

TRADE MARKS ACT 1938 (AS AMENDED) AND THE TRADE  
MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION **m** 1562165  
BY GLYCOMED INC  
TO REGISTER THE MARK **GLYCOMED**

AND

IN THE MATTER OF OPPOSITION  
THERE TO UNDER OPPOSITION **m** 41903  
BY NYCOMED IMAGING A.S.

TRADE MARKS ACT 1938 (AS AMENDED) AND THE TRADE MARKS ACT 1994

IN THE MATTER of trade mark  
application **m** 1562165  
by Glycomed Inc  
5 to register a mark in class 5

and

IN THE MATTER of opposition  
thereto under opposition **m** 41903  
by Nycomed Imaging A.S.

10 DECISION

On 11 February 1994 Glycomed Incorporated, of California USA, applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark **GLYCOMED** in Class 5 in respect of the following goods:

15 “Pharmaceutical and veterinary preparations and substances; diagnostic preparations and substances; chemical substances and reagents, all for pharmaceutical, veterinary or diagnostic purposes; diagnostic preparations for sale in kit form; all included in Class 5.”

On 19 January 1995 Nycomed Imaging AS filed notice of opposition against the application. The grounds upon which the opposition is based are, in summary -

- 20           !       Section 12 — The trade mark in suit being confusingly similar to the opponent’s NYCOMED trade mark registrations and being for identical goods or goods of the same description.
- !       Section 11 — Owing to the reputation of the opponent’s trade mark NYCOMED in the United Kingdom, use of the trade mark in suit would be  
25           likely to deceive or cause confusion or otherwise be disentitled to protection in a court of justice or would be contrary to law.
- !       Sections 9(3)(b) and 10(2)(b) — The trade mark in suit not being adapted to distinguish and/or being incapable of distinguishing.
- 30           !       Section 17(2) — The registration and use of the trade mark in suit would unfairly prejudice the continuance of the opponent’s lawful trade in the United Kingdom under its trade mark NYCOMED, and would erode the opponent’s goodwill and would not be in the public interest. Registration should therefore be refused in the exercise of the Registrar’s discretion.

The opponent relies on a number of earlier registrations of the mark NYCOMED, both as a word-only mark, and in the form shown below:—



5 There is also one registration for the mark THROMBOTRACK NYCOMED. The registrations are in Classes 1, 5, 9 and 10, and cover a range of pharmaceutical preparations and medical apparatus. For example, trade mark m 1255764 (NYCOMED) is registered in Class 5 for:—

“Pharmaceutical preparations and diagnostic reagents for in vivo use.”

The applicant filed a counterstatement denying these grounds and also asking the Registrar to exercise discretion in their favour.

10 Both parties sought an award for costs.

The matter came to be heard on 7 April 1999 when the opponent was represented by Mr Arnold Watkins of Frank B Dehn & Co. The applicant did not attend, and was not represented.

15 By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. Nevertheless, these proceedings having begun under the provisions of the Trade Marks Act 1938, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, and unless otherwise indicated, all references in the remainder of this decision are references to the provisions of the old law.

20 Opponent’s Evidence

25 This consists of a statutory declaration dated 14 May 1996 by Mr Tore Talseth who is the President of Nycomed Imaging AS (hereafter “Nycomed”). Mr Talseth confirms that is he conversant with the English language and that the facts set forth in his declaration are either within his personal knowledge or have been ascertained from the records of the opponent or its subsidiary companies. The opponent is a wholly-owned subsidiary of the Hafslund Nycomed AS group of companies, which Mr Talseth describes as one of the leading pharmaceutical companies in Scandinavia and one of the leading suppliers of medical contrast media throughout the world.

30 Mr Talseth declares that the NYCOMED company name has been used from 1986 when Nyegaard & Co A/S changed its name to Nycomed AS. Nycomed AS subsequently changed its name to Hafslund Nycomed AS, the parent company of the group. Mr Talseth states that companies bearing the name NYCOMED have been trading throughout the world under this name since 1986. Hafslund Nycomed AS has its headquarters in Oslo, Norway, and has

subsidiaries in thirty six (36) countries. The company is listed on the stock exchanges in Oslo, London, Copenhagen, New York, Frankfurt and Vienna.

Copies of pages from Hafslund Nycomed's Annual Report for 1994, outlining the activities of Nycomed, are exhibited to Mr Talseth's declaration. Mr Talseth states that it is clear from this exhibit that his company and its parent company are major manufacturers and merchants of chemical products and that NYCOMED is their house mark and is associated with all of their products.

