O/0301/23

TRADE MARKS ACT 1994

REQUESTS BY OMNIVISION GMBH

FOR PROTECTION IN THE UK OF INTERNATIONAL TRADE MARKS

1634054 & 1634057

AND

OPPOSITIONS 432512 & 432593

BY NOVARTIS AG

Background and pleadings

1. This is an opposition by Novartis AG ("the opponent") to two requests by OmniVision GmbH ("the holder") for the protection of international trade marks ("IRs") 1634054 and 1634057 in the UK. The date of the international registrations, and of the designations of the UK, is 17th November 2021.

2. The IRs are for the trade marks **Ocuzopt** and **Brinzopt**. These word marks are registered in standard characters. Protection of the IRs is sought in class 5 in relation to:

> *Pharmaceutical preparations for veterinary use; pharmaceuticals; dietary supplements and dietetic preparations; medical preparations.*

3. The holder claims priority from earlier filings in Germany on 20th May 2021 (Brinzopt) and 21st May 2021 (Ocuzopt).

4. The opponent's grounds of opposition are, in summary, that:

(i) The opponent is the proprietor of earlier UK trade mark 900864504, which consists of the word AZOPT and is registered in class 5 in relation to *ophthalmic pharmaceutical product for the treatment of glaucoma*;

(ii) The contested IRs are similar to the earlier trade mark, which is registered for identical or similar goods;

(iii) There is a likelihood of confusion on the part of the public;

(iv) The earlier trade mark has a strong reputation and use of the IRs would, without due cause, take unfair advantage and/or be detrimental to the reputation or distinctive character of the earlier mark;

(v) The earlier trade mark has been used throughout the UK since April 2000 and the opponent has acquired goodwill under the sign in relation to the goods for which it is registered;

(vi) Use of the IRs would constitute a misrepresentation to the public that the parties are connected, and this would damage to the opponent's established goodwill;

(vii) Therefore, protection of the IRs would be contrary to sections 5(2), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

5. The holder filed counterstatements denying the grounds of opposition. I note, in particular that the holder:

(i) claims that the -OPT suffix is an abbreviation for 'optical' and therefore descriptive of the goods at issue;

(ii) asserts that the different prefixes to the marks are sufficient to avoid confusion;

(iii) claims that the relevant public is primarily the pharmaceutical industry, who will pay a high degree of attention when selecting the goods, which will also help to avoid confusion;

(iv) put the opponent to proof of the use, reputation and goodwill claimed for the earlier trade mark in the UK.

6. Both sides seek an award of costs.

7. The opposition proceedings are consolidated.

Representation

8. The holder is represented by Potter Clarkson LLP. The opponent is represented by Tomkins & Co. Neither party requested a hearing. Consequently, this decision is based on the evidence and the written submissions filed.

The evidence

9. Only the opponent filed evidence. It consists of a witness statement by Ms Fiona Bride with 5 exhibits. Ms Bride is the 'Value and Access Head' of Novartis

Pharmaceuticals UK Ltd, which is a subsidiary of the opponent. Her evidence goes to the use made of the earlier mark in the UK since 2017.

Proof of use

10. The earlier trade mark is a 'comparable mark' created at the end of 2020 when the UK left the EU. It is to be treated as though it was applied for and registered on the same dates as the EUTM on which it is based was applied for and registered in the EU. This means the earlier mark is deemed to have been registered in the UK in 1999. Consequently, the opponent's reliance on this mark is subject to it satisfying the proof of use requirement set out in section 6A of the Act, which is as follows:

> *"(1) This section applies where*
>
> > *(a) an application for registration of a trade mark has been published,*
> >
> > *(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and*
> >
> > *(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.*
>
> *(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.*
>
> *(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.*
>
> *(3) The use conditions are met if –*
>
> > *(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or*

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

11. The relevant 5 year periods are therefore 21st May 2016 to 20th May 2021 (Brinzopt) and 22nd May 2016 to 21st May 2021 (Ocuzopt). As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It states:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) -

(3) Where [IP completion day] *falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —*

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union".

12. Section 100 of the Act states that:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

13. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

14. In *Walton International Ltd & Anor v Verweij Fashion BV*[1] Arnold J. (as he then was) summarised the law relating to genuine use as follows:

"114. […] The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 Ansul BV v Ajax Brandbeveiliging BV, Case C-416/04 P Sunrider Corp v OHIM, Case C-442/07 Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky', Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH, Case C-149/11 Leno Merken BV v Hagelkruis Beheer BV, Case C-609/11 P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG, Case C-141/13 P Reber Holding & Co KG v OHIM and Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: Ansul at [35] and [37].

