TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3019983
IN THE NAME OF COLONIS PHARMA LIMITED TO REGISTER THE
FOLLOWING TRADE MARK IN CLASS 5:**

MUCODIS

AND

OPPOSITION (NO 401107) BY SANOFI AVENTIS NETHERLANDS BV

The background and the pleadings

1) This is a dispute concerning, in essence, the names of two pharmaceutical products, **MUCODIS** and **MUCODYNE**. MUCODIS was filed on 29 August 2013 by Colonis Pharma Limited ("the applicant") and published for opposition purposes on 27 September 2013. The applicant wishes to register the mark for the following class 5 goods:

> Pharmaceutical preparations; medicines for humans; mucolytic agents; preparations including mucolytic agents; anti-mucolytics; dietetic substances adapted for medical use; sanitary preparations for medical purposes; plasters, materials for dressings; nutritional supplements included in class 5 for humans and/or for animals; vitamins; minerals and mineral salts; none of the aforesaid goods being pain killers.

2) MUCODYNE was filed on 30 November 1970 and stands in the name of Sanofi Aventis Netherlands BV ("the opponent"). It completed its registration process as long ago as 1972 which means that the use provisions contained in section 6A of the Trade Marks Act 1994 ("the Act") must be met if this earlier mark is to be relied upon. The earlier mark is registered for the following class 5 goods:

> Pharmaceutical substances and preparations, all for use in the treatment of conditions and ailments affecting the respiratory passages of the body.

3) The opponent relies on its MUCODYNE mark as the basis for grounds of opposition under sections 5(2)(b) and 5(3) of the Act. It further relies on the use it has made of MUCODYNE as the basis for a further ground under section 5(4)(a).

4) The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of its earlier mark. Both sides filed evidence[1]. I will address the evidence when it is pertinent to the matters that need to be determined. Neither side requested a hearing, both filing written submissions instead.

Sections 5((2)b)/5(3) – the use conditions

5) As stated above, the use conditions are applicable to the earlier mark, conditions which are met if: "...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…"

[1] The opponent's evidence was given by Mr Nicholas-David Lair (a trade mark lawyer in the legal department of the opponent's parent company) and the applicant's evidence was given by Mr Antony Xavier Gallafent (the applicant's trade mark attorney) and by Mr Stephen Jeremy Martin (the applicant's chief executive officer).

6) In the opponent's written submissions it is stated:

> "The opponent filed material demonstrating that a MUCODYNE product has been marketed in the UK, that product being a mucolytic medicine or agent with Carbocisteine as its active ingredient. This is obviously a much smaller range of goods than
>
> > "Pharmaceutical substances and preparations, all for use in the treatment of conditions and ailments affecting the respiratory passages of the body."
>
> The goods for which registration 968333 is registered."

Furthermore, Mr Gallafent states in his evidencet:

> "Other than acknowledging that the Opponents have demonstrated that the sign MUCIDYNE has been used in the UK in the past five years in association with a mucolytic medicine…."

7) I will therefore proceed on the basis that genuine use is no longer challenged, the only challenge being to the breadth of the specification for which the earlier mark should be taken into account. I should add that this is a sensible acceptance by the applicant given that the sales of MUCODYNE have ranged between £15 million and £25 million per annum over the last five years[2] and, as I will come on to explain, it has a huge share of the relevant market. In terms of a fair specification, the starting point is to consider what the mark has, as a matter of fact, being used in relation to. The opponent's witness, Mr Lair, describes the product thus:

> "Mucodyne is a prescription drug prescribed to patients for making sputum (phlegm) easier to cough up in certain lung conditions, such as chronic pulmonary disease ("COPD"), bronchitis or cystic fibrosis"

8) Mr Lair does not refer to the product as a mucolytic, or, indeed, that its purpose it to reduce mucus. However, I note that these terms are used in the exhibits to his witness statement, e.g. in a product leaflet (Exhibit NDL6) for MUCODYNE it is explained that the product contains a medicine called carbocisteine which belongs to a group of medicines called mucolytics. The leaflet adds:

> "It works by making mucus (phlegm) less sticky. This makes the mucus easier to cough up."

