

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION **m** 2104338
AMGEN INC.
TO REGISTER THE TRADE MARK

RENERVEX

AND

IN THE MATTER OF OPPOSITION BY
BRISTOL-MYERS SQUIB CO.
THERE TO UNDER OPPOSITION **m** 46296

DECISION

Amgen Inc., of 1840 DeHavilland Drive, Thousand Oaks, California 91320-1789, USA applied on 4 July 1996 to register the mark RENERVEX for the following goods in Class 5: 'Prescription pharmaceuticals for use in the treatment of neurological diseases.'

5 The application is opposed by the Bristol-Myers Squibb Company on the following grounds:

! s 5(2)(b) in that the Applicants mark is similar to the Opponents' earlier mark and is to be registered for identical or similar goods;

! s 5(4)(a) because use of the Applicants mark is liable to be prevented by virtue of the law of passing-off.

10 The Opponents are the owners of an earlier mark PRESERVEX (No. 2041039) filed on 12 October 1995 for 'Pharmaceutical preparations and substances' in Class 5.

A counter statement is provided by the Applicants denying the grounds of opposition, and both parties ask for their costs. A Hearing was held on 15 December 1999 where Mr Charlton of Elkington & Fife represented the Applicants, and Ms Reid of Council, instructed by
15 Carpmaels & Ransford, represented the Opponents.

The Evidence

The Opponents enclose an Affidavit and two Statutory Declarations.

20 The Affidavit is from Dr Herbert Trachsler, the Director of Prodesfarma AG, to whom the earlier mark was assigned from Bristol-Mayer Squibb (see Exhibit HT2). Mr Trachsler says that the mark PRESERVEX has been used in the United Kingdom continuously since April 1996, on pharmaceutical products for the treatment of arthritis. Literature on the mark is enclosed at Exhibit HT3. He adds that Goods under the trade mark PRESERVEX have been sold throughout the United Kingdom and the approximate annual turnover of goods sold under the Mark PRESERVEX in the United Kingdom is £ 1,140,774. Apparently, about
25 £3,105 is spent annually promoting goods sold under the mark (a bundle of promotional literature is enclosed in Exhibit HT4).

Dr Trachsler says:

30 'The trade mark RENERVEX under Application No. 2104338 is so similar to my Company's trade mark PRESERVEX and is to be registered for identical or similar goods In visual terms the marks PRESERVEX and RENERVEX appear similar because they are virtually of the same length and they share the -ERVEX suffix, this suffix comprising over half the length of each mark. If the marks are handwritten, the scope for confusion is even greater. When handwritten, the letters PR can appear as the letter R; in addition, the

letter S in lower case of PRESERVEX could be mistaken for the letter N in lower case as in RENERVEX. I particularly have in mind a case where the marks are handwritten on a prescription and I believe that one of the marks could easily be mistaken as the other. In terms of sound, the marks share significant phonetic similarities in that they both consist of three syllables and end with the identical -ERVEX suffix. Although this is a fairly detailed analysis of the marks, it shows that the marks PRESERVEX and RENERVEX share striking similarities in look and sound. The marks are overall confusingly similar and one mark could be misheard, misread or mistaken as the other.'

Dr Trachsler also says that a search of the United Kingdom Trade Mark Register for marks in Class 5 which contain the suffix -ERVEX showed that PRESERVEX is the only mark on the Register in Class 5 which has the suffix -ERVEX.(Exhibit HT5). Further, a search of the database 'Imsmarq Pharmaceuticals in use' (which apparently contains over 6,000 marks and names) showed that the only -ERVEX suffix mark in the United Kindom is PRESERVEX.

The Opponents' also include a Statutory Declaration from Erik Rees, with 40 years of experience of in handwriting analysis, and a founder member of the British Institute of Graphologists.

He comments on the way in which RENERVEX and PRESERVEX may be handwritten and compare the appearance when handwritten. He says that: 'There is no doubt in my mind that circumstances could arise when there might be some confusion between the two words' and adds:

'If a physician abbreviates or works quickly under pressure, as they so often do, then the initial P of PRESERVEX and R of RENERVEX can become illegible. The N of RENERVEX and the S of PRESERVEX can equally be mistaken for each other. Should a pharmacist not be aware of either of the products or indeed not think about the similarity of the names of the two drugs being used, then mistakes could take place.'

Finally, for the Opponents, Stephen Chesnoff, the Assistant Secretary of Bristol-Myers Squibb Company states that his Company was the proprietor of the trademark PRESERVEX registered under No. 2041039 until 7th May 1997 when the trademark was assigned to Prodesfarma AG. He confirms the details of use of the trademark PRESERVEX set out in Dr Trachsler's Declaration.

The Applicants enclose one Declaration from Peter John Charlton, a Registered Trade Mark Agent and a Partner in the firm of Elkington and Fife, who has been entirely responsible for the prosecution of the present application and the handling of the opposition.

