

O-297-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3276998
BY DR REDDY'S LABORATORIES (UK) LIMITED
TO REGISTER THE TRADE MARK**

ARONIX

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 412561 BY NOVARTIS AG**

Background and pleadings

1. On 13 December 2017, Dr Reddy's Laboratories (UK) Limited ("the applicant") applied to register the trade mark **ARONIX** under number 3276998 ("the contested mark"). It was published on 23 February 2018 in respect of "pharmaceutical and veterinary preparations, in particular sildenafil", in class 5.

2. The application is opposed by Novartis AG ("the opponent"). The opposition, which is based upon s. 5(2)(b) of the Trade Marks Act 1994 ("the Act"), is directed against all of the goods in the application. The opponent relies upon its earlier International (EU) trade mark number 1262636 for the trade mark **ARODIGE**. The mark was registered on 29 June 2015 and the EU was designated on the same date. A priority date of 19 June 2015 from Swiss trade mark number 675021 is claimed. Protection in the EU was granted on 29 June 2016. The mark is registered in class 5 for "pharmaceutical preparations", which are the goods relied upon.

3. The opponent claims that the marks are similar and that the goods are identical, which will give rise to a likelihood of confusion, including the likelihood of association.

4. The applicant filed a counterstatement denying the grounds of opposition.

5. Given its date of priority, the opponent's mark qualifies as an earlier mark in accordance with section 6 of the Act. As it had not completed its registration process more than 5 years before the publication date of the application in suit, it is not subject to the proof of use provisions contained in s. 6A of the Act. The opponent may rely upon all of the goods it has identified, without showing that it has used the mark.

6. Both parties filed evidence. The matter came to be heard before me, by videoconference, on 8 May 2019. The opponent was represented by Simon Bentley, for Abel & Imray. The applicant was represented by Duncan Curley, for Innovate Legal Services Limited.

Case Management

7. During the proceedings, a case management conference was held regarding an extension of time request made by the applicant. The request was partially allowed, for the reasons which I gave in my letter of 21 January 2019.

Evidence

8. Both parties' evidence contains a mixture of evidence and submissions. The latter are taken into account but there is no need for me to repeat them here.

Opponent's evidence in chief

9. This consists of the witness statement of Antoinette Lachat, who has been a Senior Trade Mark Specialist at the opponent since 2007.

10. Ms Lachat states that brand names containing the prefix "ARO-" are not common.¹ She provides the results of a "UK pharma in-use search for marks beginning with ARO-".² There are 82 results, four of which include marks beginning with "ARO-": "AROMASIN" (launched in 2001, last recorded sales 2018), AROMAT CHALK OPIUM (no launch date, last recorded sales 2018), "MAG CARB AROM OTM" (launched April 2002, last recorded sales 2005) and "MAG CARB AROMAT" (no launch date, last recorded sales 2012).

Applicant's evidence

11. This consists of the witness statement of Samantha Beaumont, who is the UK Associate Director- Marketing for the applicant. She has held the position for nine years.

¹ Lachat 1, §3.

² Exhibit AL1

12. Ms Beaumont provides prints from the National Institute for Health and Care Excellence (“NICE”)- British National Formulary.³ “AROMASIN”, “AROVI” and “AROVIT” are listed. No dates are visible. She explains that AROMASIN is a “cancer treatment medication that has been around for nearly 20 years”.⁴

13. There is produced a list of results from a “pharmaceutical names in use” search for the terms “ARONIX”, “ARO*” and “NIX”.⁵ None of the pharmaceuticals beginning with “ARO” appears to be in use in the UK.

14. The results of a trade mark search for marks protected in the UK in class 5 and beginning in “ARO” are provided.⁶ It would appear that 222 marks are shown in list form, with further details of selected marks also provided.

