

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2222441
BY J URIACH Y CIA, SA
TO REGISTER THE TRADE MARK:**



IN

CLASS 5

AND

**THE OPPOSITION THERETO
UNDER No 51182
BY RECKITT BENCKISER HEALTHCARE (UK) LIMITED
BASED UPON THE EARLIER TRADE MARK:**

DISPRIN

AND OTHERS

Trade Marks Act 1994
in the matter of application no 2222441
by J Uriach y Cia SA
to register the trade mark:



in class 5
and
the opposition thereto
under no 51182
by Reckitt Benckiser Healthcare (UK) Limited

BACKGROUND

1) On 15 February 2000 J Uriach y Cia, SA (referred to afterwards as Uriach) applied to register the above trade mark (the trade mark). The application was published for opposition purposes in the Trade Marks Journal on 19 April 2000. Following the publication the specification was limited to the following goods:

an antithrombotic platelet antiaggregating agent

The above goods are in class 5 of the International Classification of Goods and Services.

2) On 18 July 2000 Reckitt & Colman Products Limited and Reckitt & Colman (Overseas) Limited filed a notice of opposition to this application. During the proceedings Reckitt Benckiser Healthcare (UK) Limited (referred to afterwards as Reckitt) took over the opposition. The company changes that led to this change of the opponent are detailed in the evidence of Ms Baxter below.

3) Reckitt at the hearing limited its opposition to two main grounds:

- that there would be a likelihood of confusion with various of its earlier trade marks and so registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).
- owing to Reckitt's reputation in the trade marks DISPRIN, DISPROL and DISPRIL use of the trade mark is liable to be prevented by the law of passing-off and so contrary to section 5(4)(a) of the Act.

4) Reckitt listed a large number of earlier rights but at the hearing it made mention of three specific United Kingdom trade mark registrations. I reproduce the details of these trade marks below:

- Registration no 1458180 of the trade mark **DISPRIN**. The trade mark was filed on 14 March 1991 and registered on 24 April 1992 for:

pharmaceutical, veterinary and sanitary preparations and substances; all included in class 5 and none being for export except to the Republic of Ireland

- Registration no 1405987 of a series of three trade marks: **DISPRIN CV**, **DISPRIN CV.** and **DISPRIN C.V.**. The trade marks were filed on 23 November 1989 and registered on 19 April 1991 for:

pharmaceutical preparations and substances; all included in Class 5; none being for export other than to the Republic of Ireland

- Registration no 1003166 of the trade mark **DISPROL**. The trade mark was filed on 12 December 1972 and is registered for:

analgesic preparations, all being for sale in the United Kingdom otherwise than for export, but not excluding goods for export to the Irish Republic

All the above goods are in class 5 of the International Classification of Goods and Services.

5) Uriach filed a counterstatement in which it denies the grounds of oppositions.

6) Both sides filed evidence and seek an award of costs.

7) A hearing was held on 6 March 2003. At the hearing Uriach was represented by Mr Campbell of counsel, instructed by Potts Kerr & Co, and Reckitt was represented by Mr Edenborough of counsel, instructed by Alexander Ramage Associates.

EVIDENCE

Evidence for Reckitt

Witness statement of Michael Robin Stillings

8) Mr Stillings is head of Global Professional Relations for Reckitt. He states that he is Reckitt's "world expert in analgesia, cold and flu, and cardiovascular aspirin" He states that he is regarded as Reckitt's world authority on aspirin. Mr Stillings has a BSc in chemistry and a PhD in synthetic organic chemistry. He is honorary professor of bio-organic chemistry at the University of Hull and chairman of the medical and scientific committee of the European Aspirin Foundation, which he describes as an industry sponsored body to promote the safe and responsible use of aspirin. Mr Stillings states that he has written a number of papers on the subject and that he works closely with Professor Peter Elwood who he describes as the clinician who produced the first study of

the use of aspirin in cardiovascular disease. Mr Stillings states that this study was published in the “BMJ” in 1974.

