

TRADE MARKS ACT 1938 (AS AMENDED) AND

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 1507425
IN THE NAME OF KABUSHIKI KAISHA PILOT (ALSO T/A
THE PILOT CORPORATION) TO REGISTER A MARK IN CLASS 16**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO. 37748 BY THE GILLETTE COMPANY**

5 **TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 1507425
in the name of Kabushiki Kaisha Pilot (also T/A
10 The Pilot Corporation) to register a mark in Class 16**

and

**IN THE MATTER OF Opposition thereto under
15 No. 37748 by The Gillette Company**

DECISION

20 On 21 July 1992 Kabushiki Kaisha Pilot of Tokyo, Japan applied under Section 17(1) of the
Trade Marks Act 1938 to register the following mark:-

25 **Dr. GRIP**

30 Application was made in Class 16 for a specification of “writing instruments”.

The application is numbered 1507425.

35 On 24 November 1993 The Gillette Company of Boston, United States of American filed
notice of opposition to this application. In summary the grounds of opposition are as
follows:-

- 40 i) under Sections 9 and 10 of the Act in that the mark applied for is descriptive
and non-distinctive for the goods at issue;
- ii) under Section 11 by reason of the opponents’ use and reputation in their
registered mark FLEXGRIP,
- 45 iii) under Section 11 in that the mark applied for would be deceptive if not used in
relation to goods adapted or suitable for medical use.

The opponents also ask the Registrar to refuse the application in the exercise of his discretion.

50 The mark FLEXGRIP is registered in the UK. Details are given below:

5	No.	MARK	CLASS	JOURNAL/PAGE	SPECIFICATION
10	1296702	FLEX-GRIP FLEXGRIP (Series of 2)	16	5951/8581	Writing and drawing instruments; parts and fittings and containers included in Class 16 for all the aforesaid goods; inks and ink refills for pens.

The applicants filed a counterstatement denying these grounds. Both sides seek an award of costs in their favour.

Both sides filed evidence in these proceedings and the matter came to be heard on 25 June 1998 when the opponents were represented by Mr C Morcom of Her Majesty's Counsel instructed by Gillette Management Inc. and the applicants were represented by Ms D McFarland of Counsel instructed by Venner, Shipley & Co., their Trade Mark Agents.

By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 of that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Opponents' Evidence

The opponents filed a Statutory Declaration dated 10 March 1995 by Robert Gordon Sample Forrester, the Assistant Secretary of The Gillette Company. He has been employed by his company for 29 years. He is also a Director of Gillette U.K. Limited, a wholly owned subsidiary responsible for the manufacture and/or marketing of products in this country and abroad.

Mr Forrester says that his company first became involved with writing and drawing instruments in September 1955 through the acquisition of a Californian Corporation named Frawley Corporation. Frawley Corporation had introduced in the early 1950s a ball point pen under the trade mark PAPER MATE and, by virtue of that acquisition, his company acquired all rights in and to the trade mark PAPER MATE.

In addition to the trade mark referred to in the summary of grounds the opponents are also the registered proprietors of DYNAGRIP (No. 1522052), FLEXGRIP PLUS (No. B1507065) and FLEXGRIP ULTRA (No. 1567238). Mr Forrester exhibits at (RGSF1) photocopies of the original advertisements in the Trade Mark Journal. Collectively, he refers to those registrations as GRIP marks. He goes on to say that the Trade Mark FLEXGRIP has been used since early 1988 and the Trade Mark DYNAGRIP since 1992, both within the United Kingdom and throughout the world and on a very extensive scale in relation to writing and drawing instruments.

5 He exhibits (RGSF2) a table representing sales by volume and value from 1988 to 1994 for products bearing the `GRIP marks`. The precise details are the subject of a confidentiality order but have been communicated to the applicants in these proceedings. Sales of products under the GRIP marks have extended throughout the United Kingdom. An extensive list of major towns and cities is given in support of this claim. The goods have been extensively
10 promoted. He goes on to produce (RGSF3) specimens of product packaging, leaflets and advertising material illustrating the manner in which the GRIP marks are used. These items are said to have been in use between 1988 and 1994.

