

O-308-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2278615
BY PHARMACIA & UPJOHN COMPANY TO
REGISTER THE TRADE MARK VYKTRA IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION No. 80546
BY SMITHKLINE BEECHAM PLC**

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**IN THE MATTER OF Application No. 2278615
by Pharmacia & Upjohn Company to register the Trade
Mark VYKTRA in Class 5**

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by SmithKline Beecham Plc**

Background

1. On 21 August 2001 (but claiming an international priority date of 4 May 2001) Pharmacia & Upjohn Company applied to register the mark VYKTRA for the following specification of goods:

“Pharmaceutical preparations for the treatment of infectious disease, pain, inflammation, cardiovascular diseases, oncology, ophthalmological conditions, central nervous system disorders in Class 5.”

2. The application is numbered 2278615.

3. On 16 January 2002 SmithKline Beecham Plc filed notice of opposition to this application. They are the proprietors of the mark VYKAST which is registered with the Community Trade Mark Office under No 972620 for “pharmaceutical and medicinal preparation for human use”. That registration has a filing date of 28 October 1998 and is thus an earlier trade mark within the meaning of Section 6(1)(a) of the Act. Having regard to the respective marks and the fact that identical/similar goods are involved they say that there is a likelihood of confusion. Accordingly, the mark for which registration is sought offends the provisions of Section 5(2)(b) of the Act.

4. The applicants filed a counterstatement denying the above ground. Both sides ask for an award of costs in their favour.

5. Both sides filed evidence. The parties were reminded of their right to be heard or to offer written submissions. Neither side has opted to do so. Acting on behalf of the Registrar I, therefore, give this decision on the basis of the papers filed.

Evidence

6. I will merely record at this point that the evidence filed in this case is as follows:

Alan Sinclair Cox	-	Witness statement dated 4 November 2002
Peter John Charlton	-	Witness statement dated 9 May 2003

7. Mr Cox is a solicitor and registered trade mark attorney who is Global Head of Trade Marks for Glaxo-SmithKline. Mr Charlton is a partner in the firm of Elkington & Fife, trade mark attorneys, who represent the applicants in this matter. A considerable part of the evidence filed consists of identification of the case law which I should take into account and submissions on the matter of comparison of marks. Mr Cox also gives evidence on issues to do with medical confusion. I do not propose to offer the normal evidence summary at this point but will deal with relevant parts of the material before me in the course of my decision below.

The Law and Principal Authorities

8. Section 5(2) reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, 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.”

9. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* 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*, 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 v. Puma AG*, 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 Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, 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*, 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 BV v. Puma AG*, 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 CV v. Adidas AG*, 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*, paragraph 29.

10. I have, in addition, been referred to a number of cases which deal with circumstances surrounding pharmaceutical trade marks. I will comment on these separately below.

Comparison of Goods

11. The applicants' specification covers pharmaceutical preparations intended for treatment of a range of medical conditions and illnesses which are specified but broad in scope. The opponents' earlier trade mark is registered for pharmaceutical and medicinal preparations at large. The only qualification is that they are 'for human use'. On a notional view of the matter the inescapable conclusion is that the applied for goods are, or could form, a subset of the opponents' broadly based goods specification. Accordingly identical goods are involved.

Distinctive Character of the Respective Marks

12. This is a factor to be taken into account (see items (d) and (f) above). Neither side has filed evidence of use. My consideration must, therefore, be based on the inherent characteristics of the marks. So far as I am aware both are invented words. Furthermore they do not appear to have any obvious descriptive connotations in relation to the goods. That normally points to a relatively high degree of distinctive character. I believe that to be the case here.

Comparison of Marks

13. In addition to the well accepted principles of visual, aural and conceptual similarity set out in *Sabel v Puma* ((d) above), Mr Cox's witness statement also reminds me that the beginnings of words are usually held to be of particular importance not least because there is a tendency to slur the endings of words. That is a long established principle which finds expression notably in *TRIPCASTROID Trade Mark* 42 RPC 264 (at page 279). That was a case under the preceding law but is no less applicable today.

14. Mr Cox also submits that the marks in issue share the common prefixes VYK which, he suggests, are identical in sound and pronunciation and that the "common verbal elements are considered to be more significant than the existing differences which are minor". He also points to similarities in structure, number of characters and syllables and the rhythm of the words.