9) Furthermore, also in Exhibit NDL6 there is a Summary of Product Characteristics document which was prepared by the Medicines and Healthcare Products Regulatory Authority about MUCODYNE which, inter alia, describes

[2] Paragraph 18 of Mr Lair's witness statement.

that the product is composed of carbocisteine, a "mucolytic agent for the adjunctive therapy of respiratory tract disorders characterised by excessive, vicious mucus, including chronic obstructive airways disease". I come to the view that the earlier mark has been used in relation to a carbocisteine based mucolytic pharmaceutical product.

10) In terms of arriving at a fair specification, I must decide upon a fair description for the goods. The description must not be over pernickety[3]. It is necessary to consider how the relevant public (which for these goods would include both healthcare professionals and end-users) would likely describe them[4]. The General Court ("GC") in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

> "43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.
>
> 44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.
>
> 45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the

[3] See *Animal Trade Mark* [2004] FSR 19.

[4] See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

11) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed Page 23 of 68 in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

12) The goods of the earlier mark read:

"Pharmaceutical substances and preparations, all for use in the treatment of conditions and ailments affecting the respiratory passages of the body"

13) Only one type of product has been sold under the earlier mark, a carbocisteine based mucolytic pharmaceutical product. It seems to me that a healthcare professional is likely to describe it with reference to the relevant group of medicine (i.e. as a mucolytic) rather than use more general terminology such as respiratory treatment products. In terms of end users, I accept that they are unlikely to use terms such as mucolytics, but, nevertheless, I consider that they will have an understanding of the basic purpose of the product and that it is, effectively, for mucus relief; therefore, not even the end user will describe the product as a respiratory treatment product. The terms as registered are in my view far broader than the goods for which the mark is used and will cover pharmaceuticals for the treatment of conditions for which MUCODYNE is not helpful and pharmaceuticals which operate in very different ways to MUCODYNE. I come to the view that a fair specification for which the earlier mark may be relied upon should read:

> "Mucolytic and mucus relieving pharmaceutical substances and preparations, all for use in the treatment of conditions and ailments affecting the respiratory passages of the body"

14) For sake of completeness, I should add that it is not necessary to include in the fair specification the fact that the product is carbocisteine based; this is my view would be too pernickety and would not reflect the appropriate category of goods.

SECTION 5(2)(B) – LIKELIHOOD OF CONFUSION

15) Section 5(2)(b) reads:

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

16) The Court of Justice of the European Union ("CJEU") has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases[i]:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

17) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on what is involved. Guidance has come from the CJEU relating to average consumers of pharmaceuticals. This is exemplified by the judgment in *Alcon Inc v OHIM* C-412/05 P ("*Alcon"*) where it was stated:

> "56 In the present case, having regard to that case-law, the Court of First Instance was fully entitled to hold, which indeed is not disputed by any party in these appeal proceedings, that the healthcare professional at issue must be included in the relevant public for the purposes of the application of Article 8(1)(b) of Regulation No 40/94, the function of the trade mark as an indication of origin being also relevant to intermediaries who deal with the goods commercially in so far as it will tend to influence their conduct in the market (see, to that effect, Case C-371/02 *Björnekulla Fruktindustrier* [2004] ECR I-5791, paragraphs 23 and 25).
>
> 57 However, contrary to what the applicant claims, the fact that intermediaries such as healthcare professionals are liable to influence or even to determine the choice made by the end-users is not, in itself, capable of excluding all likelihood of confusion on the part of those consumers as regards the origin of the goods at issue.
>
> 58 In so far as it found in paragraph 49 of the judgment under appeal, in its definitive assessment of the facts, that the products at issue are sold in pharmacies to the end-users, the Court of First Instance was fully entitled to infer therefrom that, even though the choice of those products is influenced or determined by intermediaries, such a likelihood of confusion also exists for those consumers since they are likely to be faced with those products, even if that takes place during separate purchasing transactions for each of those individual products, at various times.
>
> 59 It is settled case-law that the perception of the marks in the mind of the average consumer of the category of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion (*Lloyd Schuhfabrik Meyer*, paragraph 25, and Case C-361/04 P *Ruiz-Picassoand Others* v *OHIM* [2006] ECR I-643, paragraph 38).

