

TRADE MARKS ACT 1994
IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 691240
AND THE REQUEST BY BIOFARMA S.A
TO PROTECT A TRADE MARK
IN CLASS 5

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 70099
BY MUNDIPHARMA AG

BACKGROUND

- 1) On 25 March 1998, Biopharma Societe Anonyme, of 22, Rue Garnier, F-92200, Neuilly - sur-Seine, France on the basis of a registration held in France, requested protection in the United Kingdom of the trade mark SPREDIOL under the provisions of the Madrid Protocol.
- 2) The international registration is numbered 691240 and protection was sought in Class 5 for "Pharmaceutical products ". An International priority date of 22 October 1997 was claimed on the basis of the registration in France.
- 3) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.
- 4) On 28 January 1999 Mundipharma AG of St Alban Rheinweg 72/74, 4006 Basel, Switzerland filed notice of opposition to the conferring of protection on this international registration based on their proprietorship of UK Trade Mark number 2122764. The grounds of opposition are based upon Sections 3(6) and 5(2)(b).
- 5) The applicants subsequently filed a counterstatement denying the above grounds. They also filed an amendment to the specification limiting the goods to "Pharmaceutical products for the prevention and/or the treatment of the menopause and for the prevention and treatment of pre- and post- menopausal symptoms".
- 6) Both sides ask for an award of costs.
- 7) Both sides filed evidence in these proceedings. Neither party wished to be heard in this matter. My decision will therefore be based on the pleadings, the evidence filed and written submissions supplied.

OPPONENTS' EVIDENCE

- 8) The opponent filed a declaration, dated 9 February 2000, by Kurt Wuest a Director of the opponent company. He has held this position for 14 years and states that he is conversant with the English language.
- 9) The opponent is the proprietor of the UK Trade Mark number 2122764 for the mark

SUPREDOL registered for “Pharmaceutical preparations and substances” in Class 5. The registration is dated 5 February 1997.

10) Mr Wuest states that the marks of the two parties will be confused because:

“The marks SUPREDOL and SPREDIOL both commence with the letter “S” and end with the suffix “OL”. They both have the same number of letters and share the common centrally placed element “PRED”. Thus, the common features of these marks may be expressed by “S.PRED#OL”, where “.” is a “U” in my company’s mark SUPREDOL and “#” is the letter “I” in the mark SPREDIOL.”

11) Mr Wuest observes that the applicant’s claim that the marks are not similar is based on the use of the suffix “DIOL” which it is claimed evokes the active ingredient of those pharmaceutical products and that that ingredient is well known in the medical field. However, the ingredient is not stated. Mr Wuest then provides at exhibit KW2 the entire section on Menopausal disorders from the October 1999 issue of Monthly Index of Medical Specialities (MIMS). None of the product “brand names” listed has the suffix DIOL. Of the forty-nine preparations listed containing oestrogen only ten do not contain oestradiol and three of those ten contain Oestriol. He claims therefore that there is no reason why the presence of the suffix DIOL would enable one to reliably distinguish a preparation bearing the mark SPREDIOL from one bearing the mark SUPREDOL.

12) At exhibit KW3 and KW4 Mr Wuest provides more parts of the October MIMS. These parts deal with “Contraception” and “Obstetrics and gynaecology”. These show only one brand name having the suffix DIOL, which contains Ethinyloestradiol, there is also a list of twenty eight other preparations which contain this substance.

13) Mr Wuest also claims that the legendarily poor hand writing of doctors and the poor recollection of prescribed products by patients will lead to a dangerous situation where one product is taken in mistake for the other.

APPLICANT’S EVIDENCE

14) The applicant filed a declaration, dated 19 June 2000, by Catherine Boudot the Head of the Trade Marks Department of the applicant company. Ms Boudot states that she has “a reasonable understanding of English”.

15) Ms Boudot claims that the opponent’s mark is made up of the laudatory prefix SPR and the suffix DOL which has specific relevance in the pharmaceutical field as it is derived from the Latin word DOLOR which has a definition of “pain; one of the cardinal sins of inflammation”. The definition of SUPR is “an abbreviation of supreme”. She also provides at exhibits 2 and 4 copies of marks on the UK Register in Class 5 with the prefix SUPR and the suffix DOL. However, this is of little or no relevance to the case because “state of the Register” evidence is, in principle, irrelevant: TREAT 1996 RPC 281.

16) In addition at exhibits 3 & 5 she provides copies of the May 2000 MIMS and the Chemist and Druggist Price List which shows that there are a number of registered marks which have either the prefix SUPR or the suffix DOL.

