

IN THE MATTER of the Trade Marks Ordinance

AND

IN THE MATTER of an Application by

Bracco Industria Chimica S.p.A.

to register the word "TEONICON"

in Class 5 in respect of

pharmaceutical preparations

AND

IN THE MATTER of an Opposition by

Ethicon Inc.

D E C I S I O N

of

Mr P. Murphy acting for the Registrar of Trade Marks.

Hearing on 22nd April 1975.

Mr R.I. Campbell of Messrs Johnson, Stokes & Master appeared for the Applicants.

Mr A.J. Sakhrani, instructed by Messrs Wilkinson & Grist, appeared for the Opponents.

---

On 31st December 1971, Bracco Industria Chimica S.p.A., a company organised and existing under the laws of Italy, with its registered office at Via Egidio Folli 50, 20134, Milan, Italy, (hereinafter referred to as "the Applicants") submitted through their then agents, Messrs Brutton & Stewart, an Application to the Registrar of Trade Marks (hereinafter referred to as "the Registrar") for the registration in Part A of the Register of the word "TEONICON" in Class 5 in respect of pharmaceutical preparations.

The supporting Statutory Declaration made by Dr.ssa Diana Bracco De Silva, a Director of the Applicants, on 22nd December 1971, stated that the trade mark had not hitherto been used by the Applicants either in a country or place other than Hong Kong, or in Hong Kong itself, in respect of the goods mentioned in the application but that the Applicants intended to use it in Hong Kong if and when it was registered (The statement that the mark had not hitherto been used by the Applicants in a country or place other than Hong Kong in respect of the goods mentioned in the application appears to be incorrect and, if so, is another example of the somewhat haphazard way in which trade mark application forms and supporting documentation are sometimes completed).

On 14th January 1972 the Registrar wrote to Messrs Brutton & Stewart granting consent to advertisement of the application for registration of "TEONICON" in the Gazette and the mark was duly advertised in the Gazette of 18th January 1972, page FN 152.

On 20th March 1972, Ethicon Inc., an American corporation organised and existing under the laws of the State of New Jersey and having its registered address at U.S. Highway No.22, Bridgewater Township, New Jersey U.S.A. (hereinafter referred to as "the Opponents") indicated through their agents Messrs Wilkinson & Grist that they intended to oppose the application. Formal Notice of Opposition was filed on 27th December 1972. The grounds of opposition to the mark were :

- "1. The mark applied for, "Teonicon", so nearly resembles the Opponent's mark, "Ethicon", in respect of the same description of goods as to be likely to deceive or cause confusion. The Opponent's said mark is already on the Register, being No.613 of 1956 in Class 5 and has been advertised in the Gazette on 29th June 1956.
2. The Opponent's said mark has been in continuous and extensive use in this Colony since January 1937 by reason of which the same has

become well known in this Colony. By reason of such reputation, use of the mark applied for would be so deceptive and confusing as to be disentitled to protection in a Court of law.

3. Further to 2 hereof, both the Opponent's said mark and the mark applied for are in respect of pharmaceuticals by reason of which use of the mark applied for would be so deceptive and confusing, alternatively would be so likely to deceive or cause confusion, that such use would be disentitled to protection in a Court of law.
4. The nature of the use of the mark applied for, namely upon pharmaceuticals, is such that in all of the foregoing circumstances the Registrar should refuse the application in the exercise of his discretion."

the specification of goods for the said registered mark No.613 of 1956 is "Pharmaceutical, veterinary and sanitary substances, ligatures, bandages, dressings, and other materials for medical, surgical, dental, gynecological, obstetrical and veterinary use".

The Counter-Statement filed by the Applicants on 13th July 1973 sets out the grounds on which they relied as supporting their application as follows :

- "1. The trade mark which we are applying to register on this application does not so nearly resemble the said registered trade mark No. 613/56 of the opponent as to be calculated to deceive or cause confusion.
2. The word "TEONICON" which we are applying to register is not liable to be confused with the opponent's said registered trade mark No. 613/56 consisting of the word "ETHICON". The words themselves are sufficiently different and distinct to avoid any probability of deception or confusion even if used for the same goods or goods of the same description.