9) Mr Stillings states that in lay terms an anti-thrombotic platelet antiaggregating agent is an agent that reduces the risk of platelets sticking together. He states that it is the inappropriate (sic) sticking together of platelets that leads to blood clots. He states that if this happens in the heart you get a heart attack and if it occurs in the brain you get a stroke. A medicine that reduces the risk of the platelets sticking together reduces the risk of heart attack or strokes. Mr Stillings states that there are various reasons why platelets stick together and aspirin attacks one of these, cyclo-oxygenase (more commonly known as COX). Mr Stillings states that DISPRIN is a soluble aspirin and like any aspirin it targets COX all over the body. He states that in the platelet it reduces thromboxane which is the “pro-aggregant” that “recruits” platelets thereby forming blood clots.

10) Mr Stillings states that the product marketed by Reckitt as DISPRIN is an anti-thrombotic platelet antiaggregating agent; all aspirin products are. Mr Stillings states that not all aspirin products are licensed to be marketed for this purpose, although they all perform the function. He states the DISPRIN CV does have a license to be marketed for this purpose. Mr Stillings states that the only differences between DISPRIN CV and DISPRIN products are that the DISPRIN CV product is dispensed in tablets of 100 milligrams and is micro encapsulated for slow release, whereas DISPRIN is marketed in tablets of 300 milligrams and is soluble. He states that DISPRIN CV was withdrawn from the United Kingdom market in 2001 for commercial reasons. Mr Stillings states that DISPRIN CV was being actively marketed in February 2000.

11) Mr Stillings exhibits at MRS1 a copy of a label relating to the DISGREN product. The exhibit states that Triflusal is the sole active substance of DISGREN. Mr Stillings states that Triflusal is a simple derivative of aspirin. He exhibits at MRS2 an extract from the “British Pharmacopoeia 2000” relating to triflusal. The extract states that triflusal is a platelet aggregation inhibitor. However, I can find no reference in the extract to aspirin.

12) Mr Stillings states that according to the extract from the “British Pharmacopoeia 2000” triflusal is practically insoluble in water. He notes from the material exhibited at MRS1 that DISGREN is in capsule form. Mr Stillings states that capsules are not designed to be soluble.

Witness statement of Rosina Margaret Baxter

13) Ms Baxter is an analytical chemist and deputy director of trade marks for Reckitt Benckiser plc.

14) Ms Baxter states that for many years Reckitt & Colman Products Ltd (or its predecessors in business) was the principal trading subsidiary within the United Kingdom of a group of companies controlled by Reckitt & Colman plc (or its predecessors in business). She states that goods which were exported from the United Kingdom to

countries other than the Republic of Ireland were exported by Reckitt & Colman (Overseas) Ltd. Trade marks owned by Reckitt & Colman Products Ltd were for goods for sale in the United Kingdom and the Republic of Ireland. Trade marks owned by Reckitt & Colman (Overseas) Ltd were for goods for export from the United Kingdom, other than to the Republic of Ireland. Following the business restructuring which led to the formation of Reckitt Benckiser plc, Reckitt & Colman Products Ltd took assignment of trade marks owned by Reckitt & Colman (Overseas) Ltd in the United Kingdom and changed its name to Reckitt Benckiser Healthcare (UK) Ltd.

15) Ms Baxter states that Reckitt's predecessors in business have used the trade marks DISPRIN, DISPROL and DISPRIL for many years. She states that DISPRIN was first marketed in 1948 and has been used in the United Kingdom since then. She states that the trade mark is used for aspirin and paracetamol. Ms Baxter states that aspirin has analgesic and platelet anti-aggregating properties and paracetamol has analgesic and anti-pyretic properties. She states that since 1959 products corresponding to DISPRIN have been exported under the trade mark DISPRIL. From 1985 Reckitt's predecessors have marketed soluble paracetamol tablets and paracetamol suspension under the DISPROL trade mark. She states that these products have analgesic and anti-pyretic properties. She states that Reckitt's predecessors have also marketed DISPRINEX. Ms Baxter states that this product was marketed around 1973 and was an analgesic in the form of an effervescent tablet.

