

**IN THE MATTER OF INTERNATIONAL TRADE MARK
REGISTRATION No 719637
SEEKING PROTECTION IN THE UNITED KINGDOM
AND STANDING IN THE NAME OF OMEGA FARMA EHF**

AND

**IN THE MATTER OF OPPOSITION No 70282 THERETO
BY H LUNDBECK A/S**

**IN THE MATTER OF International Trade Mark
Registration No 719637
seeking protection in the United Kingdom
and standing in the name of Omega Farma ehf**

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**IN THE MATTER OF Opposition No 70282 thereto
by H Lundbeck A/S**

BACKGROUND

1. On 14 September 1999, the holder of International Trade Mark registration No. 719637, Omega Farma ehf of Reykjavik, Iceland sought to extend protection to the United Kingdom. The trade mark in question was the word OROPRAM and protection was sought in respect of; "medicine and medicinal products intended for human therapy." The goods fall within Class 5 of the International classification. In accordance with the Trade Marks (International Registration) Order 1996 the request was examined by the Trade Marks Registry and following acceptance was published in the Trade Marks Journal.
2. On 5 April 2000, H Lundbeck A/S of Valby, Denmark filed notice of opposition. The ground of opposition is based upon Sections 5(2)(a) and (b) of the Act because of their earlier trade mark, a Community Trade Mark, No. 34405 in respect of the trade mark SEROPRAM which is registered in respect of "medical preparations".
3. The applicants, through their trade mark attorney's Abel & Imray, accepted that the opponents had the earlier registration described above but denied that their trade mark and the opponents trade marks were confusingly similar. They stated that the suffix PRAM appearing in both trade marks was indicative of the generic medicine citalopram.
4. Only the opponents filed evidence in these proceedings.
5. In accordance with the Trade Mark Registry's practice I reviewed the case and informed the parties that I did not consider it necessary for an oral hearing to be held in order that the matter could be disposed of. The parties agreed a decision could be taken on the basis of the pleadings and the evidence filed. Abel & Imray on behalf of the applicants also provided written submissions. Having considered all of this material I give the decision set out below.

DECISION

6. As indicated above, the opponent's filed evidence. This consisted of two Statutory Declarations by Stephen Richard James of RGC Jenkins & Co, the opponents Trade Mark Attorneys. The first Statutory Declaration is dated 18 December 2000. Mr James states that the opponents' trade mark SEROPRAM is used to identify the anti-depressant product citalopram in a number in countries of the European Union, including Austria, France, Greece, Italy and Spain. He also provides details of the characteristics of the drug. Citalopram has as

its therapeutic indications, major depression and panic disorders. Mr James goes on to say that the suffix PRAM is not exclusively linked in pharmaceutical terms with the drug citalopram. He produces a list of drugs sold in the United Kingdom (taken from the Chemindex data base which have a generic name containing the string-PRAM - He draws attention to the generic name DOXAPRAM appearing in the list. He also produces a list of drugs sold in the United Kingdom which have a brand name containing the string-PRAM-and draws attention to the brand name DOPRAM. This is a drug used as a ventilatory stimulant in the treatment of acute respiratory failure and to stimulate respiration following anaesthesia.

7. Mr James states that in his view it is clear from the applicants' Counterstatement that they intend to use the trade mark OROPRAM to identify a pharmaceutical product containing citalopram. Their view that the suffix PRAM appearing in both trade marks is indicative of the generic medicine citalopram confirms this. It follows, he says, that if the trade mark OROPRAM is registered and was brought into use in the United Kingdom it will identify an identical pharmaceutical product to that identified by SEROPRAM. By that he means that both trade marks will identify an anti-depressant product containing citalopram.

8. Mr James goes on then to provide comments upon the similarity of the respective trade marks based upon decisions of the European Court of Justice which I do not need to summarise. Mr James' second Statutory Declaration is dated 4 April 2001. By this means he exhibits a photograph of a tablet bottle containing twenty-eight OROPRAM 10mg. tablets. These tablets, he says, contain citalopram hydrobromide as the active ingredients. These tablets are on sale in Iceland. This, he asserts shows that the applicants' trade mark is destined to be used in the United Kingdom as a tablet form of citalopram. This is precisely the drug and dosage form that the trade mark SEROPRAM is used to identify. That concludes my summary of the evidence insofar as I consider it necessary.

9. The grounds of opposition are set out in the Statement of Grounds refer to Sections 5(2)(a) and (b) which state:

"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."

10. 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;

11. As will be noted, Section 5(2)(a) requires that the respective trade marks be identical before that provision bites. In this case, the respective trade marks are the words OROPRAM (the applicants' trade mark) and the word SEROPRAM (the opponents' trade mark) these are not identical and therefore the provisions of Section 5(2)(a) can not apply and the opposition insofar as it is based on that provision is dismissed. I go on therefore to consider the opponents ground of objection under Section 5(2)(b):

12. 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. From these the following can be taken:

- (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 Schuhfabrik 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.