[1] [2018] EWHC 1608 (Ch)

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: Ansul at [36]; Sunrider at [70]; Verein at [13]; Leno at [29]; Centrotherm at [71]; Reber at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: Ansul at [36]; Sunrider at [70]; Verein at [13]; Silberquelle at [17]; Leno at [29]; Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: Gözze at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: Ansul at [37]. Internal use by the proprietor does not suffice: Ansul at [37]; Verein at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle at [20]-[21]. But use by a non-profit making association can constitute genuine use: Verein at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71]; Reber at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72] and [76]-[77]; Leno at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32].”

15. Ms McBride’s evidence is that the opponent has sold AZOPT eye drops for the treatment of glaucoma in the UK since 2017. Unit sales in the UK in 2017 exceeded 50k. In 2018, unit sales in the UK rose to almost 200k. In 2019 and 2020, annual unit sales were 160 – 170k. The product appears to be sold at around £6 per unit. Therefore, in 2020 (for example) UK sales were worth over £1m. There are no corresponding figures for the EU.

16. There is no evidence that the opponent actively promotes the product or, if it does, how much it spends doing so.

17. Proofs of product packaging and patient information leaflets bearing the mark dated between 2017 – 2021 are provided[2]. It appears from these that the generic name for the product branded as AZOPT is Brinzolamide, and that it is only available on prescription.

18. Exhibit 5 to Ms McBride's statement consists of more technical information about the product, including a copy of a report from the European Medicines Agency. This indicates that in March 2000 it granted the product a marketing authorisation for the EU for the treatment of patients with ocular hypertension or open-angle glaucoma. The report confirms that Azopt eye drops are only available on prescription. There are similar pages from the website medicines.org.uk dated June 2018. These indicate the product was available at that time in the UK. Further pages from the NHS website also confirm that Azopt is available on prescription in the UK.

19. The holder's representatives criticise the opponent's evidence on the basis that:

(i) it includes internal documents, such as proofs;

(ii) although the evidence provided shows a description of what the mark is used for, none of the evidence actually shows use of the mark in relation to the goods covered by the earlier trade mark;

(iii) no supporting data has been provided for the sales figures for goods sold in the UK under the mark Azopt over the past five years;

(iv) there are no details of where in the UK these sales have been made.

20. It is well established that evidence must be considered as a whole. Although there are some gaps in the evidence, the evidence as a whole shows that AZOPT was used in the UK in relation to eye drops for the treatment of glaucoma between 2017 and 2021. The average consumer would regard this product as corresponding with the description of goods in the registration (i.e. *ophthalmic pharmaceutical product for the*

[2] See exhibit 4.

treatment of glaucoma). Given the specific nature of the goods described in the specification, there is, in my view, no need to cut down the protection afforded to the earlier mark to anything less than the registered specification.

The section 5(2)(b) ground of opposition

21. Section 5(2)(b) of the Act is 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 trade 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".*

Comparison of goods

22. The respective goods are set out below.

Goods covered by earlier mark	Goods covered by contested marks
Ophthalmic pharmaceutical product for the treatment of glaucoma	Pharmaceutical preparations for veterinary use; pharmaceuticals; dietary supplements and dietetic preparations; medical preparations.

23. Goods can be considered identical when the goods for which the earlier mark is entitled to protection are included in a more general category of goods in the specification of the later trade mark[3]. The term *pharmaceuticals* in the specification of the IRs clearly encompasses the goods for which the earlier mark is protected. The same applies to the broad term *medical preparations*. The opponent's goods are not limited for human use. Consequently, the registered description of goods also covers goods for use on animals. It follows that *pharmaceutical preparations for veterinary*

[3] See, for example, *Gérard Meric v OHIM,* Case T-133/05.

use in the specification of the IRs must also be taken to encompass the opponent's goods. Each of these terms must therefore be considered as covering identical goods.

24. In the judgment of the CJEU in *Canon*[4], the court stated at paragraph 23 of its judgment that:

> *"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".*

25. Even if I am wrong to find that the opponent's specification covers pharmaceuticals for the treatment of glaucoma in animals, such goods must be considered highly similar to equivalent products for human use. This is because the nature, purpose and method of use of the product are the same.

26. This leaves *dietary supplements and dietetic preparations.* The opponent submits that these goods are complementary to the goods for which the earlier mark is protected because *"consumers would purchase the supplements to treat* [glaucoma] *naturally, adjacent to traditional therapy, including eye drops*."