16) Ms Baxter exhibits at RB1 the following:

- An article entitled "The History and Development of the Reckitt Analgesic Preparations". This bears a manuscript note "RCH Mag. Vol 4 No 2 1962". The article deals with the development and use of aspirin and states that in 1948 calcium aspirin was introduced to the medical profession under the name DISPRIN. There are various references to DISPRIN and the advantages it has in being soluble form. There are also various pictures of the packaging for DISPRIN.
- A page that is entitled in manuscript "Source: Reckitt & Colman "Guide to Shopping" 1973". On this page a packet of DISPRIN can be seen. There is also reference under the heading analgesics to DISPRIN, DISPRINEX (which is described as an analgesic with vitamin C) and JUNIOR DISPRIN.
- A page headed "Oral Analgesics Market Brand Share By Value". The page indicates that the source is "Independent Retail Audit July/August 1986". DISPRIN is indicated to have a market share by value of 7%, placing it fourth on the list. The brands above it have 7.2%, 7.8% and 8.5% shares of the market.

17) Ms Baxter exhibits at RB2 various documents which I will now describe. There is an article by Mike Stillings, who has made a witness statement for Reckitt. This article is from "Cardiology in Practice Bulletin 1993". The details of the article advise that it was sponsored by Reckitt & Colman Products Ltd and was produced as a supplement to "Cardiology in Practice 1993". The article states that low-dose aspirin can significantly reduce the risk of myocardial infarction. It goes on to extol the virtues of DISPRIN CV.

Included in the article is reference to aspirin inhibiting platelet aggregation. On the back page of the piece there is a full page advertisement for DISPRIN CV. An advertisement, which Ms Baxter states appeared in “The Grocer” of 17 July 1993, publicises DISPRIN DIRECT. DISPRIN DIRECT dissolves in the mouth without water. Ms Baxter states that a piece entitled “Our New Product – “DISPRIN”” comes from the Reckitt & Colman in-house magazine for winter 1948/49. A variety of advertisements are exhibited from 1949 to 1999. They all extol the advantages of DISPRIN’s soluble nature. In an article from “The Grocer” of 5 November 1977 the pharmaceutical marketing director of Reckitt & Colman Pharmaceutical Division answers questions about analgesics. A large part of the article deals with DISPRIN. In the article he states that the market for analgesics is dominated by two brands, DISPRIN and ANADIN and that DISPRIN is the second largest brand in the grocery trade. There is a promotional feature for DISPRIN from “The Grocer” of 10 July 1999. In this advertisement feature the DISPRIN range is identified as DISPRIN EXTRA which is soluble and combines aspirin and paracetamol, original DISPRIN which is soluble aspirin and DISPRIN DIRECT which is described as “an aspirin tablet which dissolves in the mouth and has a pleasant, fruity flavour”.

18) Ms Baxter exhibits at RB3 “pack shots” of DISPRIL, which she states date from between 1959 and 1966. She also exhibits a price list from 1 March 1960 which shows the prices for DISPRIN and DISPRIL. Ms Baxter exhibits at RB4 material relating to various DISPROL products from between 1985 and 1993. All the matter comes from the in-house magazine or trade publications. Ms Baxter exhibits a copy of DISPRINEX packaging from 1973. A video of DISPRIN advertisements is exhibited at RB6. A list accompanies the video which indicates that the advertisements date from between 1968 and 1998. No indication is given as to when, where and how often the advertisements have been shown. From other material exhibited, which refers to television campaigns, it would appear that these advertisements were part of television campaigns rather than for cinema usage. However, in the absence of supporting information as to when, where and how often the advertisements appeared these advertisements add little to Reckitt’s case.

