

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2104719
BY JOHNSON & JOHNSON
TO REGISTER THE MARK
COLOCALM
IN CLASS 5

AND IN THE MATTER OF OPPOSITION THERETO
BY SOLVAY DUPHAR B.V.

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IN THE MATTER OF APPLICATION No 2104719

5 by JOHNSON & JOHNSON TO REGISTER A TRADE MARK IN CLASS 5

AND IN THE MATTER OF OPPOSITION THERETO

by SOLVAY DUPHAR B.V..

10 **DECISION**

BACKGROUND

15 On 9 July 1996, Johnson & Johnson of One Johnson & Johnson Plaza, New Brunswick, New Jersey, 08933 - 7001, USA applied under the Trade Marks Act 1994 for registration of the trade mark **COLOCALM** in respect of the following goods in Class 5:

“Pharmaceutical preparations and substances.”

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On the 24 December 1996 Solvay Duphar B.V. filed notice of opposition to the application. The grounds of opposition are in summary:

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i) Solvay Duphar B.V. the opponents, are the proprietors of the mark COLOFAC, registered in class 5 for “Anti-spasmodic preparations”, registration No 891059.

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ii) The opponents claim that the mark applied for, COLOCALM, is phonetically very similar to their registered mark COLOFAC, in addition the goods covered by the application (pharmaceutical preparations and substances) would include the goods (anti-spasmodic preparations) for which the opponents mark is registered.

iii) The opponents therefore claim that the application offends against the provisions of Section 5(2) and 5(4) of the Trade Mark Act 1994.

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The applicants subsequently filed a counterstatement denying all of the grounds of opposition, other than agreeing that the opponents are the registered proprietors of the trade mark as claimed. Both sides ask for an award of costs.

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Both sides filed evidence in these proceedings and the matter came to be heard on 13 January 1999 when the applicant was represented by Ms Jones of Counsel, instructed by the trade mark agents D Young & Co, and the opponents by Mr Rackham of Lloyd Wise Tregear, their trade mark agents.

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OPPONENTS’ EVIDENCE

This takes the form of a statutory declaration by Dai Davies dated 31 July 1997. Mr Davies is

the Sales and Marketing Director of Solvay Healthcare Ltd, a position he has held since December 1996 having worked for the company for 13 years in sales and marketing positions.

Solvay Healthcare Ltd is a wholly owned subsidiary of Solvay S.A., a Belgium company which also owns Solvay Pharma B.V. which is the current name of Solvay Duphar B.V. the opponents.

Solvay Healthcare Ltd has sold an anti-spasmodic product in the UK under the trade mark COLOFAC since the early sixties, although the exact date is uncertain. The product contains mebeverine hydrochloride, a compound generally available and out of patent for many years. This compound has proved very effective in treating irritable bowel syndrome (IBS). Mr Davies states that COLOFAC is the market leader in products for the treatment of IBS. Sales figures and details of promotional expenditure are as follows:

YEAR	SALES £	PROMOTIONS £
1991	7,000,000	800,000
1992	6,900,000	325,000
1993	6,700,000	355,000
1994	6,200,000	100,000
1995	6,000,000	50,000
1996	5,700,000	360,000

Until April 1997 the product was available solely on prescription. However, a modified version, still sold under the COLOFAC mark is now available as an “Over the counter” (OTC) product. Examples of the packaging for both the prescription and OTC version are provided at exhibits DD1 and DD2. A blister card of 20 tablets as sold under prescription is also provided at exhibit DD3. All three exhibits have the COLOFAC mark clearly printed on them.

Promotions have taken the form of leaflets and circulars being sent to doctors, individual chemists and purchasing managers of chemist chains. Also the opponents have arranged for consultants in the field of IBS to write articles discussing cases. With the advent of OTC sales the promotional budget is likely to be between £1.1 and £1.5 million. Examples of leaflets etc are at exhibit DD4. In addition the applicants provide an information booklet to sufferers who request one, with some 20,000 copies having been issued.

The claim to be the market leader made by Mr Davies is backed up with data produced by a company called International Medical Statistics Ltd. At exhibit DD5 are the figures produced for April 1997 which show that COLOFAC enjoys approx 40% of the market. He also claims that when doctors prescribe the generic version (merbeverine hydrochloride) 60% of chemists provide COLOFAC. This Mr Davies states proves that “chemists are very well aware of the COLOFAC mark and probably feel that their patients expect to receive the branded product COLOFAC rather than a generic product or another brand”.

At exhibit DD9 are copies of pages from “Mims Monthly Index of Medical Specialities”, a publication provided particularly for doctors which lists alphabetically all drugs available. The publication is dated June 1997 and whilst COLOFAC is listed in both the index and the relevant page for “acid-peptic and motility disorders”, COLOCALM does not feature on either page, indicating, according to Mr Davies, its lack of availability.

