

**O-399-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION NO 3064124  
BY GENERAL NUTRITION INVESTMENT COMPANY  
TO REGISTER THE TRADE MARK**

**PROSTA-T**

**IN CLASS 05  
AND  
OPPOSITION THERETO (UNDER NO. 403212)  
BY TAKEDA PHARMACEUTICAL COMPANY LIMITED**

## BACKGROUND

1) On 14 July 2014, General Nutrition Investment Company ('the applicant') applied to register the following trade mark:

### **PROSTA-T**

The specification of goods has been subject to amendment since the date of filing. It currently reads as follows:

**Class 5:** Herbal dietary and nutritional supplements.

2) The application was published on 08 August 2014 in the Trade Marks Journal and notice of opposition was subsequently filed by Takeda Pharmaceutical Company Limited ('the opponent').

3) The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The following UK Trade Mark ('UKTM') is relied upon:

UKTM details	Goods relied upon
<p><b>UKTM No: 1234431</b></p> <p><b>PROSTAP</b></p> <p><b>Filing date: 28 January 1985</b></p> <p><b>Date of entry in the register: 28 January 1985</b></p>	<p><b>Class 5:</b> Pharmaceutical preparations comprising luteinizing hormone-releasing hormones, for injection and/or sustained release purposes, all for human use.</p>

4) The opponent's trade mark is an earlier mark in accordance with section 6 of the Act and, as it had been registered for more than five years before the publication date of the applicant's mark, it is subject to the proof of use requirements, as per

section 6A of the Act. The opponent made a statement of use in respect of the goods shown in the table above.

5) The applicant filed a counterstatement denying any similarity between the respective marks and goods and any likelihood of confusion. It also requested the opponent provide proof of use of its mark for the goods relied upon.

6) Both parties filed evidence. The applicant's evidence was also accompanied by submissions. Neither party requested to be heard. Only the opponent filed written submissions in lieu. I do not intend to set out the parties' submissions in detail; rather I will bear them in mind and refer to them as, and when, appropriate. I now make this decision after careful consideration of the papers before me.

