

O-113-10

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF:

APPLICATION NOS 2468113 & 2468114

BY INEOS HEALTHCARE LIMITED

TO REGISTER THE TRADE MARKS:

**ALFA-REN
&
ALPHA-REN**

AND

OPPOSITION THERETO (UNDER NOS 96489 & 96490)

BY TEVA PHARMA CAUTICAL INDUSTRIES LIMITED

TRADE MARKS ACT 1994

**In the matter of application nos 2468113 & 2468114
by INEOS Healthcare Limited to register the trade marks:
ALFA-REN & ALPHA-REN**

and

**Opposition thereto (under nos 96489 & 96490)
by Teva Pharmaceutical Industries Limited**

Background

1. These consolidated proceedings concern trade mark applications 2468113 (ALFA-REN) and 2468114 (ALPHA-REN). Both were filed on 28 September 2007 by INEOS Healthcare Limited (“INEOS”). The goods sought to be registered in relation to both marks were:

Class 01: Chemicals for use in science and the pharmaceutical industry; chemicals for use in the manufacture of pharmaceuticals, medical preparations and veterinary preparations.

Class 05: Chemical preparations for medical purposes; pharmaceutical and veterinary preparations; magnesium iron hydroxy carbonate or hydrotalcite for pharmaceutical or veterinary purposes; pharmaceutical and veterinary preparations for use in renal dialysis and in the treatment of renal diseases and kidney ailments; phosphate binders for use in the treatment of hyperphosphataemia.

2. During the proceedings the specification of application 2468113 was limited to:

Class 5: Pharmaceutical products for the treatment of hyperphosphataemia in kidney failure patients, not in fine powder form.

Application 2468114 is not subject to such a limitation.

3. Teva Pharmaceutical Industries Limited (“Teva”) oppose both applications. Both of its oppositions were filed on 26 February 2008. Teva’s opposition to application 2468113 was maintained despite the amendment set out above. Both oppositions are based on grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Both grounds of opposition are based on a single earlier trade mark of which Teva is the proprietor. The details of the earlier trade mark are:

UK trade mark registration 1180583 in respect of the trade mark:

ALFAD

Filing date: 23 August 1982

Date registered: 22 August 1984

Registered in respect of: "Pharmaceutical and veterinary preparations and substances"

4. Teva claims that in the five year period before the publication of INEOS' applications it had used its trade mark in relation to:

"Pharmaceutical preparations being a calcium regulator".

5. The necessity for the above claim stems from the proof of use provisions contained in section 6A of the Act¹. This provides that an opposition which is based on an earlier mark that completed its registration procedure before the start of the period of five years ending with the date of publication of the applied for mark (INEOS' marks) can only succeed if the use conditions are met. I will set out the use conditions shortly. Teva's earlier mark falls within this category² and, so, must meet the use conditions if it is to form the basis of a successful opposition.

6. INEOS filed a counterstatement denying the grounds of opposition. In its counterstatement INEOS put Teva to proof on its claim to have used its earlier trade mark.

7. The cases were consolidated in view of the similar issues to be determined. Both sides filed evidence. Rather than summarise the evidence separately, I will, to the extent necessary, simply draw from it, and refer to it, in the body of this decision. The matter then came to be heard before me on 25 March 2010 where INEOS were represented by Mr Simon Malynicz, of counsel, instructed by Wynne-Jones, Laine & James. Teva did not attend the hearing, but instead filed written submissions in lieu of attendance.

Decision

8. Before considering any of the grounds of opposition, I must deal with the proof of use provisions. This is because the extent to which the earlier trade mark can be relied upon under the grounds of opposition, if at all, must be established. Section 6A of the Act reads:

"6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

¹ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

² Both of INEOS' applications were published on 28 September 2007 whereas Teva's earlier mark completed its registration procedure in 1984 i.e. well before the beginning of the five year period which ends on the date of publication of INEOS' applications.

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

(b)

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services...”

9. At the hearing, Mr Malynicz conceded that the scale of use set out in Teva’s evidence would, all other things being equal, amount to genuine use. However, the primary argument he put forward in relation to the proof of use provisions related to the form of the mark as used (as set out in Teva’s evidence) compared to the form of the earlier mark as registered. It was argued that the form of actual use altered the distinctive character of the mark from the form in which it was registered. In other words, it is not a form of use that is a permissible variant as per section 6A(4)(a) of the Act.

10. The above argument stems from the fact that the mark used by Teva is:

AlfaD

11. By way of explanation, I will briefly refer to Teva’s evidence, which is given by Kim Innes, its commercial director. Throughout the witness statement, whenever the

trade mark is mentioned, it is described as the AlfaD product. A number of exhibits accompany the witness statement such as a letter from the Medicines and Health Products Regulatory Agency granting marketing authorisation, a patient information leaflet, and examples of packaging. All of them carry the sign AlfaD rather than the trade mark as registered, ALFAD.

12. Teva's written submissions did not specifically address this issue. For his part, Mr Malynicz submitted that the correct legal approach can be seen in *Bud/Budweiser Budbrau* [2003] RPC 25 where Lord Walker of Gestingthorpe stated:

"43. ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?"