3. The goods for which the opponent's said registered trade mark is registered are not the same goods or the same description of goods as those for which we are on this application applying to register the said word "TEONICON". To the best of our knowledge and belief, the opponents use their mark in connection with surgical sutures, e.g. catgut which is an entirely different description of the goods to those in respect of which we are applying for registration. A description of the nature of our goods and their use is attached hereto and marked "A".
4. Even if the goods for which the opponent's said trade mark is registered are the same description of goods as those included in our application, yet having regard to the goods not being the same goods but different goods and having regard to the differences between the said word "TEONICON" and the word "ETHICON", there is no probability of deception or confusion between the said words or marks or of the goods of the applicant being passed off as or mistaken for the goods of the opponent.
5. The only resemblance between the two words is the use of the suffix "ICON". In itself, this suffix is meaningless and when used in connection with the respective words, does not result in them being in any way similar. In support of this, we cite the following trade marks now standing in the trade marks register of Hong Kong :-

<u>NAME</u>	<u>T.M. No.</u>	<u>Class</u>
LUTEONOSTICON	21-1970	5
HUBENOSTICON	1603-1971	5
THEERICON	617-1968	5
TEEICON	1029-1965	5
INTEERICON	311-1960	5"

The Opponents' evidence consists only of an Affidavit dated 4th January 1974 by Mr Anthony J. Abbruzze, Chairman of the Opponents, in which he states inter alia: "The Opponent has been producing surgical sutures and ligatures for 44 years and for some 20 years or more has been the leader in this particular field. The Opponent has also been producing surgical soaps and pharmaceutical powder, waxes and pastes for, at least 25 years. In Hong Kong alone, the volume of imports and sales over the last 14 years has been more than 95,000 pounds sterling. Most hospitals and doctors know of and/or are using products of the Ethicon name.". He also states that the Opponents have an educational programme concerning new surgical operations involving sutures and/or ligatures and that this programme extends to Hong Kong where educational literature is distributed, but no further details are given.

With regard to the information given about sales in Hong Kong, it will be noted that (a) sutures belong to Class 10 and are not included in the specification of goods in the mark applied for and that, similarly, surgical soaps belong to Class 3 and (b) that no breakdown of sales figures is given for each type of goods sold.

The Applicants' evidence consists only of a Statutory Declaration by the said Dr.ssa Diana Bracco De Silva who, inter alia, annexes to the Declaration a copy of a Decision dated 13th June 1974 by the Registrar of Trade Marks in London in the matter of an application by the Applicants for the registration of "TECNICON" in Class 5 in respect of "Pharmaceutical and veterinary preparations and substances", and in the matter of an opposition thereto by the Opponents. The Decision was in favour of the Applicants. The Hong Kong Trade Marks Registry is an independent registry and I am not legally bound by the London decision but, of course, I attach great weight to it because both Registries operate under the same legislation, subject to certain exceptions which are not of any great importance in connection with the present case.

Dr.ssa Bracco De Silva states that the goods in respect of which the Opponents claim use of the mark "ETHICON" are mostly outside the specification of goods in its registered mark. She also states that no evidence of sales of goods bearing the Opponents' registered mark on the items included in the specification in the present application has been produced.

Having regard to all the circumstances, I have decided, as did the Registrar in London, that essentially this objection must be considered under Section 20 of the Ordinance because there is no doubt that the specification of goods in the Opponents' registered mark completely overlaps the specification in the application under consideration.

The questions to be considered under the corresponding Sec.12(1) of the Trade Marks Act 1938 were authoritatively summarised in Smith Hayden & Co. Ltd.'s Application (1946) 63 RPC 97 by Evershed J. and are reproduced in "Kerly's Law of Trade Marks and Trade Names", Tenth Edition (hereinafter referred to as "Kerly"), section 10-02 (pages 172-174).

I consider that the first point to be decided in considering this case is whether the two marks are to be used on the same goods or goods of the same description. The matters to be taken into account in considering this question are set out in Jellinek's Application (1946) 63 RPC 59 and are repeated in Kerly, 10-12, (page 162). However, I do not think that in this case there is any difficulty in deciding that the goods covered by the mark applied for are the same as the goods covered by the registered mark.

I also consider that the onus is on the Applicants to prove that the Opposition is not justified. I base this on Kerly, 17-03, (page 451) :

"(1) On an application to register, the Registrar or an opponent may object that the trade mark is not registrable by reason of section 11 and of section 12(1).

In such cases the onus is on the applicant to satisfy the Registrar

that the trade mark applied for is not reasonably likely to deceive or cause confusion, so that refusal to register does not involve the conclusion that the resemblance is such that either an infringement action or a passing-off would succeed. In cases in which the tribunal considers that there is doubt as to whether deception is likely the application should be refused."

The rules for comparison of two words alleged to have a deceptive resemblance are set out in Chapter 17 of Kerly.

The first important question is: "Who are the people whom the mark must be calculated to deceive". In Kerly, 17-05 (pages 453 and 454) the answers given by the Courts in past cases are summarised as: "All of those who are likely to become purchasers of the goods upon which the marks are used, provided that such persons use ordinary care and intelligence". At 17-06 (page 454) Kerly states:

"It is clearly not enough to show that retail dealers buying goods for resale would not be deceived, since they might themselves fraudulently or carelessly make use of the ambiguous character of the trade mark to deceive their customers, the ultimate purchasers."