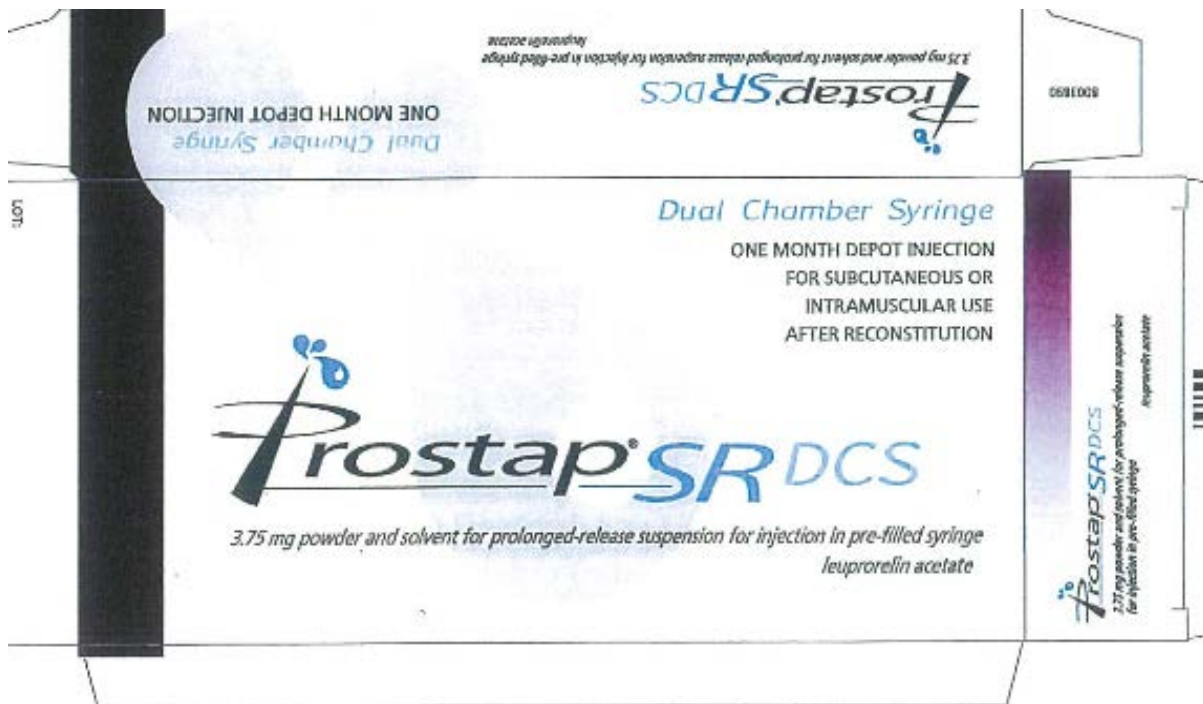
## **EVIDENCE**

### **Opponent's evidence**

7) The opponent's evidence comes from Gen Asano, Interim Brand Director of Takeda UK Limited, which Mr Asano states is the wholly owned UK subsidiary of the opponent. Mr Asano's evidence can be summarised as follows:

- The PROSTAP trade mark is used by Takeda UK limited with the full authority and consent of the opponent.
- The opponent's goods are scheduled pharmaceuticals available solely on Doctor's prescription.
- The opponent's goods have been sold and are currently available in the UK in two presentations that are described on the packaging as i) *Prostap SR DCS* "one month depot injection" and ii) *Prostap 3 DCS* "three month depot injection".
- Exhibits GA1 and GA2 show packaging boxes used for the opponent's goods, one example of which is shown below.

Front of box:



The name of the product is stated, as follows, on the back of the box:

**Prostap<sup>®</sup> SR DCS (3.75 mg)**

- Exhibits GA3 and GA4 show information leaflets from the packaging boxes entitled "INFORMATION FOR THE USER". One such leaflet, shows (amongst other things) the following information:

**PROSTAP<sup>®</sup> SR DCS**  
**3.75 mg Powder and Solvent for Prolonged-release Suspension**  
**for Injection in Pre-filled Syringe**  
**Leuprorelin acetate**

## **1. WHAT PROSTAP SR IS AND WHAT IT IS USED FOR**

**PROSTAP SR is a synthetic hormone which can be used to reduce the levels of testosterone and estrogen circulating in the body.**

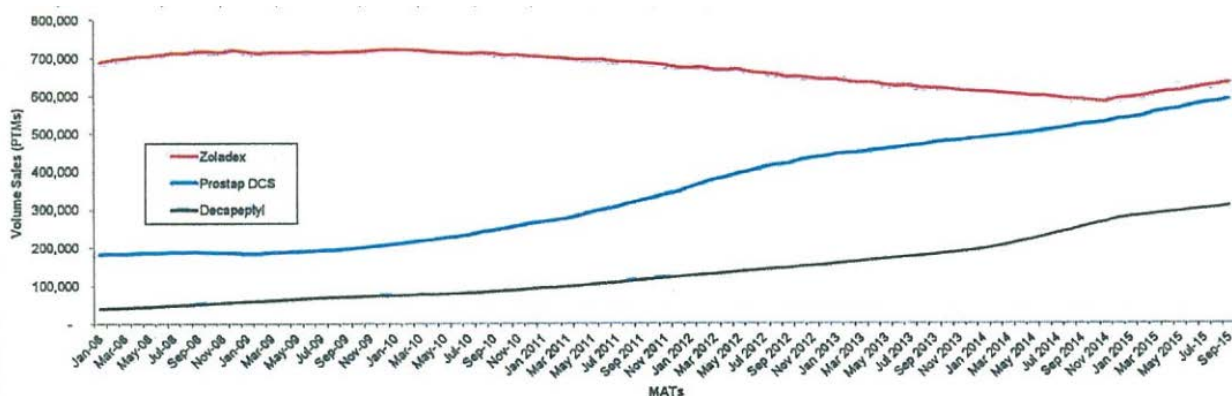
**PROSTAP SR is used to treat prostate cancer in men and endometriosis and uterine fibroids in women. It can also be used to reduce the thickness of the lining (endometrium) of the womb (uterus) in preparation for surgery.**

