

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2277425
BY PFIZER PRODUCTS INC
TO REGISTER A TRADE MARK IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 80522
BY F HOFFMAN – LA ROCHE AG**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2277425
by Pfizer Products Inc to register a trade mark in Class 5**

and

**IN THE MATTER OF Opposition thereto under No. 80522
By F Hoffman – La Roche AG**

BACKGROUND

1. On 8 August 2001 Pfizer Products Inc applied to register the trade mark EVARISE in Class 5 of the register for a specification of – “Pharmaceutical and veterinary preparations and substances”.
2. The application was accepted by the Registrar and published in the Trade Marks Journal.
3. On 3 January 2002 Forrester Ketley & Co on behalf of F Hoffman – La Roche AG filed a Notice of Opposition under Section 5(2)(b) of the Act on the ground that the mark applied for is similar to the following earlier international trade mark owned by the opponent and is to be registered for identical or similar goods and there exists a likelihood of confusion on the part of the public:

| NUMBER | MARK | DATE OF PROTECTION IN THE UK | GOODS |
|---------------|-------------|-------------------------------------|--|
| 692134 | EVONISE | 18 NOVEMBER 1997 | Class 5 Pharmaceutical, veterinary and sanitary preparations. |

4. The applicant through its agent, Gill Gennings & Every, filed a counterstatement denying the grounds of opposition.
5. The parties did not file evidence and neither party requested a hearing. However, both parties forwarded written submissions to assist the hearing officer and both have asked for an award of costs in their favour.

Opponent’s Submissions

6. The opponent’s written submissions are attached to a letter dated 14 February 2003 from its agents in these proceedings, Forrester Ketley & Co.

7. The opponent points out that the respective marks comprise three syllables, are of the same length (seven letters), commence with the letters EV and end with the letters ISE. In the view of the opponent the marks would be pronounced in the same manner.

8. The opponent goes on to state that identity of goods exists and in normal and fair use of the mark e.g. through prescription of the pharmaceuticals by doctors, factors such as difficult to read hand-writing and phonetic similarities could lead to confusion. In support of this contention, the opponent draws attention to the decision of the Registrar's Hearing Officer Mr Allan James of 13 March 1998 in Opposition Number 45064 relating to an application for the mark PROSYNAP in Class 5 (BL/O/055/98) and in particular the following extracts:

“... If allowance is made for normal and fair use of the marks – where it cannot be assumed that the marks would be seen together, and which would include use of the words in other forms, such as in handwritten form on a doctor's prescription – the difference between the marks may not be nearly so apparent. In these circumstances I think there is potential for visual confusion” (page 11, lines 8 to 12)

and

“... I bear in mind that both marks are invented words which are more likely to be confused through imperfect recollection than familiar dictionary words. I also bear in mind that the goods within the applicants' specification are unlikely to be available 'over the counter'. However, even if this is right, it is possible for professional medical staff to be confused in the right circumstances” (pages 11, lines 20 to 24).

Applicant's submissions

9. The applicant's written submissions are attached to a letter dated 18 February 2003 from its agents in these proceedings, Gill Jennings & Every.

10. The applicant submits that the immediate and overwhelming impression of the two marks is different and the marks appear dissimilar in their overall visual, phonetic and conceptual effect. The applicant goes on to criticise the opponent's approach of breaking down the marks by reference to specific elements as such a mechanical assessment is misleading. In the applicant's view the correct approach is not to dissect a mark but to concentrate on the whole and overall impression created thereby.

11. The applicant states that the element ISE, which appears in both marks, is not distinctive of any trader in the pharmaceutical field and in support attaches a “review of the register” showing numerous marks terminating with ISE. The applicant adds that beginnings of marks are more important than the endings of marks.

12. Next, the applicant turns to the prefixes of the respective marks and states that EVAR and EVON are entirely dissimilar and contends that, as a whole, the marks are different on a phonetic basis.

13. Turning to the goods at issue and their channels of trade, the applicant submits that the usual tests should apply to pharmaceutical goods and that a “likelihood of confusion” should be demonstrated rather than just a possibility thereof. On the issue of doctors hand-written

prescriptions, the applicant contends that most doctors now prescribe using computer printers, that it is inequitable to postulate a user of a mark being unprofessional and that the mere possibility of poor handwriting does not equate to a likelihood of confusion.

14. The applicant goes on to consider “imperfect recollection” and submits that, given the differences in the marks, the degree required in this case would be beyond that of the reasonably informed consumer. Furthermore, the applicant contends that marks comprising of “invented words” are the norm in the pharmaceutical field and that nothing has been put forward by the opponent to demonstrate the distinctiveness of its mark and the resulting penumbra of protection.