15. Mr Charlton, for the applicants, points to the concentration of consonants in his clients' mark, and suggests that it creates an unusual visual impact which differentiates it from the earlier trade mark. In his view the marks will be pronounced as "vick-tra" and "vy-cast" (ie a short vowel sound and long vowel sound in the respective first syllables) and with the syllable breaks placed accordingly. On this basis the second syllable of the earlier trade mark is phonetically identical to the word 'cast', a recognisable word. He suggests that this helps to differentiate the marks aurally and conceptually.

16. Turning to my own view of the marks they are self-evidently, of equal length, composed of two syllables and share the first three letters. To the eye (and even more so to the ear) the earlier trade mark is more naturally seen as being composed of the elements VY and KAST rather than, say, VYK and AST. It nevertheless remains the case that both marks commence with the same unusual three letter combination – unusual in the sense that I am not aware of any other words that begin with this string of letters. But a further aspect of visual appreciation of the applied for mark is the effect of the accumulation of consonants at the beginning of the mark (strictly perhaps semi-vowel in the case of the Y). These factors seem to me to pull in opposite directions when it comes to assessing visual similarity but it cannot be denied that there is a modicum of similarity.

17. Whilst I have written submissions containing the parties' views on how the marks are likely to be pronounced there is no evidence as to how the relevant public actually pronounces them (if they are in use). My own immediate reaction corresponds to the applicants' view, namely that the applied for mark is more likely to be pronounced with a short 'i' sound in its first syllable. I accept that others may approach pronunciation of the mark differently and use a long 'i' sound but, on the whole, I think this is less likely. I am rather more confident that the construction of the earlier trade mark will lead to pronunciation as 'vy-cast' with a long 'i' sound in the first syllable. On that basis I find a low degree of similarity from an oral/aural standpoint.

18. As neither word yields an obvious meaning the relevant public will be unable to differentiate between them in the way that they can with visually or phonetically similar dictionary words. On the other hand conceptual considerations seem to me to

be of somewhat less importance where the marks under consideration are invented words.

Likelihood of Confusion

19. As is noted in *Sabel v Puma* ((a) above) the likelihood of confusion is a matter of global appreciation taking all relevant factors into account. Mr Cox has filed evidence bearing on the particular circumstances that exist in the context of prescribing, dispensing and administering pharmaceutical products including the fact that many medical professionals work long hours and under pressure; that prescriptions are often written by hand and subject to the risks associated with poor handwriting; that it is not uncommon for doctors to telephone through prescriptions to pharmacists; that the consequences of errors in this field can be serious and even fatal; and that these problems have been recognised to the point that computer programmes and voice dictation systems are now available to mitigate the effects. Mr Cox supports his observations on these points with Exhibits ASC1 to 7. Mr Charlton, in turn, has referred me to a number of decisions by a Registry Hearing Officer and the Appointed Person dealing with the approach to be adopted.

20. The debate as to whether a higher or lower threshold should, or needs to be applied in relation to pharmaceutical products is not a new one. As Mr Charlton has pointed out, the Appointed Person (Professor R Annand) approved the following statement of the Registry Hearing Officer in *Glaxo Group Plc v Allergan Inc* (BL O/414/01 and BL O/293/02):

“16. It seems to me that the role of the Registrar is to apply the Trade Marks Act 1994 and its subordinate legislation to the proceedings brought before her. Other provisions and authorities exist for the licensing of pharmaceuticals and in my view, it is not the role of the Trade Marks Registry to stray into these areas. Under the provisions of the Act and acting on behalf of the Registrar I must consider whether there exists a likelihood of confusion if the applicants’ and opponents’ trade marks are used in respect of the goods for which they are respectively applied for and registered. I must find a likelihood of confusion not merely a possibility of confusion; *Reactor* at page 290.”

21. In *H Lundbeck A/S and Omega Farma EHF* (BL O/208/02), Professor Annand, again sitting as the Appointed Person, said:

“I have arrived at this view [on the merits of the appeal] without engaging in the debate whether a higher or lower threshold needs to be reached before confusion can be established in conflicts between pharmaceutical trade marks. 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).”

22. I note, too, that in *Choay S A v Boehringer Ingelheim International GmbH* [2001] ETMR 693, a similar conclusion was reached in relation to the standard of the test to be applied. The OHIM Board of Appeal observed that:

“In some Member States the view is taken that a likelihood of confusion should be accepted more readily in the case of medicines on account of the serious consequences that can ensue if the patient takes the wrong products. In other countries the view is taken that pharmaceutical trade marks will not be confused so easily because the consumer has the assistance of qualified professionals and is particularly attentive to the differences between marks for pharmaceutical products because of the importance of taking the right product.

In the Board’s view, the conflicting considerations which underlie these opposing views are likely to cancel each other out in many cases, with the result that no special criteria need be applied to trade marks for pharmaceutical products.”

