TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 10595 BY BOEHRINGER INGELHEIM KG FOR A DECLARATION OF INVALIDITY IN RESPECT OF TRADE MARK No 2002897 IN THE NAME OF DALLAS BURSTON ASHBOURNE LIMITED

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 10595 by Boehringer Ingelheim KG for a Declaration of Invalidity in respect of trade mark No 2002897 in the name of Dallas Burston Ashbourne Limited

DECISION

Trade mark No 2002897 is registered in Class 5 for "pharmaceutical preparations and substances, all containing Ipratropium". The mark is the word IPRATROPIOVENT. It stands registered from the filing date of 19 November 1994.

By application dated 18 February 1999 Boehringer Ingelheim KG applied for this registration to be declared invalid. They say that they are the proprietors of, and have used, the following earlier trade marks:

No	Mark	Class	Journal	Specification
999121	ATROVENT	5	4952/1425	Pharmaceutical, veterinary and sanitary preparations and substances; medical and surgical plasters; material prepared for bandaging; disinfectants and antiseptics; and preparations for killing weeds and destroying vermin
1079667	DUOVENT	5	5218/1841	Pharmaceutical, veterinary and sanitary preparations and substances; disinfectants (other than for laying or absorbing dust); and antiseptics
1189134	OXIVENT	5	5529/2232	Pharmaceutical preparations for the treatment of asthma, spastic bronchitis and perennial rhinitis
1209355	COMBIVENT	5	5563/0948	Pharmaceutical, veterinary and sanitary preparations and substances; disinfectants (other than for laying or absorbing dust); antiseptic preparations

Objections are, therefore, said to arise:

(i) under Section 47(2)(a) having regard to Section 5(2)(b)

(ii) under Section 47(2)(b) having regard to Section 5(4)(a) (and, inter alia, to the law of passing off)

(iii) under Section 47(1) having regard to the provisions of Section 3(1)(b).

The registered proprietors' agents indicated by letter dated 28 May 1999 that they had no instructions to submit a detailed counterstatement beyond a denial of the above grounds. Reference was also made to a successful defence in opposition proceedings against the then application. I comment in passing that I understand that that opposition was deemed abandoned without evidence being filed.

The applicants ask for an award of costs in their favour. Only the applicants filed evidence. The parties were invited to say whether they required a hearing. As neither side made any such request the Registry indicated that a decision would be taken from the papers filed. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Applicants' evidence

The applicants filed two statutory declarations by Georgina Lonsdale, the Marketing Development Manager of Boehringer Ingelheim Ltd, an associate company of the applicants.

Ms Lonsdale says that the Boehringer companies are active in the field of respiratory healthcare and have been marketing pharmaceutical products in the UK under various marks, including ATROVENT, DUOVENT, OXIVENT and COMBIVENT for many years (these are the earlier trade marks referred to above).

ATROVENT was first introduced in the UK in 1977. The wholesale value of sales is given as follows (taking the period up to the material date in these proceedings):

Year ending	**Sales**
1992	£16,654,000
1993	£19,166,000
1994	£23,491,800

ATROVENT is said to be the number one brand in its class with a market share of approximately 50 per cent according to British Pharmaceutical Index Data.

Samples of publicity materials and advertisements are exhibited at GL1.

The DUOVENT product is said to have been introduced in the UK in 1982, OXIVENT in 1991 and COMBIVENT in 1994. These products have a combined annual turnover in excess of £18 million. Advertising and promotional expenditure on the whole respiratory range is

given for the years 1995 and 1999 ranging from £1.3 million to £2.2 million. No figures are given for periods up to and including the material date.

In the UK there are some thirty wholesalers where the above named products are available. There are said to be in excess of twelve thousand pharmacies which normally have several packs of the products for dispensing.

Ms Lonsdale goes on to comment as follows on her reasons for believing that confusion will arise if the mark in suit is allowed to remain on the register:

> "All four products are used in the treatment of respiratory ailments and diseases such as bronchial asthma and chronic obstructive pulmonary disease. Ipratropium bromide is a major generic chemical used in such treatments, either as the sole active ingredient or in combination with other generic compounds. For example, the sole active ingredient in ATROVENT is ipratropium bromide however, DUOVENT and COMBIVENT combine ipratropium with fenoterol and salbutamol respectively. OXIVENT uses a different active ingredient - oxitropium bromide. The products are available only on prescription and are provided in a variety of strengths and delivery devices such as pressurised metered dose inhalers (MDI), breath-activated MDI, nebuliser solutions and dry powder inhalers.
>
> Treatments which have ipratropium or oxitropium bromide as their main active ingredient are referred to as anticholinergics. With the marks ATROVENT, COMBIVENT, DUOVENT and OXIVENT, Boehringer have a monopoly in "VENT" suffixed marks in relation to anticholinergic products for use in respiratory healthcare.
>
> There is now produced and shown to me marked "GL2" pages from the alphabetical index of the Monthly Index of Medical Specialities illustrating this assertion.
>
> It is my belief that the prefix "IPRATROP" in the applicant's [1] mark must, in order to avoid deception on the part of the relevant public, mean that goods bearing the mark have ipratropium as their main active ingredient, ie they are anticholinergics. Consequently, due to Boehringer's monopoly in "VENT" suffixed marks in relation to anticholinergics, it is an inescapable conclusion that there is an extremely strong likelihood of confusion as to the origin of the applicant's mark.
>
> One use of the ATROVENT product is in conjunction with Boehringer's patented pressurised metered dose inhaler (MDI). If a patient requires treatment with an ipratropium MDI there is currently only one product on the market which fulfills this requirement - ATROVENT MDI. This has been the case since 1977. A doctor would prescribe ATROVENT MDI by either writing "ATROVENT inhaler" or the generic name "Ipratropium inhaler" on the prescription. Since the launch of ATROVENT in 1977, no matter which version has been written on prescriptions, an ATROVENT

[1] This and subsequent references in the passage from Ms Lonsdale's declaration should, I think, have referred to 'registered proprietors'.

MDI has had to be dispensed by the pharmacist. The applicant's use of IPRATROPIOVENT will clearly cause confusion as it is a combination of the trade mark ATROVENT and the generic name ipratropium.

I consider that there is a high degree of similarity between the trade mark IPRATROPIOVENT and the trade mark ATROVENT and I believe that confusion would arise between the trade marks IPRATROPIOVENT and the trade mark ATROVENT."

Finally Ms Lonsdale expresses the belief that "IPRATROPIUM (I think this should have been IPRATROPIOVENT) is far too close to the generic chemical name ipratropium to be afforded monopoly protection .....".

Ms Lonsdale's second declaration is for the purpose of exhibiting the results of a questionnaire survey conducted on the applicants' behalf by Le Ber Associates. Le Ber operate a service whereby questionnaires can be sent to a panel of General Practitioners by pharmaceutical companies. Participants are initially recruited through a random mailing list exercise. From the responses received a panel of about 300 GPs is selected using national demographics to provide a representative sample. The questionnaires are varied and cover a number of topics on behalf of a number of companies in one go. The GPs receive vouchers from shops such as Marks & Spencer, John Lewis etc as an inducement to complete the questionnaires. I will deal with the specific questions and the results of the questionnaire exercise in my decision below.

That completes my review of the evidence.

I will deal firstly and briefly with the objection under Section 3(1)(b) that the mark should not be registered as it is devoid of distinctive character. The applicants say it is too close to the generic chemical name ipratropium. It is, of course, not necessarily a criticism of a mark that it alludes to the goods. In this particular case I note that the specification is limited to goods containing ipratropium. The registered proprietors have, therefore, made no attempt to conceal the basis of the first element of their mark. But it is the mark as a whole I must consider. I have no hesitation in coming to the view that the mark applied for is sufficiently far removed from the generic chemical name that there can be no objection under Section 3(1)(b).

Section 5(2)(b) reads:

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

(a) .....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

The European Court of Justice has provided guidance for the consideration of matters under this Section of the Act in *Sabel BV v Puma AG (1998 RPC 199 at 224), Canon v MGM (1999 RPC 117* and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV (1999 ETMR 690 at 698)*. It is clear from these cases that:-

(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/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;

(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 therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

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

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

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purpose;

(h) but if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section.

It will be apparent from the above evidence summary that the applicants base their case primarily on the likelihood of confusion between the mark applied for, IPRATROPIOVENT, and their mark ATROVENT though they also rely on three other marks in support of their claim to a monopoly in -VENT suffixed marks. The applicants have also supplied evidence of use of their ATROVENT mark and to a lesser extent the other three marks relied on. So far as the supporting exhibits (GL1) are concerned, where dates are discernible they are sometime after the material date. This point aside there is sufficient supporting comment and explanation that I am prepared to infer that ATROVENT can claim an enhanced level of distinctive character as a result of the use made of it ((f) above). I note, for instance, that in 1998 ATROVENT is said to have been the number one brand in its class with a market share of approximately 50 per cent. It is true that 1998 is after the material date but sales were at

roughly the same level in 1994 so it is reasonable to assume the claim was sustainable at the earlier date. Also the claim has not been challenged.