27. 'Complementary' means[5]:

> *"...there is a close connection between* [the goods]*, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."*

28. In its final written submissions the opponent draws my attention to two decisions in which the registrar has held that *dietary and nutritional supplements* and *dietetic beverages adapted for medical purposes; dietetic food adapted for medical purposes* are similar to *pharmaceutical preparations.* The first decision is BL O/427/19 (HiGrain

[4] Case C-39/97
[5] *Boston Scientific Ltd v OHIM*, Case T-325/06

v HiGreen). The Hearing Officer held the goods were similar on the basis that *"The physical nature of these goods may be the same in that they may come in the form of tablets, capsules, powders or liquids, for example. The trade channels may overlap."* However, she held that the respective goods were not complementary. The second case is BL O/487/21 (Foster v Noster). The Hearing Officer held that the goods were similar for similar reasons. Again, it was held that the goods were not complementary.

29. The holder denies that these goods are similar.

30. There is no evidence that *dietary supplements and dietetic preparations* may be used to assist in the treatment or prevention of glaucoma. Still less that consumers "*may think that the responsibility for those goods lies with the same undertaking"* [that markets *ophthalmic pharmaceutical product for the treatment of glaucoma*]. I therefore reject the opponent's submission that the goods are complementary. I accept that the goods could both be marketed in liquid form and both can be generally classified as 'health' products. However, the specific purpose of the goods (treatment of glaucoma v general health) is different, as is the method of use (you do not put *dietary supplements and dietetic preparations* in your eye). The goods are not in competition. *Ophthalmic pharmaceutical product for the treatment of glaucoma* appears to be a prescription medicine, whereas *dietary supplements and dietetic preparations* are normally over-the-counter products. In these circumstances, the mere fact that both could be found in a pharmacy, and take the form of a liquid, appears insufficient to establish that they are similar goods. I find they are dissimilar.

Global assessment of the likelihood of confusion

31. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Average consumer

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question[6].

33. The holder submits that the average consumer of medicinal products pays a high degree of attention when selecting such goods.

34. The opponent denies this. According to the opponent, "*as the products are pharmaceuticals sold over the counter",* the relevant average consumer is a member of the public who will not pay a high level of attention. Further, so far as *dietary supplements and dietetic preparations* are concerned, the opponent says that the public will pay only a low degree of attention during the selection process.

35. In *Olimp Laboratories sp. z o.o. v EUIPO*[7], the General Court considered the average consumer for pharmaceutical and medical products in class 5 and the level of attention the consumer pays when selecting such goods. It said:

[6] CJEU, *Lloyd Schuhfabrik Meyer,* Case C-342/97
[7] Case T-817/19, EU:T:2021:41

"39. Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 5 December 2010, Novartis v OHIM (TOLPOSAN), T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, Forest Pharma v EUIPO – Ipsen Pharma (COLINEB), T-36/17, not published, EU:T:2017:690, paragraph 49).

40. Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, TOLPOSAN, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited)."

40. The General Court's judgment postdates the UK's departure from the EU. Therefore, this judgment is not binding on me. However, it merely summarises findings from earlier judgments of the court at times when the UK was a member of the EU. Therefore, the contents of the decision are binding on points of law. Otherwise, the later judgment has only persuasive value.

41. I accept the holder's submission that average consumers of the goods at issue include members of the general public. Even where the goods are chosen by medical professionals, as appears to be the case for *ophthalmic pharmaceutical product for the treatment of glaucoma,* the end user is the general public. The fact

that intermediaries such as healthcare professionals are liable to influence, or even to determine, the choice made by end-users makes medical professionals part of the relevant public[8]. However, the involvement of medical professionals is not capable of excluding the likelihood of confusion on the part of end users as regards the origin of the goods at issue[9].

42. Where pharmaceuticals are sold on prescription, medical professionals are likely to pay a high level of attention. The level of attention paid by the general public receiving such prescription goods is also likely to be above average because of the importance of the medication to their medical condition. This remains the case for non-prescription pharmaceuticals bought over the counter. Selecting the correct pharmaceutical may not be quite as important to the consumer in these circumstances as getting the right prescription pharmaceutical. On the other hand, in this scenario end consumers have sole responsibility, or at least more responsibility, for choosing the correct product. These findings apply equally to *pharmaceutical preparations for veterinary use.*

43. I accept that the average consumer of *dietary supplements and dietetic preparations* is likely to be a member of the general public. Such a consumer will be concerned to ensure the products meets their health needs, but not to the same extent as they would be concerned to receive the right pharmaceutical product to treat a medical condition such as glaucoma. Taking the 'wrong' supplement also carries fewer health risks than taking the wrong pharmaceutical. In my view, such consumers would therefore pay a medium or 'average' degree of attention when selecting these products.