Nycomed's products are marketed in the United Kingdom by Nycomed (UK) Limited — a wholly-owned subsidiary of Nycomed. Nycomed (UK) Limited has traded in contrast media, diagnostic reagents and diagnostic kits, and associated apparatus and instruments in the United Kingdom under the NYCOMED name since 1986.

Mr Talseth exhibits a UK price list for contrast media products available under the NYCOMED mark. Mr Talseth goes on to state that all of the above products have been manufactured in the UK under the NYCOMED name for a considerable number of years and the parent group has invested significant amounts in promotion and advertising products under the mark. The following table shows the promotional and advertising expenditure worldwide of the Hafslund Nycomed AS group under the NYCOMED mark dating back to 1986:

| Year | Total Promotional Expenditure £000's | Advertising £000's |
|------|--------------------------------------|--------------------|
| 1995 | 1,114                                | 123                |
| 1994 | 1,219                                | 171                |
| 1993 | 722                                  | 136                |
| 1992 | 622                                  | 80                 |
| 1991 | 508                                  | 46                 |
| 1990 | 472                                  | 43                 |
| 1989 | 431                                  | 39                 |
| 1988 | 303                                  | 39                 |
| 1987 | 272                                  | 17                 |
| 1986 | 160                                  | 17                 |

Mr Talseth exhibits a selection of magazine advertisements of NYCOMED products in the United Kingdom spanning the period January 1988 to March 1992, and also a selection of product leaflets/brochures for contrast media products available in the United Kingdom showing use of the NYCOMED mark. The following turnover figures are stated for the United Kingdom for the years 1986 to 1994:

| Year | Turnover (£) | Year | Turnover (£) |
|------|--------------|------|--------------|
| 1986 | 4,291,898    | 1991 | 9,348,795    |
| 1987 | 5,192,706    | 1992 | 10,337,128   |
| 1988 | 6,220,827    | 1993 | 12,065,419   |
| 1989 | 7,539,934    | 1994 | 12,882,994   |
| 1990 | 8,851,444    |      |              |

In Mr Talseth's opinion, the trade mark in suit (GLYCOMED) is very similar to his company's NYCOMED house mark and in view of the close proximity of the GLYCOMED mark with NYCOMED, use of GLYCOMED on the relevant goods would result in confusion of purchasers and prospective purchasers of products and would result in highly damaging erosion of substantial goodwill in his company's NYCOMED house mark built up over a number of years. He concludes by stating that since the products in question are pharmaceuticals that are administered to human patients there is also a very strong likelihood that confusion will lead to accidental mis-use of products and consequent potentially fatal effects.

#### 10 Applicant's Evidence

The applicant's evidence consists of a statutory declaration dated 14 July 1997 by Mr Michael George Ashby who is a lecturer in Phonetics and Linguistics at University College, London. Mr Ashby's declaration consists of observations on the phonetic and linguistic characteristics of the words GLYCOMED and NYCOMED.

15 Mr Ashby says that the invented word GLYCOMED is likely to be given a consistent pronunciation by native speakers of English. Some minor variations may occur, but they are not linked with specific regional accents. He declares that the word will be pronounced with three syllables: GLY - CO - MED or GLYC - O - MED. (He adds that it is uncertain whether the C, which will have the sound [k], will be attached to the first syllable or to the second.) Individual speakers might well vacillate between one form and the other. He  
20 declares that in the first syllable, the letter Y is likely to be pronounced "long" (that is, as a diphthong) as in try or sky. There is a small probability that some might pronounce y "short" as in typical or crystal.

In the second syllable, the O may be given a full value as in go, or weakened to the obscure vowel ('schwa') as in the second syllable of orthodox or acrobat. A speaker's choice on this  
25 matter may depend on his/her analysis of the composition of the word. The third syllable MED has only one likely pronunciation, as in the first syllables of medicine or medical.

Mr Ashby declares that the main stress of the word would be placed on the first syllable, GLYcomed. The second syllable of the word is likely to be without any stress. The third  
30 syllable is likely to carry a weak or secondary stress. The first syllable of the word is thus in auditory terms the most prominent part of the word, and this will remain true at different rates of speaking and regardless of differing word combinations into which it is placed.