Mr Forrester makes a number of observations on the issue of confusion (I take these into
15 account in reaching my decision) and to the goodwill and reputation attaching to his company's GRIP marks. Dealing with the applicants' mark he goes on to say that he is advised that the mark applied for consists of the letters "Dr" and the non-distinctive word GRIP, the mark as a whole being descriptive of and non-distinctive for writing instruments featuring a particular grip codified by the letters "Dr". Mr Forrester exhibits (RGSF4) a copy
20 of the definition of the abbreviation of the letters `Dr` from the Little Oxford English Dictionary, which states that it is an abbreviation for the word `Doctor`. Mr Forrester goes on to say that the letters `Dr` or the word `Doctor` are not in common use in relation to writing and drawing instruments and he believes it to be true that the letters `Dr` in combination with the word GRIP suggests writing instruments adapted or suitable for medical or surgical use or
25 for use by doctors.

Mr Forrester maintains that there is a long history of writing instruments being devised for medical or surgical use, or for use by doctors. He exhibits at (RGSF5) a photocopy of a provisional 1912 patent specification for a combination Fountain Pen and Clinical
30 Thermometer, at (RGSF6) a U.K. Patent specification for a combined writing and cutting implement for ampoules which are filled with liquids eg. medicines, at (RGSF7) a photocopy of a U.K. Patent Application outlining a pen adapted to hold a liquid such as medicine for use in emergencies and at (RGSF8) details of the recently launched Mitsubishi "Medical Pen" Mr Forrester states that it is his belief that the general public upon seeing writing instruments
35 bearing the mark Dr. GRIP will believe that such goods are for medical or surgical use, or for us by doctors, and thus other use of the mark would be clearly deceptive.

Also exhibited (RGSF9) is a pen manufactured by Roger Needham & Sons of Shropshire. The writing on the pen states that it is a food marker which has `food safe marking ink` which
40 complies with EU and national regulations. It is the formulation of the ink which makes it suitable for use on foodstuffs and Mr Forrester believes that these criteria are the same as those for ink formulations for use on human skin.

At Exhibit (RGSF11) is a pen made by BEROL which was passed onto Mr Forrester's
45 Company by one of their stationery suppliers as an example of a medical marker. This pen, says Mr Forrester, has been specifically manufactured with an ink that can be used safely to mark the skin and appears simply to be a promotional item for products bearing the mark NEURONTIN registered in respect of medicinal and pharmaceutical preparations. Mr Forrester makes the point that, without specific knowledge of the source and the purpose of

5 the pen, there is nothing to identify its unique properties and therefore upon inspection the general public would not be able to distinguish its unique purpose. Mr Forrester believes that there may be a serious risk to public health if products sold under the Dr GRIP trade mark are mistakenly used in the belief that they have been adapted specifically for medical use.

10 In conclusion he expresses the view that use of the mark Dr GRIP will be confused with his company's GRIP marks and the reputation which these products have acquired. Also, Mr Forrester maintains that, if registered and used, the mark Dr GRIP will create a potential risk to public health as the prominence of the abbreviation 'Dr' is likely to substantially increase the risk of the product being confused with genuine medical pens.

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Applicants' Evidence

The applicants filed a declaration dated 20 May 1996 by Akia Tsuneto, the President of Kabushiki Kaisha Pilot (also trading as PILOT CORPORATION) of Tokyo, Japan. He has
20 been associated with the company for many years and makes his declaration on the basis of company records and facts within his own knowledge.

Mr Tsuneto says that his company coined the mark Dr GRIP for a high quality pen designed to reduce considerably normal gripping pressure and thus alleviating problems for the writer
25 such as aching joints or muscle fatigue. The pens under the mark Dr GRIP were first exported to the U.K. in June 1992. Mr Tsuneto exhibits at PKK1 promotional material showing the mark in relation to the goods, at PKK2 tables showing net profits relating to goods sold under the mark in the U.K. for the years 1992 to 1995 and import invoices and at PKK3 sample invoices showing sales of goods under the mark to customers in the U.K. He confirms that
30 the applicants have sold goods under the mark throughout the United Kingdom and an extensive list of major towns and cities is given in support of this claim. At Exhibit PKK4 is an estimate of total expenditure relating to advertising of the mark since the date of first use. Mr Tsuneto points out that the applicants ran a promotion in 1995 in conjunction with W H Smith Ltd known as "Free Refills for Life".