44. Medical professional are likely to select pharmaceuticals mainly by visual means, from lists on websites, from printed publications, or in the case of pharmacists, from written prescriptions. Members of the public are likely to select over-the-counter products in the same way. However, average consumers of both kinds, and end users of prescription pharmaceuticals, are also to verbalise the trade marks through

[8] *Björnekulla Fruktindustrier AB v Procordia Food AB*, CJEU, Case C-371/02, at paragraph 25.
[9] See *Alcon V OHIM,* Case C-412/05, CJEU, at paragraph 57.

oral recommendations, discussions between medical professionals about the appropriate medicine, or requests made to medical professionals.

Distinctive character of the earlier mark

45. In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV*[10], the CJEU stated that:

> *"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 WindsurfingChiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).*
>
> *23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."*

46. The opponent submits that the earlier mark is highly distinctive because it consists of an invented word (AZOPT). The holder says that '-opt' is an abbreviation for optical. There is no evidence that 'opt' is a recognised abbreviation for 'optical' in the UK. In any event, the earlier mark is AZOPT, which (as a whole) has no

[10] Case C-342/97

meaning. I therefore accept the opponent's submission that AZOPT is an invented word and inherently distinctive to a relatively high degree.

47. The opponent says the distinctiveness of the mark has been enhanced through use. However, as the holder points out, the opponent's evidence of use is rather sparse. It shows use of AZOPT in the UK from 2017 to 2021. The sales figures appear significant, but there is no market share data to place them in context. There is no evidence of any advertising. The absence of marketing aimed at the general public is understandable because the product appears to be available only on prescription. However, there is no evidence of advertising aimed at medical professionals either. The mere fact that nearly 700k units of the product were sold in the UK during the five years leading up to the priority dates of the IRs is sufficient for me to infer that the factual distinctiveness of the earlier mark must have been enhanced to some degree. However, this enhancement is likely to have been small and focussed mainly on medical professionals and members of the public with glaucoma (or their family, friends, or other carers) who were repeat users of AZOPT.

Comparison of the marks

48. The respective trade marks are shown below[11].

Earlier trade mark	Contested trade marks
AZOPT	**Ocuzopt** **Brinzopt**

49. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks,

[11] As all the marks are registered in standard characters (i.e. the words themselves are the protected subject matter) the difference between upper and lower case presentation is irrelevant.

bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*[12] that:

> *".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."*

50. The opponent submits that "*The shared unusual suffix ZOPT establishes a clear degree of similarity between the respective Marks. It is submitted that the key textual element from a visual and phonetic perspective is the suffix "ZOPT", and it is this element which dominates the average consumer's visual and phonetic perception of the Marks."*

51. The holder disputes that the average consumer would break down the contested marks into their constituent letters, and says there is no reason why -ZOPT would be perceived as a suffix. The holder also points out that the beginnings of marks tend to make more impact on consumers that the ends[13].

52. I note that the earlier mark is noticeably shorter (5 letters) than the contested marks (7 and 8 letters). The final 4 letters of the marks are the same -ZOPT. The beginnings of the marks look quite different (OCU- and BRIN- v the letter A-). In my view, there is a medium degree of visual similarity between the marks.

52. According to the opponent, the earlier mark will be pronounced as a two syllable word, the first syllable sounding like the letter A and the second -ZOPT. The opponent submits that the IRs will also be pronounced as two syllable words: OCU-ZOPT and BRIN-ZOPT.

[12] At paragraph 34 of its judgment in Case C-591/12P.
[13] As a general rule, this is true. See, for example, *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, CFI (as the EU's General Court was then known).

53. In my view, AZOPT could be pronounced as A-ZOPT or AZ-OPT. Similarly, BRINZOPT could be pronounced as BRIN-ZOPT or BRINZ-OPT. Average consumers are likely to differ in their pronunciation of these marks. Average consumers who pronounce AZOPT as A-ZOPT and BRINZOPT as BRIN-ZOPT, will perceive a medium degree of aural similarity between them. This is because the ZOPT sound makes more impact than the spoken letter 'A' in the earlier mark; and notwithstanding that it would be the second syllable, it also accounts for a significant part of the sound of BRIN-ZOPT. Average consumers who pronounce AZOPT as AZ-OPT and BRINZOPT as BRINZ-OPT, will perceive a similar degree of aural similarity between them.

