint confirmed that there was no substantive challenge to the Hearing Officer's evaluation of the similarity of the marks. In my view, that concession was inevitable, having regard to the approach to evaluation of similarity and likelihood of confusion in a case of this kind (see *Apple Inc v Arcadia Trading Limited* [\[2017\] EWHC 440 \(Ch\)](#) at [11] per Arnold J, as to the approach). As to the similarity of the marks, Britannia drew attention to some of the case law from the EUIPO including especially *Eveline v. Omega* (Case R 991/2017-2) "LACTAMED" at [82] on the term "Med" as an abbreviation of medical.
5. Mr Wohanka initially raised an objection to the provision of a skeleton argument on behalf of Britannia with lengthy cases and, in the circumstances, I invited the professional representative appearing for Britannia to explain somewhat more fully in his submissions what the main points were and draw attention to the short passages of relevance in these cases. He did so helpfully and that was acceptable to Mr Wohanka.

6. As the hearing developed and consistent with the limited grounds of appeal, it appeared that Conjoint's central complaint related not to the substance of the decision as to the manner in which Britannia and the Registrar had addressed the issue. In particular it was said that, when the mark was applied for, the Registrar had drawn Conjoint's attention to prior rights (including the trade marks relied on). Although there was no evidence on the matter, I invited the representative of Britannia to explain briefly to Conjoint why it was that the mark had not been opposed instead of being allowed to proceed to registration followed by a claim for invalidity. It was explained that the relevant correspondence may not have come to the attention of the individuals at Britannia concerned with the issue quickly enough, during an internal re-organisation of responsibility for these issues. Britannia's position was that it was clear that there had at no time been express or tacit consent to pursue this registration.
7. Mr Wohanka indicated that, as a result of the combination of Britannia's failure to object sooner and the Registrar's action in registering the mark, it had been lulled into a false sense of security as to its entitlement to use and register the mark and had built up business on the basis of it.
8. None of this was the subject of evidence. However, it appears, on the basis of the submissions before me, that Britannia did not oppose the mark within the period provided to do so as a result of an internal issue. Conjoint on its part had adopted a mark primarily or exclusively for its export trade which was clearly similar to the mark "Britannia" without appreciating that the absence of opposition at the time did not mean that registration would not remain vulnerable to attack at a later point. It appears that Conjoint went ahead in developing products using the "BritanniaMed" brand (albeit for overseas markets) based on this misapprehension and it was said that changing it would be costly. I have no reason to doubt that Conjoint was acting under the belief that, because the Registrar had not indicated that there was an objection, it would be free to pursue and maintain its registration. That, however, is not the effect of the law in a situation of this kind.
9. Moreover, it does not give rise to any valid grounds for overturning the hearing officer's decision. It is clear that this was a decision he was entitled to take. Indeed, given the similarity of the respective marks and the identity of the respective goods for which the

proprietor's mark was registered with those of Britannia's prior registration, this was an inevitable result.

10. I must therefore dismiss this appeal.

The allegation of bad faith

11. Finally, as noted above, one of the grounds of invalidation was based on section 3(6) of the Act, namely an alleged lack of bona fide intention to use the mark. Such a claim does in any event not impugn the integrity of an applicant for registration in the way that some allegations of bad faith can do. In this case, it amounts to little more than saying that, as a matter of law, the application in so far as it was made to protect export trade for South America was inappropriately made in the UK if there was no intention to use the mark in the UK.

12. The hearing officer did not find it necessary to consider this ground having upheld the opposition under section 5(2) and declined to deal with it. The consequence for Conjoint however is that an allegation of bad faith has been made, the case has been decided against Conjoint on other grounds and there has been no adjudication of whether this allegation was well founded which, it is suggested, is an unfortunate position for a reputable company to be left in.

13. I did not hear argument on the substantive issue or on the extent to which it is appropriate for a hearing officer to decline to deal with grounds of challenge which have not been formally abandoned. The circumstances in which a tribunal other than one of final appeal may appropriately decline to deal with particular issues is not always a straightforward question. The ordinary approach in the United Kingdom is that the first instance tribunal should address all issues which require findings of fact so that it is not necessary for an appellate court to remit further issues for determination should it hold that the basis on which the first instance tribunal decided the case was incorrect (see *Warner Lambert v. Generics* [2015] EWHC 3370 at [23], Arnold J and [2018] UKSC 56 at [116]-[118], Supreme Court). More recently in *Trump International Ltd v DTTM Operations LLC* [2019] EWHC 769 (Ch) (29 March 2019), Henry Carr J said at [56], specifically in the context of an appeal in a trade mark registration context:

“Since he determined that the Application was made in bad faith, I have considerable sympathy for the Hearing Officer's position that it was unnecessary to determine the other grounds of opposition. However, I consider that it would have been sensible for him to express, briefly, his conclusion on each of those grounds. Experience in the European Patent Office shows that where only one ground of an opposition is determined, it is frequently necessary for the board of appeal to remit the matter back to the opposition division where an appeal is successful, for determination of the other grounds. This can lead to significant delays in the determination of cases.”

14. Notwithstanding those clear statements, the correct approach to this aspect of procedure specifically before the Registrar should, in my view, be determined in a case in which it is necessary to do so and full argument can be heard. This should preferably involve submissions on behalf of the Registrar, *inter alia*, because of particular procedural characteristics of such proceedings and because it might be argued that the benefits in not requiring hearing officers to deal with all grounds in all cases outweigh the disadvantages. Given the clear conclusion the hearing officer reached as to similarity of the marks on the primary ground of opposition under section 5(2), I do not think that he can be criticised for declining to deal with the issue of bad faith.
15. However, if it provides any comfort, before this tribunal Conjoint must be presumed not to have acted in bad faith.

Costs

16. Britannia has been successful on this appeal and is therefore entitled to a contribution to its costs. Its skeleton (excluding the annexes) was brief, as were the oral submissions. An award of £500 was made by the hearing officer in respect of the minimal evidence and submissions in lieu of a hearing. A somewhat smaller sum is appropriate on this appeal, given that Britannia was the respondent, largely repeated its arguments below and the hearing was brief. The appropriate sum is **£300** making **£1200** in total including the award below.

BL O/173/19

APPOINTED PERSON

2 April 2019

Representation

Mr Paul Wohanka of Conjoint Export Services (South America) Ltd for the Appellant

Mr Jonathan Thurgood of HGF Limited for the Respondent