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Mr Tsuneto explains that the applicants instructed Venner, Shipley and Co. to file a new British Trade Mark Application to register Dr GRIP in July 1992. He goes on to say that the application was accepted prima facie in January 1993 with no citations raised. He strongly
40 disputes paragraph 5 to Mr Forrester's declaration where it is claimed that ownership of the DYNAGRIP and FLEXGRIP marks entitles the opponents to regard themselves as proprietors of GRIP marks per se. He accepts that the opponents' marks may serve possibly to establish the opponents' ownership of a family of 'FLEXGRIP' marks but, in his view, cannot and should not be interpreted as a monopoly of GRIP marks. In support of this
45 assertion at Exhibit PKK5 Mr Tsuneto provides details of other registrations for GRIP marks under different ownerships which in his view cover inter alia writing instruments or goods of the same description.

In relation to the opponents' assertion to have a monopoly in GRIP marks, Mr Tsuneto points
50 out that nowhere in the opponents' evidence is there any reference to use/registration of the mark GRIP alone. In Mr Tsuneto's opinion it is more relevant to consider whether Dr Grip is confusingly similar to FLEXGRIP and DYNAGRIP. In consideration of the state of the

5 Register in Class 16 for writing instruments containing the word GRIP Mr Tsuneto submits that, having regard to the visual, phonetic and conceptional nature of Dr GRIP in comparison with FLEXGRIP and DYNAGRIP, there is no likelihood of confusion. He further submits that it is the precise combination of each of the three marks DYNAGRIP, FLEXGRIP and Dr GRIP which renders each distinctive in its own way.

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Mr Tsuneto notes that the opponents have been using their trade mark FLEXGRIP in the UK since 1988 and Mr Forrester's declaration reveals no single instance of actual confusion having taken place in the market between his client's concurrent use of Dr GRIP and the mark FLEXGRIP. At PKK6 is exhibited a copy of the Stationery Trade Review Reference Book and Buyers Guide 1995 which refers to the applicants' mark Dr GRIP but not the opponents' marks. Mr Tsuneto states that the applicants' range of pens are at the higher end of the market retailing at £6.25 whereas it is understood that the opponents FLEXGRIP pens retail at 85 pence per pen, thus in his view rendering the risk of confusion even more remote.

20 Mr Tsuneto notes that the trade mark DYNAGRIP has been used only since 1992 and expresses the view that it seems improbable that significant use of DYNAGRIP had been made in the UK prior to commencement of use by the applicants of Dr GRIP to support the opponent's claims under Section 11. He goes on to submit that Mr Forrester cannot be familiar with current British Registry Examination practice otherwise he would be aware that the mark Dr GRIP is a prima facie distinctive mark as evidenced by the Examiner's Report issued on 13 January 1993 and exhibited at PKK7. Mr Tsuneto says that to the best of his knowledge and belief there is no inherent distinctiveness/deceptiveness problems with marks containing Dr. - the Registry's DOCTOR practice is exhibited at PKK8. He stresses that neither Section 9/10 nor Section 11 objections were raised by the examiner in respect of the applicant's mark during examination.

35 At PKK9 Mr Tsuneto exhibits examples of marks incorporated the abbreviation "Dr" which have been accepted for registration on a prima facie basis and points out that none are restricted to "medical or surgical use, or use by doctors". The marks are registered in a number of Classes and he submits that use of the `Dr` element in respect of writing instruments would carry no greater significance than use of a `Dr` element in respect of, say, drinks or toilet preparations. Mr Tsuneto states the applicants' mark was coined because of the special properties of the pens which are adapted to alleviate muscle strain and reduce writing stress and use of the mark would not be deceptive having regard to the nature of the product.