**The safety and efficacy of PROSTAP SR in children has not yet been established.**

- The opponent has “enjoyed substantial sales” of its PROSTAP pharmaceutical products in the UK. Exhibit GA8 consists of a table showing total sales of PROSTAP goods on a month-by-month basis from April 2004 to September 2015. Mr Asano explains that the figures in the table are abbreviated (e.g. 18,658 refers to £18,658,000). The table shows that sales were in excess of £10,000,000 per month from April 2004 until July 2009. In August 2009 sales totalled £15,666,000. The figures for the following months gradually increase such that the total sales in July 2014 alone amounted to £47,169,000.
- Mr Asano states that the table in Exhibit GA8 also includes a comparison of the monthly turnover achieved by the opponent’s PROSTAP products with the three major competing products of other key manufacturers, namely the DECAPEPTYL SR product of IPSEN PHARMA S.A.S., the FIRMAGON product of Ferring B.V., and ZOLADEX of AstraZeneca UK limited. These four products constitute the UK LHRH (Luteinizing Hormone-Releasing Hormones) market during the period April 2004 to September 2015. Mr Asano states that the figures show the market share enjoyed by the PROSTAP goods of the opponent is “significant”. The figures provided are voluminous. It suffices to record here that the figures relating to the six month period prior to publication of the contested mark are (figures are in £ millions, D = DECAPEPTYL SR, F = FIRMAGON, P = PROSTAP, Z = ZOLADEX and LHRH = Luteinizing Hormone-Releasing Hormone market):

	Jan 2014	Feb 2014	Mar 2014	Apr 2014	May 2014	June 2014	July 2014
D	20,007	19,370	21,553	22,776	21,980	22,771	25,220
F	1,310	1,239	1,370	1,510	1,489	1,500	1,772
P	45,280	38,341	41,307	44,672	43,800	43,810	47,169
Z	52,405	45,510	48,602	49,063	49,038	47,557	50,170
LHRH (Total)	119,002	104,460	112,832	118,021	116,307	115,639	124,330

- Exhibit GA9 consists of the following graph showing the comparison between the volume of sales of DECAPEPTYL (bottom line), ZOLADEX (top line) and PROSTAP (middle line) from January 2008 to September 2015.



- Exhibit GA10 consists of a further table which indicates, inter alia, that the market share enjoyed by the opponent's PROSTAP goods rose from 19.3% in 2008/2009 to 37.9% in 2013/2014.
- Exhibit GA11 contains numerous documents, including invoices, showing the relationship between Clarity Pharma Ltd (the opponent's wholesaler) and Takeda UK Limited. Mr Asano states that Clarity Pharma Ltd take orders for PROSTAP products and then supply these mainly to GP surgeries, dispensing doctor's surgeries, pharmacists and hospitals throughout the UK.
- Exhibits GA12 and GA13 consist of a number of tables which Mr Asano states illustrates the range of customers to whom Takeda UK Limited supplied the

opponent's PROSTAP goods during the period April 2012 to March 2013 (GA12) and January 2013 to January 2015 (GA13). The customers include BOOTS COMPANY PLC, ALLIANCE (FORMERLY UNICHEM), AAH and BAP Pharma and many others, including pharmacies and hospitals.

- Mr Asano states that Takeda UK Limited participates in various UK-based marketing initiatives to increase the awareness of key health professionals and organisations in relation to its PROSTAP pharmaceuticals goods. Exhibit GA14 consists of photographs showing an exhibition stand at the British Association of Urological Surgeons (BAUS) held 23 – 26 June 2014 at the BT Convention Centre in Liverpool. Mr Asano explains that the BAUS exhibition is held in different cities around the UK e.g. Manchester, Glasgow and Liverpool. The following signage can be seen in the photographs:



- Mr Asano states that Takeda UK limited has placed advertisements for PROSTAP products in the newsletter of the British Association of Urological Nurses (BAUN). Examples of advertisements from 2009, 2010 and 2011 are provided at Exhibit GA15. A snapshot of the advert from 2009 is reproduced below:

**Takeda**

Leuprorelin: the world's most widely used LHRHa

**Prostate Cancer is the most common cancer in men in the UK with over 34,000 new cases diagnosed each year!**

Takeda, one of the world's leading research based Pharmaceutical Companies, discovered and developed the first LH-RH agonist, Prostap (leuprorelin acetate) in the mid 1970s. Leuprorelin is the world's most used LHRHa and is licensed for all stages of prostate cancer.

**Now even better value**

As part of the recent PPRS pricing reforms, Prostap prescribing costs have now been significantly reduced<sup>1</sup>.

