

O/037/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 1180583  
IN THE NAME OF TEVA PHARMACEUTICAL INDUSTRIES LIMITED  
OF THE TRADE MARK:**

**ALFAD**

**AND THE APPLICATION FOR REVOCATION THERETO  
UNDER NO. 83927  
BY CYTOCHROMA DEVELOPMENT INC**

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### **BACKGROUND**

1. On 2 December 2010, Cytochroma Development Inc (“the applicant”) filed an application for the revocation on the grounds of non-use of registration number 1180583. The registration stands in the name of Teva Pharmaceutical Industries Limited (“the registered proprietor”). The registration procedure was completed on 22 August 1984. At the time the application for revocation was made, the registration’s specification was *pharmaceutical and veterinary preparations and substances*. A request to surrender part of the specification was made by the registered proprietor on 2 March 2011; consequently, the registered specification is now *pharmaceutical preparations and substances*.

2. The applicant seeks revocation of the registration in full under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). It claims that no use was made of the mark in the form as registered, for the goods as registered, in the five year period following registration; i.e. under section 46(1)(a) of the Act. The dates relating to the section 46(1)(a) period set out in the statement of case are 23 August 1984 to 22 August 1989. The applicant’s statement of case claims non-use under section 46(1)(b) from 30 November 2005 to 29 November 2010. Prior to the hearing, I wrote to both parties to clarify the position with respect to the pleaded dates on Form TM26(N) and in the applicant’s statement of case, and the effective dates of revocation. This was because no specific revocation date had been pleaded under section 46(1)(a), although the five year period was set out in the statement of case. Additionally, there was a discrepancy between the section 46(1)(b) dates as set out in the TM26(N) and the dates set out in the statement of case. On the basis that there were no objections to the Form TM26(N); that the section 46(1)(a) dates were set out in the statement of case; that the defence was filed on the basis of the section 46(1)(b) period pleaded in the statement of case; that the registered proprietor’s evidence was filed to meet that period, which accorded, bar a day either side of it, with the section 46(1)(b) period pleaded in the TM26(N); and that the day either side of the two periods does not, on the evidence filed, have a material bearing on the proceedings, I indicated that I intended to proceed for the dates set out above (as per the statement of case) and for effective dates of revocation of 23 August 1989 (section 46(1)(a)) or 30 November 2010 (section 46(1)(b)). Both

parties confirmed that they were content to proceed on this basis and so I need say no more about this issue<sup>1</sup>.

3. The applicant filed a counterstatement in which it defended its registration in respect of *pharmaceutical preparations and substances*: this corresponds to the remaining goods in the specification, post-surrender. The registered proprietor states that the mark was put to genuine use in the UK for these goods in the relevant periods. It later refined this claim to use only within the section 46(1)(b) time period which, it claims, saves the mark from revocation.

4. Both sides filed evidence and the matter came to be heard before me on 27 January 2012, by telephone conference. The applicant was represented by Mr Simon Malynicz, of counsel, instructed by Wynne-Jones, Lainé and James LLP. The registered proprietor was not represented, but its trade mark attorney (Mr Graham Farrington of Ladas & Parry LLP) filed written submissions in lieu of attendance.

### **Evidence**

5. The registered proprietor has filed witness statements from Mr Graham Farrington and from Ms Kim Innes, who is a commercial director of the registered proprietor.

6. Mr Farrington states that the registered proprietor has used the mark ALFAD in the form AlfaD in the UK since 1998. Use in the UK is by a subsidiary of the registered proprietor called Teva UK Limited and is with the registered proprietor's authority. Mr Farrington refers to an earlier set of proceedings before the Registrar, opposition 96489, in which the present registered proprietor was the opponent, relying upon the mark the subject of these proceedings as the basis for the opposition. It was required to provide proof of use of the mark. Mr Farrington states that the registered proprietor is relying upon the same evidence that it filed in the opposition proceedings for these revocation proceedings. He states that the use shown in the opposition proceedings in the period 2003-2008 falls within the requisite timescale for these proceedings. Mr Farrington adduces the earlier evidence under exhibit GF1: this consists of a witness statement by Ms Innes dated 3 December 2008 and exhibits K11 – K14.