19) Ms Baxter gives the following turnover figures:

	1997	1998	1999	2000
	£K	£K	£K	£K
DISPRIN	2296	2329	2437	2110
DISPROL	1889	1957	2079	1886
DISPRIN CV	182	196	147	118
TOTAL	4367	4482	4663	4114

20) Ms Baxter gives the following figures for the promotion and advertising of DISPRIN and DISPROL:

1997	£
DISPRIN	534,859
DISPROL	286,281
1998	£
DISPRIN	128,642*
DISPROL	338,609
1999	£
DISPRIN	841,800
DISPROL	475,788
2000	£
DISPRIN	339,022
DISPROL	293,289
TOTAL	£3,238,290

*There appears to be a typing error for the figure for DISPRIN for 1998. It is written as 1,28,642, indicating a digit is missing. Also the total figure given in the statement is £4,238,290. Consequently, it would appear that the figure for DISPRIN for 1998 should have been £1,128,642.

Witness statement of Benjamin Alexander Ramage

21) Mr Ramage is a trade mark attorney. His evidence relates to a survey that he had conducted. The survey involved the sending out of approximately three hundred questionnaires to pharmacists. There were twenty seven responses. The first page of the questionnaire collected the personal details of the respondent. The second page asked the respondent if he or she saw the trade mark of Uriach for an *anti-thrombotic platelet anti-aggregating agent* would he associate it with any particular company. The third page asks the respondent if he or she is aware of the product marketed as DISPRIN and if so with which product he or she would associate it. It also asks what DISPRIN's active ingredient is. The final page asks the respondent if he or she is aware of the product marketed as DISPRIN CV and if so the purpose of the product. The respondent is asked if there is a likelihood of confusion between the application and DISPRIN and DISPRIN CV. It goes on by asking for the reasons for this opinion.

22) The head note to *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293 gives a useful summary to the requirements for a survey:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be

disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”

23) Mr Ramage has twenty seven responses. The goods of Reckitt are for the public at large, if those of Uriach are not necessarily so. He has chosen pharmacists for his survey, he has even excluded other professions involved in medicine. His sample does not represent a relevant cross-section of the public and certainly is not statistically significant. He leads the respondent into a line of speculation that he or she would not normally have embarked upon: is there a likelihood of confusion in respect of a trade mark that the respondent has not, for the most part, heard of and DISPRIN and DISPRIN CV? In relation to the question as to with what company the respondent would associate Uriach’s trade mark the response cannot be “clean”. The questionnaire makes references to DISPRIN and asks who is responsible for that product. The respondent cannot come to his response with uninfluenced mind. His response will be tainted by the associations with DISPRIN. In my experience it is also human nature to try and come up with the “right result” for questionnaires. With the other questions weighted towards DISPRIN and Reckitt the respondent is pushed to give the “right answer” – a form of the Milgram effect. The posting out of the questionnaires also skews the results. Rather than give spontaneous responses the respondent has time to consider his/her responses and put them into the context of the questionnaire as a whole. There is also a standard statistical skew in that the repliers to written surveys do not necessarily represent the average person. Beyond this the respondents are asked to give their views on the likelihood of confusion. Experts are experts in the market not on confusion – see *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283. The issue of confusion is for me to decide not the respondents.

24) I, therefore, intend to say no more about the survey nor the evidence which has been put in by Uriach about the survey nor the evidence in reply by Mr Ramage. The survey is so flawed, in my view, it can have no effect in this case, either for one side or the other.

Evidence Of Uriach

Witness statement of Stephen Waller

25) Mr Waller is an associate member of the Chartered Institute of Patent Agents. A good deal of Mr Waller’s evidence deals with the Reckitt’s survey; for the reasons given above I will say nothing about this part of the evidence. In relation to Reckitt’s survey Mr Waller exhibits a questionnaire from a Mr Paxman, who was one of the respondents.

From this questionnaire and the statement of Mr Waller it would appear that DISPRIN is not available upon NHS prescription.

