

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

BETWEEN

PINEWOOD LABORATORIES LIMITED

Applicant

and

MAY & BAKER LIMITED

Opponent

CONCERNING

Trade Mark Application No. 2005/02608 (233179)

COZITAN

Background

1. On 12 December, 2005, Pinewood Laboratories Limited, an Irish company of 1 M50 Business Park, Ballymount, Dublin 24, made application (No. 2005/02608) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the word COZITAN as a trade mark in respect of goods in Class 5, namely, pharmaceutical preparations and substances.
2. The application was accepted for registration and advertised accordingly under No. 233179 in Journal No. 2039 on 8 February, 2006.
3. Notice of opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 8 May, 2006 by May & Baker Limited of RPR House, 50 Kings Hill Avenue, Kings Hill, West Malling, Kent ME19 4AH, United Kingdom. The Applicant filed a counter-statement on 1 August, 2006 and evidence was subsequently filed by the parties under Rules 20 and 21 of the Trade Marks Rules,

1996 (“the Rules”). A hearing was then appointed for 27 November, 2008 but the parties informed the Controller that they did not intend to be represented at the hearing so that the matter went for decision on the basis only of the materials filed.

4. Acting for the Controller, I decided the opposition on 1 December, 2008. The parties were notified on the following day that I had decided to dismiss the opposition and to allow the mark to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) filed on 19 December, 2008.

Scope of the opposition

5. The notice of opposition lists eleven separate grounds of opposition arising, variously, under Sections 6, 8, 10 and 37 of the Act. The great majority of these grounds of opposition are not properly particularised in the notice of opposition and were not subsequently substantiated by the filing of any relevant evidence whatsoever. The only ground of opposition that was properly particularised and in support of which evidence was filed is that under Section 10 of the Act to the effect that registration should be refused in light of the Opponent’s prior registration and use of the trade mark NOZINAN in relation to pharmaceuticals.

The evidence filed and facts claimed

6. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits JSH1-JSH5) dated 1 February, 2007 of Joëlle Sanit-Hugot, who is described as “proxy holder” of the Opponent. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibit TH1) dated 31 January, 2008 of Tony Hynds, Marketing Director (Ireland) of the Applicant and a Statutory Declaration (and Exhibits AB1-AB3) dated 11 February, 2008 of Alison Boydell, Trade Mark Agent of Anne Ryan & Co., the Applicant’s Agents.
7. I would summarise the relevant facts averred to in the evidence as follows. The Opponent is the proprietor of the trade mark NOZINAN, which is registered

under No. 94051 as of 4 May, 1979 in respect of pharmaceutical preparations and substances for human use and for veterinary use. The mark has been used since that time in connection with goods covered by the registration. The Opponent and its sister companies within the Sanofi-Aventis Group hold registrations of the trade mark NOZINAN in various countries throughout the world, including several in the European Union. Sales of goods under the trade mark in the period 2002-August, 2006 amounted to €542,840.

Grounds of decision

8. The relevant parts of Section 10 of the Act, insofar as the present matter is concerned, read as follows:

10-(2) A trade mark shall not be registered if because –

.....

(b) it is similar to an earlier trade mark and would be registered for goods ... 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 of the later trade mark with the earlier trade mark.

and

(3) A trade mark which is 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 State and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

9. For either of those provisions to apply there would have to be a degree of similarity between the respective trade marks COZITAN and NOZINAN such that the average consumer, who was aware of the latter used as a trade mark for pharmaceuticals would be caused to call it to mind if exposed to use of the former as a trade mark for those goods. The creation of such a link between the trade marks in the mind of the average consumer would be a necessary prerequisite to

any possible confusion, association, detriment or unfair advantage arising from the use of the trade mark COZITAN. In my opinion, there is insufficient similarity between the marks to suggest that the average consumer would make any link between them. I take that view because, notwithstanding the positioning of the character strings “O-Z-I” and “A-N” in each of the marks, the marks are more different than similar when compared by reference to the respective overall impressions given by them. That is because the respective initial letters, C and N, which produce entirely different sounds, have a significant impact in creating the overall impression given by each of the marks. It is well established that the opening syllable of a word mark is generally the most important in terms of its visual and aural identity¹ and the opening syllables of these marks, namely CO and NO, respectively, are markedly different. The overall aural and visual impressions given by each of the words COZITAN and NOZINAN are dominated and determined primarily by their initial letters and the differences between those letters creates a clear visual and aural difference between the trade marks.

10. As regards the conceptual or connotative significance of the respective marks, since both consist of invented words it may be said that they have no meaning and are, therefore, neither conceptually similar nor dissimilar. Nevertheless, the average person may be expected to form some kind of conceptual impression of a word to which he is exposed through its use as a trade mark, even in the case of a word that is essentially meaningless. Such conceptual impressions may arise from elements of the word in question which themselves have recognised meanings or from possible visual or phonetic similarities that there may be between the word and a dictionary word or words. This phenomenon by which we make subconscious verbal and conceptual associations which may subsequently play a significant part in recollection is one which I think may fairly be considered in deciding whether there is a likelihood of confusion between trade marks, even though the marks themselves may consist of meaningless words. In this regard, I think that the shared elements of the marks in question here, namely “OZI” and “AN”, are not such as to be likely to trigger recollection of the respective marks individually, or to suggest any connotative connection between them in the mind

¹ that principle was applied by Smyth J in *Unilever PLC –v- The Controller of Patents, Designs and Trade Marks and Sunrider Corporation* [2006] IEHC 427

of the average person. There is no similarity between the words, or their phonetic equivalents, that may be identified as elements of these trade marks – “cosy”, “tan”, “zit”, “nosy”, “nan” – such that there is no basis on which to assume even a subliminal connection between the marks in the consumer’s perception.

11. Because of the clear differences between the overall impressions given by the trade marks COZITAN and NOZINAN, I am not persuaded that the average person who knew of a pharmaceutical product called NOZINAN would be caused to recollect that product and name if he were to encounter pharmaceuticals offered for sale under the name COZITAN. Even in the case of a consumer who was struck by the similarity in the phonetic progression of the two words (and who would not, in my opinion, constitute the average or likely case), I do not think that there is any real likelihood that he would make a link between the two products as a result. It is far more likely that he would perceive the similarity for what it is – a mere coincidence. For these reasons, I have decided that the prior registration and use of the trade mark NOZINAN does not constitute grounds for refusal, under Section 10 of the Act, of the application to register COZITAN and I have decided to dismiss the opposition accordingly.

Tim Cleary

Acting for the Controller

15 January, 2009