He says that the Applicants vigorously contests the Opponent's view of the alleged similarity of the respective trade marks RENERVEX and PRESERVEX. He says that when words are read or heard, a meaning is ascribed to the words by the brain if at all possible, and the Opponents' trade mark would be interpreted as 'PRESERVE-X' whereas the Applicants' trade mark would be interpreted as 'RE-NERVE-X' or as a play on the word 'RENERVATE'.

In Mr Charlton refers to Exhibit PJC1 which contains which contains details of the registered marks numbered 1560151 and 873778, that is, PLEGIVEX and PYRALVEX respectively. In Exhibit PJC2 are extracts from the Monthly Index of Medical Specialities ('MIMS') for April 1995, April 1996, April 1997 and April 1998. These show that the trade mark PYRALVEX has been in use in the UK over the relevant period.

Finally, there is further Declaration from Dr Trachsler.

He comments Mr. Charlton's attempts to ascribe meanings to the marks PRESERVEX and RENERVEX and says '..that there is no such word as "re-nerve" ', and that it would be '..odd to say that the mark RENERVEX would be interpreted as "RE-NERVE-X" '. He says that '..the marks share overall similarities in look and sound..' as stated previously. Dr Trachsler also says of the marks 'PLEGIVEX' and 'PYRALVEX' that:

'These marks are not relevant to the conflict between the marks PRESERVEX and RENERVEX. The marks PLEGIVEX and PYRALVEX both have the same 3-letter suffix -VEX and they begin with the letter P, but other than that they share nothing in common with the marks PRESERVEX and RENERVEX. PLEGIVEX and PYRALVEX are different in appearance and sound from the mark PRESERVEX.'

The Decision

Turning to the first ground of opposition, section 5(2)(b) of the Act reads:

'(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 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.'

The mark PRESERVEX is an 'earlier trade mark' by virtue of s 6(1)(a).

This section of the Act partially implements Article 4(1)(b) of the Directive. In the BALMORAL¹ Decision Mr Geoffrey Hobbs, acting as the Appointed Person, when interpreting the expression "a likelihood of confusion on the part of the public" referred to the following extract from the SABEL v PUMA² Case:

¹Trade Marks Act 1994: In the matter of Application no. 2003949 to register a trade mark in class 33 in the name of ROSEMOUNT ESTATES PTY LIMITED; Decision of the Appointed Person, 18 August 1998 (unpublished).

²European Court of Justice in Case C-251/95 *SABEL BV v. PUMA AG* [1998] RPC 199.

‘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, taking into account all factors relevant to the circumstances of the case. That 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 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. 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 the 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.’

Mr Hobbs then went on to construct the following query:

‘The tenth recital to the Directive and these observations of the Court of Justice indicate that an objection to registration under Section 5(2) of the Act should be taken to raise a single composite question: are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the ‘earlier trade mark’ and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?’

In the current case the ‘Hobbs test’ can be recast as:

‘Are there similarities between RENERVEX and PRESERVEX, in terms of the goods they specify, which would combine to create a likelihood of confusion in the mind of the average consumer if they were used simultaneously on the market?’

This query is composite in nature and the similarity of the marks and goods must be weighed together. The specifications accompanying the marks are:

RENERVEX: ‘Prescription pharmaceuticals for use in the treatment of neurological diseases’ and

PRESERVEX: ‘Pharmaceutical preparations and substances’.

At the Hearing Mr Charlton pointed out, and the Opponents agreed, that their product is marketed and sold as a non-steroidal anti-inflammatory (NSAID). He argued that these were different from prescription pharmaceuticals used in the treatment of neurological diseases. However, under this section I must consider normal and fair use of the marks, to the full-width of their specifications.

The first implication of this is that the goods are identical. The Applicants' goods are a subset of the Opponents and are thus included within the Opponents' specification. Mr Charlton at the Hearing said the Opponents' specification was very wide. Ms Reid, however, pointed out that the Opponents' registration is not under attack, and I do not believe I can limit the protection they enjoy in their mark because they have restricted the use they have made of it to date to a certain class of drug.

The second implication is, because one of the marks is specified as a prescription only medicine, the 'average consumers' in this case would be doctors and professional pharmacists.

Finally, I think 'normal and fair' use of the marks will include its written versions. Though it was argued at the Hearing that the majority of GPs these days print out their prescriptions, I am unclear as to whether this is the practice in Hospital Outpatients; traditionally prescriptions are handwritten and I have seen no evidence to contradict this. It seems to me that written prescriptions fall under 'normal and fair use' in the present case. I do not believe I can include in this, however, poor handwriting. The registration of the mark should not depend on confusion that may result from inadequate reproduction.

