O-242-03

DECISION OF THE TRADE MARKS REGISTRY

TRADE MARKS ACT 1994

APPLICANT: PHARMACIA CORPORATION

OPPOSITION Nº. 90438

AND

OPPONENT: SANOFI-SYNTHELABO

APPLICATION Nº. 2249115

CLASS 5

ETURION

TRADE MARKS ACT 1994

BACKGROUND

1. The mark is ETURION. It was applied for on 17th October 2000 by the Pharmacia Corporation, 5200 Old Orchard Road, Skokie, Illinois, United States of America for:

    Class 5: Pharmaceutical preparations for the treatment of cardiovascular conditions.

2. Registration of the mark is opposed by Sanofi-Synthelabo under s. 5(2)(b) on the basis of the earlier registration No. 2248589, for 'Medical products for the treatment of benign prostate hypertrophy', also in Class 5.

3. A Counterstatement was provided by the applicants denying the grounds asserted. Both parties ask for costs to be awarded in their favour.

HEARING

4. Neither party requested a hearing, though each provided written submissions.

EVIDENCE

5. No evidence was submitted during the normal course of the proceedings. Nevertheless, on 8th May 2003, the opponents wrote to the Registrar as follows:

    "We will not be making a request for a Hearing.

    We would however like to provide the attached document as a written submission. The document is a certified English translation of the French National Institute of Industrial Property decision in relation to our client's opposition to the French trade mark ETURION. The French trade marks office found a similarity between our client's mark URION and the French mark and rejected the French mark.

    Please confirm that you are willing to accept the attached document as a written submission. Whilst we are aware that the decisions of other European trade mark offices are not legally binding upon you, we consider that the decision should be highly persuasive."

    I was unable to provide the confirmation requested, and orally informed the opponents' agents of my view: I regard this material as unsworn evidence, put forward with no application calling for its late inclusion. As a consequence, I intend to ignore it.

6. Even if I did not, I am not convinced the decision of the French Trade Marks Office will avail them much in this matter anyhow. First, the goods at issue in the French case are not the same as here, the National Institute of Industrial Property finding that those covered by the registration request 'constitute general categories including the products covered by the [opponents'] anterior trademark', that is, the goods at issue were identical or similar. Second, the French case found that the earlier mark (URION) 'imitated' the later (ETURION), and that the parties did not contest this. I take this to mean that the marks were considered similar. I

come to the same conclusion below. However, the degree of similarity may vary according to an English speakers' appreciation of the marks and a French speakers' appreciation of them. Aural and semantic reactions are likely to differ. For example, *et* is the common French conjunction 'and'. All in all, even if I took note of this late material from the applicants, they would gain little or nothing from it.

7. Following from this conclusion, I have only the *prima facie* case to consider.

LAW

8. The relevant section of the Act is:

> "5(2) A trade mark shall not be registered if because -
>
> (a) … , or
>
> (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."

DECISION

9. In approaching this section I am mindful of the following decisions of the European Court of Justice (ECJ) on this provision (equivalent to Article 4(1)(b) of Directive 89/104/EEC) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *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,* paragraph 22;
>
> (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV,* paragraph 23, 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,* paragraph 27;
>
> (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV*, paragraph 23;
>
> (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*, paragraph 23;
>
> (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*, 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*, paragraph 24;

(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*, paragraph 26;

(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*, 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*, paragraph 29.

Similarity of goods

10. These are:

Applicants	Opponents
Pharmaceutical preparations for the treatment of cardiovascular conditions.	Medical products for the treatment of benign prostate hypertrophy.

The applicants, referred to the following passage in *Canon*, where the ECJ stated:

> "23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary."

This list is not exhaustive, and to it I add the respective uses of the goods (*British Sugar Plc v. James Robertson & Sons Ltd* [1996] R.P.C. 281, at 298, point (a)).

The applicants went on to state:

> "The comparison of goods here is between medical products for the treatment of benign prostrate hypertrophy and pharmaceutical preparations for the treatment of cardiovascular conditions. No evidence has been supplied by either party, but a cardiovascular condition is one which is of or relating to or involving the heart and the blood vessels, whereas prostate hypertrophy concerns non-tumourous enlargement of the prostate gland which is a gland found only in males at the neck of the bladder where it joins the urethra. Whilst one is dealing with pharmaceutical products in each case, their use is in relation to entirely different conditions. We would contend that this would mean that these are dissimilar goods and if that is the case then it is not necessary even to consider the issue of likelihood of confusion."

11. It could be argued that the applicants have strayed into giving evidence here. But I think such a conclusion would be harsh. The information they have provided is about as much as one might infer from the parties' respective specifications, against a background of what must be

common knowledge. Nevertheless, I do not believe that it helps me much: as will be seen the lack of evidence from either party in this matter limits my understanding of the 'relevant factors' (*Sabel*, paragraph 22) in this case, and I can make no assumptions.

12. With this in mind, I intend to apply the factors identified in *Canon*, as far as I am able.

Nature of the goods

13. 'Medical products' includes the applicants' 'pharmaceutical preparations', but this helps me but little: I understand 'nature' to be the physical nature of the goods, but medicines can be in tablet form (capsules? lozenges?), and can also be powders, liquids, aerosols and gases. Without more information, the nature of the goods remains a matter of conjecture. Even if I took 'nature', here, to be chemical nature, that is, formulation, I can assume little: it might be that the same compounds are used in the treatment of both of the conditions listed above (certain types of diuretic for example, but that is total speculation).