In this case, I do not think that there is any likelihood of the retail dealers, i.e. retail chemists or pharmacists, being confused by the two marks.

With regard to the public, I consider that I must take into account the fact that the Opponents have registered the mark in respect of "Pharmaceutical, veterinary and sanitary substances" etc. and that there is no legal reason why they should not in a few months time start marketing a completely new range of preparations which will be sold in ordinary chemists shops and which do not require a doctor's prescription. In short, I consider that I must consider all the members of the public who at any time

use a chemist's shop, which means a very large cross-section of the community. I find support for this view in the Bayer Products Ltd.'s Application ("Diasil") (1947) 64 RPC 125. At pages 127 and 128, there is the following extract from the Registrar's original decision:

"From a purely commercial point of view I should imagine that under these circumstances the Opponents are unlikely to apply the mark "Alasil" to goods other than those in respect of which it has established its reputation, but however that may be, the mark is registered in respect of all "Chemical substances prepared for use in medicine and pharmacy" and I must consider the application and opposition only on the basis that the Opponents' mark may be applied to any goods within the ambit of this specification".

Wynn - Parry J. also states at page 134 :

"Still considering the matter under Section 12 I have, as regards the Appellants, to postulate a wide range of customers, because I have to postulate the use of the mark "Alasil" in relation to all goods falling within Class 5, and I have to postulate customers purchasing over the counter goods within the class not requiring, as a condition of their being supplied, the production of a doctor's written prescription as well as purchasers who require such a prescription."

Having decided on the persons to be considered the second important question which Kerly states I must consider is "What amount of resemblance is likely to deceive". Kerly points out at 17-07 (page 455) :-

"As Lord Cranworth said in *Seixo -v- Provezende* "What degree of resemblance is necessary ... is from the nature of things incapable of definition a priori. Nor is the standard always the same: thus in the case of pharmaceutical products, in the absence of restrictions upon their distribution, it is the more important that the

public should be protected from the consequences of deception and confusion."

Kerly also goes on to state at page 456 :-

"In comparing the marks, the Registrar or the court, as the case may be, must, as appears from the authorities referred to below, take into account all the circumstances of the case, and must consider whether, as a whole, the applicant's mark is substantially different from the opponent's.

The onus of proof in relation to the reasonable probability of section 12(1) of the Act of 1938 was summed up by Parker J. in a case involving the comparison of two words, as follows: "You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances, and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

At the Hearing, Mr Campbell reminded me that the Registrar had granted consent to advertise this Application without citing any conflicting marks. He argued, in summary, that I should have particular regard to the respective first syllables of the two marks and that, on this basis, there is no danger of confusion between the two marks. He pointed out that the Opponents' figures as to sales of their goods in Hong Kong were not at all precise. He also referred to the Opponents' educational programme here and asked whether surgeons, doctors and nurses would be confused by the marks. Finally, he asked me to be influenced by the U.K. Registrar's decision.

Mr Sakhrani for the Opponents argued to the general effect (a) that the principles laid down in decided cases showed that the mark applied for should be refused because there is a danger of confusion with the registered mark and (b) that I should be particularly strict in deciding whether or not there is a danger of confusion in this case because it involves medicines. He also reminded me of the danger of imperfect recollection and referred me to the relevant section 17-23 in Kerly (page 469).

He suggested that the mark applied for could be pronounced "Ten-ee-con" but did not produce any evidence to that effect. I personally regard the possibility of such a pronunciation as rather remote but, even if the mark were so pronounced, I do not think that it would increase the mark's phonetic resemblance to the registered mark.

With regard to point (a) above, Mr Sakhrani referred to a number of well-known cases -

- (i) Magdalena Securities Ltd.'s Application (1931) 48 RPC 477.  
"UCOLITE" was refused registration because of danger of confusion with the registered mark "COALITE". However, I agree with the point made by Mr Campbell in reply, that the degree of resemblance between those two marks was very obvious and far greater than in this case.
- (ii) "Buler" Trade Mark Application (1966) RPC 141 and "Bulova Accutron" Trade Mark Application (1969) RPC 102. I regard both these cases as stressing the importance of the first syllables of a mark and I note that the "Buler" case is included in footnote 31 to Section 17-20 in Kerly (page 467) as an illustration of this principle. Since the first syllables in the two marks under consideration are, in my opinion, very different I think that these cases tend to support Mr Campbell's arguments.
- (iii) Reynolds v Laffeaty Limited (1957) RPC 311 and (1958) RPC 387 where an interdict was granted against "Watermatic" as an infringement

of "Aquamatic". This case was unusual in that there were no obvious similarities between the respective first syllables of the marks. Jenkins L.J. states at p.312 of the report on the 1957 proceedings :

"It will be seen that the two words both end with the syllable 'matic', but that, while the Plaintiff's mark begins with the word 'Aqua', making 'Aquamatic', the Defendants' mark begins with a different word, namely, 'Water', to make 'Watermatic'. As to this difference it is fair to add that 'aqua' is the Latin equivalent of 'water'. It may be said, therefore, that the general idea underlying the two names is the same. Moreover there is certainly some resemblance between the two as seen written, more especially if seen written one after the other at some interval of time; and, although perhaps the words 'Water' and 'Aqua', pronounced in the ordinary way and taken by themselves, are not phonetically very similar, the same cannot be said with equal force when they are uttered as part of the respective trade marks, 'Watermatic' and 'Aquamatic'."