**Medical Support**

Medical queries should be directed to Takeda UK Ltd. Adverse events and product complaints should be reported to Takeda UK Ltd. on 01226 537500 or email [drugquality@takeda.co.uk](mailto:drugquality@takeda.co.uk)

**What's new at Takeda UK Ltd?**

On the 1st July the Marketing Authorisations for Prostap SR and Prostap 3 in the UK returned to Takeda UK Ltd., with full responsibility for distribution of the products being assumed.

The transfer of Prostap is of significant importance to Takeda given the Company's commitment to working with clinicians and healthcare professionals to deliver more effective therapies for cancer patients.

You can also report directly to the Medicines and Healthcare products Regulatory Agency at [www.yellowcard.gov.uk](http://www.yellowcard.gov.uk)

**Prostap**  
leuprorelin acetate depot injection

PE032020a Date of preparation: September 2009

He further explains that prostate cancer and therapies are a key theme of these advertisements. I note that the advert shown above states, inter alia, “Takeda.... discovered and developed the first LH-RH agonist, Prostap (leuprorelin acetate) in the mid 1970s. Leuprorelin is the world's most used LHRHa and is licensed for all stages of prostate cancer”. Further, the advertisement from 2010 states “...when it comes to prostate cancer treatment, choose an LHRHa that goes beyond what you might expect” and the advertisement from 2011 states “Prostap DCS is indicated for all stages of prostate cancer...” The small print on the second page of the adverts also indicates, under the heading “Dosage and Administration”, that PROSTAP can also be prescribed for the treatment of Endometriosis and Preoperative Management of Uterine Fibroids in women.

- Exhibit GA16 consists of a bundle of advertisements for PROSTAP products extracted from the iSell online platform relating to the period 2011, 2013 and 2014. All of the adverts refer to “PROSTAT DCS” being a LHRH for the treatment of prostate cancer and appear to be aimed at medical healthcare professionals such as nurses and doctors. Some also bear the following mark:





- Mr Asano states that the advertising and marketing budget allocated to PROSTAP products is substantial and has not varied, year-by-year, during the “key period in issue” in these proceedings. Exhibit GA17 comprises, what Mr Asano states are, media and advertising invoices from various media companies used by Takeda UK Limited in which there is specific mention of the PROSTAP brand and product. Under the heading “description” in the invoices, there are items such as “Prostap Prostate Cancer Leaflet” (July 2014, £610.70), “Prostap DCS Demo DVD” (May 2013, £1,065.50), “Prostap Formulary Pack – Revised PI, including pack and distribution” (May 2013, £1,692.00), “Prostap pull up banners” (July 2013, £3,759.93), “Prostap microsite content development” (June 2013, £39,286.00), “Prostap – Advert photography” (April 2013, £39,985.00).
- Exhibit GA18 consists of a further large bundle of invoices which Mr Asano states relate to promotion and advertising of PROSTAP products even though they do not make any specific mention of PROSTAP. Some of the invoices appear to relate to the production of booklets (in 2013) about living with prostate cancer or endometriosis, others relate to expenses incurred through various symposiums or workshops in 2013/14.

### **Applicant’s evidence**

8) This comes from Roger Charles Lush of Carpmaels & Ransford (Trade Marks) LLP, the applicant’s representatives in these proceedings, and can be summarised as follows:

- Exhibit RCL1 consists of the first page of a Google search for the word PROSTA, conducted on 18 January 2016. The page shows 10 results in total, at least 7 of which appear to relate to a product called “Urostemol Prosta capsules”. One refers to a product named “Puncto Prosta”.

- Exhibit RCL2 consists of a printout from 18 January 2016 from the Electronic Medicines Compendium listing details of the Urostemol Prosta product shown in Exhibit RCL1 (i.e. its ingredients, uses, side effects etc.) The product is described as a “traditional herbal medicinal product used for the relief of lower urinary tract symptoms in men related to an overactive bladder, or who have a confirmed diagnosis of enlarged prostate (benign prostatic hyperplasia; BPH).”
- Exhibit RCL3 shows a contents page and layman’s summary report by the Medicines Compendium listing details about Puncto Prosta (one of the Google Search results shown in Exhibit RCL1). This product is also described as a traditional herbal medicinal product for relief of lower urinary tract symptoms in men who have a confirmed diagnosis of enlarged prostate.
- Exhibit RCL4 is a printout from Amazon UK showing details of a product named PROSTAPLEX, which consists of pharmaceutical capsules designed to support prostate health in older men.
- Exhibit RCL5 shows the results of a search of the UK trade mark register for marks in class 5 beginning with the letter string ‘PROST’. Mr Lush states that there are 111 such marks. He further states that a number of the registrations specifically cover pharmaceutical preparations and those for the treatment of the prostate e.g. PROSTABRIT.
- Exhibits RCL6 and RCL7 consist of images taken from the applicant’s US website in January 2016 showing, what Mr Lush states is, an equivalent product to that envisaged to be sold under the PROSTA-T mark. The exhibit shows a product labelled MEGA MEN, below which are the words “Prostate & Virility”. The following descriptions are also present on the product label: “Clinically studied multivitamin”, “Supports prostate health with saw palmetto, pygeum and lycopene” and “Clinically shown to improve vitality”.