Similarly, at exhibit DD10, pages from the “Chemist and Druggist Journal” are provided which again show the opponents’ product but not that of the applicant. Mr Davies states that he is not aware of any sales by the applicants of products under the COLOCALM mark.

He further states that to the best of his knowledge no other trade mark including the initial letters COLO has been used on a product for treating IBS. He believes that this initial part of mark would be the aspect remembered by doctors and patients alike. In particular as the whole point of mebeverine hydrochloride is that it is an anti-spasmodic preparation which does calm an irritable bowel. The ending of the opponents mark could therefore be seen to be a descriptive element.

It is stated that IBS sufferers tend to be nervous and tense and. usually take a drug to treat their IBS for a short period and then will not require it again for months if not years. According to Mr Davies this will have the following effects:

- 1) Their recollection of the product name is therefore likely to be less than perfect.
- 2) Their condition would not be helped if they purchased COLOCALM instead of COLOFAC as they would be nervous of trying a new drug.
- 3) Given the fact that COLOFAC is the brand leader in treating IBS any competing product branded COLOCALM would cause confusion to medical personnel and patients and therefore damage the opponents’ reputation.

APPLICANTS’ EVIDENCE

This consists of three statutory declarations. The first two by Jacqueline M Lake and Vicky Wright, both dated 28 November 1997, deal with survey evidence. Ms Lake is a Director and Ms Wright an employee of Farncombe International Ltd , Investigation Agents.

Between them they contacted 48 chemists to enquire about the trade mark COLOCALM. They asked two questions:

- 1) With what pharmaceutical preparation, if any, would you associate the trade mark COLOCALM?
- 2) With what pharmaceutical business / company, if any, would you associate the trade mark COLOCALM?

Of the 39 chemists who replied all except one stated that they did not associate the trade mark COLOCALM with any pharmaceutical preparation. Only one suggested that it might contain Mebeverine. Of the 38 who said they did not associate the mark with a pharmaceutical preparation six did suggest that it might be connected with the colon / intestine / bowel. None of the respondents offered a name of a company in response to question number two.

The applicants other statutory declaration was from Penelope Ann Nicholls, dated 11 December 1997. Ms Nicholls is a partner in the firm of D. Young and Co, chartered Patent Attorneys and Trade Mark Attorneys.

5 She lists eight trade marks (other than the two involved in this case) which, as at 10 December 1997 were on the UK Trade Mark Register in Class 5 and which have the prefix COLO (see Annex A attached). Ms Nicholls claims that none of the eight marks listed were opposed by Solvay Duphar B.V.

10 EVIDENCE IN REPLY

This consists of two statutory declarations. The first of which is again by Mr Davies, dated 15 May 1998. He comments that the fact that none of the pharmacists questioned in the survey recognised the mark COLOCALM is hardly surprising given that the mark is not in use in the UK, and is not included in standard lists of drugs. He reiterates his fears over confusion should the applicants' mark COLOCALM be registered. The use of this mark on a product to treat IBS would cause confusion he claims, but Mr Davies envisages an even worse scenario should the mark be used on a product for treating other conditions. Mr Davies states that it is his understanding that the applicants are considering using the mark applied for on a product containing domperidone. As this compound is not effective in treating IBS, any confusion in the market could lead to sufferers of IBS using a product which would not have a curative effect on their ailment and so would adversely affect the reputation of the opponents' product.

25 To back up his fears of confusion Mr Davies refers to the comments of some pharmacists linking the name COLOCALM to IBS, the colon or mebeverine. He concludes that as approx 10% of the pharmacists questioned linked the unused trade mark COLOCALM with IBS or similar medical ailments, this would lead to a danger to the public health and also to damage to the opponents' mark.

30 The second statutory declaration is by Mr Allan Dale, dated 1 June 1998, a qualified pharmacist for 33 years who is the proprietor of a chemist shop in Oldham. His store was one of those contacted as part of the applicants survey, although in his absence the survey questions were fielded by a locum. Mr Dale comments that he has to be aware of all prescription drugs in both brand name and generic form. In addition he has to be aware of the names of OTC products.

35 Mr Dale says he was contacted by the agent for the opponents, Mr Anthony Rackham, who is a friend of his. Mr Dale confirmed that he had not heard of a product called COLOCALM, and when asked what the product might be suggested that it would be for treating IBS. Mr Dale came to this conclusion as the COLO part of the mark suggested the colon and CALM a calming effect. Calming the colon is what is required in treating IBS

40 Mr Dale confirms that he is aware of the product COLOFAC, in both its prescription and OTC form. The only other product available OTC for treating IBS that Mr Dale is aware of is COLPERMIN.

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

DECISION

Firstly I consider the grounds of opposition under Section 5 (2) (b) which states:

5 “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,
10 there exists a likelihood of confusion on the part of the public, which includes the
 likelihood of association with the earlier trade mark.”