15. Ms Beaumont provides copies of UK Register details of two trade marks “RODIGE” and “ARODIGE”, which she says were the only results of a search for marks with the suffix “-DIGE”.⁷

Opponent’s evidence in reply

16. This consists of the second witness statement of Ms Lachat. She indicates that AROMASIN is a product on the UK market for the treatment of cancer, adding that it is an aromatase inhibitor, a class of drugs used to treat breast cancer in postmenopausal women and gynecomastia in men.⁸

17. Ms Lachat also gives evidence that NICE registration does not mean either that the drug is in use in the UK or that there have been any sales of it.⁹ Ms Lachat exhibits a page from www.mims.co.uk, which she claims is “the leading reference database for

³ Exhibit SB-1.

⁴ §3.

⁵ SB-2.

⁶ SB-3.

⁷ SB-4 and §7.

⁸ Lachat 2, §4.

⁹ Lachat 2, §6.

pharmaceutical products currently on the UK market”.¹⁰ The database search result for AROVIT returned no results. The only visible date is the printing date of 31 January 2019. A further search results page from www.drugs.com indicates the countries where “AROVIT” may be available.¹¹ The UK is not listed.

18. Ms Lachat also provides a print from www.gccprescribing.org.uk, which contains the details of a drug’s name change from BECAT to AROVI.¹² It was published on 20 August 2018 (i.e. after the application date).

19. That completes my summary of the evidence, to the extent I consider necessary.

Section 5(2)(b)

20. Section 5(2)(b) of the Act reads as follows:

“5 (2) A trade mark shall not be registered if because -

[...]

(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”.

21. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co*

¹⁰ AL2 and Lachat 2, §6.

¹¹ AL3.

¹² AL4.

GmbH v Klijsen Handel B.V., Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, EU:T:2006:247, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

23. There appears to be no dispute that the applied-for “pharmaceutical preparations, in particular sildenafil” are identical to the earlier mark’s “pharmaceutical preparations”. As “in particular” has no limiting effect, that is clearly the case.

24. Mr Bentley submitted that “veterinary preparations” are identical to “pharmaceutical preparations”, the latter not being limited to medicines for humans. Dr Curley’s skeleton argument indicated that the applicant maintained that there was no identity but, when I asked him at the hearing if this was the applicant’s position, he stated only that the applicant has no interest in veterinary preparations.

25. I agree with Mr Bentley that “pharmaceutical preparations” implies medical drugs, and that the term is not limited to drugs for a particular species. I see no reason why pharmaceutical preparations would not include veterinary preparations. These goods are identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

26. Both parties agreed at the hearing that there are two groups of relevant consumer for pharmaceuticals, namely members of the public and healthcare professionals, as accepted in *Mundipharma AG v OHIM*, Case T-256/04, EU:T:2007:46.

27. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect (*Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch)). For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik*.

28. Mr Bentley submitted that the average consumer will pay a reasonably high level of attention. Dr Curley submitted at the hearing that the level of attention will be higher than average for the general public and higher still for medical professionals. This is somewhat at odds with the claim to a high level of attention in his skeleton argument.¹³

29. Given that the goods are likely to affect the consumer's state of health, I will proceed on the basis that the general public will, when purchasing pharmaceuticals, pay at least a reasonably high level of attention. The level of attention paid by professionals is likely to be high, given the potentially more powerful drugs and serious consequences of mistakes.

30. The purchase is likely to be mainly visual for both groups, with the general public selecting goods from the shelves in retail premises and professionals consulting specialist publications, whether online or in hard copy. The selection process for both groups may also involve aural considerations, for example through advice being sought prior to purchase or discussion with representatives from pharmaceutical companies.

Comparison of trade marks

31. It is clear from *Sabel* (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 Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in *Bimbo*, 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

¹³ Applicant's skeleton, §20.

light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

32. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given 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:

Earlier mark	Contested mark
ARODIGE	ARONIX

33. Mr Bentley submitted that the marks are visually and aurally similar to a high degree, stressing the position of the shared letters “ARO” and the similar length of the words. He submitted that they are conceptually neutral. Dr Curley argued that the marks have no visual, aural or conceptual similarity.

34. The earlier mark comprises the word “ARODIGE”, presented in capital letters. The overall impression is of the word as a whole.

35. The later mark is also a single word, “ARONIX”, presented in capital letters. The overall impression of the mark is contained in the word.

