TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION No 714120
AND THE REQUEST BY GRÜNENTHAL GMBH
TO PROTECT A TRADE MARK IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER No 70345 BY ASHBOURNE PHARMACEUTICALS LIMITED

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Background

1) On 10 December 1999 Grünenthal GmbH of Aachen, Germany, on the basis of a registration held in Germany, requested protection in the United Kingdom of the trade mark **Aclav**. The registration was published with the following specification:

pharmaceutical and veterinary products - class 5

2) 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.

3) On 2 August 2000 Ashbourne Pharmaceuticals Ltd of Brixworth, Northamptonshire filed a notice of opposition to granting protection within the United Kingdom to the international registration.

4) The opponent states that he is the registered proprietor of United Kingdom registration no 2199195 of the trade mark **Amiclav** which is registered in respect of: *pharmaceutical preparations and substances, all for human use.*

5) The opponent claims that registration of the application in suit would be contrary to section 5(2)(b) of the Act. He contends that the respective trade marks encompass similar and identical goods and that the respective signs are similar. The opponent states that the respective trade marks are confusingly similar phonetically and visually. He states that the respective trade marks are visually similar because both marks begin with the letter "A" and end with the letters "CLAV" and are similar in length. He states that, in relation to phonetic similarity, that both marks start and end with identical syllables. He states that the only difference between the signs is the middle syllable "mi", which he states is unstressed and of less importance than the first and last syllables. He states that this syllable may be lost entirely when the word is spoken quickly or over the telephone. The opponent states that as a result of the phonetic similarity between the respective trade marks that there is a risk of confusion.

6) The applicant filed a counterstatement. The applicant states that he accepts that the respective trade marks encompass identical or similar goods. He states, however, that the respective trade marks are visually, phonetically and conceptually distinguishable. The applicant states that his trade marks consists of five letters and two syllables whilst that of the opponent's trade mark consists of seven letters and three syllables. He states that consequently the respective trade marks

are clearly different in both appearance and sound. The applicant states that the "A" which forms the first syllable of his trade mark would be pronounced long as in the indefinite article "A", whereas the initial "A" of the opponent's trade mark would be pronounced as a short vowel. He states that there would, therefore, be a distinct phonetic difference between the two trade marks even if the second syllable "MI" of the opponent's trade mark was left entirely unstressed as suggested by the opponent; a suggestion which the applicant refutes. The applicant states that the prefix "AMI" has a meaning which will be apparent to a substantial number of people in the United Kingdom, i.e. as the French word meaning friend. He states that the applicant's corresponding prefix (sic) "A" has no such meaning. The applicant states that the two trade marks will, therefore, be distinguishable conceptually. He states that the suffix "CLAV" is not exclusive to the opponent in the context of pharmaceutical preparations/products. The applicant states that a search has revealed two United Kingdom protected marks - registration no 1503739 XICLAV and the reserved word CO-AMOXICLAV. In the counterstatement the applicant states details were attached in relation to these two marks. However, no such details were received by the registrar.

7) Both parties seek an award of costs.

8) Both parties filed evidence. They both agreed that a decision could be made on the basis of the papers filed. Consequently a decision will be taken from a careful study of the papers.

9) Acting on behalf of the registrar I duly give the following decision.

Opponent's evidence

10) The opponent's evidence consists of a statutory declaration dated 21 February 2001 by Pauline Cakebread, who is managing director of operations for the opponent.

11) Ms Cakebread exhibits at PC1 a copy of the certification of registration for trade mark registration no 2199195. She states that regulatory approval for the opponent to supply Co-Amoxiclav tablets BP250/125 mg using the product name "Amiclav Tablets 259/125 mg" was given on 30 March 2000. She exhibits at PC2 a copy of the letter from the Medicines Control Agency in relation to the latter matter. She goes on to state that the trade mark was first used on 15 September 2000. She goes on to give further details in relation to use. However, as the relevant date in the instant proceedings is 10 December 1999, the date that the applicant sought protection for his trade mark in the United Kingdom, such use does not have a bearing upon the instant case. I, therefore, say no more about the evidence in respect of this matter. She states that the respective trade marks are visually and phonetically similar which may result in the customer, be that a doctor, pharmacist or patient, being confused. She states that the customer may believe that the goods of the applicant are those of the opponent or are in some way connected with the opponent. She also refers to the possibility of imperfect recollection.