23. Nevertheless there remains the question of what considerations and circumstances bearing on the pharmaceutical industry are relevant and to be borne in mind in addressing the issue of likelihood of confusion. In *Glaxo Group Ltd v Bayer Aktiengesellschaft*, O/199/02 I indicated that I thought it right to:

“..... take account of all relevant surrounding circumstances bearing on the trade in such goods and the nature and characteristics of the average consumer. Thus in the circumstances of this case I bear in mind that the goods may be available over the counter or by prescription (taking a notional view of the matter); that the average consumer may be medical professionals and/or the public at large; that handwritten prescription may be involved; that the public may be ordering/purchasing goods in the environment of a busy chemists shop. I also consider that, notwithstanding that a customer may have an ailment at the time, the average person is unlikely to be so careless in health issues that he or she will act in other than a reasonably circumspect and observant fashion.

This is not to say that the points made by Mr Thomas should be lightly dismissed. Clearly there can be and have been serious, and in some cases fatal consequences of errors arising from failure in the prescribing/dispensing process. Nevertheless I do not think it is suggested that handwritten prescriptions or other ‘risk factors’ in the system generally result in problems. It is reasonable to assume that the overwhelming majority of prescriptions and purchases whether over the counter or through a medical professional result in the correct product being supplied. Whilst errors may be serious when they occur they are not typical of what happens. The position seems to me to be that the test in trade mark law terms should have regard to the normal range of circumstances found in the trade rather than seek to compensate for irregular or exceptional occurrences. I also bear in mind the guidance from the *Lloyd Schuhfabrik* case ((b) above) which requires me to assume that the average

consumer is reasonably well informed and reasonably circumspect and observant.”

24. Many of the considerations I am asked to take into account here were raised in that earlier case. Indeed many of the examples of mistakes occurring in drug names were referred to there and must, I think, be well known within the industry (ISORDIL/PLENDIL, DEMEROL/ROXANOL, PITRESSIN/PITOCIN etc).

25. I, therefore, regard the above conclusions as being broadly applicable in the current case including the fact that, absent specific evidence to the contrary, I must make allowance for the fact that the average consumer may be medical professionals and/or the public at large.

26. I am inclined to think that visual appreciation of pharmaceutical marks is of particular importance given that pharmacists will generally be working from a prescription (which may be typed or hand written) from a medical professional and that over the counter medicines may be selected from displays in a chemists shop, supermarket or other such outlets. Equally oral usage and references must be allowed for. Members of the public may choose to put their requirements to a pharmacist or shop assistant and Mr Cox refers to the practice of doctors telephoning prescriptions to chemists or pharmacists.

27. I have not found this an easy matter to resolve. The marks have the first three letters in common. Furthermore the combination VYK is an unusual one. My impression is, however, that that point of similarity is diluted by the overall effect of the words and particularly the fact that the earlier trade is more likely to be seen and referred to as VY-KAST whereas the applied for mark is made up of a visually unusual combination of letters.

28. There are dangers in, on the one hand, over-analysis see ((c) above) and, on the other, failing to allow for imperfect recollection. The latter must particularly be allowed for where invented words are concerned. Bearing in mind the principle of interdependency between the elements of the test, I have come to the conclusion that, allowing for the points of visual similarity, a lesser degree of aural similarity and identity between the goods, the net effect falls short of pointing to a likelihood of confusion.

29. Even so I have hesitated over the final outcome because, if consumers make an association between the marks in the circumstances set out in *Canon v MGM* see ((i) paragraph 9 above), then that also amounts to a likelihood of confusion within the meaning of the Section. In particular, it gives rise to the question as to whether consumers, who were not confused between the marks, might nevertheless consider that the presence of the element VYK in the applied for mark suggested another product from the manufacturers or supplier of VYKAST products. No family of marks argument has been advanced by the opponents and I am not aware that there is a practice in the pharmaceutical industry of using a common stem for derivative, or related products. But that is not conclusive. It is possible that the strength and unusual nature of the VYK combination may be enough to lead a small number of consumers to think that goods sold under the respective marks emanated from the same trade source. However, I bear in mind that the Act requires a likelihood of

confusion. A mere possibility is not sufficient (see *REACT Trade Mark*, [2000] RPC 295 at page 290). In the event, therefore, I find that the balance of the argument is marginally in the applicants' favour.

30. The applicants have succeeded on the basis of my consideration of the only ground on which the opposition has been brought. They are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £1250. 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 15th day of October 2003

M REYNOLDS
For the Registrar
the Comptroller-General