26) Mr Waller states that he has been advised by Uriach that DISGREN will only be available in the United Kingdom on prescription. He exhibits a printout from www.netdoctor.co.uk which states that DISPRIN CV was discontinued in the United Kingdom in January 2001. Mr Waller exhibits a page from Reckitt's website. This shows DISPRIN, DISPRIN EXTRA and DISPRIN DIRECT and states that these are the three DISPRIN products sold in the United Kingdom. DISPRIN EXTRA is described as containing both aspirin and paracetamol. The page would appear to have been downloaded on 18 June 2002.

27) Mr Waller exhibits at SW5 a list. He describes this as a list of countries where pharmaceutical products sold under DISGREN have been approved by the appropriate regulatory body. In fact the list is headed as being for triflusal. However, for America and Asia it shows use of the trade mark DISGREN. For Europe the only reference to use of the trade mark DISGREN is in Spain. Uriach are listed as the licensee only in Spain.

28) Mr Waller exhibits an affidavit from Dr Julian Garcia Rafanell. Dr Garcia is the scientific director of the research and development department of Uriach. He has twenty five years experience in pharmacology and antithrombotic agents. He is a member of the Spanish Society of Pharmacology and a contributing editor to "Drugs of the Future". Dr Garcia, before joining Uriach, had the biochemistry chair at the School of Chemical Sciences of the University of Barcelona. He has a doctorate in chemistry.

29) Dr Garcia states that triflusal is an anti-platelet agent structurally related to salicylates but is not derived from aspirin. He states that it is not possible to obtain triflusal using aspirin as a raw material. He gives in some detail the differences between triflusal and ASA, stating that triflusal has various advantages over ASA. He does not advise what ASA signifies, although from the context I assume it relates in some way to aspirin; especially as the technical name for aspirin is acetylsalicylic acid.

DECISION

Family of trade marks

30) At the hearing Mr Edenborough pursued the claim that Reckitt had a family of DIS prefixed trade marks. He based this claim upon the three trade marks listed above: DISPRIN, DISPRIN CV, DISPROL.

31) The family of trade marks concept was one that was accepted under the old Act. It has been accepted as part of the global appreciation of the likelihood of confusion under the current Act (see for instance the decisions of the appointed persons in BL 0/411/01 and BL 0/207/02). It is also a position that has been accepted by the Community Trade Mark Office (see for instance decision no 1649/2000 of the Opposition Division). That an undertaking owns a family of trade marks does not mean, however, that the trade

marks are to be considered as a job lot; there has to be a mark to mark comparison (see *ENER-CAP Trade Mark* [1999] RPC 362).

32) To a large extent the position as to a family of trade marks follows that under the old law as exemplified by the decision of the Assistant Comptroller in *Beck, Koller* [1947] 64 RPC 76. I consider that the principles upheld in that decision hold good today:

- there must be use of the trade marks – if the public are not aware of the trade marks they are not going to associate a common element with one particular trader
- the less distinctive the common element the lesser the strength of the family
- use of the common element by other traders will further weaken the strength of the family

33) Use has been shown for all the above trade marks, use covering the date of the filing of the application (the relevant date). Use has been shown for the trade mark DISPRIL. However, Ms Baxter states that this has been for export only; from the evidence it would appear that this trade mark is used in countries where Reckitt cannot use the trade mark DISPRIN. As this use is for export only it is not going to be in the knowledge of the average consumer in the United Kingdom and so cannot assist Reckitt. There is also use shown of DISPRINEX. However, this relates solely from 1973 and there is no indication of the extent of the use. There is nothing to indicate that at the relevant date, 15 February 2000, that the relevant consumer would be aware of this trade mark. So the best, indeed the only case, that Reckitt has for its claim to a family of trade marks rests with the three trade marks identified by Mr Edenborough.