## **DECISION**

### **Proof of use**

9) Section 6A of the Act states:

**“Raising of relative grounds in opposition proceedings in case of non-use**

6A. - (1) This section applies where -

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

(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, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

10) Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequently, the onus is upon the opponent to prove that genuine use of the registered trade mark was made in the relevant period.

11) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He stated:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-

9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector

concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”


### **The relevant period**

12) In accordance with section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five year period ending on the date of publication of the contested mark. In the case before me, that period is 09 August 2009 to 08 August 2014.

### **Has there been genuine use in the relevant period?**

13) The opponent’s evidence shows that sales of its prescription-only luteinizing hormone-releasing hormones (‘LHRH’) i.e. “synthetic hormone which can be used to reduce the amount of testosterone and oestrogen circulating in the body”, have been

continuous, significantly large and ever increasing over the relevant period in the UK, as can be seen from the table provided in Exhibit GA8, which indicates that sales in August 2009 alone totalled £15,666,000 and steadily increased, month by month, thereafter such that the total sales in the month of July 2014 alone amounted to £47,169,000. The opponent's share of the UK LHRH market has also increased from 19.3% in 2008/2009 to 37.9% in 2013/2014. It is also clear that the mark, as registered, has been used since, in addition to use in the stylised

form, , there is also use of PROSTAP (word only) on the back of the packaging boxes, on the information leaflet for the user inside those boxes and in the body of the text in advertisements for the opponent's products. In the light of all this, I have no hesitation in finding that the earlier mark has been put to genuine use in the relevant period on, and in relation to, LHRH.

### **Framing a fair specification**

14) Having found that the earlier mark has been put to genuine use in the UK, I now need to consider what constitutes a fair specification. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“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.”

15) In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and

considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In



carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

16) I remind myself that the specification, as registered, reads:

“**Class 5:** Pharmaceutical preparations comprising luteinizing hormone-releasing hormones, for injection and/or sustained release purposes, all for human use.”

The specification, as registered, is already a narrow one. The evidence suggests that LHRH are a recognised category of pharmaceuticals with a specific purpose. It seems unlikely to me that the specification would cover goods which work in very

different ways to PROSTAT or those which would be used to treat conditions for which PROSTAT would be ineffective. Further, as the evidence shows that LHRH can be used to treat more than one medical condition, to limit the opponent's specification to LHRH for the treatment of specific conditions appears to me to be overly picky and so too would a limitation of "for injection only" given that there may be other forms in which the opponent's goods could potentially be administered (such as tablet or capsule form).

17) That leaves the question of whether the specification should nevertheless be amended to take account of all of the use having been made in relation to prescription-only goods. In this regard, I bear in mind that certain pharmaceuticals may be available both with or without a prescription or may switch from being prescription-only to non-prescription over time and therefore it may not always be appropriate to limit a pharmaceutical specification in this way. However, in the case before me, given the way in which the opponent's goods work on the body and the types of conditions they are intended to treat, it seems unlikely to me that they are the sort of pharmaceutical which will switch to being freely available. It is also notable that, in his evidence, Mr Asano makes much of the fact that the opponent's goods are prescription-only. He draws my attention to this on more than one occasion, as he states:

"The PROSTAP branded products of the Opponent are scheduled pharmaceuticals available solely on Doctor's prescription. These products may only be dispensed lawfully by Doctors and Pharmacists."

And

"Bearing in mind that the PROSTAP products of the Opponent are available exclusively on prescription..."

