

O-143-04

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL TRADE MARK
REGISTRATION NO. M798409
IN THE NAME OF CHUGAI SEIYAKU KABUSHIKI KAISHA**

AND

**IN THE MATTER OF AN APPLICATION FOR A
DECLARATION OF INVALIDITY NO. 16037
THERE TO BY BIOPARTNERS GMBH**

IN THE MATTER OF international trade mark registration No. M798409
in the name of Chugai Seiyaku Kabushiki Kaisha

AND

IN THE MATTER OF an application for a Declaration of Invalidity
No. 16037 thereto by BioPartners GmbH

BACKGROUND

1. The trade mark “RAVANSA” has been protected in the UK since 19 February 2003 under number M798409 and stands in the name of Chugai Seiyaku Kabushiki Kaisha. It is protected in respect of:

Class 05:
Medicines for human purposes.

2. On 12 November 2003, BioPartners GmbH filed an application for a declaration of invalidity of the UK designation. The action was filed on Form TM26(I) together with the appropriate fee. The statement of case accompanying the application set out the grounds of action, which are as follows:

- Under sections 47(2)(a) and 5(2)(b) of the Act as the applicant claims that use of the protected mark is likely to cause confusion on the part of the public, which includes the likelihood of association with the applicant’s earlier trade marks.

The applicant gave details of its earlier trade marks in the statement of case, these were listed as “RAVANEX”, which has been protected in the UK under Community Trade Mark (CTM) number E2572246 and UK trade mark number 2302711 and stands in the name of BioPartners GmbH. Both are protected in respect of:

Class 05:
Pharmaceutical preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, foods for babies; plasters; materials for dressings; material for stopping teeth; dental wax; disinfectants; pharmaceutical preparations for the treatment of hepatitis C.

3. On 5 December 2003 a copy of the application for invalidation and the statement of grounds were sent to the registered proprietor at his address as recorded on the register. In the accompanying letter it was stated that the registered proprietor would need to appoint a representative in the UK to act for them as well as filing a Form TM8 and counter statement. The registered proprietor did not appoint a representative, neither did they file a Form TM8 and counter-statement to defend the registration. The consequences of failure to defend the registration were set out in the letter dated 5 December 2003, namely that the application for declaration of invalidity could be granted in whole or in part.

4. It does not however follow that the uncontested nature of this action will automatically mean success for the applicant for the declaration of invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant to prove why it is that the registration should be declared invalid.

5. I am mindful of the decision in the *Firetrace Case* (BL 0/278/01) where the Hearing Officer stated:

“It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

6. The reason that the Hearing Officer arrived at this view is the statutory presumption of validity in Section 72 of the Act which states:

“In all legal proceedings.....the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transaction of it.”

7. With this in mind, on 6 February 2004, the Trade Marks Registry wrote to the applicant’s representative inviting him to file any evidence or make any submission which he felt would support the applicant’s case and, at the least, establish a prima facie case. He was also invited to state whether he wished to be heard or would accept a decision from the papers filed.

8. On 15 March 2003 the applicant for invalidity’s representative provided a submission giving their opinion of the case against the registered proprietor. They also stated that they were content for the decision to be taken on the basis of the papers filed.

9. The submission argued that their CTM was filed at OHIM on 11 February 2002 and that their UK trade mark was filed on 12 June 2002, claiming priority from the earlier CTM application, and was registered on 7 February 2003, and therefore these qualify as earlier trade marks under section 6(1)(a) of the Act. They went on to argue that the criteria for the assessment of similarity, as defined by the European Court of Justice (ECJ) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Sabel BV v Puma AG* [1998] RPC 199, were met in this case. In their assessment of the similarity they addressed the visual, phonetic and conceptual similarity of the respective trade marks, which differ only in the sixth and seventh letters. Further they referred to the OHIM Board of Appeal decision R1178/2000-1 (14 February 2002) *TEMPOVATE & EMOVATE/EUMOVATE*, in particular paragraph 51 which includes a statement regarding the purchasing practices of medicinal products:

“ . . . Bearing in mind that in some countries medicinal products are administered over the counter, without prescriptions, that some consumers tend to resort to self-prescription and that professionals are often overworked and tend to write prescriptions with a hardly legible handwriting, the main similarities between the marks could give rise to a risk of confusion, considering the fact that not only specialist agents are confronted with the two signs in issue but also the normal average consumer who will not be able to memorise the slight differences between the two marks.”

10. Acting on behalf of the Registrar and after a careful study of the papers before me I give the following decision.

DECISION

11. The applicant claims that the registration should be declared invalid as per section 47 of the Act on the basis of the provisions of section 5(2)(b). The relevant parts of the Act are as follows:

“47. - (1)

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

“5. - (1)

(2) A trade mark shall not be registered if because -

(a), 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.”

“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,”

12. In dealing with section 5(2) and in my consideration of a likelihood of confusion or deception I take into account the guidance provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] 45 FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723, in particular, that the likelihood of confusion must be appreciated globally and take into account all relevant factors.

13. I note that the applicant’s CTM application number E2572246 is under opposition at the OHIM and has yet to be registered, whilst I could take this trade mark into consideration any decision based upon it in respect of these proceedings would have to be suspended until such time as the application achieved registration. However, the UK trade mark number 2302711 has been registered, is identical to the CTM application, both in terms of the trade mark itself and in the goods for which the CTM application was published. This will therefore form the basis of the applicant’s case; I do not need to take the CTM application into account.