34) The essence of a family of trade marks is a common element in conjunction with a different element(s). So DISPRIN and DISPROL have the common element DISPR and the differing elements IN and OL. DISPRIN CV does not follow this pattern. It has the complete DISPRIN trade mark and then a subsidiary indicator; what could be described as brand and sub-brand. It is another DISPRIN trade mark. There is no standard pattern as between DISPRIN and DISPROL. To follow the logic of Mr Edenborough's argument FORD CAPRI, FORD CORTINA and FORD ZEPHYR would form a family of trade marks. It is not a position with which I can reconcile myself. I consider that all that Reckitt can rely upon for a family of trade marks are the trade marks DISPROL and DISPRIN. It is a rule of thumb that a minimum of three trade marks are required to form a family of trade marks. With only two trade marks the public is not likely to identify a common pattern as emanating from one undertaking. However, if one accepts the family argument on the basis of two trade marks, which I would not say is out of the question, it would depend on such factors as the intensity of use, proximity of the goods etc. The common element of the trade marks is DISPR. Mr Edenborough argued that DIS is the common element. As a matter of fact this is not the case, the fact is that the share element is DISPR. Consequently as Uriach's trade mark commences with DISGR, there is no repetition of the common element. For Reckitt to gain from a family of trade marks the trade mark which it claims conflicts with its family must share that element. Without that common element whether Reckitt has a family of trade marks or not cannot assist it.

I, therefore, do not consider that the family of trade marks issue can assist Reckitt in this case.

35) Mr Campbell pointed out the common element is DISPR. He also referred to the list of drugs exhibited at SW3 to the witness statement of Mr Waller. He submitted that if Reckitt was trying to rely on the DIS element it could not succeed owing to the various drugs that are listed which commence with DIS. The list is better than state of the register evidence, state of the register says nothing about what is happening in the market. However, I do not consider that it is a lot better. I cannot tell from the list which drugs have generic names and which brand names. I have no idea for what the names have been used, the extent that they have been used and the circumstances of their use. If the issue of a family of trade marks depended upon this information it would not sway me. (What does sway me is that I, like Mr Campbell, consider that the common element is the letters DISPR, not DIS.)

Likelihood of confusion - section 5(2)(b) of the Act

36) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

37) It was accepted by everyone that Reckitt’s best case lays with its DISPRIN trade mark. This registration is the closest to the trade mark of Uriach, it encompasses pharmaceutical preparations and substances at large. If Reckitt needs or could benefit from reputation its best case will lie with DISPRIN. Consequently, I will only deal with the DISPRIN registration. This registration satisfies the definition of an earlier trade mark.

38) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

Comparison of goods

39) The DISPRIN specification includes *pharmaceutical preparations and substances*. The goods of the application are a type of pharmaceutical preparation. Consequently, the goods of the earlier registration encompass the goods of the application. The respective goods are, therefore, identical.

Comparison of trade marks

40) The trade marks to be compared are:

Reckitt's trade mark:

DISPRIN

Uriach's trade mark:



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). 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). I take into account 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 (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* page 84, paragraph 27).

41) Mr Campbell argued that DISPRIN has a conceptual association; it tells the consumer that the goods are dissolvable aspirin. He stated that the public had been educated to view the trade mark in this manner because of the way in which it has been promoted. This publicity refers to DISPRIN as soluble aspirin. Mr Campbell's argument rests on the premise that the public indulge in the philological analysis of trade marks. This may be a habit of trade mark professionals but I do not think that it is the habit of the public. The ECJ also tells us that the public usually view trade marks in their entirety. Even if the average consumer indulged in Mr Campbell's philological analysis I do not see how he would come to the same conclusion. Why should the consumer think that DIS stands for dissolvable, especially when the word regularly used by Reckitt in relation to its goods is soluble. Why should this consumer think that Reckitt has taken some of the letters of aspirin and added it to the end; especially as the end of DISPRIN is not pirin? I am unconvinced by Mr Campbell's arguments. I do not consider that either trade mark will bring conceptual associations to the mind of the average consumer. Consequently, the trade marks cannot be differentiated in the mind of the consumer by reference to conceptual hooks. Mr Campbell's argument is also based on the use of the trade mark for

soluble aspirin. The trade mark is not restricted to such goods; it covers all pharmaceutical substances, the soluble, the insoluble, aspirin and non-aspirin. If I was to accept Mr Campbell's argument how could it apply to goods that are not aspirin or are not soluble or both?