17) Lastly, Ms Boudot states that the active ingredient of her company's product is "estradiol". It is claimed that this ingredient is well known in the medical and scientific fields in the prevention and treatment of pre and post menopausal symptoms. Ms Boudot states that she believes that medical practitioners would readily recognise the significance of the suffix DIOL contained in the trade mark.

OPPONENT'S EVIDENCE IN REPLY

18) The opponent filed a second declaration, dated 18 October 2000 by Mr Wuest. He takes issue with the applicant on the issue of whether SUPR is a prefix. He states that it is an abbreviation only.

19) Mr Wuest comments that the products listed in MIMS are for use in treating very different types of medical ailment. He also points out that the pronunciation of the word DOLOR is shown in the applicant's evidence to be "do'lor" not "dol'or". This he claims would mean that the suffix "dol" would not be recognised as standing for dolor. Further, he claims that the suffix "dol" is not commonly used in relation to pain relief products. He provides at exhibit KW6 copies of the July 2000 MIMS which shows ninety-four products for the relief of pain. Only five have the suffix "dol". He therefore contends that his company's mark would not be seen as a combination of the prefix SUPR and the suffix DOL. He states that the mark SUPREDOL is an invented word having no apparent connotations.

20) Mr Wuest disputes that the suffix DIOL in the applicant's mark would be recognised by medical practitioners as indicating the presence of the hormone estradiol. He provides copies of sections of the July 2000 MIMS and states that only one entry has the suffix "diol" from the sixty two products listed under the headings "obstetrics & gynaecology" and "contraception".

21) That concludes my review of the evidence. I now turn to the decision.

DECISION

22) In their written submission the opponent withdrew the ground of opposition under Section 3(6).

23) I therefore turn to the remaining ground of opposition under Section 5(2)(b) of the Act which states:-

*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 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."

24) An earlier right is defined in Section 6, the relevant parts of which state

6.- (1) In this Act an 'earlier trade mark' means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b)...

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

25) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik 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* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, 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 Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, 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* page 224;

(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* page 224;

(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-Meyer Inc.* page 7 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* page 8, 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* page 224;

(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* page 732, 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-Meyer Inc.* page 9, paragraph 29.

26) Clearly, in my view, the specification of the mark in suit is subsumed within the specification of the opponent's mark 2122764. The limitation to the specification requested by the applicant does not alter this view. The goods of the two parties are therefore, in my opinion, to be regarded as identical for the purposes of Section 5(2). It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the goods or services for which it is registered, and any other relevant factors.

27) When comparing the mark in suit, SPREDIOL, to the opponent's mark, SUPREDOL, visually the respective marks have the first seventh and eighth letters in common. The marks are of equal length. Both are invented words.

28) Aurally, the opponent's mark is clearly a three-syllable word being pronounced either "SOUP - RED - OL", "SOUP - RE - DOLL" or "SUE- PRED- OL". Whilst the applicant's mark is also a three syllable word which would be pronounced "SPREAD - EE - OL" or "SPRE - DI -OL". The opponent points out that both marks have the letters "PRED" as a grouping within them. However, for this to make itself heard the applicant's mark would have to be pronounced "SSS- PRED-IOL". I cannot imagine anyone utilising such an awkward method of pronouncing the applicant's mark when there are far more obvious ways available.

29) Both marks are invented words. The applicant has suggested various allusions in both its mark and that of the opponent. I reject all these claims. In my view there is no conceptual image in either mark and neither will the average consumer see obscure references to either Latin words or ingredients.

30) It has also been suggested that confusion will arise due to the legendary poor hand writing of doctors. However, medical practitioners have to be quite au fait with a wide range of treatments and products. They are highly trained individuals who are able to differentiate between products and are highly unlikely to prescribe and the wrong drug. Confusion is made less likely given that the applicant's specification is limited to "Pharmaceutical products for the prevention and/or the treatment of the menopause and for the prevention and treatment of pre- and post- menopausal symptoms".

31) However, the specifications of both parties, despite the evidence they provided, does not limit the parties to prescription drugs but could include "over the counter" products. Therefore, the average consumer must be the general public. Medications are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. Even allowing for the notion of imperfect recollection, the average consumer is not likely to be confused.

32) I must also consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. No evidence of use of the mark has been filed. Therefore, I must assume that the opponent did

not enjoy an above average reputation at the relevant date.

33) With all of this in mind I come to the conclusion that while there are superficial similarities, they are more than counterbalanced by the differences, and when all factors are considered, that there was no realistic likelihood of confusion at the relevant date. Consequently, the opposition under Section 5(2)(b) fails.

34) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £735. This sum 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 15TH day of August 2001

George W Salthouse
For the Registrar
The Comptroller General