

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2193241
BY STEVENDEN HEALTHCARE LIMITED TO REGISTER THE MARK
EUMOGEL IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50155
BY GLAXO GROUP LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2193241
by Stevenden Healthcare Limited to register the mark
Eumogel in Class 5**

and

**IN THE MATTER OF Opposition thereto under No 50155
by Glaxo Group Limited**

DECISION

1. On 30 March 1999 Stevenden Healthcare Limited applied to register the mark EUMOGEL in Class 5 for 'topical corticosteroids'. The application is numbered 2193241.
2. On 9 September 1999 Glaxo Group Ltd filed notice of opposition to this application. They base their opposition on the fact that they have registered and used the mark EUMOVATE in the UK. The registration number is 1028936. It has a filing date of 3 May 1974 and was published in Trade Mark Journal 5032/233. The specification of that registration reads ' pharmaceutical and veterinary preparations and substances'.
3. Arising from this objection is taken under Section 5(2), 5(4)(a) and 5(4)(b). There is also a request that the application be refused in the exercise of the Registrar's discretion. No such power is available to me.
4. The applicants filed a counterstatement denying or not admitting the above grounds.
5. The opponents filed evidence in the form of a statutory declaration by Lesley Jane Edwards, their Head of Trade Marks. The applicants filed a witness statement by Stephen Jeremy Martin, their Chairman and Chief Executive. I will draw on this evidence as appropriate in the decision which follows.
6. Both sides ask for an award of costs in their favour.
7. Neither side has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.
8. Section 5(2) reads:

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

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

- (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."

As identical marks are not involved sub paragraph (b) applies here.

- 9. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* 1999 RPC 117, *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (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; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (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; *Sabel BV v. Puma AG*, paragraph 24;

- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

10 The Sabel v Puma case (see (f) above) requires me to take into account both the inherent characteristics of the opponents' earlier trade mark and any enhanced degree of distinctive character arising from its use. The opponents have filed evidence of use of their mark. The main points to emerge are:

- S EUMOVATE is a topical corticosteroid product. From the supporting exhibits it is possible to see that such products are used in the treatment of many skin diseases such as eczema, psoriasis and dermatitis
- S the mark has been used in the UK since 1975
- S sales figures are given for both the ointment and cream forms of the treatment for the years 1992 to 1999. Turnover is reasonably stable at or about £3 million in total per annum
- S various exhibits are supplied in support of these claims including extracts from the British Journal of Dermatology (LJE3), copies of packaging (LJE4) and a selection of invoices (LJE5).

11. Save what can be inferred from names and addresses on the invoices it is not entirely clear what the normal distribution routes are for the products or whether they are only available on prescription from a GP or as over the counter (OTC) treatments. I infer from the packaging that the goods would normally be prescribed by a doctor but some of the descriptive and instructional text suggests that a medical practitioner may not always be involved. There is no evidence or claim that the mark is used on any pharmaceutical products other than topical corticosteroid creams and ointments. As pharmaceutical names tend, for obvious reasons, to be applied to single products or product types only it is reasonable to suppose that the same is true here.

12. The applicants challenge the opponents' evidence in a number of respects. They say that the British Journal of Dermatology extracts do not go so far as to say that EUMOVATE is a leading corticosteroid product; that they do not shed light on the likelihood of confusion (but why should they?); and that one of the articles is co-authored by an employee of Glaxo Laboratories Ltd.
13. It seems to me that the articles do give some support to the opponents notwithstanding the applicants' criticisms. They establish the long standing presence of EUMOVATE in the market place (the articles date from the early 1980s). They are technical appraisals and not, therefore, primarily concerned with whether any given product under consideration enjoyed a particular degree of pre-eminence in the market. Even so I note that EUMOVATE is invariably shown in the list of treatments considered. Taken in context I think the articles suggest that EUMOVATE was one of the established products in the field at the time.
14. The other point to emerge from this evidence is that, whilst the opponents' specification is cast in broad terms, their goods are in essence the same as the applicants'. Both are topical corticosteroids. They differ only to the extent that the opponents are in cream or ointment form and the applicants' in gel form. For practical purposes, therefore, identical goods are involved.
15. Although it is often the case that pharmaceutical brand names are in their totalities invented words, it is equally common for them to be made up from, or at least contain, elements that are descriptive of or allusive to, for instance, the active ingredient, the condition to be treated or the nature of the treatment (GEL in the applicants' mark for instance). Where such descriptive or allusive elements are present it is necessary to consider whether, or to what extent, this factor is likely to be recognised by customers and whether it impacts on the likelihood of confusion by focussing more attention on other aspects of the mark concerned. It implicitly also raises the question of who are the customers for the product ie. whether experienced and knowledgeable medical staff, GPs, or in the case of OTC products the public at large. Generally speaking the more experienced and technically knowledgeable the customer group the greater their awareness is likely to be of competing product names and any meaningful allusions in marks. These factors in turn are likely to bear on the ability to differentiate between marks and the likelihood of confusion. What is the position here?
16. The applicants say of how their mark came to be adopted:

"The mark was perceived to be an original and inventive mark comprising the descriptive suffix "-GEL" in combination with the prefix "EU-", meaning "good, well, normal". The prefix "EU-" also recognises the potential market for the product within the European Union. Since the product in relation to which my Company wishes to use the trade mark EUMOGEL also acts as an emollient, the "MO-" element of the mark was chosen to allude to this emollient action. Taken as a whole, the mark constitutes a pleasing and

memorable invented word, alluding to a gel product for use in Europe possessing beneficial emollient properties, but which is wholly distinctive and capable of distinguishing my Company's goods."