Bearing all of this in mind, together with my view that the average consumer would fairly describe the goods on which the mark has been used as being ones which are 'prescription-only', a fair specification is:

“**Class 5:** Prescription-only pharmaceutical preparations comprising luteinizing hormone-releasing hormones, for injection and/or sustained release purposes, all for human use.”

It is this specification upon which I will base my assessment of the likelihood of confusion under section 5(2)(b) of the Act.

### **Section 5(2)(b)**

18) Section 5(2)(b) of the Act provides:

“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.”

19) The leading authorities which guide me are from the Court of Justice of the European Union (‘CJEU’): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of goods

20) The goods to be compared are:

Opponent's goods	Applicant's goods
<b>Class 5:</b> Prescription-only pharmaceutical preparations comprising luteinizing hormone-releasing hormones, for injection and/or sustained release purposes, all for human use.	<b>Class 5:</b> Herbal dietary and nutritional supplements.

21) In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

“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 include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

22) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a) The respective users of the respective goods or services;

- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

23) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267, Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

24) In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... 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) (IP TRANSLATOR)* [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 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) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...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.”

26) Finally, I also bear in mind that, where it is not obvious to me that there is similarity between any of the respective goods, the onus is on the opponent to present evidence in support of its contentions that there is similarity (see, for example, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97, paragraph 22).

27) Dealing firstly with nature and method of use, the applicant’s goods are “herbal” and are likely to come mainly in tablet or capsule form to be consumed orally. The evidence shows that the opponent’s goods are synthetic hormones which (currently) come in powder and solvent form and are administered by injection. I bear in mind though that they may be capable of being provided in other forms such as tablets or capsules to be taken orally. Accordingly, there is, notionally speaking, overlap in nature and method of use given that the respective goods could come in the same form and be consumed in the same way.

28) Turning to the intended purpose, the evidence shows that the opponent’s goods are used to reduce the levels of testosterone and oestrogen circulating in the body for the treatment of various conditions such as prostate cancer in men and endometriosis and uterine fibroids in women. As regards the applicant’s goods (which are not limited in any way and therefore cover all kinds of “herbal dietary and nutritional supplements”) these, broadly speaking, are likely to be consumed for the purpose of supplementing a person’s diet in order to support or enhance the health

of the body generally or specific parts of the body. I note that the applicant's own evidence indicates that its goods may be used to "Support prostate health..."<sup>1</sup> I find that there is a certain degree of similarity in purpose given that both parties' goods may be used to improve prostate health (albeit that they may do so in different ways).

29) In terms of trade channels, the opponent's goods are those which are prescription-only and will be dispensed through hospitals, pharmacies and doctors surgeries. I would not expect the applicant's goods, being *herbal* in nature, to be the subject of a doctor's prescription and there is no evidence before me to suggest otherwise. My own experience informs me that they are more likely to be freely available in general retailers. I accept though that they may also be available through pharmacies and so there may be some limited overlap in trade channels.

30) The users of the opponent's goods includes the prescriber i.e. health professionals such as doctors, and the end user i.e. the general public. As the user of the applicant's goods will also be the general public, there is some coincidence here.

31) Although both parties' goods may be used for improving a person's health and specifically, the health of the prostate, it is not obvious to me that they would be in competition or have any meaningful complementary relationship and this is not borne out by the evidence.

32) Taking into account all factors, I find the overall degree of similarity between the goods to be low.

### **Average consumer and the purchasing process**

33) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading)*

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<sup>1</sup> Exhibit RCL6



*Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

34) I have already indicated earlier in this decision that the users of the opponent’s goods are likely to include both the prescriber, such as doctors and the end user, the general public. The applicant’s goods, on the other hand, are unlikely to be acquired by prescription but rather will be self-selected by the general public from a retailer/pharmacy. It follows that, the average consumer of the parties’ goods is only the same insofar as the general public is concerned and so it is from the perspective of that consumer that the likelihood of confusion must be assessed.

35) In *Aventis Pharma SA v OHIM*, Case T-95/07 the GC stated:

“29 .... Furthermore, even supposing a medical prescription to be mandatory, consumers are likely to display a high degree of attention when the products in question are prescribed, having regard to the fact that they are pharmaceutical products (ATURION, paragraph 27).”