Upjohn I. said at p.388 of the report on the 1958 proceedings:

"The Plaintiff says that he cannot claim, and does not claim, an essential feature of his mark in the prefix "Aqua". He said he could not do that; nor in the suffix "matic". But he says he is entitled to have the whole word "Aquamatic" protected, and bearing in mind that "Watermatic" has the same idea to anyone with the least knowledge of the Latin tongue, there is a complete similarity of ideas, as was pointed out by Jenkins, L.J. Indeed, there is evidence of the Plaintiff that in the trade you do not have to have

knowledge of the Latin tongue to know that "aqua" means water, and that seems to me plainly right. In this day and age every child must know that "aqua" has something to do with water. So the real point the Plaintiff makes there is that the idea underlying these two words is the same, and applying ordinary tests he would say that a purchaser with a memory but, as Lord Russell pointed out in the Coca-Cola case, a person of average memory but with his usual imperfections, might, on making a second purchase, easily confuse "Watermatic" with "Aquamatic", both bringing the same idea to mind."

It seems to me that both the learned judges were very considerably influenced by the fact that "aqua" is the well-known Latin equivalent of "water" and that the general idea of the two marks is therefore the same. As I shall explain later, I consider that in the Application under consideration the registered mark strongly suggests "ethical" and I am sure that this is the "idea" which remains in the mind of a purchaser. "TEONICON" on the other hand appears to me to be an invented word which does not convey any specific "idea" to a purchaser. I therefore consider that this case cannot be regarded as a precedent for refusing the present Application.

With regard to point (b) above, I have already indicated from my reference to 17-07 of Kerly (page 455) that I agree that in the case of pharmaceuticals it is even more important than usual that the public be protected from the consequences of deception and confusion. Mr Sakhrani emphasized the point by referring me to Edward's Application (1945) 63 RPC 19 where "Jardex" was refused registration in respect of 'disinfectants' because of the registered mark "Jardox" in respect of 'extract of meat',

even although the two marks were in different classes. However, as Mr Campbell pointed out in his reply to Mr Sakhrani's argument, the similarity between those two marks could hardly have been greater and I do not think that the degree of similarity between the two marks under consideration is comparable.

Mr Sakhrani also referred me to the Compagnie Industrielle des Petroles' Application (1907) 24 RPC 585 where "Motricine" was refused in respect of petrol because of the registered mark "Motorine" in respect of lubricating oils. Here again, however, I feel that the degree of resemblance between the marks was great and that no such resemblance exists in this case.

Having carefully considered the evidence and the points put to me at the Hearing, I have reached the conclusion that the possibility of confusion between the two marks is so small that I would not be justified in refusing registration of the mark applied for. It is generally accepted that the first syllables of a mark are the most important and I do not see how anyone could confuse "Eth" and "Teon" visually or phonetically even if one accepts, which I do not, Mr Sakhrani's claim that the latter could be pronounced "Ten". It is true that "icon" is common to both marks, but I am satisfied that the suffix is used fairly often in Class 5 marks and there was no evidence to the effect that the public associate the suffix exclusively with the Opponents' goods. As the Registrar in London pointed out in his decision, the Opponents' mark is close to "ethical" which is used as a descriptive word in the medicines field and, like him, I think that the "ethi" prefix will stay in the mind of a person who has seen or heard the mark. On the other hand, "teon" does not convey any such idea.

I therefore do not think that there is any danger that the two marks will be confused either visually or phonetically or because of imperfect recollection, even by ordinary members of the public.

I take the same view in so far as the objections apply under

Section 12(1) of the Ordinance, because even accepting that "Ethicon" has acquired a substantial reputation in Hong Kong, it appears that its use has to a large extent been in respect of goods outside 'pharmaceutical preparations' in Class 5.

I find that the Applicants are entitled to an award of costs, that any representations which either party may wish to make as to the amount of these costs will be considered if received within 21 days from the date of this Decision and that failing such representation or subject to any representations calling for special treatment, costs will be calculated on the usual scale.

*b*  
(P. Murphy)  
Senior Solicitor  
18th July, 1975.