54. Most consumers will probably pronounce OCUZOPT as three syllables, OC-U-ZOPT, in the same way that the well-known word OCULAR is pronounced OC-U-LAR. Those average consumers who pronounce AZOPT as A-ZOPT will perceive a low to medium degree of aural similarity with OC-U-ZOPT. Those average consumers who pronounce AZOPT as AZ-OPT will perceive a low degree of aural similarity with OC-U-ZOPT.

55. Neither party contends the marks as wholes have any conceptual meanings which bear on their overall similarity.

Likelihood of confusion

56. The relevant dates for assessing the likelihood of confusion are 20th May 2021 (Brinzopt) and 21st May 2021 (Ocuzopt).

57. I will first consider the likelihood of direct confusion, including the possibility of imperfect recollection of the marks, where the parties' specifications cover identical goods and the risk of confusion is therefore the highest, i.e. *pharmaceutical preparations for veterinary use; pharmaceuticals; medical preparations*.

58. Taking account of:

(i) AZOPT being distinctive to a relatively high degree;

(ii) The extent of the overall visual and aural differences between AZOPT (or Azopt) and Brinzopt/Ocuzopt;

(iii) The different beginnings of the marks;

(iv) The high or, at least, above average level of attention likely to be paid by relevant average consumers and end users;

I find that there is no likelihood of direct visual or aural confusion between the earlier mark and the contested marks.

59. If I am right that *dietary supplements and dietetic preparations* are dissimilar to *ophthalmic pharmaceutical product for the treatment of glaucoma,* the opposition under s.5(2) fails for this reason alone[14]. However, in case I am wrong about this I will consider the likelihood of confusion on the footing that the goods are similar, as the opponent contends.

60. Taking account of:

(i) AZOPT being distinctive to a relatively high degree;

(ii) The extent of the visual and aural differences between the marks;

(iii) The different beginnings of the marks;

(iv) The average level of attention likely to be paid by relevant average consumers and end users;

(v) That the goods are (at most) similar to a low degree;

I find that there is no likelihood of direct visual or aural confusion between the earlier mark and the contested marks.

61. In *L.A. Sugar Limited v By Back Beat Inc.*[15], Mr Iain Purvis Q.C., as the Appointed Person, explained that:

[14] See *Waterford Wedgwood plc v OHIM* – Case C-398/07P, CJEU.
[15] Case BL O/375/10

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

62. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*[16], Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the

[16] [2021] EWCA Civ 1207

Appointed Person in *Cheeky Italian Ltd v Sutaria*[17] where he said at [16] that *"a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion."* Arnold LJ agreed, pointing out that there must be a *"proper basis"* for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

63. The opponent's case is that the -ZOPT suffix of the marks is sufficiently distinctive that it will cause average consumers to believe that Ocuzopt and Brinzopt are logical and consistent brand extensions of AZOPT (or Azopt).

64. The holder points out that -ZOPT is not a word and is not strictly a suffix either. According to the holder, if the average consumer were to break the parties' marks down into their constituent parts, he or she would mentally break the marks at the point of the -OPT endings, which the holder says (without any evidence) is an abbreviation for 'optical'.

65. I accept that -ZOPT is not a word and has no meaning. However, I think all the opponent means by 'suffix' is a distinctive letter string at the end of the marks. Despite it being generally the case that consumers pay more attention to the beginnings of marks than the ends, there is no hard rule that confusion cannot be caused by marks with the same or similar endings[18]. This is particularly possible where the common ending is distinctive[19]. ZOPT is an unusual letter string. In principle, it could be distinctive enough to give rise to a likelihood of indirect confusion. However, this argument is predicated on the basis that the average consumer will perceive the ends of the parties' marks as -ZOPT.