13. Mr Malynicz also referred to decisions of Mr Arnold QC (as he then was) when sitting as the Appointed Person in *NIRVANA* (BL O/262/06) and in *REMUS* (BL O/061/08). In the second of these cases Mr Arnold QC stated:

"I do not consider that the subsequent developments discussed above undermine the correctness of the view which I articulated in *NIRVANA* as follows:

'33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

'34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

14. The above decisions deal with the issue of permissible variants in the context of revocation proceedings. However, the legislation relating to the use of a permissible variant in a proof of use context mirrors that as set out in revocation proceedings³. In view of this, the jurisprudence identified above is applicable here. I also note that when Mr Arnold QC dealt with this issue in *REMUS* he thoroughly reviewed the jurisprudence that had been published since his decision in *NIRVANA* and still considered his approach to be correct. I am not aware of any decision or judgment since *REMUS* which means that the test outlined above is no longer valid or relevant. I therefore intend to approach the matter on the basis of the test set out by Mr Arnold QC.

³ Section 6A(4)(a) of the Act is worded in an identical manner to the relevant part of section 46(2).

15. The mark as registered consists of the word ALFAD. The first question is to determine what is the distinctive character of the mark as registered. Mr Malynicz argued that the distinctive character resides in the word as a whole which, he argued, is an invented word. I agree with this assessment. The first (and I would say only) impression of the mark is as a single invented word. It will be pronounced as AL-FAD or ALF-AD. I see no reason why anyone would unpack and break down the mark into two components ALFA and D. Whilst marks registered without any particular form of presentation are often used with different casing, there can be no getting away from the fact that what has been registered is the invented word ALFAD. Indeed, Teva stated in its own evidence that:

“When referred to by name the product is pronounced “Alfa-Dee” and not “Alf-add” as might be considered the way it would be spoken on looking at the trade mark registration in plain letters.”

16. This certainly highlights Teva’s own view that the mark as registered (in plain letters) will be heard (and presumably seen) as ALF-AD. A similar argument was made in Teva’s written submissions. Although the argument was made in relation to the degree of similarity between the marks, the argument cuts across to the issue here. I do not, though, need to place too much weight on Teva’s “concession” given that this is the view that I have come to in any event.

17. The next step is to identify the differences between the mark as registered and the mark as used. The respective marks are:

The mark as registered	The mark as used
ALFAD	AlfaD

18. The differences between the marks are that although they both consist of the same five letters and in the same order, the registered mark is presented in all uppercase lettering whereas the mark as used is presented with an uppercase “A”, a lower case “lfa” and then an upper case “D”. This creates a visual difference because the presentation of AlfaD creates a separation of the element “Alfa” from the element “D”. Although there may be no space between Alfa and D, the capitalisation of the letter D and the upper and lower case presentation of Alfa creates this effect. This creates a visual difference between the mark as registered which then, inevitably, follows through to create an aural difference - the AlfaD mark will be pronounced as ALFA-DEE (ALFA being pronounced in the same way as the Greek letter Alpha) whereas the mark as registered will be pronounced as ALF-AD or AL-FAD. There is also a conceptual difference given that ALFAD will be seen as an invented word whereas AlfaD will be seen as a combination of the phonetic equivalent of the Greek letter Alpha together with the single letter D.

19. The final question is whether the distinctive character of the registered mark is altered. Mr Malynicz argued that, overwhelmingly, the question should be answered in the affirmative. Given my assessment of the distinctive character of the registered mark and given my assessment of the differences between the two versions, I must agree. Mr Malynicz brought my attention to the decision of Mr Iain Purvis QC (sitting

as the Appointed Person) in *INoTheScore* (BL O-276-09). In that case, the differences in casing was a factor (although there was another factor involved in that case) in him deciding that there had been an alteration of the distinctive character of the mark as registered despite there being aural and conceptual identity between the two marks he was considering. Whilst I do not rely on this decision to any significant extent because each case must, of course, be considered on its own merits, it does, nevertheless, highlight that the casing of words can have an impact. I therefore agree with Mr Malynicz that the distinctive character of the mark as registered is altered on a visual, aural and conceptual level when considering the mark which is used.

20. My conclusion is that the use presented in evidence is not use of a trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. As such, the use cannot be relied upon to demonstrate genuine use. The consequence of this is that Teva has failed to meet the use conditions set out in section 6A(3) of the Act. In accordance with section 6A(2), I cannot refuse INEOS' applications for registration on the basis of Teva's earlier mark. There is, therefore, no need to address the grounds of opposition themselves. The opposition fails.

Costs

21. Having been successful, INEOS is entitled to a contribution towards its costs⁴. I hereby order Teva Pharmaceutical Industries Limited to pay INEOS Healthcare Limited the sum of £1500. This sum is calculated as follows:

Preparing a statement and considering the other side's statement	£500
Preparing evidence and considering and commenting on the other side's evidence	£400
Preparing for and attending a hearing	£600

22. In calculating the above costs, I have taken into account that some savings would have been made through case consolidation. Furthermore, although the cases were not consolidated when INEOS filed its counterstatements, its two counterstatements were essentially the same. Finally, INEOS' evidence consisted, in part, of a duplication of evidence from other proceedings; I have reduced the costs award that I would otherwise have given in view of this.

23. The above sum should 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 April 2010

**Oliver Morris
For the Registrar
The Comptroller-General**

⁴ Costs are based on the scale set out in TPN 4/2007