According to Mr Ashby, most of the comments relating to GLYCOMED apply also to NYCOMED, with the result that the two words are likely to be pronounced as rhymes. He  
35 goes on to state that the two words GLYCOMED and NYCOMED differ in the consonant sounds at the beginning of the stressed syllable. The difference may be considered salient for the following reasons:—

- in speech, as in writing, consonants contribute more to the identification and discrimination of words than do vowels
- the stressed syllable of a word is likely to be the loudest portion of the word, and the portion pronounced on the highest (and therefore most prominent) pitch
- the consonants at the beginning of the stressed syllable are generally pronounced more clearly and energetically than consonants in other positions
- GLYCOMED begins with a sequence of two consonants, but NYCOMED with a single consonant.

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10 Mr Ashby says that the most prominent part of a word for visual recognition is the beginning. He also observes that GLYCOMED and NYCOMED will not be close to each other in any alphabetical listing.

15 Overall, says Mr Ashby, the similarities and differences between the forms may be thought closely analogous to those between, say, scandalise and vandalise. Both are rhyming pairs of three syllables, differing in the onsets to the initial syllable, one having a single consonant, the other a consonant sequence.

20 He goes on to declare that as far as the evident composition of the words is concerned, most educated speakers will be aware that gluc(o)- or glyc(o) are established English word elements indicating “sweet”, “sugar”. In this case the -o- vowel is historically correct as the “thematic” vowel for the Greek root. However, this -o- vowel has been taken over as a general  
25 connective vowel in English and used to form many invented compounds, even when the elements of the compounds are not from Greek. Hence many speakers would assume the structure of GLYCOMED to be GLYC - O - MED. Some may regard CO as an abbreviation of the English word company, as it is reasonably common for CO in this sense to be incorporated into trade names.

30 Finally Mr Ashby states that English speakers will not generally be familiar with any element NY-, NYC-, or NYM. Those with any knowledge of Scandinavian languages may know that ny is both the Norwegian and Swedish word for “new”. In the spelling of Norwegian, the letter ‘y’ represents a rounded high front vowel of a type not found in English (approximately as in French lune). The likely English rendering of NY with the vowel of try bears no resemblance to the correct vowel.

#### Opponent’s Evidence in Reply

35 This consists of a statutory declaration dated 14 January 1998 by Mr Arnold Jack Watkins. Mr Watkins is a chartered patent agent and registered trade mark attorney. Mr Watkins declaration exhibits several colour photographs showing the trade mark NYCOMED on labels affixed to round containers and bottles. As is often the case with round containers and bottles, the part of the trade mark that is most prominent depends upon the positioning of the container or bottle relative to the viewer. Mr Watkins says that from certain positions it would be difficult or even impossible to distinguish between the two trade marks.

Regarding the evidence of Mr Ashby that the Glyc(o)— prefix would be seen as being indicative of “sweet” or “sugar”, Mr Watkins provides exhibits to show that some of Nycomed’s products (Dextrans) are made up of glucose units. On this basis Mr Watkins suggests that a GLUC- (or GLYC-) trade mark has an appropriate connotation in connection with these NYCOMED products of the opponent.

That concludes my review of the evidence, and I now turn to consider the grounds of opposition. Mr Watkins accepted that if he failed in his grounds of opposition under section 11 and section 12 then he would also fail under sections 9 and 10. No evidence has been adduced in support of the grounds of opposition under sections 9 and 10, nor were any submissions in support of these grounds made at the hearing. I therefore formally find that the opposition based on sections 9 and 10 fails.

### *Sections 11 and 12*

These sections of the Act read as follows:-

“11. It shall not be lawful to register as a trade mark or part of a trade mark mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of-

- (a) the same goods,
- (b) the same description of goods, or
- (c) services or a description of services which are associated with those goods or goods of that description.

The reference in section 12(1) to a near resemblance is clarified by section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

The established tests for objections under these sections have been laid down in the *OVAX* case<sup>1</sup> by Mr Justice Evershed and subsequently adapted by Lord Upjohn in *BALI*<sup>2</sup>. Applied to the facts of the present case, the tests may be expressed as follows:-

**(Under section 11)** Having regard to the user of the marks NYCOMED and  NYCOMED, is the tribunal satisfied that the mark applied for, GLYCOMED, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

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<sup>1</sup>Smith Hayden & Co Ltd’s Application [1946] 63 RPC 97

<sup>2</sup>BALI Trade Mark [1969] RPC 472

(Under section 12) Assuming use of the opponent's marks NYCOMED and  NYCOMED, in a normal and fair manner for any of the goods covered by the registrations of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicant uses the mark GLYCOMED, normally and fairly in respect of any goods covered by the proposed registration?