66. I accept this is true of Ocuzopt, the final syllable of which is clearly -ZOPT. It is made even more likely by the fact that the relevant public are likely to recognise OCU- as the beginning of the word Ocular thereby evoking a connection with the eye and vision. However, I do not consider the letter string -ZOPT will necessarily strike the relevant public as a recognisable component of Brinzopt. This mark divides just as naturally into BRINZ-OPT as BRIN-ZOPT. Further, the significance of BRINZ- as the

[17] BL O/219/16
[18] See, for example, *Bristol Global Co Ltd v EUIPO,* T-194/14.
[19] See, for example, *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person, at paragraph 39.

first five letters of the generic name for the opponent's goods (Brinzolamide) is unlikely to be lost on medical professionals paying a high degree of attention when selecting such goods for their patients. For these reasons, medical professionals are more likely to recognise -OPT as the second component of Brinzopt. It is true that a significant proportion of them will also see -OPT as the end of AZOPT because that mark divides just as naturally into AZ-OPT as A-ZOPT. However, it is (rightly) not suggested that the mere coincidence of AZOPT (or Azopt) and Brinzopt ending in -OPT is sufficient to constitute a *"proper basis"* for a finding of indirect confusion.

67. Although Brinzolamide appears to be prominently identified as the active ingredient in the opponent's goods in patient information leaflets[20], average end users of pharmaceuticals containing this active ingredient are less likely to be familiar with the name than medical professionals who select and prescribe it. It follows that they are much less likely to attach any meaningful significance to the letters BRINZ- in Brinzopt. It follows that a significant proportion of such end users may indeed perceive -ZOPT as the ending of Brinzopt. However, not only are the beginnings BRIN- and A- different, but the distinctive character of Brinzopt will appear to these end users to be evenly distributed across the mark as a whole rather than weighted on the -ZOPT ending. Therefore, I do not consider that end users will be caused to believe that Brinzopt is a logical and consistent brand extension of AZOPT. I do not rule out the possibility that Brinzopt may bring AZOPT to mind, but this is mere association not indirect confusion[21].

68. I therefore reject the opponent's case that there is a likelihood of indirect confusion between AZOPT and Brinzopt if both are used in relation to identical goods. The case for indirect confusion is even weaker when it is considered in relation to (only) similar goods. I therefore also reject the opponent's opposition to Brinzopt under section 5(2) of the Act in relation to pharmaceuticals and medical preparations, which are not *ophthalmic pharmaceutical product*[s] *for the treatment of glaucoma.* For the same reasons, I would also have rejected the opponent's s.5(2)(b) objection to the registration of Brinzopt in relation to *dietary supplements and dietetic preparations* (if they are similar goods).

[20] See exhibit 4.
[21] *Duebros Limited v Heirler Cenovis GmbH,* the Appointed Person, BL O/547/17.

69. In my view, there is more to be said for the opponent's case for indirect confusion between AZOPT and Ocuzopt. For the reasons given above, there is little doubt in my mind that the latter mark will be recognised by the relevant public as having the beginning OCU- and the ending -ZOPT. The beginning of the contested mark (OCU-) is likely to be recognised, particularly (but not exclusively) by medical professionals dealing with eye problems, as the beginning of the well-known word 'Ocular'. Such average consumers and end users are therefore likely to recognise that the beginning of Ocuzopt (i.e. OCU-) alludes to goods connected with the eyes and/or vision. This will focus more of their attention on the ending (-ZOPT) as the more distinctive component of the mark.

70. A significant proportion of these people will notice that -ZOPT is also the last 4 letters of the existing 5 letter brand name AZOPT (or Azopt). In my view, this is likely to be sufficient to cause a significant proportion of the relevant public as a whole to believe that Ocuzopt is a brand extension used by the same undertaking that markets AZOPT (or Azopt) in relation to a treatment for an eye condition. I accept that not all average consumers/end users will come to this conclusion. Many will not. However, it is not necessary for there to be a likelihood of confusion on the part of all, or even a majority, of the relevant public[22]. It is sufficient that there is a likelihood of confusion on the part of a significant proportion of them. I am satisfied there is.

71. The opposition under section 5(2)(b) therefore succeeds against the trade mark Ocuzopt, to the extent that it covers pharmaceuticals for the treatment of conditions of the eyes and/or vision.

72. The position is different for pharmaceuticals and medical preparations for other purposes. This is because the beginning OCU- will appear meaningless for such goods with the result that the distinctive character of Ocuzopt will be spread evenly across the mark. In these circumstances there is no *"proper basis"* for finding that there is a likelihood of direct or indirect confusion. The same applies to *dietary supplements and dietetic preparations* (even if they are similar goods).

[22] See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ at paragraph 34(v).

