

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2227154
BY CELLTECH R&D LIMITED
TO REGISTER THE TRADE MARK
HUMICADE
IN CLASS 5

AND IN THE MATTER OF OPPOSITION THERETO
UNDER No 51342
BY CENTOCOR INC.

BACKGROUND

1) On 24 March 2000 Celltech Therapeutics Ltd of 216 Bath Road, Slough, Berkshire, SL1 4EN applied under the Trade Marks Act 1994 to register the trade mark HUMICADE in respect of the following goods in Class 5: “Pharmaceutical compounds and preparations; anti-TNF anti-bodies; preparations for the treatment of Crohn’s disease and of rheumatoid arthritis.” The company subsequently changed its name to Celltech R&D Limited.

2) Opposition to the registration was filed by Centocor Inc. of 200 Great Valley Parkway, Malvern, 19355 Pennsylvania, United States of America on 23 August 2000. The grounds of opposition are in summary:

a) The first opponent is the proprietor of Community Trade Mark Registration No. 947051 REMICADE which is registered for the following goods in Class 5: “Pharmaceutical and medical preparations and substances; pharmaceutical compositions for the treatment of autoimmune diseases”. The mark was registered on 28 February 2000 with an International priority date of 9 July 1998.

b) The opponent claims that the goods are identical or similar and that both marks have the component “-micade”. They also claim that their REMICADE product was launched in September 1999 and is a pharmaceutical preparation used for the treatment of rheumatoid arthritis and Crohn’s disease. They claim that there exists the likelihood of confusion (including association) with the earlier trade mark.

3) The applicant filed a counterstatement denying all the grounds of opposition.

4) Both sides ask for an award of costs. Both sides filed evidence in these proceedings and the matter came to be heard on 17 October 2002, when the applicant was represented by Mr Tappin of Counsel instructed by Messrs Carpmaels & Ransford, while the opponent was represented by Mr Mitcheson of Counsel instructed by Messrs D Young & Co.

OPPONENT’S EVIDENCE

5) The opponent filed a statement by William J Tarbit the Regulatory Affairs Director of Schering-Plough Ltd the exclusive UK distributor of REMICADE for the opponent company Centocor Inc.

6) Mr Tarbit states that:

“The REMICADE product is a pharmaceutical preparation (specifically an anti tumour necrosis factor-alpha monoclonal antibody) for the treatment of Crohn’s disease and rheumatoid arthritis. The precise goods sold under the REMICADE mark consist of a vial containing 100mg infliximab powder which is used to produce a concentrate which is administered intravenously.”

7) Mr Tarbit states that the mark has been in continuous use in the UK since September 1999 when it was marketed as a treatment for severe cases of Crohn’s disease. It was first marketed as a treatment for rheumatoid arthritis in June 2000. At exhibit WJT1 is a copy of an extract from The Lancet dated 4 December 1999 which details a study using the REMICADE product on rheumatoid arthritis patients. He states that his company has advertised the mark in the UK spending £100,000 in 1999 and £800,000 in 2000. At exhibit WJT2 are copies of advertisements for REMICADE. He states:

“The advertisement relating to the treatment of rheumatoid arthritis was published in the journal Rheumatology in June 2000. The advertisement relating to the treatment of Crohn’s disease was published in the British Medical Journal on 8 and 22 January, 19 February and 18 March 2000, and in the BJS and GUT in January and March 2000.”

8) The exhibits show a full page advertisement but do not show the name of the journal or the date of publication. Mr Tarbit also claims that literature has been sent to Consultant Rheumatologists, Registrars, pharmacists and nurses. He states that such literature was sent to 1200 people, and that it is likely that more than one person would have seen each piece of literature sent out. The brochure sets out details of studies on the effects of the drug REMICADE. Each page has the name REMICADE printed prominently upon it, although in a number of instances the letter “A” appears in a different colour and font to the rest of the mark. On the last page of the brochure it states that:

“Remicade should only be administered to adults (age 17 upward) by physicians experienced in the treatment of rheumatoid arthritis or inflammatory bowel diseases. All patients administered Remicade are to be observed for at least 1 to 2 hours post infusion for side effects.”

9) Times for infusion of the drug are also provided and all are stated as being two hours.

10) Mr Tarbit provides sales figures for the product in the UK as follows:

Year	Sales £
1999	540,000
2000	3,982,000

11) Mr Tarbit states that in his opinion the mark in suit is confusingly similar to the opponent’s mark, due to the similarity of the goods and the identity of the “-micade” suffixes of the

marks. He also points out the visual and phonetic similarities of the marks when considered as wholes. He states that, to his knowledge, there are no other marks with the suffixes “-micade”, “-icade” or “-cade” on the market in the UK in respect of pharmaceutical preparations for the treatment of Crohn’s disease or rheumatoid arthritis. He also claims that as the applicant’s mark has not been used in the UK that there is no evidence of co-existence.