15. This completes my summary of the submissions received in this case and I now turn to the decision.

DECISION

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

“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.”

17. 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,”

18. 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-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik 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 Schuhfabrik 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-Mayer Inc*, page 132, 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 224;
- (g) account should be taken 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 was registered; *Lloyd*, paragraph 29.
- (h) 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;
- (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*, page 333, paragraph 29.”

19. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent’s registrations on the basis of their inherent characteristics assuming normal and fair use of the marks.

20. Turning first to a consideration of the respective goods covered by the specifications of the application in suit and the opponent's earlier mark it is obvious that they both cover identical goods in Class 5.

21. I now go on to compare the mark in suit with the opponent's earlier mark. Both marks comprise invented words and as pointed out by the opponent, the marks EVARISE and EVONISE are both seven letter marks which commence with the letters EV and end with the letters ISE. However, as the applicant points out and the guiding authorities also make clear I must compare the marks as a whole and I must be careful not to over analyse the marks as the real test is how marks would be perceived by customers in the normal course and circumstances of trade. I would only add that the opponent's mark is an inherently distinctive mark deserving a good penumbra of protection.

22. Firstly, I turn to a visual comparison of the respective marks. Both marks are of the same length (seven letters) and share the first two letters and the last three letters. They differ in their third and fourth letters. As mentioned earlier in my decision similarity must be considered in the light of overall impression. On this basis, given that the differing letters are in the middle of the marks where their visual impact is relatively less apparent than it would be at the beginning or termination of the marks, and after bearing in mind the potential for imperfect recollection, the respective marks in totality possess obvious visual similarity and there is considerable scope for visual confusion.

23. In relation to aural use the marks share the same first syllable EV and similar terminations which would share the ISE sound. While clear aural similarities exist I believe the opponent's case for aural similarity to be less strong than the visual one.

24. Next, I turn to a conceptual comparison of the marks. As both marks consist of invented words then, notwithstanding visual and aural similarity, I do not believe there is much in the way of conceptual similarity and I do not consider the marks to be conceptually similar overall. However, as the marks comprise invented words they are not likely to be distinguished in the way dictionary words with similar appearances but differing meanings would be and imperfect recollection of the marks may well be a factor.

25. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must also consider in relation to the goods at issue, who the average customer is and make appropriate allowance for imperfect recollection.

26. The specifications of the applicant and opponent cover a wide range of Class 5 goods. They include prescription only products and also goods which could be purchased over the counter e.g. at a supermarket or high street chemist, sometimes through self selection. The average customer may therefore be either an ordinary member of the public or a medical professional. In relation to purchases made by the public I do not believe that there are any special circumstances which suggest that the average customer pays a particularly high level or low level of attention in the purchase of the goods. They are not casual "bags of sweets" cases but neither are they expensive and sophisticated purchases. Turning to the position where a medical practitioner is involved in the selection and prescription of the products, I would add that I do not believe that this would result in any greater likelihood of confusion. I am fortified in this view by the comments of Professor Annand, acting as the Appointed Person in the cases of Oropram/Seropram (O/208/02) and Allergan's Application (O/293/02) when she stated:

“For my own part, I do not believe that different standards exist or are necessary to exist. The test of likelihood of confusion is flexible enough to allow each case to be judged according to its own peculiar facts. Relevant considerations may include those mentioned by the First Board of Appeal in *TEMPOVATE/EMOVATE, EUMOVATE*, supra, namely that some medicinal products are administered over the counter without prescriptions, some consumers resort to self-prescription and professionals are often overworked and may write prescriptions in hardly legible handwriting (although drugs may be prescription only, professionals may be on hand to assist choice with OTC products and pharmacists usually check illegible prescriptions).”

CONCLUSION

27. On a global appreciation, taking into account all the relevant factors, I have come to the following conclusions:

- (i) the respective marks are visually similar and to a lesser degree aurally similar;
- (ii) the customer for the goods is not necessarily a specialised or sophisticated customer and the goods are not necessarily purchased with great care or consideration.

28. Considering the position in its totality I believe that there is a likelihood of confusion on the part of the public. In reaching this conclusion I have borne in mind that an average customer rarely has the chance to make direct comparisons between marks, but must instead rely upon the imperfect picture of them he has kept in his mind.

29. The opposition under Section 5(2)(b) is successful.

COSTS

30. The opponent has been successful and is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £500, which takes into account that no evidence was filed in this case and no hearing took place. 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 08 day of April 2003

**John MacGillivray
For the Registrar
the Comptroller-General**