

**SUPPLEMENTARY DECISION**  
**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 3085533**  
**by Glaxo Group Ltd**  
**to register in Class 5 the trade mark:**

**EVONTRUS**

and

**IN THE MATTER OF Opposition No. 403995 thereto**  
**by Evonik Industries AG**

1) On 10 December 2015 I issued a written decision (BL O-587-15) in these proceedings, in which Glaxo Group Ltd (“the Applicant”) sought registration of the word mark **EVONTRUS** for the following goods in Class 5: *pharmaceutical and medicinal preparations and substances; vaccines*. The application was opposed under section 5(2)(b) of the Trade Marks Act 1994 by Evonik Industries AG (“the Opponent”). The Opponent relied on its earlier mark **EVONIK**, registered for goods and services in a number of classes, of which only the following goods in Class 5 were relied on for the purposes of the opposition: *pharmaceutical, veterinary and sanitary preparations*.

2) At paragraph 26 of my earlier decision I found that “in addition to products used exclusively by medical professionals and general prescription medication, pharmaceutical and medicinal preparations and substances also include over-the-counter or self-selected goods. I accept that consumers are in general likely to pay greater attention to the purchase of goods which affect their health. However, and in particular bearing in mind the principle of imperfect recollection, I consider that the differences between the marks will not be sufficient to offset their similarities in the mind of members of the general public purchasing the kind of everyday pharmaceutical or medicinal products which are available off-the-shelf in shops, on the internet, etc. For these consumers there is a likelihood of confusion”.

3) At paragraph 27 of my earlier decision I said: “ I have given some thought to whether it is necessary to consider if the specification applied for could be amended so that it would in practice satisfactorily exclude occasion for confusion on the part of consumers who are not medical or healthcare professionals. In this case I have been unable to devise a specification which would achieve this object through simple deletions or by adding a “save for” type of exclusion. In accordance with TPN 1/2012, paragraph 3.2.2 I therefore invite the Applicant to put forward a revised specification and accompanying submissions detailing any types of goods it wishes to register which

- fall within the ambit of pharmaceutical and medicinal preparations and substances;
- are clearly such as to exclude occasion for confusion on the part of consumers who are not medical or healthcare professionals;

- do not fall foul of the guidance issued by the CJEU in the Postkantoor decision.

The Applicant's written submissions, which should be copied to the Opponent, should explain why it considers its suggested specification will clearly exclude occasion for confusion on the part of consumers who are not medical or healthcare professionals. The Applicant is allowed a period of 21 days from the date of this decision in which to file these submissions. On their receipt the Opponent will be allowed 21 days to comment on them. I shall then issue a supplementary decision in which I shall decide whether the proposed specification is free from objection .... I have now received the submissions of both parties.

4) The Applicant initially suggests the following revised specification ("Revised Specification"):

*"Pharmaceutical and medicinal preparations and substances, all of the aforesaid available only on prescription; vaccines"*

The Applicant's submissions on this were as follows:

“6. The Applicant submits that the Revised Specification falls within the ambit of pharmaceutical and medicinal preparations and substances because the words “all of the aforesaid available only on prescription” have the clear effect of limiting the scope of “pharmaceutical and medicinal preparations and substances” to a subset of this term.

7. The Applicant further submits that the Revised Specification excludes occasion for confusion on the part of consumers who are not medical or healthcare professionals because:

7.1.the pharmaceutical and medicinal preparations and substances in question are limited to only those which are available on prescription;

7.2.such goods will by definition only be dispensed by medically and/or healthcare trained individuals who are less susceptible to imperfect recollection, because of the higher level of care and attention they would naturally take when prescribing these goods than would be the case for end consumers or members of the general public purchasing them directly over the counter;

7.3.in addition, and again by definition, these goods would not be available over the counter and as such, end consumers or members of the general public would not have any opportunity to compare goods bearing the respective marks EVONTRUS and EVONIK directly. As a result of the above, there would, in the Applicant's submission, be no opportunity for confusion.

8. The Applicant submits that the Revised Specification does not fall foul of the guidance issued by the CJEU in the Postkantoor decision because the Revised Specification does not include an exclusion, but rather a positive limitation of these class 5 goods (see C-363/99, Postkantoor, paragraph 114)”.

5) In the event that I am not prepared to accept the Revised Specification above, the Applicant also submits the following further specification (the “Alternative Specification”):

*“Pharmaceutical and medicinal preparations and substances, all of the aforesaid for supply only on the prescription of a registered medical practitioner; vaccines”*

6) The Applicant's submissions on this second proposed specification were as follows:

“11. The Applicant submits that the Hearing Officer should accept the Alternative Specification for the same reasons as those set out in paragraphs 6-8 above. In addition, however, the Applicant would draw the Hearing Officer's attention to the fact that the Alternative Specification exactly mirrors wording set out in the Manual of Trade Marks Practice as an example of a limitation which continues to be accepted in specifications of goods (see Classification Desk Instructions, page 22, paragraph 2.21, Territorial and other limitations, attached)”.