15 I have to determine whether the marks are so similar that there exists a likelihood of confusion on
the part of the relevant public. In deciding whether the two marks are similar I rely on the
decision of the Court of Justice of the European Communities in the Sabel v Puma case C251/
95 - ETMR [1998] 1-84. In that case the court stated that:

20 “Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion
on the part of the public. In that respect, it is clear from the tenth recital in the preamble
to the Directive that the appreciation of the likelihood of confusion ‘depends on
numerous elements and, in particular, on the recognition of the trade mark on the
market, of the association which can be made with the used or registered sign, of the
degree of similarity between the trade mark and the sign and between the goods or
services identified’. The likelihood of confusion must therefore be appreciated globally,
25 taking into account all factors relevant to the circumstances of the case.

30 Global appreciation of the visual, aural or conceptual similarity of the marks in
question, must be based on the overall impression given by the marks, bearing in mind,
in particular, their distinctive and dominant components. The wording of Article 4(1)(b)
of the Directive - “there exists a likelihood of confusion on the part of the public” -
shows that the perception of the marks in the mind of the average consumer of the type
of goods or services in question plays a decisive role in the global appreciation of the
likelihood of confusion. The average consumer normally perceives a mark as a whole
and does not proceed to analyse its various details.

35 In that perspective, the more distinctive the earlier mark, the greater will be the
likelihood of confusion. It is therefore not impossible that the conceptual similarity
resulting from the fact that two marks use images with analogous semantic content may
give rise to a likelihood of confusion where the earlier mark has a particularly distinctive
character, either per se or because of the reputation it enjoys with the public.”
40

45 The first issue is to determine the identity of the relevant public or average consumer. At the
relevant date, 9 July 1996, the product was sold only as a prescription drug. However, it has
subsequently been put onto the market as an “over the counter” (OTC) product using the same
trade mark. The relevant public is therefore not confined to doctors and pharmacists but must
include the general public. Whilst the opponents raised the apocryphal spectre of the average
doctor’s appalling handwriting being misread by the pharmacist, they also accepted that for the
most part doctors and pharmacists used computers to produce prescriptions.

It is clear from the Sabel v Puma case, that a mark with a strong reputation deserves more protection than one with a limited reputation. At the hearing it was common ground that the opponents, as market leaders in the provision of treatments for IBS, enjoy a considerable reputation in their mark COLOFAC. The opponents also argued that none of their competitors in the IBS field used trade marks beginning with the prefix COLO.

Mr Rackham invited me to take account of a decision by the Office for Harmonization in the Internal Market (OHIM) in the case of Brauerei Beck GmbH & Co v Warsteiner Brauerei Haus GmbH & Co KG. In which it stated:

“In comparing signs, it is of relevance that experience has shown that the public attributes greater importance to the beginning of a word in identifying a sign than it does to the following components of the word. Furthermore, in aural terms, vowels always have a more striking effect than consonants”.

It is not clear exactly what product the applicant intends to use the mark on, other than a pharmaceutical preparation or substance in class 5. As this specification would, if registered, encompass the opponents goods the marks must be considered on the assumption that the goods of the two parties are identical. This provides the opponents with their strongest scenario

It is accepted that people do have a habit of slurring the ends of words and ordinarily the initial part of a mark is the most important. However, when, as in this case, the initial part of the mark has an obvious meaning, in this instance COLO will be understood by the average consumer to mean colon, then the ending of the mark assumes equal importance. In any event I must consider the marks as wholes and not draw a comparison between the two halves, be it the front as the opponents would prefer, or the rear half as would better suit the applicants..

Visually the words have identical beginnings. Two of the three letters in the second part of the opponents mark appear in the second part of the applicants mark. However they are in different positions within the words and overall convey a different image.

Phonetically the first two syllables of each mark are identical. The opponent’s mark has a very hard third syllable ending whilst the applicants has a soft sound to it. Even allowing for imperfect recollection and the slurring of word endings it is my view that the marks are unlikely to be confused through aural use.

As the ECJ stated in Sabel v Puma, the public normally perceive trade marks as wholes and do not proceed to analyse the various details. That suggests that the opponents’ claim that the public regard the prefix of their mark - COLO - as itself distinctive of their goods, should be treated with caution. Where the earlier mark has a particular reputation (as I have already found the opponents’ mark has in relation to treatments for IBS), it is more likely that factors such as a common distinctive prefix in another word mark may cause the public to wonder whether there is some sort of connection in trade, even if there are significant differences between the words as wholes. Of course, every case turns on its own facts.

For their part, the applicants point out that the prefix COLO is not artificial, it is the first four letters of the word COLON. The applicants say that, if the public stop to consider the matter at

all, they are more likely to take their mark as an allusion to calming the colon than to another version of the opponents goods.