Further, in *Laboratorios Del Dr Esteve, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-230/07:

“36 In the present case, the Board of Appeal rightly stated that, considering the nature of the goods concerned, being food supplements, the consumer’s level of attention would be rather sustained. It is apparent from case-law that the relevant public’s degree of attentiveness with regard to vitamins, food supplements, herbal, medical and pharmaceutical preparations is higher than

average because consumers who are interested in that type of product take particular care of their health so that they are less likely to confuse different versions of such products (Case T-202/04 *Madaus v OHIM– Optima Healthcare (ECHINAID)* [2006] ECR II-1115, paragraph 33).”

As indicated by the case law above, the level of attention that will be paid by the general public in respect of both parties’ goods will be high. In terms of how the goods will be selected, I would expect the applicant’s goods to be self-selected from the shelves of, for example, a general retailer or pharmacy or perhaps requested orally over the counter. In terms of the opponent’s goods, the general public will acquire these by prescription, after discussions with health care professionals. Bearing all of this in mind, I find that visual and aural considerations are equally important.

### **Comparison of marks**

36) 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. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would therefore be wrong to artificially dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due

weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

## **PROSTA-T v PROSTAP**

37) The opponent's mark, consisting of the single word PROSTAP in plain block capitals, is not readily divisible into separate components; its overall impression is based solely on that word. The applicant's mark consists of PROSTA followed by a hyphen and the single letter T. The opponent argues that 'PROSTA' "must be considered the most dominant and distinctive component" of the applicant's mark because it is a "readily identifiable component which precedes the suffix "-T"". It is true that 'PROSTA' enjoys a prominent position at the beginning of the mark and occupies the greatest proportion of the mark as a whole. However, given that it alludes to the prostate (as conceded by both parties<sup>2</sup>) it is not, of itself, particularly distinctive (at least insofar as goods relating to the health of the prostate are concerned). Bearing this in mind, together with the combining effect of the hyphen, which links that word with the letter 'T', I consider that the distinctiveness of the mark rests in the mark as a whole for goods aimed at the prostate. For other goods, although the allusive message of PROSTA will be lost, again the combining effect of the hyphen results in the distinctiveness resting in the mark as a whole.

38) It is a general rule of thumb that the beginnings of words will tend to have the greatest impact on the consumer's perception.<sup>3</sup> The first six letters of the marks are identical to the eye. In the applicant's mark, those letters are followed by '-T' and, in the opponent's mark, they are followed by 'P'. There is a good degree of visual similarity.

39) The opponent refers me to a number of other cases where marks were considered to be aurally similar such as Viagra and Viagrene, Bud and Budmen etc. I do not find these cases helpful; none of the cases involve marks which bear any resemblance at all to the marks before me, moreover, every case must be assessed

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<sup>2</sup> See paragraph 2.5 of the opponent's written submissions dated 20 May 2016 and page 2 of the applicant's written submissions dated 1 February 2016.

<sup>3</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 [81] - [83]

on its own merits. The applicant's mark will be vocalised as PROST-A-TEE and the opponent's mark as PROST-AP. Again, I bear in mind that, as the opponent states, it is usually the first parts of a mark that will have the greatest impact on the ear and in this case the first syllables are identical and the second syllables are similar.

However, I must also bear in mind that the third syllable in the applicant's mark is entirely absent from the opponent's mark. Where marks are reasonably short in length, as is the case here, the presence in one mark of a syllable which is entirely absent from the other, has a greater impact on the overall level of aural similarity than where longer marks are concerned, even where the relevant syllable is present/absent at the end of the mark. In my view, the marks at issue are similar to no more than a medium degree to the ear when considered as a whole.

40) Both marks, as a whole, have the appearance of being invented in nature. Nevertheless, even invented marks are capable of being evocative or suggestive of a concept(s) if there are aspects of the marks which resemble known words.<sup>4</sup> The opponent submits:

“Both marks incorporate the term “PROSTA” which may be identified as alluding to the goods possessing characteristics that enhance the health of the male prostate gland. Such obvious conceptual similarities would not go unnoticed by the relevant public.”

The applicant submits:

“Conceptually, both marks clearly allude to the prostate...”

It is clear that both parties agree that both marks are likely to be perceived as alluding to the prostate, at least insofar as goods which are intended to treat/promote the health of the prostate are concerned. There is therefore some conceptual similarity despite the invented nature of the marks as a whole. I will, however, need to bear in mind that that is not a particularly distinctive allusion in the context of those goods. As regards other goods there will be nothing to lead the consumer to

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<sup>4</sup> *Usinor SA v OHIM* (Case T-189/05)

perceive that allusive message. In those circumstances, the marks would be neither similar nor dissimilar; the conceptual position would be neutral.