The section 5(3) ground of opposition

73. Section 5(3) and (3A) state:

> *"(3) A trade mark which-*
>
> *is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.*
>
> *(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected".*

74. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

> (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; General Motors, paragraph 24.
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; General Motors, paragraph 26.
>
> (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; Adidas Saloman, paragraph 29 and Intel, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; Intel, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; Intel, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; L'Oreal v Bellure NV, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; Intel, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the

earlier mark; L'Oreal v Bellure NV, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; L'Oreal v Bellure NV, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

Reputation

75. As I have already observed, the opponent's evidence of use of AZOPT in the UK (or EU) is limited. I have already held that it is sufficient to establish genuine use of the earlier mark and a small enhancement to the distinctive character of the mark. Distinctive character is measured by how strongly a mark designates the goods/services of a particular undertaking. The question here is whether it is also sufficient to establish that the earlier mark AZOPT had a qualifying reputation at the relevant dates of 20th and 21st May 2021. Whether a mark has a qualifying reputation for the purposes of section 5(3) depends on whether a knowledge threshold has been passed. In this case, whether AZOPT was known to a significant part of the relevant public concerned with an *ophthalmic pharmaceutical product for the treatment of glaucoma.*

76. In examining whether this condition is fulfilled, it is necessary to take into consideration all the relevant facts of the case, in particular the market share held by

the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it[23].

77. Although what appear to be significant UK sales figures for goods sold under the mark have been provided, there is no evidence of the market share held by the earlier mark. Consequently, it is not possible to say whether the earlier mark is a leading brand for the goods for which it is registered, or just one of many. There is some indication that the earlier mark has been on the UK and EU markets for many years, but the opponent's witness does not say when the mark was first used in either market. Consequently, it is not possible to know whether, or to what extent, the earlier mark was used in the UK or EU prior to 2017. Given the nature of the goods, it seems likely that the earlier mark was used throughout the UK from (at least) 2017. There is no evidence of any investment made by the opponent promoting the earlier mark.

78. There is no point in a party putting forward a section 5(3) case unless it is prepared to support it with appropriate evidence of (at least) a reputation. The opponent has not done this. Therefore, my primary finding is that the opponent's section 5(3) claim falls at the first hurdle.

79. In case I am wrong about this, I will briefly examine the opponent's case on the footing that AZOPT had the required reputation in the UK at the relevant dates.

The degree of similarity between the conflicting marks

80. This is covered above.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

81. Most of the descriptions of goods in the specifications of the contested marks cover goods that are identical to the goods for which I am assuming (contrary to my primary finding) the earlier mark has a qualifying reputation. The remainder are similar goods or, in the case of *dietary supplements and dietetic preparations,* dissimilar goods sold

[23] See *General Motors,* CJEU, at paragraph 27.

into the same market (i.e. the healthcare market). In all cases, there is likely to be a substantial overlap in the relevant public, which includes medical professionals and the general public.

The strength of the earlier mark's reputation

82. At best, the evidence establishes that the earlier mark had a modest reputation in the UK in May 2021.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

83. The earlier mark is relatively highly distinctive.

Whether there is a likelihood of confusion

84. There is no likelihood of confusion, except in respect of Ocuzopt, and then only if it is used in relation to pharmaceuticals for the treatment of conditions of the eyes and/or vision.

Conclusion on link

85. Use of Ocuzopt in relation to pharmaceuticals for the treatment of conditions of the eyes and/or vision is likely to cause a significant proportion of those familiar with AZOPT (or Azopt) to call that mark to mind.

86. Use of Brinzopt in relation to pharmaceuticals for the treatment of conditions of the eyes and/or vision may also cause a small-but-still-significant proportion of those familiar with AZOPT (or Azopt) to call that mark to mind.

87. Otherwise, use of Ocuzopt and Brinzopt will not cause any significant proportion of the relevant public to call AZOPT to mind.

<u>Unfair advantage/detriment to the reputation or distinctive character of the earlier mark</u>

88. The holder has advanced no argument that it has due cause to use the IRs.

89. I have already held that use of Ocuzopt in relation to pharmaceuticals for the treatment of conditions of the eyes and/or vision is likely to cause a significant proportion of the relevant public to indirectly confuse the mark with AZOPT. I accept that a mistaken belief that Ocuzopt is a brand extension of AZOPT (or Azopt) for such goods would be likely to give Ocuzopt an unfair advantage by riding on the reputation of the existing brand (i.e. it would make it easier to market Ocuzopt). Further, if the pubic believe that goods marketed under Ocuzopt and AZOPT come from the same undertaking (as opposed to Ocuzopt merely bringing AZOPT to mind), uncontrolled use of Ocuzopt would be liable to damage the reputation of AZOPT, if Ocuzopt is used in relation to lower quality products. The section 5(3) ground of opposition to Ocuzopt would therefore succeed in relation to pharmaceuticals for the treatment of conditions of the eyes and/or vision.