7. Throughout her evidence, Ms Innes refers to the AlfaD product for prescription-only medicines. She states, at paragraph 6 of her witness statement:

“It is to be noted that the “AlfaD trade mark is used consistently on all packaging and materials in the form AlfaD. When referred to by name the product is pronounced “Alfa-Dee” and not “Alf-add” as might be considered the way it would be spoken on looking at the trade mark registration in plain letters.”

Ms Innes' exhibits are consistent with this statement: they all show AlfaD and none show ALFAD.

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<sup>1</sup>The Appointed Person (Mr Daniel Alexander QC) dealt with a similar issue in a revocation action, *The Light* BL O/472/11, which lends support for the approach taken in these proceedings.

## Decision

8. Section 46 of the Act reads as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

9. Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequently, the onus is upon the registered proprietor to prove that genuine use of the registered trade mark was made in the relevant periods.

10. The applicant takes a single point: its contention, as advanced by Mr Malynicz at the hearing, is that the use of AlfaD is use which alters the distinctive character of the mark in the form in which it was registered (ALFAD) and so falls outside of what would be an acceptable variant under section 46(2) of the Act.

11. Both parties submit that the correct legal approach is set out in *Bud/Budweiser Budbrau* [2003] RPC 25. Lord Walker of Gestingthorpe stated:

“43. ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

12. Mr Malynicz also referred to decisions of Mr Arnold QC, sitting as the Appointed Person in *NIRVANA* (BL O/262/06) and in *REMUS* (BL O/061/08). In the second of these cases Mr Arnold QC stated:

“I do not consider that the subsequent developments discussed above undermine the correctness of the view which I articulated in *NIRVANA* as follows:

‘33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

'34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

13. In *OAQ "Alfa-Bank v Alpha Bank A.E. [2011] EWHC 2021 (Ch)*, although Briggs J cautioned against elevating *NIRVANA* to a statutory test, observing that there are bound to be occasions where the addition of a word or words would not alter the distinctive character of the mark as registered, he stated that the *NIRVANA* formula was:

"a perfectly sound and authoritative unpicking of the test laid down in section 6(A)(4)(a) of the Act".<sup>2</sup>

14. In making my assessment of whether the use of AlfaD complies with section 46(2), I will follow the *NIRVANA* formula which is, in essence, the enquiry articulated by Lord Walker. It being common ground that the use has been of AlfaD, I need to ascertain the differences between the marks and evaluate whether the differences alter the distinctive character of the mark as registered. In order to answer that question, I also need to determine the distinctive character of the mark in its registered form. This will be my starting point.

15. The registered mark is ALFAD. It will be seen and heard as a two-syllable word: AL-FAD. The registered proprietor's evidence points clearly to a belief that the form in which its trade mark is registered would be pronounced in this way (it refers to a pronunciation of 'Alf-add'). I agree with Mr Malynicz: the distinctive character of the registered mark resides in the whole word ALFAD which is an invented word.

16. The next point in the enquiry is to establish the differences between the mark used and the mark in the form in which it is registered:

Mark used: AlfaD

Mark registered: ALFAD

17. The registered proprietor submits the following:

"The mark that has been used is the five letter combination in exactly the order that those letters appear in the registration and on that basis it appears that it is perfectly reasonable to conclude that this is use of the mark as registered."

It is plain that AlfaD is a five letter combination in the same order as ALFAD. There is no difference in that respect. The difference between ALFAD and AlfaD is that the

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<sup>2</sup> Section 6A(4)(a) mirrors the wording under the relevant part of section 46(2) of the Act.

D is capitalised, whereas the preceding three letters are not. Although there is no physical gap between them 'Alfa' and D, the effect of the capitalised D is to separate 'Alfa', and D, not least because it is unusual to place a capital letter in a word where the preceding letters are in lower case (in this case the capital letter is at the end of the word). The effect produced by this irregular use of upper and lower casing represents a marked difference between ALFAD and AlfaD<sup>3</sup>. It causes Alfa to stand out in a way which it does not do in ALFAD. In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch), Mann J said:

“As has been observed elsewhere, consumers are not trade mark lawyers who view marks with the experience of years of forensic dissection and mutation of their elements. They are people on whom the marks are intended to have a fairly immediate impression (that, after all, is largely the purpose of the mark).”