> 60 In addition, the Court of Justice has already held that the average consumer only rarely has the chance to make a direct comparison between the different signs but must place his trust in the imperfect picture of them that he has kept in his mind (*Lloyd Schuhfabrik Meyer*, paragraph 26, and judgment of 23 September 2004 in Case C-107/03 P *Procter & Gamble* v *OHIM*, not published in the ECR, paragraph 44).
>
> 61 Furthermore, since it is undisputed that the whole process of marketing the goods at issue is aimed at the end-user's acquisition of them, the Court of First Instance was entitled to hold that the role played by intermediaries, even if they are healthcare professionals whose prior intervention is required in order to sell those goods to end-users, must be in part balanced against the high degree of attentiveness which may be shown by those users, in the light of the fact that the goods at issue are pharmaceutical products, when they are prescribed and, consequently, against those users' ability to make those professionals take into account their perception of the trade marks at issue and, in particular, their requirements or preferences.
>
> 62 In this connection, it should be recalled that the Court has already ruled that where the goods or services with which the registration application is concerned are intended for all consumers, the relevant public must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect (Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble* v *OHIM* [2004] ECR I-5173, paragraph 33, and Case C-329/02 P *SAT.1* v *OHIM* [2004] ECR I-8317, paragraph 24).

18) The goods are, primarily, pharmaceutical products. They could all be prescribed/dispensed by healthcare professionals and will be purchased or used by members of the public. There are, therefore, two distinct average consumers to consider as suggested by the above guidance. The end-user will have less technical/specialist knowledge than a healthcare professional.

19) In terms of the degree of care and attention used, this will be higher than the norm (for both types of average consumer) given that the goods are aimed at treating medical conditions. A high degree of importance attaches to the goods given that the products will normally be ingested or taken in some form; taking/prescribing the wrong product could have serious consequences. It is considered that aural and visual considerations equally apply given the various ways in which the goods may be selected, including asking for pharmaceuticals in a chemist or discussing treatments with a doctor. I note that the applied for goods cover more than just pharmaceuticals (e.g. plasters and vitamins); it may be that for these type of goods a more casual approach will be adopted.

Comparison of goods

20) When comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 – "*Meric*") even if there are other goods within the broader term that are not identical. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

> "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 includ*e, inter ali*a, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

21) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

> "(a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

22) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensible for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

> "It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi* v *OHIM – Sissi Rossi* (*SISSI ROSSI*) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi* v *OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam* v *OHIM – Propamsa* (*PAM PLUVIAL*) [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés* v *OHIM – Bolaños Sabri* (*PiraÑAM diseño original Juan Bolaños*) [2007] ECR I-0000, paragraph 48)."

23) In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* were he warned against applying too rigid a test:

> "20. In my judgment, the reference to "legal definition" suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*."

24) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that "in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade"[5] and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning[6]. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

> "..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of

[5] See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

[6] See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

> the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

25) Each of the applied for terms is to be considered with the (fair) specification of the earlier mark which reads:

> "Mucolytic and mucus relieving pharmaceutical substances and preparations, all for use in the treatment of conditions and ailments affecting the respiratory passages of the body"

26) From that starting point, I consider that the following of the applied for terms are identical with the goods of the earlier mark:

> Pharmaceutical preparations; medicines for humans; mucolytic agents; preparations including mucolytic agents; anti-mucolytics

because they are either broad terms which encompass the goods of the earlier mark, or, alternatively, are effectively the exact same product, mucolytics. In relation to identity on the basis of broad terms, I accept that there will also be other goods which fall within the broad term which are not identical, indeed, there may be goods which are not similar at all. I will come back to this issue at the end of my decision if it is necessary to do so. I will now go through the rest of the terms:

Dietetic substances adapted for medical use; Nutritional supplements included in class 5 for humans and/or for animals;

27) The submissions of the opponent are, to the effect, that such goods are for treating medical problems and may be injested, facts which also apply to pharmaceuticals. It is submitted that dietetic substances may be sold as alternative treatments for a particular condition, in competition (or indeed to complement) more conventional medicines. Finally, the possibility of there being shared trade channels through pharmacies and supermarkets is put forward. Whilst this is all noted, the submissions strike me as being pitched at a far too high a level of generality. The goods of the earlier mark are of a specific type (mucolytics) for specific conditions (effecting respiratory passages). There is no evidence before me to suggest that dietetic substances or nutritional supplements are sold for similar purposes. It is not obvious to me that they could. Bearing everything in mind, my finding is that the goods are not similar.

Vitamins; minerals and mineral salts

28) The same analysis applies here, indeed, there is even less prospect of these goods being similar.

Sanitary preparations for medical purposes; plasters, materials for dressings

29) The position here is starker again; I see no prospect of similarity at all given the vastly different nature, purposes and methods of use. The goods do not compete and they do not complement. Any similarity based on trade channels and users is superficial in the extreme. The goods are not similar.

Comparison of marks

30) The competing marks are:

MUCODIS and **MUCODYNE**

31) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

32) The applicant argues in its submissions that the MUCO- element of the respective marks is non-distinctive, so meaning that more emphasis will be placed on the ends of the marks (DIS and DYNE respectively) which, it submits, are not very similar. The opponent argues that even if MUCO- was of weak distinctive character, a whole mark comparison must still be made without dissecting the marks – it notes that the first 5 letters of each mark, MUCOD-, are shared.

33) In terms of evidence, Mr Gallafent (for the applicant) provides a Collins dictionary extract for the word MUCO-, a combining form for mucus or mucous. He also puts forward a reasonably long list of trade marks registered as either UK or Community trade marks registered in class 5 which start with MUCO-, although, it is not clear if they are in use or, indeed, whether they are in use in relation to mucolytics. Mr Gallafent also provides Collins dictionary references for DYNE and DIS, the endings of the respective marks. DYNE is a unit of force, DIS an indication of reversal or negation. Mr Martin (also for the applicant) provides evidence of the existence of another mucolytic product called MUCOCLEAR and, also, a product called MUCOGEL - the latter is for the treatment of gastric ulcers rather than being a mucolytic. This evidence needs to be considered as part of

the assessment of mark similarity (and later in relation to whether there exists a likelihood of confusion), not least because it has the potential to impact upon conceptual similarity and how the marks will be perceived by the average consumer(s).

34) In terms of how the marks will be conceptualised, and whether there are any conceptual similarities/differences between the marks, I must be satisfied that such concepts will be perceived by the average consumer(s). The question is, therefore, based on how the average consumer(s) will see the respective marks, a question that should not be answered following any form of analytical exercise. In terms of concepts, I also bear in mind that marks which make clear evocative references are legitimate considerations[7]. There are two average consumers. In relation to healthcare professionals, they are likely to understand the MUCO- element in each mark, when used in relation to mucolytics and mucus relieving products, as some form of combining form indicating mucus. In relation to the endings of the marks, I doubt that the meaning of DYNE or DIS will be appreciated when the mark is considered as a whole, so the concept is of a made up word albeit one which makes an evocative reference to mucus. However, for other goods (as covered by the applied for mark), including other pharmaceuticals, there will be no evocative meaning as there is nothing inherent in the nature of the goods to provide a relevant cue to mucus.

35) In relation to the end-user, I come to the exact same conclusion. In relation to goods which are being used for the relief of mucus, and whilst the level of specialist knowledge is less, the evocation is still reasonably clear. For other goods there will be no evocation. The net effect of all this is that in relation to mucolytics there is a degree of conceptual similarity on the basis that both marks make some form of evocative reference to mucus. That this is not a particularly distinctive evocation for these goods is a point that will need to be taken into account when I assess whether there exists a likelihood of confusion. From the perspective of other goods, both marks will be seen as invented words so there is conceptual neutrality.