12) At exhibit WJT4 Mr Tarbit provides copies from the “March” edition of the Monthly Index of Medical Specialities (MIMS). He states that MIMS is an independently produced publication that is designed as a prescribing guide for general practitioners. There are a number of products listed for the treatment of rheumatoid arthritis, rheumatism and osteoarthritis. Mr Tarbit states that none of the marks listed under these headings have as a suffix “-micade”, “-icade”, “-cade” or “-ade”.

13) Mr Tarbit states that:

“As mentioned, the REMICADE product is used for the treatment for severe cases of Crohn’s disease and rheumatoid arthritis, and is administered to patients that have not responded to more conventional treatments. It is recommended that the REMICADE product is administered only by physicians experienced in the treatment of rheumatoid arthritis or inflammatory bowel diseases.

Clearly, the goods which are marketed under the REMICADE mark are identical to those specified in respect of UK Trade Mark Application No. 2227154 HUMICADE. I am not aware of the prescription advice that is or will be given, or of contraindications in respect of the HUMICADE product. It appears likely, however, that if the REMICADE and HUMICADE products are mistaken in practice for example, due to a physicians poor handwriting, or a mistake on the part of pharmaceutical, nursing or medical staff, the results would be potentially very serious.

I believe that, given the opponents reputation in and the uniqueness of its REMICADE brand, that if the applicant is permitted to use or register the name REMICADE in connection with the goods specified, confusion may arise leading medical professionals or hospital staff to purchase or use the applicant’s product in the mistaken belief that it is the opponent’s REMICADE product.”

APPLICANT’S EVIDENCE

14) The applicant filed two statements. The first, dated 30 January 2002, is by Caroline Bonella the opponent’s Trade Mark Attorney.

15) At exhibit CB1 Ms Bonella provides copies of pages from the opponent’s website dated 19 December 2001. She acknowledges that this is after the relevant date but states that the material is indicative of the way in which the opponent is using the REMICADE mark. She draws attention to the manner in which the drug is administered stating that:

“It is not used on a drug which is self administered by the patient -see page 2 with the reference to “prescription medication”; pages 6 and 7 dealing with “essential

equipment” and supplies such as IV poles and, optionally, a reclining chair; page 7 where there is a reference to an infusion rate of two hours. Clearly the REMICADE product is not going to be sold over the counter or supplied on prescription by high street pharmacists.”

16) Ms Bonella states that the applicant’s mark has yet to be used on pharmaceuticals in the UK, although she claims that press notices have been released and articles have appeared in the financial and scientific press. She also provides copies of internet searches which produced 105 “hits” for HUMICADE and 1600 “hits” for REMICADE. Ms Bonella claims that this is an indication that the two marks can coexist.

17) The applicant’s second statement, dated 25 January 2002, is by Dr Phillip Ansell the Patents Manager of the applicant company. He confirms that the applicant’s mark is intended for use on a product which is still under development, and so there has been no use of the mark in suit.

18) Dr Ansell states that the applicant’s product is intended to be administered in much the same way as the opponent’s product. That is by qualified medical staff in a hospital ward, or similar, whilst the patient is lying down. It is not a self administered or over the counter drug. He states that:

“The REMICADE product is derived from both human and mouse proteins, whereas my company’s product has a significantly greater proportion of human protein. For this reason the name HUMICADE was adopted in order to emphasise what is considered by my company to be a significant development and improvement in treatments for both Crohn’s disease and rheumatoid arthritis.”

19) Lastly he states that:

“Finally, I would like to deal with the suggestion that the marks could be confused when hand written. Frankly, I find this suggestion far-fetched. Even with handwriting that is difficult to read, the marks are distinguishable in manuscript form. In addition, prescriptions these days are not generally hand-written, particularly in hospitals where drugs of this kind are being prescribed and where, therefore the greatest care has to be exercised. Prescriptions are completed electronically so there is no risk of confusion between the two marks.”

20) That concludes my review of the evidence. I now turn to the decision.

DECISION

21) The only ground of opposition is under Section,5(2)(b) of the Trade Marks Act 1994 which states:

“5.-(2) A trade mark shall not be registered if because -

- (a)
- (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.”

22) An earlier trade mark is defined in Section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

23) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a

highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 224;

- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, 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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

24) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

25) At the hearing Mr Tappin, for the applicant, confirmed that the goods of the two parties are identical.

26) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

27) Whilst the products produced under the marks in suit are currently administered by qualified health professionals, the specifications of both marks are not restricted to prescribed medicines. However, Mr Tappin formally applied at the hearing for the applicant's specification to be limited by the addition of the following "all being prescription-only compounds or preparations".

28) Therefore, the average consumer in this case should be considered to be pharmacists, medical practitioners and others in the health care sector. Therefore, I consider the matter on the basis of notional and fair use across the range of goods for which the trade mark is now sought to be registered (*REACT* [2000] RPC at page 288).