Applicant's evidence

12) The applicant's evidence consists of a witness statement dated 25 May 2001 by Dr Peter

Charles Turner who is a fellow of the Institute of Trade Mark Attorneys and a fellow of the Chartered Institute of Patent Attorneys.

13) Dr Turner states that the second paragraph of the declaration of Ms Cakebread refers to Amiclav in upper case although it is registered in title case. He states that the evidence furnished by the opponent shows the mark used in lower case. Dr Turner comments that the registration certificate exhibited at PC1 identifies the proprietor as Ashbourne Pharmaceuticals rather than Ashbourne Pharmaceuticals Limited. He states that he agrees that the respective goods are identical or similar.

14) Dr Turner states that the earlier registration consists of seven letters and three distinct syllables whilst the application in suit has five letters and two syllables. He states that consequently the respective trade marks are different in both appearance and sound.

15) Dr Turner states, contrary to the statement of grounds of the opponent, that he does not see why the syllable "mi" of the earlier registration should be either unstressed or lost altogether. He states that he understands that in some circumstances a particular syllable in the middle of a long word (having six or seven syllables) might be lost in rapid speech but the earlier registration has only three syllables. Dr Turner states that the initial letter "A" in the respective trade marks could be pronounced differently - although he accepts opinions on this matter may differ. He states that his own instinctive reaction would be to pronounce Aclav with a long initial "A", as in acorn, and Amiclav - probably because he sees the first two syllables as making up the French word Ami - with a short "A" as in amicable.

16) Dr Turner states that the respective trade marks break down naturally into "Ami" plus "clav" and "A" plus "clav". The prefixes "Ami" and "A" have different meanings - as stated in the counterstatement of the applicant - and so introduce a conceptual distinction between the respective trade marks.

17) Dr Turner states that one needs to pay particular attention to the beginnings of the respective trade marks. He states that the prefixes "Ami" and "A" are clearly distinguished from each other visually, phonetically and conceptually. He states that one needs to consider the respective trade marks in their entireties and that it is a fact that they share the suffix "clav". He states that this suffix is not exclusive in the context of pharmaceutical preparations/products to the trade mark of the opponent. He again refers to XICLAV and CO-AMOXICLAV as in the counterstatement. He states that these examples support his contention that the opponent does not enjoy exclusive rights to trade marks with the suffix CLAV for pharmaceutical preparations and products in the United Kingdom.

Opponent's evidence in reply

18) The opponent's evidence in reply consists of a witness statement dated 29 August 2001 by Katherine Lindsay Gifford Nash, who is described as a fee-earner for the trade mark attorneys of the opponent.

19) Ms Nash states that the anomaly in relation to the proprietor was the result of a clerical error

and that documents to amend the error will be filed with the Trade Marks Registry. She states that there has been no change in the identity of the proprietor.

20) Ms Nash states that there are a number of marks for pharmaceutical products which have been confused by doctors and pharmacists when dispensing prescriptions. She states that in many cases the confused trade marks would not generally be considered to be confusingly similar by trade mark practitioners outside the pharmaceutical field. She states that within the pharmaceutical field a different threshold appears to apply when considering the likelihood of confusion. Ms Nash exhibits at KLGN1 a copy of the December 1999 issue of the "Similar Names" list. She states that this is a list of trade marks that have been confused, resulting in dispensing errors.

21) Ms Nash exhibits at KLNG2 a printout from the database of Pharmaceutical Trade Marks In-Use. She states that the printout shows that Amiclav is the only proprietary pharmaceutical trade mark in use in the UK having the suffix "-clav". She states that CO-AMOXICLAV is the generic name for amoxicillin trihydrate and clavulanic acid and is, therefore, not a brand name. She states that the trade mark XICLAV does not appear to be in use.