40 At Exhibit PKK10 are press cuttings relating to the British launch of the applicants' Dr GRIP pens and at PKK11 copies of letters from purchasers of Dr GRIP pens expressing their appreciation of the product.

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Mr Tsuneto states that examples of food and medical markers cited in Mr Forrester's declaration are irrelevant or are undermined by the references made by individuals at PKK11 attesting to the beneficial properties of the applicants' Dr GRIP pen. He also submits that although the applicants' goods have been on the market for some time, Mr Forrester is unable

5 to adduce a single instance of consumer confusion such that would result in risk to public health and safety. Mr Tsuneto goes on to say that instead of posing a hazard the applicants' evidence shows that Dr GRIP pens provide a very real benefit to those members of the public with hand disabilities or those who need to use a pen for a prolonged period of time.

10 The applicants filed a second Statutory Declaration dated 25 March 1996 by Geoffrey Making, Managing Director of PENTEL (STATIONERY) LIMITED of Swindon, Wiltshire. He has been employed in the stationery industry for 26 years.

15 Mr Making states that he does not consider use of Dr GRIP by Kabushiki Kaisha Pilot in respect of writing instruments gives rise to any confusion with any other brand name in the minds of the British public or, more specifically, with any trade marks owned by the Gillette Company. He goes on to say that the Dr GRIP mark is used in respect of high quality pens designed to alleviate muscle strain and/or writing fatigue in the user, and sees no reason why there should be an innate expectation that the Dr GRIP pen would be specifically for medical use.

20 That completes my review of the evidence but before turning to the grounds of opposition I record here that a request was made during the hearing by Mr Morcom, on behalf of the opponents, for the statement of case which accompanied the opposition to be amended to add an additional ground of opposition under Section 12(1) of the Act. He stated that, whilst not actually mentioned as such, as he understood it the earlier registered marks had always been at issue and therefore he submitted it was clear that the opponents were relying on Section 12.

25 Ms McFarland pointed out that the request for the addition of a new ground came very late in the proceedings and that the applicants' evidence and written submissions had not covered Section 12.

30 Having carefully considered the matter I decided that the Section 12(1) ground could not be added at this late stage in the proceedings. These proceedings have been in train since late 1993, so there has been ample opportunity for the opponents to amend the Pleadings if they so wished. As they have not done so earlier it would be unreasonable to allow an additional ground to be added at the hearing, particularly as the applicants' professional advisors had no prior warning.

35 At the outset Mr Morcom made it clear that the opponents would not be pursuing their opposition on the footing that the opponents were the proprietors of a family of GRIP marks; the opposition would be based on their FLEXGRIP mark alone.

40 I will deal firstly with the grounds based on Sections 9 and 10 of the Act. These sections read as follows:

45 "9. - (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

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- 5 (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- 10 (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- 15 (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.
- 20

(2) For the purpose of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally, or where the trade mark is registered or proposed to be registered subject to limitations in relation to use within the extent of the registration.

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(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which -

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- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.
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10 (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

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(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

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- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.
- 50

5 (3) A trade mark may be registered in Part B notwithstanding any registration in
Part A in the name of the same proprietor of the same trade mark or any part or parts
thereof”.

10 The opponents say that the applicants’ mark DR GRIP is descriptive and non-distinctive for
writing instruments featuring a particular grip codified by the letters `Dr’ and suggests writing
instruments adapted or suitable for medical or surgical use or for use by doctors. It is
certainly the case that, as demonstrated by the evidence of both parties, the word GRIP carries
a descriptive significance in relation to the goods. The prefix of the mark is the letters `Dr’
and, on the basis of the evidence and submissions, it is not disputed that these letters are an
15 abbreviation for the word DOCTOR.