13. As indicated above, the likelihood of confusion between the respective trade marks must be considered globally taking account of all of the factors set out. In that connection, I consider that the goods covered by the respective specifications are identical. The applicants' specification is for medicine and medicinal products intended for human therapy whilst the opponents' Community trade mark is registered for medical preparations. In my view these can not be separated. Therefore, despite the fact that the evidence indicates that currently the applicants and the opponents use their trade mark in respect of pharmaceutical products containing citalopram neither specification of goods is so limited. Therefore, I consider the matter on the basis of notional and fair use across the range of goods for which the trade mark is registered and is sought to be registered. (*React* [2000] RPC at page 288).

14. Submissions have been made to the Registrar in recent cases where the goods in question in the proceedings have been pharmaceuticals. Set out below are comments by the Registrar's Hearing Officer in the matter of an application by Allergan Inc and opposition No. 50441 by Glaxo Group Ltd [SRIS - 414-01].

15. This is not a new debate to trade mark law and Mr Wilkinson referred me to an article written by Jane Mutimear "OHIM's Approach to Pharmaceutical Oppositions" [2001] 134 Trademark World at page 26. As the title suggests, this article analyses the approach taken by the Office for Harmonisation in the Internal Market in several oppositions to Community Trade Marks which cover pharmaceutical products. The article suggests that at present OHIM adopts a higher threshold before confusion can be found. The article is critical of that approach pointing to the potential consequences to public health when two pharmaceuticals are confused. At the hearing reference was also made to a recent decision of OHIM's Third Board of Appeal *Admirall Prodesfarma S A v Mudipharma A.G.* (Case R 622/199-3). This case concerned the trade marks CODIDOL and CODEROL for pharmaceutical goods in class 5. The Third Board of Appeal upheld the decision of the opposition division and found that there was a likelihood of confusion. The parties in that case advanced similar arguments to those before me. The Board did not express a view as to the correct approach but concluded:

"Furthermore, even if, as the applicant argues, the Board were to apply a higher threshold for a finding of a likelihood of confusion, that would not be sufficient to counter the Board's finding in the present case."

16. It seems to me that the role of the registrar is to apply the Trade Marks Act 1994 and its subordinate legislation to the proceedings brought before her. Other provisions and authorities exist for the licensing of pharmaceuticals and in my view, it is not the role of the Trade Marks Registry to stray into these areas. Under the provisions of the Act and acting on behalf of the registrar I must consider whether there exists a likelihood of confusion if the applicants' and opponents' trade marks are used in respect of the goods for which they are respectively applied for and registered. I must find a likelihood of confusion not merely a possibility of confusion; *React* at page 290.

15. Taking account of all of the above I therefore need to decide whether the respective trade marks are similar such that there exists a likelihood of confusion on the part of the public. The relevant public in this case may be doctors, pharmacists as well as the public at large, purchasing over the counter pharmaceutical products.

16. Visually, the two trade marks have the same suffix, as Mr James' points out in his evidence. But I am unable to determine whether any of the relevant public would associate that suffix, PRAM, with citalopram. Indeed, Mr James' own evidence indicates that that suffix is not exclusively associated with a single pharmaceutical entity and therefore that suffix will have no specific meaning in pharmaceutical terms to anyone as far as I can tell. The prefix in each case is different, in the applicants' trade mark it is ORO and the opponents' it is SERO. Looking at the respective trade marks as a whole therefore I reach the view that visually they are different. Aurally, whilst each consists of two syllables the different prefixes result in different pronunciations thus, in my view, when considering that aspect the trade marks are also not similar. I then go on to consider notwithstanding the differences I have already indicated, whether there are, nevertheless, some conceptual similarities between the respective trade marks. Having ruled out that the suffixes indicate a common generic compound and that the prefixes are different I reach the view that there are no conceptual similarities between the two trade marks.

17. Bringing all the above into consideration and bearing in mind in particular that the differences between the respective trade marks occur in the first syllables which ensure that visually and orally there are no similarities between the trade marks and having decided that there is no conceptual similarity I conclude that the respective trade marks OROPRAM and SEROPRAM are not similar such that if the applicants' trade mark was registered there would exist a likelihood of confusion on the part of the public which would include the likelihood of association with the opponents' earlier trade mark. Thus the grounds of opposition based upon Section 5(2) (b) are dismissed.

18. As the opposition has failed the applicants are entitled to an award of costs. I therefore order the opponent to pay to the applicants the sum of £400. 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 09 day of November 2001

M KNIGHT
For the Registrar
the Comptroller-General