22) Ms Nash states that the respective trade marks have a substantial conceptual similarity as they both have the same suffix "clav". She states that this suggests that the goods include as an active ingredient clavulanic acid or a derivative thereof. She states that Amiclav is the only prescription drug being sold in the United Kingdom with the suffix "clav". She states that if someone saw a drug being marketed under the brand name Aclav they would almost certainly assume that it was an abbreviation of the mark Amiclav.

Submissions of the opponent

23) The opponent submits that the respective trade marks begin with the same letter and end with the same suffix. He states that they are of comparable length. He states that, therefore, the respective trade marks are visually similar.

24) The opponent submits that both trade marks begin with the same sound - "A" - and end with the same sound "clav". He states that the second syllable of Amiclav is short and with conventional English pronunciation is less stressed than the first and third syllables. He submits, therefore, that the respective trade marks are phonetically similar. The opponent submits that it is implausible that any member of the buying public would make a connection between his trade mark and the French word for friend or that the mark should be pronounced in a similar way.

25) The opponent submits that the respective trade marks are conceptually similar, he submits that both trade marks combine the prefix "A" with the suffix "clav", which is an abbreviation for clavulanic acid. He dismisses the applicant's comments in relation to the French word "ami" and concludes that there is no conceptual difference between the respective trade marks.

26) The opponent states that Amiclav is the only proprietary trade mark for a pharmaceutical product being sold in the United Kingdom with the suffix "clav". He submits that use of Aclav for similar or identical goods would almost certainly lead to confusion.

Decision

Preliminary issue

27) The applicant has referred to the registration certificate being in the name of Ashbourne Pharmaceuticals rather than in the name of Ashbourne Pharmaceuticals Limited. However, the opponent filed with his statement of case details of his trade mark from the Patent Office web site which show the trade mark to be in the latter name. If this were not the case it would not effect the issues before me as there is no requirement for a locus standi in opposition proceedings before the registrar (*Wild Child case* [1998] 14 RPC).

Grounds of opposition

28) The ground of opposition is under section 5(2)(b) of the Trade Marks Act 1994. The relevant provisions read as follows:

section 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.

The term 'earlier trade mark' is defined in section 6 of the Act as follows:

> 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.

Likelihood of confusion

29) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *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 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-Mayer Inc* page 9 paragraph 29.

Comparison of goods

30) Both parties accept that identical and similar goods are involved. The term "pharmaceutical products" of the application in suit would include all the goods of the earlier registration. **Owing to the common ground between the parties in relation to this matter I need say no more about it and accept that certain of the respective goods are identical and others similar.**

Comparison of signs

31) The trade marks to be compared are as follows:

Earlier registration: Application in suit:

Amiclav **Aclav**

32) The parties have argued as to whether the respective trade marks enjoy or don't enjoy a similar conceptual association. Their arguments involve not dealing with the trade marks as a whole but presuming that the potential customer will undertake a philological analysis of them. This is not something that I consider likely. I see no reason why someone in the United Kingdom should dissect the trade mark of the applicant so as to find a French word within it. The opponent states that "clav" is a standard abbreviation. He has put in no evidence to support this assertion. If it was the case it should have been simple enough to prove it by use of an extract from a dictionary. Even if it were the case he puts forward no convincing argument as to why the consumer should not simply view the trade marks in their entireties. I, therefore, consider that the respective trade marks will be seen as invented words with no conceptual association. Consequently I do not consider that the respective trade marks are confusingly similar.

