

O-113-04

IN THE MATTER OF APPLICATION NO. 2291512 IN THE NAME OF
RANBAXY LABORATORIES LIMITED

AND IN THE MATTER OF OPPOSITION NO. 90732 THERETO BY
ASTRAZENECA AB

DECISION

Introduction

1. Ranbaxy Laboratories Ltd appeals against a decision of Mr Landau acting for the Registrar dated 12 November 2003 in which he upheld an opposition by AstraZeneca AB to the appellant's Application No. 2291512 to register the mark OMERAN in respect of "pharmaceutical and medicinal preparations for human and veterinary use" insofar as it related to pharmaceutical and medicinal preparations for human use ("the Mark"). The hearing officer held that registration of the Mark was precluded by section 5(2)(b) of the Trade Mark Act 1994 having regard to two earlier registrations of the respondent, namely No. 2117046 OMEPRAL registered in respect of "pharmaceutical preparations for the treatment of gastro-intestinal disease" and No. 2246351 OMEPAL registered in respect of "pharmaceutical preparations and substances". Section 5(2)(b) provides:

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 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.

The hearing officer's decision

2. The hearing officer's reasoning was that the Mark was sought to be registered in respect of goods which were identical to the goods in respect of which each of the earlier marks was registered; that each of the earlier marks was an invented word with no allusion to the goods and with a good deal of inherent distinctiveness; that none of the three marks had any particular parts which could be considered to be distinctive and dominant components; that there was a good deal of phonetic similarity between the Mark and each of the earlier marks, with OMEPRAL being the closer of the two; that there was some visual similarity between the Mark and each of the earlier marks, with OMEPRAL again being the closer of the two; that none of the marks had any conceptual associations; and that, taking all these factors into account, there was a likelihood of confusion at least in the case of over-the-counter medicines even though consumers of such products would take some care in selecting them.

Standard of review

3. This appeal is a review of the hearing officer's decision. The hearing officer's decision with regard to section 5(2)(b) involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

The appeal

4. Before turning to the substance of the appeal I should record one point which is uncontroversial. Shortly before the hearing officer's decision was issued, the appellant amended the specification of goods for which registration of the Mark is sought to "pharmaceutical and medicinal preparations for human and veterinary use but not including any such preparations for the treatment of cardio-vascular disease, including high blood pressure, low blood pressure, congestive heart failure, diabetic nephropathy, atherosclerosis and stroke".

This amendment was made as a result of a settlement of another opposition. It appears that it was not notified to the hearing officer. This is immaterial, however, since the attorney for the appellant accepted that the amendment has no bearing on the appeal.

5. The appellant criticised the hearing officer's reasoning in a number of respects, but in my view it failed to demonstrate any error of principle on his part. I shall deal briefly with each of the main criticisms made.

6. First, the appellant points out quite correctly that, prior to the hearing officer's decision, the respondent had amended its statement of grounds of opposition so as to delete reference to OMEPRAL. It appears that this amendment had not found its way onto the file, although I note that in the respondent's written submissions to the hearing officer dated 25 September 2003 reliance was only placed on OMEPAL. Obviously, it is regrettable that the hearing officer should have decided the case upon a ground that was no longer in issue. That said, the hearing officer took scrupulous care to consider the respondent's two marks, and the cases based upon those two marks, separately: as he rightly said in paragraph 29 of his decision, the respondent's marks "cannot be treated as a job lot". Thus if one ignores everything the hearing officer said about OMEPRAL, one still has a reasoned decision in the respondent's favour based upon OMEPAL. The appellant's attorney was unable to point to any part of the hearing officer's reasoning in relation to OMEPAL which showed that it had been influenced by his reasoning in relation to OMEPRAL, but nevertheless submitted that he was likely subconsciously to have been influenced by OMEPRAL. In my judgment there is no evidence of this.

7. Secondly, the appellant contends that the hearing officer's assessment of the similarity of the marks was erroneous. This criticism is particularly directed at the hearing officer's assessment of the degree of aural similarity and to a lesser extent his assessment of the degree of visual similarity. The main point advanced is that the hearing officer reached the wrong conclusion as to the likely pronunciation of OMERAN. I agree with the hearing officer's view in

this respect, but even if I were to take a different view I am unable to see how this could be said to be an error of principle.

8. Thirdly, the appellant contends that the hearing officer made insufficient allowance for the care which is likely to be exercised by the average consumer when selecting pharmaceuticals even in the over-the-counter context. The appellant argues that pharmaceuticals are not goods like confectionery, where goods may be purchased on impulse and with little care. In my judgment the hearing officer did make due allowance for this factor. Indeed, some two and a half pages of the decision are devoted to this issue, and when reaching his conclusion the hearing officer expressly proceeded upon the basis that the customer for an over-the-counter pharmaceutical product “will take some care” (paragraph 36 of the decision).
9. Fourthly, the appellant argues that in the over-the-counter situation the customer does not rely purely upon the brand name but also upon the packaging. In my view this is a point of no substance. In general, consumers rely much more heavily upon brand names than they do upon get-up. Differences in get-up are unlikely to dispel confusion caused by imperfect recollection of similar brand names. Furthermore, the hearing officer was considering notional fair use of the respective marks, which in the circumstances of pharmaceutical products would include use in similar (though not identical) get-ups.
10. Fifthly, the appellant contends that the hearing officer was in error to disregard “state of the register” evidence showing that there were a number of registrations in Class 5 for other marks beginning with the prefix OME-. The hearing officer disregarded this evidence because the respondent demonstrated that none of the marks were being used in respect of pharmaceutical products in the United Kingdom. In adopting this approach the hearing officer correctly applied the well-known dictum of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 261 at 305. In my judgment he would have made an error of principle if he had done otherwise.

Conclusion

11. It follows that this appeal must be dismissed.

Costs

12. The hearing officer ordered the appellant to pay the respondent the sum of £1200 as a contribution to its costs. The respondent did not attend the hearing of the appeal, but submitted a letter commenting briefly on the grounds of appeal filed by the appellant. In the circumstances I direct that the appellant pay the respondent the sum of £100 as a contribution to its costs of the appeal in addition to the sum awarded by the hearing officer.

21 April 2004

RICHARD ARNOLD QC

Aidan Robson of Reddie & Grose appeared for the appellant.

Janella Barr of Wildbore & Gibbons submitted written observations for the respondent.