42) Whilst considering Uriach's trade mark in its entirety I must bear in mind its distinctive and dominant components (*Sabel*). The logo element of the trade mark, the three squares, is not the element which will act as the main hook by which the consumer will remember it. There is nothing very striking or memorable about this logo. I consider the hook for the consumer is the word element DISGREN. The logo element creates a visual difference with DISPRIN. I do not consider that anything turns upon DISPRIN being in upper case and DISGREN in title case. In normal and fair use DISPRIN could be used in title case. The two words contain the same number of letters. They share five of their seven letters and these shared letters fall in exactly the same position in the trade marks. The words will be remembered by the effect of their letters, their phonetic significance. It is not possible, in my view, to divorce the phonetic significance of the letters from their visual effect when considering the visual similarity. Part of that issue of similarity will depend on the recollection or imperfect recollection of the consumer 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*). Comparing the respective trade marks in their entirety I consider that they are visually similar.

43) An aural comparison of the two trade marks must omit the logo element. I consider that the final vowels of the two trade marks in normal use will have little or no audible difference; taking into account the tailing off of words in speech. The main aural difference rests therefore with the fourth letter of each word. The letters G and P are not similar in sound but neither, in my view, are they overpoweringly different within the context of the words as a whole; which is, of course, how they need to be considered. Taking all these factors into account I consider that there is a very strong phonetic similarity between DISPRIN and the word DISGREN.

44) Taking into account all the above I consider that the respective trade marks are similar.

Conclusion

45) There is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). 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, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49). DISPRIN does not describe the goods, it is an invented word (see above). There is nothing in the word DISPRIN that would, I believe, lead the consumer to see it as anything other than a trade mark, an indicator of origin. I can see no reason why it cannot be seen as a particularly distinctive trade mark and, therefore, it does not need to seek assistance from reputation to aid it.

46) In *Canon* the ECJ stated:

“the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion”.

In this case the respective goods are identical so reputation is not going to have an effect here either.

47) Consequently, I do not consider that reputation will help Reckitt’s case; its trade mark already has the gold standard for distinctiveness and encompasses identical goods. However, if the distinctiveness of DISPRIN was questioned I note that Mr Campbell submitted that it enjoyed a substantial reputation. So if it was not particularly distinctive inherently it has gained distinctiveness through use, at least for soluble aspirin. Mr Campbell tried to use this reputation against Reckitt. He put forward the argument that owing to the fame of DISPRIN the public would be able to differentiate between other trade marks which did not differ a great deal. Mr Campbell’s argument flies in the face of settled European law. The ECJ has decided that marks with a reputation have a greater penumbra of protection, not a lesser one. The logic of Mr Campbell’s argument if extrapolated would lead up to trade marks claiming protection under section 5(3) of the Act effectively only being protected if the conflicting trade mark was identical. Reputation can make the weak mark strong; it can lead the consumer where the goods are only slightly similar considering that they emanate from the same economic undertaking or a linked undertaking. Reputation encourages connection by the consumer, it does not discourage it. Neither does reputation eliminate imperfect recollection.

48) Mr Campbell took what I consider a self-contradictory position about the reputation of DISPRIN. He stated at one moment that the reputation related to the use of DISPRIN with a picture of a sword; so the reputation could not help Reckitt. However, this did not prevent him arguing that the reputation of DISPRIN was such as to militate against finding there would be a likelihood of confusion. I cannot see that Mr Campbell can have it both ways. I do not consider his first argument is well founded anyway. The packaging certainly shows DISPRIN with the picture of a sword, however, the publicity shows numerous references to DISPRIN word only; including the strap line “Will you have an aspirin?.....I mean a Disprin.” Even with use with the sword picture I have no doubt that the trade mark will be seen as a DISPRIN trade mark, as well as a sword trade

mark and a combined DISPRIN and sword trade mark.