14. The registration in suit, International registration number M798409, was placed on the International register on 19 February 2003, the UK was listed as a designated contracting party from that same date; international priority was claimed on the basis of Japanese application number 2002-104328, dated 10 December 2002. The applicant’s UK registered trade mark, number 2302711, was filed on 12 June 2002 and international priority was claimed, on the basis of their CTM application number E2572246, from 11 February 2002. As the filing and priority dates of the applicant’s UK registration both predate the designation and priority dates claimed by the International registration it is an earlier trade mark as defined by section 6(1)(a) of the Act.

15. The goods covered by the registration in suit are effectively identical to some of the goods covered by the applicant’s registration; “medicines for human purposes” in the specification of the trade mark registration in suit are the same goods as “pharmaceutical preparations” and “pharmaceutical preparations for the treatment of hepatitis C” in the specification of the applicant’s earlier trade mark.

16. The applicant’s mark is “RAVANEX” and that of the registered proprietor is “RAVANSA”.

17. The trade marks differ only in as far as the sixth and seventh characters are different, in one these are the letters “EX” and in the other the letters “SA”, and as such the trade marks have a small degree of visual similarity.

18. From the phonetic perspective the trade marks have differing syllabic constructions, albeit both having three syllables. The first being in the form RA – VA – NEX and the

second in the form RA – VAN – SA. With the only common syllable being the first, the overall aural impression is that the trade marks can be distinguished one from the other. Therefore from the phonetic point of view I regard these marks as dissimilar.

19. Both trade marks are invented words and as such do not individually relay a concept that would attract consumers' attention and thereby imply a conceptual similarity.

20. Overall, on taking the visual, aural and conceptual analysis into account I consider there to be little similarity between these trade marks.

21. Decisions of law of other national tribunals/courts within the EU are of persuasive value in determining the meaning of the Directive based provisions of the Act, but they are not binding upon the Registrar. In *Wagamama* [1996] FSR 716, Laddie J. decided that:

“It would not be right for an English Court, if it is firmly of a different view, to follow the route adopted by the courts of another Member State simply because the other courts expressed a view first. The scope of European legislation is too important to be decided on a ‘first past the post’ basis.”

The same must, in principle, be true of the position of the Registrar with regard to decisions of law made in other EU tribunals & courts. The Decisions of the ECJ on points of law are, of course, binding in the UK. Thus, whilst the OHIM Board of Appeal decision R1178/2000-1 is of some interest it is not necessarily determinative of this case. The particular paragraph brought to my attention relates to how the consumer and the medical professional would handle the selection and ordering of pharmaceutical products. In that particular case, TEMPOVATE & EMOVATE/EUMOVATE, the common ending was thought to be the cause of potential confusion. But in this case aurally and visually the trade marks RAVANEX & RAVANSA are distinct and not confusable. In modern medical practices prescriptions are no longer completed by hand, they are now completed from a computer terminal and printed onto the prescription form. Thus, the medical practitioner can see on screen that they have prescribed the correct drug and the pharmacist does not have to interpret a poorly written prescription with the potential for error. I note, too, that in *Choay S A v Boehringer Ingelheim International GmbH* [2001] ETMR 693 the OHIM First Board of Appeal observed that:

“In some Member States the view is taken that a likelihood of confusion should be accepted more readily in the case of medicines on account of the serious consequences that can ensue if the patient takes the wrong products. In other countries the view is taken that pharmaceutical trade marks will not be confused so easily because the consumer has the assistance of qualified professionals and is particularly attentive to the differences between marks for pharmaceutical products because of the importance of taking the right product.

In the Board's view, the conflicting considerations which underlie these opposing views are likely to cancel each other out in many cases, with the result that no special criteria need be applied to trade marks for pharmaceutical products."

Also I take note of a statement by the Registrars' Hearing Officer in *Glaxo Group Plc v Allergan Inc* (BL O/414/01) at paragraphs 16 and 17:

"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; Reactor at page 290.

17. Of course, in assessing the likelihood of confusion I must consider this matter through the eyes of the average consumer of the goods in question. Consequently, I have to take into account the way or ways in which the products in question reach the end consumer. In a case such as this a pharmaceutical may be available only on a doctor's prescription or through a pharmacist, these are professionals who are accustomed to dealing with the various products that are available and one might expect them to be more observant and circumspect than others. Other pharmaceuticals are available over the counter and are available to the general public without the intervention of a pharmacist or doctor when different considerations may apply. Each case must be determined on its own facts and on the evidence that is presented to the registry. In this case I have no evidence as to how these two pharmaceutical preparations covered by the respective specifications will be sold. The specifications are not limited in any way and so I must assume that they are or may be made available directly to the general public over the counter."

22. I have found that there is a small degree of visual similarity but no aural or conceptual similarity between the registered proprietor's and applicant's marks. Given the nature of the goods, these are not common products on a supermarket shelf, the consumer will be more circumspect about the product selection, even if bought off the shelf in a pharmacy. The applicant has argued that consumers could make an association between the marks in the circumstances set out in *Canon v MGM*. In particular, it gives rise to the question as to whether consumers, who were not confused between the marks, might nevertheless consider that the presence of the similar prefix type element in the marks suggested products from the same, or economically linked, manufacturer or supplier. However, without evidence to the contrary this does not seem likely and bearing in mind that the Act requires a likelihood of confusion, a mere possibility is not sufficient to sway the argument in favour of the applicant (see *REACT Trade Mark*, [2000] RPC 285 at page 290). Therefore, I find that the respective trade marks, even though they are registered for

the same goods, are not similar such that there exists a likelihood of confusion on the part of the public, which includes association with the earlier trade mark, if the registration in suit remains on the register.

23. The applicant has been unsuccessful, and I therefore make no order as to costs.

Dated this 21st day of May 2004

**Graham Attfield
For the Registrar
the Comptroller-General**