90. By contrast, I find that any mental association the relevant public make between Brinzopt and AZOPT (or Azopt) would be unlikely to give the former mark an unfair advantage or be detrimental to the reputation/distinctive character of that mark. This is because:

(1) The strength of any association is likely to be weak;

(2) The public are unlikely to believe that Brinzopt is a brand extension used by the undertaking that markets AZOPT;

(3) Although is not necessary to establish a likelihood of confusion in a section 5(3) case, in the absence of such a likelihood it is particularly important for the party asserting it to provide evidence from which it can logically be deduced that use of the contested mark would nevertheless give rise to one or more of the conditions set out in the section;

(4) The opponent has not done this: all aspects of the opponent's s.5(3) case (apart from consequences of a likelihood of confusion) are largely hypothetical and/or speculative[24];

[24] See *Aktieselskabet af 21. november 2001 v OHIM,* Case C-197/07P, CJEU, at paragraph 22, *Environmental Manufacturing LLP v OHIM,* Case C-383/12P, CJEU, at paragraphs 34 to 43, and

(5) The evidence indicates that the reputation of the earlier mark is (at most) modest, which makes it harder to find that, simply as a matter of probabilities, use of Brinzopt would, without causing confusion, take unfair advantage and/or be detrimental to the distinctive character of AZOPT.

91. The same findings apply to the opponent's s.5(3) case against Ocuzopt to the extent that it is directed at goods other than pharmaceuticals for the treatment of conditions of the eyes and/or vision.

92. I conclude that (if AZOPT has a qualifying reputation) the opponent's s.5(3) case provides a second legal basis for the refusal of Ocuzopt in relation to pharmaceuticals for the treatment of conditions of the eyes and/or vision. However, the opposition under s.5(3) would not have extended the success of the opposition to any other goods.

The section 5(4)(a) ground of opposition

93. Sections 5(4)(a) and (4A) state:

"(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) […]

(b) […]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

Unite The Union v The Unite Group Plc, Case BL O/219/13, Ms Anna Carboni as the Appointed Person.

application for registration of the trade mark or date of the priority claimed for that application."

94. In *Discount Outlet v Feel Good UK*[25], Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21)."

Goodwill

95. I accept that the opponent has established that it owned goodwill in the UK under the sign AZOPT at the priority dates claimed for the IRs.

Misrepresentation

96. For the same reasons I found that use of Ocuzopt would cause indirect confusion with AZOPT (or Azopt) if used in relation to pharmaceuticals for the treatment of conditions of the eyes and/or vision, I find that use of the mark would be likely to deceive a substantial number of the customers or potential customers for AZOPT into believing that Ocuzopt is marketed by the same undertaking, or a related undertaking.

[25] [2017] EWHC 1400 IPEC

97. For the same reasons I found that, if used in relation to pharmaceuticals or medical preparations for other uses, or dietary supplements and dietetic preparations, use of Brinzopt and Ocuzopt would not cause confusion with AZOPT (or Azopt), I find that use of those marks would not be likely to deceive a substantial number of the customers or potential customers for AZOPT.

Damage

98. Misrepresentation is a pre-requisite for establishing damage under passing off law. The opposition under s.5(4)(a) therefore fails in relation to pharmaceuticals and medical preparations, other than pharmaceuticals for the treatment of conditions of the eyes and/or vision. It also fails for dietary supplements and dietetic preparations.

99. Damage will readily be inferred where use of a contested mark would constitute a misrepresentation to the public that there is a connection with another party trading in the same goods. Therefore, the opposition under s.5(4)(a) provides a third legal basis for the refusal of Ocuzopt in relation to pharmaceuticals for the treatment of conditions of the eyes and/or vision. However, the opposition under s.5(4)(a) does not extend the success of the opposition to any other goods.

Overall result

100. The opposition to Brinzopt fails. The IR will therefore be protected for the goods specified in paragraph 2.

101. The opposition to Ocuzopt partially succeeds. Section 5A of the Act is as follows:

> *"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."*

102. Ocuzopt will therefore only be protected in relation to:

> Pharmaceutical preparations for veterinary use; pharmaceuticals; medical preparations; but not including any goods for use in the treatment of conditions of the eyes and/or vision; dietary supplements and dietetic preparations.

Costs

103. Both sides have achieved a measure of success. I therefore direct that each side bears its own costs.

Dated this 24th day of March 2023

Allan James
For the Registrar