Ms McFarland for the applicants argued that `Dr’ was more distinctive than a number of quasi
- descriptive prefixes or suffixes in registered GRIP marks. Mr Morcom for the opponents
drew my attention to a number of patents and products to demonstrate usage of writing
20 instruments for medical or surgical purposes, or for use by doctors. Even if I came to the
conclusion that both Dr and GRIP taken individually have some descriptive significance in
relation to the goods applied for, the question I must address is whether the combination is
adapted to distinguish or capable of distinguishing for the purposes of Sections 9 and 10
respectively. I find the combination to be unusual and fanciful. In her submissions relating to
25 Sections 9 and 10, Ms McFarland stated that the mark Dr GRIP does not impose itself into the
mind of a normal person as being an apt description for a piece of medical equipment. I think
Ms McFarland was quite right in this respect. At the examination stage in the Registry the
mark was accepted in Part A by the examiner, prima facie. In my view there is nothing in the
evidence or in Counsel’s submissions which invalidates the examiner’s decision and I propose
30 to leave it undisturbed. The opposition under Sections 9 and 10 fails accordingly.

I next consider the ground of opposition under Section 11 based upon the opponents’
contention that members of the public are likely to be confused as to the purpose of a pen
called Dr GRIP and there may be a risk to public health and safety if products sold under the
35 Dr GRIP mark are mistakenly used in the belief that they have been adapted specifically for
medical use. This section of the Act reads as follows:

40 “11 It shall not be lawful to register as a trade mark or part of a trade mark any
matter the use of which would, by reason of its being likely to deceive or cause
confusion or otherwise, be disentitled to protection in a court of justice, or would be
contrary to law or morality, or any scandalous design.”

The opponents have sought to demonstrate that a number of pens exist which are adapted in
one way or another for medical use. However, I note that some of these are based upon
45 patent applications and there is no evidence that these pens were ever produced commercially.
Further, the “Mitsubishi Medical Pen” was only made available to the public after the relevant
date in these proceedings, and another example featured in the opponents’ evidence is actually
a food marker. I conclude that the opponents have failed to establish that, at the relevant date,

5 there existed a category of pens with specific characteristics of a medical nature which the relevant public would expect to be present in pens sold under the mark `Dr GRIP'. It follows that the use of the mark is not likely to confuse or deceive the public and the opposition under Section 11 under this heading fails.

10 I therefore turn to consider the other objection under Section 11, which is grounded in the opponents user of their mark FLEXGRIP.

The established test for objections under this heading is set down in Smith Hayden & Co Ltd's application (Volume 1946 63 RPC 101) as adapted by Lord Upjohn in the BALI trade mark case [1969] RPC 496. Adapted to the matter in hand these tests may be expressed as follows:

15 Having regard to the user of the opponents' mark FLEXGRIP, is the tribunal satisfied that the mark applied for DR GRIP, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to
20 cause deception and confusion amongst a substantial number of persons?

Before embarking on a consideration of the opponents' user, it will be convenient if I first compare the marks in suit. For the purposes of this comparison I use the established test propounded by Parker J in Pianotist Co's Application (1960) 23 RPC 774 at line 26 et seq:

25 "You must take the two words. You must judge of 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
30 consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion- that is to say- not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in
35 the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

No evidence has been presented bearing on the alleged similarity of the marks. Neither have I heard any argument on the subject. I am therefore left to make a judgement in the matter
40 based entirely on my own reactions.

Obviously, the common element between these marks is the word GRIP. However, I have already commented on the descriptive nature of the word when considering the distinctiveness of the applicants' mark. It appears to me that the word GRIP has very little capacity to
45 distinguish on its own and I do not believe that the public would see its presence in the two marks before me as indicating an association with any particular party; more likely they would see it as a reference to a feature of the goods in question. In the result, I do not find that these marks are confusingly similar, and consequently I have no reason to believe that use of the applicants' mark is reasonably likely to cause deception and confusion under the terms of the Smith Hayden test. The opposition under Section 11 under this heading also fails.
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5 Finally, I come to the matter of the Registrar's discretion. The opponents asked the Registrar to refuse the mark in the exercise of his discretion but they have provided no grounds for this. Consequently, I do not feel that I can accede to their request.

10 The opposition having failed I order the opponents to pay to the applicants the sum of £635 as a contribution towards their costs.

Dated this 11 day of August 1998

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D C MORGAN
20 **For the Registrar**
the Comptroller General