With those preliminary comments in mind I go on to consider the respective marks and the likelihood of confusion. This is not a case where a claim to visual or aural similarity is made save in respect of the suffix -VENT. Taking the marks IPRATROPIOVENT and ATROVENT as wholes I see absolutely no danger of confusion on these accounts. What the applicants rely on is more in the nature of conceptual confusion. They say that the first element of the registered proprietors' mark suggests, as is the case, that the goods contain ipratropium and further that their own goods sold under the mark ATROVENT (a mark that is pre-eminent in the marketplace) have as the sole active ingredient ipratropium bromide. This, taken with the applicants' claimed monopoly in -VENT marks will, they say, lead to confusion.

In support of this proposition a questionnaire survey has been undertaken. It will be convenient at this point to consider this evidence. I have set out above the basis on which the survey was conducted. By way of general comment it should be noted that the survey appears to have been conducted some five years after the material date. Secondly the questionnaires were directed towards GPs only. The applicants' goods are sold through wholesalers to pharmacies and then on to patients. Whilst GPs no doubt have a key role in prescribing the products their views represent only one of the groupings in the purchasing/supply chain. My rather greater concern, however, is the process by which the questionnaire survey was conducted. Mailing a questionnaire for completion gives considerably less control over the process by which questions are answered than if they were put sequentially by trained interviewers. In particular it may lead to respondents reading all the questions first so that the answers to earlier questions are subliminally affected by the direction taken by later questions. I do not say that this wholly undermines the value of such an exercise merely that some caution must be exercised where part of the normal control mechanism is not present.

The questions were:

1. Assuming a drug were to be launched with the name Ipratriopiovent, do you feel it would be ..... Generic compound
   Branded drug
   Branded Generic?

2. If Ipratropiovent were to be used as a brand name, which of the following companies do you feel would most likely be the manufacturer?
   Allen & Hanburys
   3M Healthcare
   AstraZeneca
   Boehringer Ingelheim
   Glaxo Wellcome
   Baker Norton
   Generic Manufacturer

3. For what particular reason do you associate (company name) with Ipratropiovent?

4. If a product was called Ipratropiovent, would there be any confusion with any other generic or branded products, and if so, which ones?

Some 203 GPs responded. The answers to the above questions were as follows:

1.	Uncertain	2	1.0%
	Generic Compound	52	25.6%
	Branded Drug	53	26.1%
	Branded Generic	96	47.3%
2.	Uncertain	2	1.0%
	Allen & Hanburys	51	25.1%
	3M Healthcare	2	1.0%
	Astra Zeneca	10	4.9%
	Boehringer Ingelheim	**70**	**34.5%**
	Glaxo Wellcome	4	2.0%
	Baker Norton	34	16.7%
	Generic Manufacturer	30	14.8%

3. The following reasons were given for an association between Boehringer Ingelheim and Ipratropiovent (that is to say in the 34.5% of cases referred to in question 2)

%	
57.1	related to Atrovent
30.0	are the only company marketing ipratropium

The remaining answers indicate either an association with other Boehringer Ingelheim products or the fact that the latter are known for asthma products or other reasons.

4.

%	
39.4	Ipratropium
29.6	Atrovent
26.1	No/None
8.9	Combivent
3.9	Duovent
3.9	Serevent

(top 6 responses only).

On the basis of the above answers it can reasonably be said in the applicants' favour that in response to question 2 they were regarded as the most likely source for goods sold under the mark IPRATROPIOVENT (34.5% of respondents). Of the 70 GPs who made up the 34.5% over half (57.1%) made the association because they considered the name related in some way to ATROVENT. The only other large grouping (30%) made the association with Boehringer Ingelheim because they were thought to be the only company marketing ipratropium. In

relation to question 4 which asks specifically about confusion with generic or branded products the main response relates to the generic chemical name (39.4%) with the branded product Atrovent second (29.6%) and no confusion (26.1%) the only other large grouping. A number of points arise from the questions and the responses themselves.