### **Distinctive character of the earlier mark**

41) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

The applicant argues that ‘PROSTA’ is commonplace in the market for medicinal products concerned with the prostate and, consequently, the opponent’s mark is of low distinctiveness. In support of this, it refers me to the evidence of Mr Lush showing three other medicinal products sold in the UK concerned with the prostate

e.g. UROSTEMOL PRSTA, PUNCTO PROSTA and PROSTAPLEX and to a number of marks on the trade mark register starting with the string 'PROST' in class 05. The list of trade mark registrations gives no indication of the goods for which those marks are registered and there is nothing to indicate that any of those marks are actually in use. Further, the examples of medicinal products on sale, of which there only three, are not directly on point since none appear to be used in relation to LHRH. For these reasons, the applicant's evidence does not assist me.

42) I have already indicated that, inherently, the earlier mark is likely to allude to the prostate (at least insofar as goods aimed at that part of the body are concerned) by virtue of the 'PROSTA' aspect of the mark. However, I must not lose sight of the mark in its entirety. Given that PROSTAP, as a whole, is an invented word, I find that it is possessed of a good degree of distinctiveness despite the allusive reference.

43) As there is also evidence of use before me it is necessary to consider whether the distinctiveness of the mark has been enhanced through that use. Sales of the opponent's goods have been consistent and substantial under the mark PROSTAP in relation to LHRH. The opponent's share of the UK LHRH market was 37.9% in 2013/2014, being only slightly below that of the market leader, Zoladex. Whilst all of the advertising literature in relation to PROSTAP appears to be directed at health care professionals rather than the general public and therefore, the distinctiveness of the mark may have been elevated to a greater degree in the eyes of the former rather than the latter, the enormity and frequency of sales alone suggests that the mark will, in any event, have been elevated to a high degree in the eyes of the general public given that they will have been prescribed those goods, all of which bear the PROSTAP mark.

### **Likelihood of confusion**

44) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the more distinctive the earlier mark is, the greater the

likelihood of confusion (*Sabel BV v Puma AG*), and; iii) imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

45) I have found that the earlier mark is highly distinctive in the eyes of the relevant average consumer (the general public) which is an important factor weighing in the opponent's favour. I have also found that the marks are visually similar to a good degree and aurally similar to a medium degree; these factors are also important because the goods will likely be encountered both orally and visually when they are acquired by the average consumer. However, although the marks share some conceptual similarity, this stems from a common allusion to the prostate (at least in the context of goods aimed at the prostate) which, for obvious reasons, is not a particularly distinctive allusion in relation to those goods. Further, I have found that the goods are similar to only a low degree. Weighing these factors against each other and having regard for the high degree of attention that will be paid (militating against the marks being misremembered), I come to the conclusion that the marks are unlikely to be mistaken for each other; there is no likelihood of direct confusion. I also come to the same conclusion where the goods are not aimed at the prostate. Although, in those circumstances, the conceptual position would be neutral, meaning that the consumer would have no conceptual hook to aid his memory, the high degree of attention that would be paid and the low degree of similarity of the goods, when weighed against the other factors means that there is no likelihood of direct confusion in that scenario either.

46) As to whether there is nevertheless a likelihood of indirect confusion, on this matter, it is helpful to consider the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, where he stated:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on

the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

The circumstances of the case before me do not fall within any of the three categories identified by Mr Purvis. Whilst I bear in mind that these categories are illustrative rather than exhaustive, I also cannot see any other manner in which the marks are likely to be indirectly confused whether the goods are aimed at the prostate or not.

**The opposition fails.**



## **COSTS**

47) As the applicant has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 4/2007, I award the applicant costs on the following basis:

Preparing a statement and considering the opponent's statement	£200
Preparing written submissions	£300
Preparing evidence and considering the opponent's evidence	£500
<b>Total:</b>	<b>£1000</b>

48) I order Takeda Pharmaceutical Company Limited to pay General Nutrition Investment Company the sum of **£1000**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16th day of August 2016**

**Beverley Hedley**  
**For the Registrar,**  
**the Comptroller-General**