36) My finding that for mucolytics the MUCO- element will be seen as a reference to mucus does not mean that the comparison should be made solely upon the basis of the similarity between DIS and DYNE. As the opponent points out, it is still a whole mark comparison. In terms of the visual similarity between the marks, they share the first five letters MUCOD-, but end differently. From a phonetic viewpoint, the marks are likely to be articulated as MEW-CO-DINE and MEW-CO-DIS. There are points of similarity and difference which results in a medium (but not high) level of visual and aural similarity.

[7] See to that effect, the judgment of 14 February 2008 in Case T-189/05 *Usinor v OHIM* – (GALVALLOY)

Distinctiveness of the earlier mark

37) The degree of distinctiveness of the earlier mark is another important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

38) From an inherent perspective, even in relation to mucolytics, the mark is still reasonably high in distinctiveness irrespective of its evocative suffix because, as a whole, it is an invented word.

39) Evidence of use has been presented which may enhance the level of distinctiveness. I have touched on this already. The mark has clearly been used and has clearly been used on a quite large scale. Mr Martin, for the applicant, comments on the opponent's evidence of use. The context of this is that the opponent enjoyed a monopoly in carbocisteine products (I assume through patent protection), but this changed in 2011 when generic carbocisteine was able to enter the market. By way of background, Mr Martin explains that Mucodyne was originally introduced as a cough medicine in the 1970s but that doctors were then banned from prescribing branded cough medicines at all. Later, carbocisteine was allowed to be prescribed for the treatment of mucus production for patients with cystic fibrosis, but prescriptions had to be written with reference to the generic name not the brand name. Subsequent to this, in 2003, carbocisteine was allowed to be prescribed for the treatment of COPD and it appears that any prescribing prohibition (in relation to the brand name) was lifted for this purpose. Mr Martin explains that whilst the opponent's market share was absolute prior to generic carbocisteine, this has now started to tail off with the market share dropping to the mid 70% by 2013. Mr Martin states, therefore, that the sales the opponent has made are the legacy of its monopoly rather than any form of reputation or goodwill. Mr Martin also provides evidence from a document entitled Prescribing Cost Analysis Data for England which is made available by the NHS. It shows that even when the opponent had a monopoly, doctors would most often write prescriptions with reference to the generic name (carbocisteine) rather than the brand name (Mucodyne); the % of prescriptions written in generic form has ranged between 86% and 92%. Mr Martin states that this shows that doctors did not care whether Mucodyne was being prescribed or not.

40) None of the facts/data provided by Mr Martin have been challenged in any way. His evidence is therefore accepted. However, the impact that the factual scenario he paints is a matter to be decided by the tribunal. From the evidence, it is clear that large amounts of carbocisteine have been prescribed, but presumably, what is then supplied to the patient is identified as Mucodyne (as per the product packaging and leaflets shown in Mr Lair's evidence); this was so in virtually all cases prior to 2011, but still in significant proportions afterwards. In terms of the end user, they will be fully aware of the Mucodyne name (in fact they are likely to have more familiarity with the brand name than the generic name)

because that is what they end up with. In terms of healthcare professionals, pharmacists will clearly know what they are prescribing and will thus be familiar with the Mucodyne name given the large numbers of products prescribed even if they are also aware of its generic name. The same will certainly apply to specialist doctors, but, even for GPs, and even though the prescriptions they write have, in the majority of cases, been for the generic name rather than the brand name, I also consider that due to the knowledge they posses and the reference materials they consult when prescribing, they will also be fully aware that Mucodyne is a brand name, the primary one in relation to carbocisteine products. The consequence of this is that for both healthcare professionals and end users of mucolytics, the Mucodyne mark is a well known name and thus its level of distinctive is enhanced so that it is highly distinctive.