36. Visually, there is some similarity because both marks begin with the letters “ARO”. Both marks also have a letter “I” as the fifth letter. However, there is some difference in the later parts of the marks, the earlier mark ending in the letters “DIGE” and the later mark “NIX”. I bear in mind that the first part of a mark usually has more impact. Nevertheless, I consider that overall the marks are visually similar to a medium degree.

37. The earlier mark may be pronounced as “A-RO-DEEJ” or “A-RO-DIJ”, or potentially “A-RO-DEE-JAY” or “A-RO-DI-JAY”. I think it unlikely that the “IGE” syllable will be pronounced as in “oblige”, as suggested by Dr Curley.¹⁴ The later mark is likely to be articulated as the three-syllable word “A-RO-NIX”. If the earlier mark is pronounced as a three-syllable word, the first two of which are identical with the first two syllables of the later mark, there is a medium degree of aural similarity. Where the earlier mark is pronounced as four syllables, the level of aural similarity is fairly low.

38. Neither mark has a meaning. Without either mark having a meaning, there is no scope for the marks to be conceptually different. The conceptual position is, therefore, neutral.

Distinctive character of the earlier trade mark

39. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public: *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings: *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97, EU:C:1999:230, [1999] ETMR 585.

40. I note Dr Curley’s submissions that “ARO” is not distinctive of the opponent and that the evidence undermines the claim to a high level of inherent distinctiveness. The evidence filed by the parties is insufficient to show that “ARO-” would have been perceived in any particular way by the average consumer at the relevant date, given that much of it concerns other territories, is after the relevant date or is entirely without

¹⁴ Applicant’s skeleton, §8.

context.¹⁵ There is no claim to enhanced distinctiveness. The earlier mark is an invented word and is inherently highly distinctive.

Likelihood of confusion

41. The factors considered above have a degree of interdependency and must be weighed against one another in a global assessment (*Canon* at [17]; *Sabel* at [22]). They must be considered from the perspective of the average consumer and a determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“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

¹⁵ On the irrelevance of trade mark search results (“state of the register” evidence), see the GC’s comments in *Zero Industry Srl v OHIM*, Case T-400/06, EU:T:2009:331, at [73].

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”.

43. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

44. The opponent’s primary case is that there is a likelihood of direct confusion but it also claims that a consumer might suppose the marks come from the same stable. From the opponent’s perspective, its best case is where the marks are visually and aurally similar to a medium degree, the position being neutral in respect of the conceptual comparison, and where the average consumer pays only a reasonably high, rather than high, level of attention. I consider that position first. The goods are identical and the earlier mark is inherently highly distinctive. Those are both factors in the opponent’s favour. The fact that the earlier mark is an invented word means in particular that the consumer is more prone to the effects of imperfect recollection, there being no conceptual hook upon which to hang one’s memory of the word. The somewhat elevated level of attention with which the goods at issue will be purchased is, however, a factor in the applicant’s favour. Whilst acknowledging the high level of distinctiveness of the earlier mark, and that the consumer may not readily recall precisely what one mark is, I consider that the differences between the marks as wholes are nevertheless sufficient to avoid the consumer believing that one mark is the other. The opponent has not established that “ARO” on its own is distinctive of the opponent and I can see no logical step by which the consumer would be led to believe that “ARONIX” is another brand of the same undertaking. Taking all of the competing factors into account, my view is that there is no likelihood of confusion, whether direct or indirect. It follows that there is even less likelihood of confusion where the marks are less similar, or where

there is a higher level of attention on the part of the consumer, and the opposition is dismissed accordingly.

Conclusion

45. The opposition has failed. Subject to appeal, the application will be registered.

Costs

46. The applicant has been successful and is entitled to an award of costs, which are sought on the usual scale (contained in Tribunal Practice Notice 2/2016). I award costs to the applicant as follows:

Considering the notice of opposition and preparing the counterstatement: £200

Preparing evidence and considering the other party's evidence: £500

Preparing for and attending a hearing: £800

Total: £1,500

47. I order Novartis AG to pay Dr Reddy's Laboratories (UK) Limited the sum of **£1,500**. 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 30th day of May 2019

Heather Harrison

For the Registrar

The Comptroller-General