7) The Opponent submitted that neither of the Applicant's proposed alternative specifications was clear because, over time, some goods only available on prescription might become over-the-counter goods. Noting that OHIM recognises that prescription practice for pharmaceuticals varies from country to country, it pointed out that practice could change within individual countries.

8) On the issue of confusion the Opponent made the following submissions:

“In the decision the Hearing Officer implicitly held that EVONTRUS vaccines would not be confused with EVONIK vaccines, even to the extent of the consumer thinking they came from the same undertaking. We do not believe that The Hearing Officer held that all controlled drugs sold under the name EVONTRUS could not be confused with the same or different controlled drugs sold under the name EVONIK, or that some controlled drugs sold under the name EVONTRUS could not be confused with over-the-counter drugs sold under the name EVONIK.

Take the example of everyday headache tablets (obviously available over the counter). There is a very marginal difference between OTC analgesics and some prescription analgesics. Paracetamol with codeine is available over the counter, but paracetamol with a slightly higher amount of codeine is prescription only.

The relevant public could surely be confused into thinking that slightly different types of paracetamol codeine analgesics marketed under the brands EVONIK and EVONTRUS could come from the same or economically-linked undertakings. We observe here that the Hearing Officer has held that the marks are similar to a medium degree (paragraphs 19 and 20 of the decision) and that the earlier mark has a high degree of inherent distinctiveness (paragraph 23).

This is of course only one example where confusion is possible between goods within the specification of the earlier mark and the goods of later mark according to the specifications proposed by the applicant”.

9) I do not find it necessary to decide whether either of the Applicant’s suggested alternative specifications lack sufficient clarity; for the purposes of my decision in these proceedings it does not suffice simply to show that a specification would in itself satisfy the requirements for registration as such. I must assess whether there is a likelihood of confusion with the earlier mark. The consumers of prescription drugs will consist not only of doctors who prescribe the medicinal product and pharmacists who dispense that prescribed product, but also of end-users. Vaccines will be supplied to medical and healthcare professionals who administer them to the patient in the course of providing their services. Rarely, if ever, will the patient be exposed to the trade mark under which the vaccine is sold. This is different from the case of prescription medicines, where the end user will routinely obtain the prescribed pharmaceutical product in packaging bearing the producer’s trade mark. I must consider whether, from the point of view of the end-user of prescription pharmaceuticals supplied under the contested mark, there is a likelihood of confusion not only with other prescription pharmaceuticals, but also with, for example, over-the-counter or self-selected pharmaceuticals supplied under the earlier mark, where the purchaser will not necessarily have the assistance of a medical or healthcare professional.

10) At paragraph 26 of my decision of 20 December 2016 I wrote: “I have found that, in addition to products used exclusively by medical professionals and general prescription medication, pharmaceutical and medicinal preparations and substances also include over-the-counter or self-selected goods. I accept that consumers are in general likely to pay greater attention to the purchase of goods which affect their health. However, and in particular bearing in mind the principle of imperfect recollection, I consider that the differences between the marks will not be sufficient to offset their similarities in the mind of members of the general public purchasing the kind of everyday pharmaceutical or medicinal products which are available off-the-shelf in shops, on the internet, etc. For these consumers there is a likelihood of confusion”. For the reasons I have explained in paragraph 8 above, there would still be a likelihood of confusion for this class of consumer even if the Applicant’s specification were confined to prescription-only pharmaceutical and medicinal preparations and substances. Accordingly, I find that in respect both of the originally applied for *pharmaceutical and medicinal preparations and substances* and the suggested alternatives *pharmaceutical and medicinal preparations and substances, all of the aforesaid available only on prescription* and *pharmaceutical and medicinal preparations and substances, all of the aforesaid for supply only on the prescription of a registered medical practitioner* there is a likelihood of confusion.

## Outcome

11) **The opposition has succeeded** both in respect of the originally applied for

*Pharmaceutical and medicinal preparations and substances*

**and in respect of the suggested alternatives**

*Pharmaceutical and medicinal preparations and substances, all of the aforesaid available only on prescription*

**and**

*Pharmaceutical and medicinal preparations and substances, all of the aforesaid for supply only on the prescription of a registered medical practitioner*

Accordingly, **none of the above may proceed to registration.**

I have already held in my decision of 10 December 2015 that **the opposition has failed in respect of**

*Vaccines*

**which may proceed to registration.**

## Costs

12) Given the fairly equal measure of success enjoyed by the parties in these proceedings overall, I do not propose to favour either party with an award of costs.

## Appeal

13) The appeal period both for my decision of 10 December 2015 in this matter and for this supplementary decision will run from the date of this supplementary decision.

**Dated this 28<sup>th</sup> day of January 2016**

**Martin Boyle  
For the Registrar  
The Comptroller-General**