Turning now to an answer to the query cited above, *SABEL v PUMA* refers to aural, visual and conceptual similarities of the marks at issue. In terms of oral confusion, I take note that it is the well established (and no less true under the 1994 Act) that the beginnings of words are of particular importance. In the *TRIPCASTROID*³ case it was stated:

'But the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and, in my judgment, the first syllable of a word- is, as a rule, far the most important for the purpose of distinction.'

The first syllable of the Opponents' mark is unlikely to be ignored when the marks are pronounced, and I think this is enough to differentiate the two marks in this case, at least aurally.

In terms of conceptual similarity between the marks, Mr Charlton in evidence, and at the Hearing argued that the Opponents' trade mark would be interpreted as *PRESERVE-X* whereas the Applicants' mark would be interpreted as *RE-NERVE-X* or as a play on the word '*RENERVATE*'. Though pharmacists must be considered to be a generally intelligent and well informed group, I think this conclusion as to the meanings they may take of the marks is a little

³*LONDON LUBRICANTS (1920) LIMITED'S APPLICATION (1925)* 42 RPC 264 at page 279, lines 36-40.

fanciful and I consider them to be invented words, sharing no abstract notion as part of their invention. The key issue here is, perhaps, the visual difference between the marks. The Opponents' evidence includes that of a graphologist who says that '...that circumstances could arise when there might be some confusion between the two words..', these circumstances are:
5 'If a physician abbreviates or works quickly under pressure, as they so often do, then the initial P of PRESERVEX and R of RENERVEX can become illegible. The N of RENERVEX and the S of PRESERVEX can equally be mistaken for each other.' Mr Rees also adds that:
10 'Should a pharmacist not be aware of either of the products or indeed not think about the similarity of the names of the two drugs being used, then mistakes could take place'. This evidence seems to me to be less than convincing. In Mr Rees view, confusion requires the marks to be poorly represented, and I have already concluded that this cannot be part of my considerations. Further, it seems to me that pharmacists would be practised enough at their profession to distinguish the marks when handwritten normally. In my view the beginnings of words are also strong visual element in the mark-up of the mark, and confusion is unlikely.
15 The law requires 'a likelihood of confusion'. A mere possibility of confusion (in exceptional circumstance) is not enough.

Following from this, I do not believe that the Opponents have made out their case for confusion under s 5(2)(b) and this ground fails.

Turning to the next ground this is cited as s 5(4)(a) in the Statement of Grounds:

20 '(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented:-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting a unregistered trade mark or other sign used in the course of trade..'

25 To succeed in a passing off action, it is necessary for the Applicants to establish that at the relevant date (4 July 1996): (i) they had acquired goodwill under their mark, (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.⁴

30 Evidence of the date of first use of the Opponents' mark, and the extent of that use subsequently, are essential in establishing goodwill in the name PRESERVEX. I must accept Dr Trachler's statement that the Opponents' mark has been used continuously in the UK since April 1996 (first Declaration, paragraph 5). Other evidence exists, but does not help me much. A patient information leaflet in Exhibit HT3 states that it was prepared in October 1995, but not when it was made available to the profession, particularly pharmacists. The promotional literature in Exhibit HT4 records a reference to a scientific paper published in 1995, but I do not
35 know if the trade name was used in that paper (its proper chemical name may have been) and, anyhow, I am not given any information on the extent to which it would have brought the name to the attention of GPs and pharmacists. My suspicion is that this would have been minimal.

This means that the Opponents' name was used only 3 months before the Applicants' applied

⁴A fuller summary of the position can be found in WILD CHILD [1998] RPC 455, page 460ff.

for their mark. Dr Trachler states that the annual turnover of goods sold under the mark is about £1.1M, with approximately £3K spent on promotion. He provides no data on the sales or promotion that took place during this key three month period. Even if I take it that much of the promotion occurred at the launch of the product under the PRESERVEX name, sales were
5 unlikely to have been significant over this initial period. I do not think I can come to any other conclusion than that, at the relevant date, the Opponents possessed little goodwill in their mark, and not enough to merit a cause of action in the tort of passing off.

Following this conclusion the Opponents fail on this ground at the first hurdle. However, I want also to make a comment on the issue of misrepresentation before moving on. For
10 misrepresentation to occur one trader must use its mark in such a manner as to represent falsely (whether intended or not) to customers that its goods are those of another trader. In my decision under the section 5(2)(b) grounds given above I dismissed the likelihood of confusion between the two marks. I believe it even less likely here, as under s 5(4)(a) I can consider how the parties intend to use their mark. The Opponents make it clear in their evidence that their
15 product is a NSAID; and it was argued at the Hearing that these were a different class of drugs to prescription pharmaceuticals for use in the treatment of neurological diseases. In my view this does not assist the Opponents contention that misrepresentation leading to damage is likely.

The Applicants having been successful in these proceedings, are entitled to a contribution towards their costs. I therefore order the Opponents to pay to the Applicants the sum of
20 £635.00

Dated this 16th day of February 2000

**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller-General**