29) In response to the applicant's contention that pharmaceutical products should face the same test as all other goods, Mr Mitcheson stated that:

"There is no special treatment that should be given to pharmaceutical products. There are obviously different tests in relation to pharmaceuticals because of the possibly graver result of prescribing the wrong drug, but then that has to be balanced with the additional care one would expect from those involved in the process. Overall we say that those two factors balance out, so you should not have to adopt a different test for pharmaceutical goods than for any other."

30) I was referred to the comments of Professor Annand, acting as the Appointed Person in the cases of *OROPRAM/SEROPRAM* (0/208/02) and *ALLERGAN's Application* (0/293/02) as well as the views of the OHIM First Board of Appeals in the case of *TEMPOVATE/EMOVATE, EUMOVATE* (dated 14/2/02). In my view the correct approach was set out by Professor Annand in the two cases above when she stated:

"For my own part, I do not believe that different standards exist or are necessary to exist. The test of likelihood of confusion is flexible enough to allow each case to be judged according to its own peculiar facts. Relevant considerations may include those mentioned by the First Board of Appeal in *TEMPOVATE/EMOVATE, EUMOVATE*, supra., namely that some medicinal products are administered over the counter without prescriptions, some consumers resort to self-prescription and professionals are often overworked and may write prescriptions in hardly legible handwriting (although drugs may be prescription only, professionals may be on hand to assist choice with OTC products and pharmacists usually check illegible prescriptions)."

31) Ordinarily I would consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. No evidence of use in the UK has been filed. In such circumstances the opponent's marks cannot be regarded as enjoying an above average reputation at the relevant date because of use. However, it is an inherently distinctive mark. Mr Mitcheson claimed that the distinctive nature of the opponent's mark was highlighted by the fact that it was the only product in the Monthly Index of Medical Specialities (MIMS) which had the MICADE suffix. He contended that as the applicant's mark included this suffix that the average consumer would conclude that the applicant's mark emanated from the same "stable" as the opponent's mark.

32) The mark in suit is HUMICADE whilst the opponent's mark is REMICADE.

33) Visually the marks differ only in their first two letters, the remaining six letters are identical. However, it is accepted that differences in the beginnings of words are normally significant. Both marks are the same length.

34) Phonetically the marks have common endings, whilst having different beginnings. Both are three syllable words "HU-MI-CADE" or "HUM-I-CADE" and "RE-MI-CADE" or "REM-I-CADE".

35) Conceptually, to my mind neither mark conveys any meaning, both being made up words. However, at the hearing Mr Tappin, for the applicant contended that the first syllable of the mark in suit, HU, would be seen as a reference to “Human”, indicating that the applicant’s product is derived from human proteins.

36) Items of medication are, I would suggest, chosen with considerable care. The applicant has limited its specification to “prescription only” products. Clearly this significantly reduces the chances of direct confusion as medical professionals, including the clerical staff responsible for ordering, are highly trained and well versed in dealing with products which have similar names. These days most doctors use computers to print out prescriptions, however even where handwritten if the prescription is illegible the pharmacist would, as Professor Annand pointed out, check with the writer.

37) In my opinion there is little likelihood of direct confusion between the marks given the overall differences between them. However, I must also consider the opponent’s proposition regarding common origin. In the applicant’s evidence Dr Ansell states that the HU prefix was adopted to signify that the applicant’s product had a greater proportion of human protein than that of the opponent’s product. I should be slow to find that the message that the applicant has set out to convey to its prospective customers (medical professionals) will not be recognised by them. In the *OROPRAM* case Professor Annand stated at paragraph 24:

“In the applicant’s own admission the prefix of OROPRAM suggests oral delivery. That coupled with the degree of similarity in the marks, the identity of the goods and the high distinctiveness of SEROPRAM, leads me to conclude that the average consumer is likely to consider that “medicine and medicinal products intended for human therapy” offered under the mark OROPRAM originate from the opponents or an undertaking economically linked to the opponents in the sense that they are different products in the same range (*Wagamama Ltd v. City Centre Restaurants plc* [1995]FSR 713).”

38) In the instant case it is my opinion that the relevant consumer will see “HU” as a semi descriptive prefix signifying that the applicant’s goods are made from human proteins. The remainder of the applicant’s mark is the same as the middle and end of the opponent’s mark. Dr Ansell’s failure to otherwise explain the adoption of the “MICADE” suffix is also significant. I must also consider the evidence that there are no other products in the market with a “CADE” or “MICADE” suffix for the goods at issue.

39) With all of this in mind I believe that there is a tangible likelihood that the relevant consumer will believe that HUMICADE products originate from the opponent, are further goods within the opponent’s range or are produced by an undertaking that is economically linked to the opponent.

40) Consequently, the opposition under Section 5(2)(b) succeeds because of the likelihood of (origin) association with the earlier trade mark.

41) The opposition having succeeded the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £1100. This sum to be paid within seven

days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of December 2002

George W Salthouse
For the Registrar
The Comptroller General