I accept that the GEL element would be seen for what it is - a description of the form the product takes. I find it quite improbable that even a medical practitioner would deduce the purported significance of the remainder of the mark. The contraction and collocation of words/letters so obscures the applicants' intended meaning that the whole would in my view be taken as an invented and (GEL excepted) meaningless combination.

17. If EUMO - carried any more obvious or allusive meaning in relation to the goods, such that it might attract less attention as a distinguishing element, I think it is probable that the applicants would have said as much. I find nothing in the opponents' evidence either to suggest that their mark is made up in whole or in part of descriptive or allusive elements. The result is that I approach the comparison of marks on the basis that both parties' marks are invented totalities and that full weight must be given to the common element EUMO - within the marks.
18. This brings me to the remainder of the parties' evidence and submissions bearing on the marks and the likelihood of confusion. The opponents produce in their evidence the results of a EUMO prefix search in Class 5 of the UK Trade Marks Register which was carried out on the Avantiq database (Exhibit LJE6). The search results are said to show that they have a clear monopoly in the EUMO prefix with two exceptions, one being a lapsed mark and the other the mark that is the subject of this opposition.
19. The applicants for their part dispute the opponents' conclusions as to the state of the register and produce the results of a search conducted on the Marquesa database (SJM2) showing EUM- prefixed marks. I do not need to record further details of these searches. The problem with this sort of evidence is that it tells me nothing about the position in the marketplace either in terms of which (if any) of the marks are in use or on what products they are used. I can give little weight to this evidence and the related submissions. I also see little relevance in the opponents' claims relating to overseas sales and the applicants' evidence as to EUM- prefixed pharmaceutical marks said to be in use around the world. The applicants have also referred to various other trade marks owned by the opponents with allegedly descriptive prefixes (BETNOVATE and DERMOVATE) on the basis of which it is suggested that the distinctiveness of the opponents' mark resides in the -OVATE suffix. This also has little relevance to the issues before me.
20. Whether the opponents can claim a monopoly in EUMO-prefixed marks cannot be clearly established from the evidence. If there is just one EUMO- prefixed mark in use for the particular goods concerned it is a rather empty claim. The most that I am prepared to say on the strength of the other topical corticosteroid brand names referred

to in the evidence (LJE3) is that the others are quite different to EUMOVATE. It is likely that on the basis of the opponents' long standing use and not insignificant volume of sales that their mark commands some recognition in the market place over and above the degree of distinctive character that is inherent in the mark itself.

21. Turning to my own view of the marks, I regard visual and aural considerations to be important, the latter particularly if the treatments are the subject of oral recommendation by a doctor though doubtless a written prescription would also be present (if this is not an OTC product). Conceptual considerations are generally of less significance with invented words.
22. It was well established under the preceding law that the first elements of marks tend to be most important (TRIPCASTROID 42 RPC 264 at page 279 lines 28-40). There is no reason to suppose that this is any less true following the introduction of the 1994 Act. Both marks, EUMOGEL and EUMOVATE, consist of three syllable with the first two being common. It is extremely unlikely that the common element (EUMO) will go unremarked. But that is not in itself proof of a likelihood of confusion. Visually and aurally the respective endings are markedly different and unlikely to be subject to the risks associated with slurring of speech or poor handwriting. That might suggest the overall question of likelihood of confusion is finely balanced. However the test is a composite one (BALMORAL Trade Mark 1998 RPC 297) and must take into account all relevant factors (Sabel v Puma). I therefore take into account the characteristics of the marks themselves, the effect of the opponents' use, the fact that both marks are used or intended to be used on very specific and identical products, the fact that there are no other EUMO- prefixed marks shown to be in use on the goods in question, the descriptive nature of the GEL suffix in the applied for mark and the fact that the treatments are not shown to be highly specialised ones.
23. On that basis I have come to the view that there is a real risk that the relevant customer base might think that the applicants' mark was another or variant mark from the proprietor of the EUMOVATE branded product. That is to say the criterion set out in the CANON case (and referred to in (i) above) comes into play. There is a likelihood that an association would be made between the marks and that association would result in confusion as to the origin of the products. I, therefore, find that the opposition succeeds under Section 5(2).
24. The opponents have also raised objections under Section 5(4)(a) and (b). The latter is not explained or substantiated and must be dismissed. I assume the Section 5(4)(a) ground goes to the law of passing off. Geoffrey Hobbs QC, sitting as the Appointed Person, gave guidance on the elements of such an action in WILD CHILD Trade Mark, 1998 RPC 455. I do not propose to repeat that very full guidance here but it can be found at page 460 et seq of that decision. The mark used by the opponents is the same as the mark registered and the use is on a product which is contained with the terms of the specification of No. 1028936. The applicants intend to use their mark on

an identical product. In these circumstances it seems to me that Section 5(4)(a) does not give rise to substantially different considerations and is likely to produce a similar result to my finding under Section 5(2). I do not therefore propose to consider this ground in any more detail.

25. As the opposition has been successful the opponents are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £635. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12 day of February 2001

**M REYNOLDS
For the Registrar
the Comptroller-General**