Conclusions under section 5(2)(b)

41) It is clear that the factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG,* paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

42) In so far as identical goods are concerned (mucolytic type products) then I must bear in mind what I have described as the medium but not high level of visual and aural similarity, and that there is some conceptual similarity, albeit that such similarity is based on the part of the mark which gives a not particularly distinctive evocative reference to mucus. However, as the opponent rightly points out, the whole mark must be considered. I must also bear in mind the highly distinctive nature of the mark. Imperfect recollection must also be borne in mind. Whilst it may be true to say that the effects of imperfect recollection are somewhat reduced due to the more attentive way in which the goods are selected, this does not mean that the principal has no role to play at all. However, bearing all this in mind, I consider that the differences in the ends of the marks are sufficiently acute that when the average consumer (both types) encounters the respective marks in accordance with the degree of care I have assessed they will recall the differences. **There is no likelihood of direct confusion.** Whilst I accept the opponent's submission that confusion may arise between marks as a whole even if there are evocative suffixes in play (the case of FEMIVIA/FEMIBION is cited), however, each case must be considered on its own merits and, for the reasons given, I consider there is no likelihood of confusion in this case bearing in mind the whole of the marks.

43) Confusion can, of course, be indirect in the sense that the similarity that exists between the marks is put down to the economic undertakings responsible for the goods being the same or being related. In seems to me that the average

consumer(s) will regard the similarity as mere co-incidence, based primarily on the responsible undertakings using the same evocative suffix. The use of the marks will not signal that the goods come from the same stable. I should stress that I have not based this finding on the list of marks provided in Mr Gallafent's evidence because there is no evidence if they are being used or in relation to what. The evidence of Mr Martin only puts forward one other MUCO- prefixed mark for the type of goods in issue so this does not assist either. My findings are based on what I consider will be the reactions to the respective marks of the average consumer identified. **There is no likelihood of confusion in respect of identical goods.**

44) In relation to other goods, even though the MUCO- evocation may be lost (but not in relation to the earlier mark), I come to the view that the combination of the differences between the marks and the fact that the category of pharmaceuticals will be different, is sufficient to avoid confusion. **There is no likelihood of confusion for the other goods.**

45) In view of all of the above, the opposition under section 5(2)(b) fails.

OTHER GROUND OF OPPOSITION

46) In terms of the other grounds of opposition, there is no greater prospect of success under section 5(4)(a) than there is under section 5(2)(b). For the reasons outlined above, there would be no misrepresentation.

47) Under section 5(3), the opponent's would possess the relevant reputation in terms of the degree of knowledge of the mark in the field of mucolytics. It may be that a link is made given that MUCODYNE has in the past been the only type of carbocisteine and that when another product of that category is introduced which bears a medium degree of resemblance to that product name then the earlier mark may be brought to mind. However, I think the bringing to mind will be a fleeting one and I struggle to see how that leads to any of the heads of damage. In terms of unfair advantage, I do not see how any form of image transfer will occur. The relevant consumers will simply regard MUCODIS as a mucolytic product, a different product to MUCODYNE which happens to use the same evocative suffix. Its job of marketing is no easier and the reputation of MUCODYNE does not in any way pass over to make the MUCODIS product more attractive in any way. These problems arise even before coming to the required unfairness aspect of the head of damage; there is no evidence of intention nor can one, in my view, be assumed and there is nothing else before the tribunal to support this part of the claim. In terms of dilution, the MUCODYNE mark is just as capable of distinguishing it goods from those of others as it was before and, in terms of tarnishing, such a claim simply does not get off the ground. Therefore, although shortly stated, the ground under section 5(3) is also dismissed.

48) The opposition fails in its entirety.

COSTS

49) The applicant has succeeded and is entitled to a contribution towards its costs. My assessment is as follows:

Preparing a statement and considering the other side's statement - £300

Filing and considering evidence - £700

Preparing written submissions - £500

***Total* - £1500**

50) I hereby order Sanofi Aventis Netherlands BV to pay Colonis Pharma Limited the sum of £1500 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 30th day of September 2014

Oliver Morris
For the Registrar,
The Comptroller-General

[i] The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).