33) On a phonetic comparison the opponent has tried to minimise if not dismiss the "mi" syllable of his trade mark. I consider, contrary to the opponent, that the emphasis in oral use is likely to be on this syllable - as it is in the words amicable and amiable. In relation to the first letter the words amicable and amiable illustrate the difficulty in defining how it will be pronounced; in the first word the "a" is pronounced as in antic and in the second word as in apron. I, therefore, do not consider that I can proscribe how this first letter would be pronounced in relation to either trade mark. It is quite possible that it would be pronounced in the same fashion in both trade marks. I consider that the final syllable "clav" will be pronounced in the same manner in both trade marks. In a short trade mark smaller differences can militate against finding similarity. In the instant case I consider that the "mi" syllable of the earlier registration is not a small difference but a major one. It is a syllable that has a very "definite" sound, not a sound that is likely to be slurred or disappear. It was established under the 1938 Act that the beginnings of words are more important in assessing similarity than the ends (*TRIPCASTROID* 42 RPC 264 at page 279). I consider that this is a reflection of human perception and so is not an issue that changes because of a change in trade mark acts. Therefore, it seems to me that this view is equally valid under the 1994 Act. It is also a position that OHIM follows, for instance in decision no 1126/2000 - Official Journal 10/2000 at page 1506. Taking into account the above, and especially comparing the trade marks in their entireties rather than salami slicing them, I consider that the respective trade marks are not phonetically similar.

34) The opponent has stated that the respective trade marks are of comparable length. As one contains five letters and one contains seven letters I do not readily understand how they are of comparable length. They are of different length. In crude reductionist terms the earlier registration is two fifths longer. The differing letters "mi" are completely alien to the application in suit. I consider that the respective trade marks are not visually similar.

35) In consequence of the above I find that the respective trade marks are not similar.

Conclusion

36) In order to find that there is a likelihood of confusion both the goods and the signs have to be similar. This is a requirement of the Act.

36) As Mr Hobbs QC, sitting as the Appointed Person in *Raleigh International* [2001] RPC 202 stated:

> "Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences."

Consequently even taking into account the interdependency principle in relation to the proximity of signs and/or goods, it is an inevitable sequitur of finding that the respective trade marks are not similar that I must find that there is not a likelihood of confusion.

37) Whether the earlier registration enjoys a good deal of inherent distinctiveness does not effect this position either. In the instant case I am not sure that the earlier registration does enjoy a great deal of inherent distinctiveness. The opponent's own evidence shows that the trade mark is used in relation to co-amoxiclav and so his trade mark would seem to me to have a clear allusion to goods including this compound. However, I do not consider that anything turns upon this issue owing to the lack of similarity of the signs.

38) The opponent has stated that a different threshold applies in assessing the likelihood of confusion in relation to pharmaceutical products. He gives no basis for this assertion. It is something that has been argued often but not, as far as I am aware, upheld. It confuses the issue of likelihood of confusion with the effects of confusion - what could happen if an incorrect drug was taken. In relation to the issue of likelihood of confusion I must apply the precepts and concepts of trade mark law. There are agencies - such as the Medicines Control Agency - who have statutory powers to deal with what can be described as the non-trade mark law issues of trade marks used in relation to drugs. The matter is dealt with in the decision of Mr James in case BL 0-532-01 in relation to both prescription and over the counter drugs.

39) I consider that the average consumer of the goods - when non-prescription - will not pay a particularly high or low level attention in his selection of goods. The goods are neither at the bottom "bag of sweets" end of a purchasing decision, nor at the top "car" end. In relation to prescription goods I do not consider that medical professionals will pay less attention than the purchaser of over the counter goods.

40) Owing to the differences between the respective trade marks I do not consider that the concept of imperfect recollection can shift the balance in favour of the opponent.

41) The applicant has referred to state of the register evidence. The evidence in the instant case is sparse in the extreme and the evidence of the opponent indicates that in the market place in the United Kingdom his trade mark is the only pharmaceutical product with the suffix "clav". Jacob J in *Treat (1996) RPC 281* stated:

> "In particular the state fo the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence."

I do not consider the state of the register evidence of any relevance in the instant case.

42) Consequent upon the above I find that there is not a likelihood of confusion.

43) The applicant is entitled to a contribution towards his costs and I therefore order the opponent to pay him the sum of £800. 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 15th day of January 2002

D.W.Landau
For the Registrar
The Comptroller General