End users

14. These are clearly patients suffering, as the applicants state, from cardiovascular conditions or non-tumourous enlargement of the prostate gland. This will, no doubt, include significant numbers of the public, but I have no idea of those of that number who suffer from both conditions at the same time. It might be that they are numerous: cardiovascular illnesses becomes more common with age, and age is the main factor in benign swelling of the prostate. But I can come to no conclusions *sans* evidence.

Complimentary or competitive?

15. This follows on from the previous section. Certain medicines may cause side effects which require treatment by other drugs to alleviate them; if this was the case here, this would make the goods at issue complimentary with one another. Alternatively – as I have speculated above – where the same chemical is employed as a remedy for two disparate conditions, the goods at issue might be competitive. However, under the circumstances, I must regard them neither complimentary or competitive.

Method of use

16. The methods of administration of drugs are legion – oral, intravenous, subcutaneous, transdermal, sublingual, endotracheal or nasogastric to name but a few. Are these drugs self administered? Must they be taken only under medical supervision? Again, I can conclude nothing.

The uses of the goods

17. This is where I think I can be more certain: the uses of the goods are clearly different, as the medical conditions they are specified to treat differ. But is this enough to regard them as dissimilar goods?

18. It is perfectly possible that pharmaceutical preparations in Class 5 may be so regarded where they are used for the treatment of very specific conditions. One can think of many examples – for instance, a treatment for Alzheimer's disease and one for an over active thyroid. Do the current preparations fit into this category?

19. In the absence of evidence to the contrary, I think I must come to the conclusion that they might. On the basis that he who asserts must prove, I feel the onus here was on the opponents to argue their case: as it is, they have not presented me with anything that would encourage me to consider the current situation to be any different to the example I have just given. Consequently, I must come to the conclusion that the goods at issue are at the boundaries of similarity.

20. Even with this conclusion, however, the matter does not end here: as stated in *Canon*, and cited above, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa*. The applicants themselves appeared to implicitly accept this point:

> ".. we have to appreciate that it may be considered that there is sufficient similarity between the marks and sufficient similarity between the goods that the matter comes to be decided as to whether given that limited similarity in each case, there is an issue over likelihood of confusion."

21. And I agree.

The Average Consumer

22. The applicants submit:

> "Although no evidence has been provided by either party, it would not seem unreasonable to assume that given the nature of the conditions of which the respective products would be directed, that these would be likely to be prescription only drugs, or at the very least would be dispensed in some fashion by a pharmacist rather than being over-the-counter or off-the-shelf goods. We are not dealing with broad-ranging specifications covering the entire field of pharmaceutical products, as is sometimes the case with marks falling in Class 5, but instead we are dealing with quite specific areas in each case within the pharmaceutical field. The average consumer may possibly be an ordinary member of the public but is probably more likely to be a medical professional prescribing a prescription drug. If one was considering the average consumer as a member of the public, given that one is considering products relating to probably rather serious medical conditions, one would have thought that a reasonable level of attention would be paid in the selection of this type of goods. Even allowing for an appropriate level of defective recollection, we would suggest that the average consumer is not likely to confuse ETURION with URION."

23. Without evidence on this point from either party, I do not believe that I can limit the assessment of the likelihood of confusion to medical professionals only. That the average consumer '..is more likely to be..' such an individual is not enough, and to accept that contention would ask me to infer too much. The applicants' specification is not as focused as it first appears: pharmaceutical preparations for the treatment of cardiovascular conditions includes a vast array of medications and does not exclude aspirin – a drug available on

supermarket shelves – and I understand is not uncommonly used these days in the treatment of, *inter alia*, certain heart conditions. In short, the average consumer will certainly include doctors, nurses and pharmacists, but may not exclude ordinary members of the public.

The similarity of the marks

24. In my view, URION is a fanciful mark, with an unambiguous capacity to distinguish. Nevertheless, I cannot conclude that it has highly distinctive character, and is therefore of a potency that occasions greater protection, as counseled by current case law (*Sabel*, paragraph 24). From my own knowledge it is not untypical that that the appellations applied to pharmaceuticals can be allusive of their purpose or chemical formulation. It is possible that this might be the case here – perhaps there may be a reference to diuretics in the opponents' mark. Of course, without evidence, this is mere guesswork, and I can come to no such conclusion. But it is a consequence of the lack of explanation in respect of the 'surrounding circumstances' (*Pianotist Co Ltd's application* (1906) 23 RPC 774 at page 777 lines 26 *et seq*) that I must treat the mark as a robust mark, but not one that has a very significant capacity to distinguish.

25. Following from my finding that consumers would not find an intimation of meaning within the opponents' mark I do not believe that they will discern any conceptual similarity between it and the applicants' mark. Visually, their appearance is, in my view, rather different – both marks are small and this tends to emphasis the differences between them.

26. Finally, the marks will be pronounced differently. The opponents' as U-RE-UN, and the applicants' as ET-U-RE-UN, but with the ET and U 'running together' as in CENTURION. I do not believe that this verbal difference will be lost in normal speech.

27. Nevertheless, the opponents mark URION is contained within the applicants' ETURION. I think I must regard them as possessing some degree of similarity.

Likelihood of confusion

28. I have found the average consumer to be medical professionals and members of the public. The former will bring expert care to their nominal deliberations in respect of different medicines, and this will tend to mitigate against confusion. But I also believe that the latter will be vigilant in their purchase of such products.

29. All in all, though I have found certain correspondences between the marks, and some similarity between the goods, they are not enough to convince me that confusion is likely. The ground under s. 5(2)(b) fails and the opposition has failed.

COSTS

30. I see no reason to make a costs award in excess of the usual scale. Nevertheless, this still requires the opponents to acknowledge the applicants' success by paying them £700. This 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 20TH Day of August 2003.

Dr W J Trott
Principal Hearing Officer
For the Registrar