This runs contrary to the registered proprietor's submission that if the registered proprietor's average consumer, whom it states to be healthcare professionals and patients, “was confronted with the mark as it has been shown to have been used and was told that the trade mark registration is for the mark ALFAD what would be his impression? If the average consumer thinks that the mark as used is an acceptable variant from the mark as registered then it is appropriate that the mark as used be taken into account.” Clearly, the average consumer (i) would not be confronted with such a question and (ii) would not know about acceptable variants. There is no reason why the average consumer would pick out Alfa (or ALFA) in ALFAD: the word does not lend itself naturally to severance.

18. The difference created by the casing change in the letters is not only visual but is also aural: ALFAD consists of two syllables, pronounced AL-FAD, but AlfaD consist of three syllables, pronounced AI-FA-DEE. The capitalisation and hence the highlighting of the D causes it to be pronounced separately from the previous two syllables. In terms of conceptual difference, ALFAD is an invented word, devoid of concept. The conceptual signification of AlfaD is that it may be seen as a combination of the phonetic equivalent of the Greek letter ALPHA (in its Roman alphabet form) and a single letter D. This is a further layer of difference. Even if I am wrong about the ALPHA connotation and that, instead, ALFA will be seen as an invented word, it is still a different invented word to ALFAD because the capitalised D will be seen as a separate element, its concept being that it is the single letter D preceded by the invented word 'Alfa'. However, of the two scenarios, I think the ALPHA concept is the more likely.

19. Having established (i) the way in which the mark has been used; (ii) the distinctive character of the registered mark; and (iii) what the differences are

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<sup>3</sup> Mr Iain Purvis QC, sitting as the Appointed Person in *INoTheScore* BL O//276/09 considered the impact of irregular letter casing: “24. Do these differences alter the distinctive character of the mark as registered? In my view they plainly do. The immediate impact of “INoTheScore” is somewhat jarring. It initially appears to be an invented word, but the interspersed capitals make it look rather strange. After a little thought, one “unpacks” the word and realises that it is in fact a version of the phrase “I know the score” and should be pronounced accordingly. No doubt some people will see this almost instantly, but to others it will not be immediately obvious.”

between the registered mark and the mark used, the final analysis is to decide whether those differences alter the distinctive character of the mark in its registered form. There is no doubt in my mind that the alterations I have described on a visual, aural and conceptual level alter the overall distinctive character of the mark in its registered form. Even if the ALPHA concept is not strong or recognised, there is still the pronounced difference between the visual and aural impact of the mark as used compared to its registered form and these differences alter the distinctive character. Use of AlfaD is use in a form differing in elements which alter the distinctive character of the mark in the form in which it was registered. It follows that the use falls outside of the parameters of section 46(2) of the Act. Section 46(2) connects directly to section 46(1): if the use falls outside of section 46(2), it cannot assist in proving genuine use as prescribed by sections 46(1)(a) and (b):

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

...

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.”

20. The registered proprietor takes a point that in the previous set of proceedings, opposition 96489, in which it was required to prove genuine use of the instant mark and relied upon exactly the same evidence as in these proceedings, the Hearing Officer regarded the evidence as inadmissible. Examination of the form of use of a mark is a fundamental and a necessary part of the enquiry into genuine use, as can be seen from the interplay between section 46(1)(a) and (b) and 46(2), and between section 6A(3)(a) and (b) and 6A(4)(a). The evidence in these proceedings has been admitted and examined and found wanting in that which it set out to prove, as it was in the opposition case. It therefore cannot be relied upon to prove genuine use of trade mark registration 1180583.

## **Outcome**

21. The application for revocation on the grounds of non-use succeeds under both sections 46(1)(a) and 46(1)(b). Consequently the mark is revoked under section 46(6)(b), the effective date of revocation being **23 August 1989**.

## **Costs**

22. The applicant has been successful and is entitled to an award of costs. I have not made an award for the applicant's evidence as this consisted entirely of a copy of the registrar's decision in the aforementioned opposition proceedings. I award costs on the following basis<sup>4</sup>:

Preparing a statement and considering the counterstatement	£200
Application fee	£200
Considering the registered proprietor's evidence	£500
Preparing for and attendance at a hearing	£500
<b>Total:</b>	<b>£1400</b>

23. I order Teva Pharmaceutical Industries Limited to pay Cytochroma Development Inc the sum of £1400. 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 1<sup>st</sup> day of February 2012**

**Judi Pike  
For the Registrar,  
the Comptroller-General**

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<sup>4</sup> As per the scale in Tribunal Practice Notice 4/2007.