49) The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the goods are identical so the importance of the differences between the trade marks, which I have found are similar, is further lessened.

50) In the terms of the case law Reckitt has everything going for it. All the various ingredients for a likelihood of confusion have been shown. However, there is a danger of being too simplistic and automatically considering that a likelihood of confusion has been shown because of the weight of the various elements. All the weighty ingredients might have been put into a bread mix but if the leaven is missing the dough will not rise. I need to also consider the average consumer. The nature of the average consumer for pharmaceuticals varies according to the nature of the drug. At one extreme there are drugs that are only prescribed by consultants and only dispensed in hospital pharmacies, at the other, over the counter medicines. At the hearing Mr Campbell offered, if it would be of assistance, to limit the goods to being for prescription use only. Such a restriction would not affect the identical nature of the goods, as the DISPRIN specification encompasses both prescription and non-prescription products. However, it can be argued that if the goods are for prescription only there is a lesser likelihood of confusion owing to the nature of the prescribing process. In considering this issue I bear in mind that the goods of the application are the sort of thing that could be prescribed by a GP; these are not highly specialist pharmaceutical products which are administered solely within a hospital. Indeed they serve much the same purpose as DISPRIN CV did when it was sold. DISPRIN itself could be taken for the same purpose as the DISGREN goods. In considering the issue of prescription I also bear in mind that when drugs are prescribed in the surgery this is normally done in a printed form nowadays. However, when a doctor is making a home visit to a patient he will be writing the name by hand. Bad handwriting cannot be used as a carte blanche for deciding if there would be a likelihood of confusion. Mr Reynolds dealt with this issue in his Zopax decision, BL0/432/02. However, that ordinary handwriting – not bad handwriting – would be used has a bearing on the issue of likelihood of confusion where there is a high degree of visual similarity between the goods. The evidence from the website of net.doctor is also something that needs consideration. The existence of this website shows that the ordinary consumer now uses the Internet to find out about medicines. He or she is no longer the passive recipient of the doctor's wisdom. The existence of such sites indicates that consumers will look for drugs and look up drugs for their conditions. Consequently, the consumer could then visit his doctor and, for instance, ask about taking DISGREN; the phonetic similarity between DISGREN and DISPRIN then will be of importance.

51) Mr Campbell did not pursue the claim that DISPRIN and DISGREN had co-existed without confusion in other jurisdictions. I consider that this was sensible. There is no evidence that DISGREN has been used in other jurisdictions, only that it has been licensed there. Uriach is only a licensee in Spain so it is difficult to see how it can comment on the position for undertakings elsewhere. There is also no evidence for the

most part of how DISPRIN has been used in other jurisdictions, with the exception of the Indian advertisements. Other jurisdictions also tell me little as the likelihood of confusion will depend on the linguistic background in those jurisdictions and the nature and culture of the market there also. I need to consider the position in the United Kingdom.

52) Taking into account the identity of the goods, the degree of similarity between the signs, the distinctiveness of the earlier sign – DISPRIN – and the nature of the purchasing decision I come to the conclusion that there is a likelihood of confusion; such a likelihood would not be obviated by restricting the goods to being prescription only medicines.

Passing-off – section 5(4)(a) of the Act

53) I cannot see how Reckitt can be in any better position under this section of the Act than under section 5(2)(b) and so I will say no more about this ground of opposition.

COSTS

54) Reckitt Benckiser Healthcare (UK) Limited having been successful it is entitled towards a contribution towards its costs. I order J Uriach y Cia, SA to pay Reckitt Benckiser Healthcare (UK) Limited the sum of £2150. This sum is 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 13 day of March 2003

**David Landau
For the Registrar
the Comptroller-General**