5 The opponents requested at the hearing that as the product being dealt with is used for medicinal purposes any likelihood of confusion, no matter how small, be considered sufficient to prevent the applicants mark being registered. The safety of the public should be of paramount importance. Given the nature of the goods concerned I think it highly likely that consumers will give some thought to their purchase. At the hearing, and in their evidence, the opponents stated that sufferers of IBS are concerned about their health. The opponents have had requests from over
10 20,000 clients seeking further information of their condition, indicating a concern which would lead them, in my opinion, to be careful in the purchase of any remedy. Even if one were to discount this concern, in considering the overall impression of the marks it is clear that the differences, visually, aurally and conceptually are sufficient to ensure that there is no likelihood of confusion.

15 . It is my view that even if the products are considered to be identical the differences in the marks are such that no confusion would arise. The opposition under Section 5(2) therefore fails.

20 At the hearing it was agreed by the opponents that their objection under Section 5(4) could not succeed if they failed with their objection under Section 5(2) As the opponents failed under Section 5(2) I have therefore not considered their opposition under Section 5(4).

25 The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £935

Dated this 3 day of February 1999

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35 George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

817,736	2 March 1961	Registered	Jnl 4343,164
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COLOMYCIN

Medicinal and pharmaceutical preparations and substances containing or consisting of antibiotics.

Pharmax Ltd
Bourne Road
Bexley
Kent
DA5 1NX

Registered Users.

891,059	22 February 1966	Registered	Jnl 4596,141
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COLOFAC

Anti-spasmodic preparations

Solvay Duphar B.V.
C.J. van Houtenlaan 36
Weesp
The Netherlands

Registered Users.

974,423	3 May 1971	Registered	Jnl 4863,2274
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COLOSTRENE

Drenches, being veterinary preparations for use in the treatment of watery mouth disease in lambs.

Battle, Hayward & Bower Ltd
Victoria Chemical Works
Crofton Drive
Allenby Road Industrial Estate
Lincoln
LN3 4NP

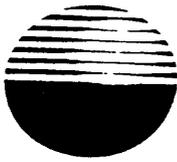
1,571,079	6 May 1994	Registered	Jnl 6054,774
COLOZINE			
Pharmaceutical preparations and substances; all included in Class 5.			
Approved Prescription Services Ltd Leeds Business Park 18 Bruntcliffe Way Morley Leeds LS27 0JG			
2,104,572	8 July 1996	Registered	Jnl 6146,263
COLOCURE			
Pharmaceutical preparations and substances.			
Johnson & Johnson One Johnson & Johnson Plaza New Brunswick New Jersey 08933-7001 United States of America			
2,112,859	15 October 1996	Registered	Jnl 6157,36
COLOTRANS			
Human pharmaceutical preparations.			
Johnson & Johnson One Johnson & Johnson Plaza New Brunswick New Jersey 08933-7001 United States of America			
2,112,861	15 October 1996	Registered	Jnl 6158,278
COLOFURAN			
Human pharmaceutical preparations.			
Johnson & Johnson One Johnson & Johnson Plaza New Brunswick New Jersey 08933-7001 United States of America			

1,358,968

27 September 1988

Registered

Jnl 5857,45



Coloplast

Coloplast

*To be associated with No. 801,945 (4270,780) and others.
Date claimed under International Convention 28 June 1988.*

Pharmaceutical preparations and substances; pharmaceutical preparations for use in the treatment of colostomy and/or ileostomy patients and for the surgical treatment of urology conditions; sanitary towels, sanitary belts, sanitary napkins, articles of sanitary underclothing, tampons for hygienic and surgical use, plasters and dressings, all for medical and surgical use, bandages (other than elastic bandages), pocket medicine cases (fitted), materials prepared for bandaging; preparations and substances, all for use in hygiene, sanitary preparations and substances; all included in Class 5.

Coloplast A/S
Bronzevej 2-8
DK 3060 Espergaerde
Denmark

1,405,151

20 November 1989

Registered

Jnl 5858,600

COLOPLAST

To be associated with No. 1,358,968 (5857,0447) and others.

Pharmaceutical preparations and substances; sanitary towels, sanitary belts, sanitary napkins, articles of sanitary underclothing, tampons for hygienic and surgical use; plasters and dressings, all for medical and surgical use; bandages (other than elastic bandages), pocket medicine cases (fitted); materials prepared for bandaging; preparations and substances all for use in hygiene; sanitary preparations and substances; all included in Class 5.

Coloplast A/S
Bronzevej 4
DK-3060 Espergaerde
Denmark

1,440,967

24 September 1990

Registered

Jnl 5888,5003

COLOFIBRE

Pharmaceutical preparations and substances; all included in Class 5 and all containing fibre.

Madaus Aktiengesellschaft
Ostmerheimer Strasse 198
D-51109 Koin
Germany