(i) question 2 is not open ended. It invites respondents to speculate on a likely manufacturer from a limited list of names and without an 'other' or 'don't know'category;

(ii) question 3, although open ended in itself, takes as its starting point the answer to the limited response range available from question 2. It is clear also from the supporting comments that an element of speculation is involved in the answers with a number of respondents admitting to guesses;

(iii) the answers to question 3 make it clear that a significant number of respondents think (rightly or wrongly) that Boehringer Ingelheim are the only company marketing ipratropium. The association is, therefore, with the principal or only source of a generic chemical rather than a brand association as such;

(iv) as ATROVENT has a dominant market share and ipratropium as its sole active ingredient it is not surprising that an association was made with Boehringer Ingelheim but it is not necessarily indicative of brand confusion;

(v) the structure of the questionnaire is such that the issue of confusion is not raised until question 4 by which time respondents have been invited to speculate on association with a particular manufacturer and the reasons for that association. Even so the main reaction was to link the mark with the generic chemical rather than Atrovent.

Of the 34.5 per cent of respondents who suggested Boehringer Ingelheim as the most likely manufacturer of products under the mark IPRATROPIOVENT just over half (57.1 per cent) did so because they considered it related in some way to ATROVENT. That is 19.6 per cent of the total responses. Even that figure has to be seen against the background of the inherent weaknesses in the structure of the questions and to a lesser extent the absence of control in the conduct of the survey. A large percentage of respondents identified Boehringer Ingelheim in response to question 2 because that company was judged to be the only company marketing ipratropium products. That suggests to me that some caution must be exercised in interpreting the responses identifying ATROVENT as the reason for the association. In other words association with the manufacturer of the leading brand containing ipratropium may reflect a deductive process or intelligent speculation rather than a likelihood of confusion in the normal course of trade. I do not, therefore, regard the questionnaire survey as providing sufficiently robust or conclusive support for the applicants' position.

The other related matter relied upon by the applicants is their claim that they have a "monopoly in 'VENT' suffixed marks in relation to anticholinergic products for use in respiratory healthcare". By anticholinergics they mean treatments which have ipratropium or oxitropium bromide as their main active ingredient. In support of this is exhibited (GL2)

pages from the alphabetical index of the Monthly Index of Medical Specialities (the date of this publication is not clear). Under the heading ipratropium bromide six brand names are listed of which three are the applicants' marks ATROVENT, COMBIVENT and DUOVENT. Under the heading oxitropium there is just a single mark, the applicants' OXIVENT.

Clearly there are not a large number of branded products containing the chemicals concerned and hence a very narrow basis on which to claim a VENT suffix monopoly in the first place. Neither party has indicated whether VENT would be taken to be allusive in itself (for ventilating purposes?), but I note that the questionnaire survey and comments refer to a brand SEREVENT and various other VENT prefix marks (VENTOLIN and VENTODISKS). My principal concern with the applicants' claim is that it is based on a position which is said to pertain in relation to a very narrow and specific range of products. The pharmaceutical preparations concerned are for the treatment of asthma and other respiratory conditions. The applicants' products exist alongside and compete with other and different formulations designed to treat such conditions. The applicants do not, as I understand it, claim a monopoly in -VENT marks for this general category of products merely those respiratory healthcare pharmaceuticals which are termed anticholinergics and have ipratropium or oxitropium as their sole or main active ingredient. That seems to me to be an artificial division of the market for such products which is unlikely to be recognised by customers (taking that term in its broadest sense). The applicants' position would have been rather more convincing if they had been able to demonstrate that within the general field of respiratory healthcare products they enjoyed the monopoly they claim.

In the event, therefore, I have come to the view that the applicants have not established a likelihood of confusion for the purposes of Section 5(2)(b). The application fails on this ground.

Section 5(4) reads:

> "5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
>
> (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
>
> (b) .....
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

This is a case where the marks used by the applicants are the same as those registered (that is the earlier trade marks set out at the start of this decision). The goods in respect of which use is claimed are within the specifications of the registered marks. I have also taken into account the applicants' reputation, particularly in their ATROVENT mark, in my consideration of the Section 5(2) position. In these circumstances I do not think the applicants are in a position to succeed under Section 5(4)(a) by reference to the law of passing off when they have failed under Section 5(2).

The application as a whole fails. The registered proprietors have not made a request for costs so no award is necessary.

Dated this 24 day of August 2000

M REYNOLDS
For the Registrar
the Comptroller-General