I will deal with the matter under section 12 first. The opponent has nine separate registrations for the two marks NYCOMED and  NYCOMED, and a further registration of the mark THROMBOTRACK NYCOMED in Class 10. For the purposes of section 12, I need only consider **m** 1255764 — NYCOMED — registered in Class 5 for “Pharmaceutical preparations and diagnostic reagents for in vivo use”. If the opposition cannot succeed under section 12 on the basis of **m** 1255764, then in my view it cannot succeed on the basis of any of the opponent other earlier marks.

It is clear that identical goods are involved as both specifications include pharmaceutical preparations and diagnostic reagents. The matter therefore resolves itself into a comparison of the marks themselves. So far as I am aware, the test advanced by Mr Justice Parker in the *PIANOTIST* case<sup>3</sup> remains the appropriate test for similarity of marks in proceedings under the 1938 Act and I propose to apply it in this case. The relevant passage reads:-

“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.”

The applicant has provided evidence from Mr Ashby, a lecturer in phonetics and linguistics, in relation to the phonetic and linguistic characteristics of the words GLYCOMED and NYCOMED. I propose to treat Mr Ashby's evidence as expert testimony; however it is expert testimony as to the likely *pronunciation* of the words GLYCOMED and NYCOMED and as such it is only one factor that I must bear in mind in determining the likelihood of confusion.

Mr Watkins' declaration highlights the particular risk of confusion owing to use of the trade marks on round containers and bottles, and specifically how confusion might arise if only part of a label is visible. In one of the exhibits to his declaration, a bottle bearing the NYCOMED mark has been photographed from an angle such that only the letters “YCOMED” are visible. In his submissions before me at the hearing, Mr Watkins emphasised the risk of confusion in

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<sup>3</sup>In the Matter of an Application by the Pianotist Company Ld for the Registration of a Mark [1906] 23 RPC at page 777

such circumstances. Prima facie this is an attractive argument; especially in the field of pharmaceutical products where the goods are often packaged in bottles or other round containers. However, I am not persuaded that a potential customer will purchase such a product on the basis of a partial view of the label on the bottle. If the goods are available  
5 'Over The Counter' (OTC) it is more likely that a person will pick up the bottle and view the label as a whole. In the case of Prescription Only Medicines (POM's), pharmacists are well aware of the danger of dispensing incorrect substances and I am therefore even less convinced that there is any likelihood of confusion. With regard to section 11, I note that the  
10 opponent's use of the mark has been in relation to 'contrast agents' — a range of chemicals that may be swallowed or injected into a patient before the patient is X-rayed or scanned. Mr Watkins confirmed that these products are used in hospitals and clinics, and are only available on prescription (POM).

At the hearing, I expressed some concern that the photographs of the NYCOMED bottles exhibited to Mr Watkins' declaration were cut off such that the majority of the lower portion  
15 of the label was not shown. There may be an entirely innocent explanation for this, albeit Mr Watkins conceded that he could not be certain what it was. The most likely explanation was that the larger part of the label had been deliberately obscured to focus attention on the NYCOMED element, which is used as a house mark, rather than the individual product brand name. In my opinion this further weakens the opponent's position under section 11.

20 It is well established that the first syllable of a word is important for the purpose of distinction (see *TRIPCASTROID* [1925] RPC 264). Mr Ashby's evidence underscores this when he says:-

"The main stress of the word would be placed on the first syllable: GLYcomed."

The comparison of marks is a very subjective matter. As suggested by Parker J in *Pianotist*  
25 (above) I have judged these two words by their sound, repeating them alternately to myself a number of times, and I have come to the conclusion that the first consonants in the respective marks are strong and do have the effect of differentiating the marks. I also take into account that the respective first consonants are visually dissimilar and that, owing to the nature of pharmaceutical products generally, most people will take reasonable care when selecting the  
30 goods.

In short, taking into account all the above matters, I do not think that there is a real tangible risk of confusion on the basis of normal and fair use of the mark GLYCOMED by the applicant. Accordingly the opposition under section 12 fails.

In relation to section 11, where it is necessary to consider the specific use made by the  
35 opponent of their marks, I believe the position is much clearer. The opponent has demonstrated substantial use of the trade mark NYCOMED in relation to contrast media since 1986 in the United Kingdom. Nevertheless, the mark has been used as a house mark with other trade mark matter distinguishing the particular product. Thus it seems extremely unlikely to me that the opponent's goods will, in use, be specified merely as "NYCOMED",  
40 without some additional indication as to precisely which of the opponent's products is intended. Having regard to such a pattern of user, in accordance with the established test, I

am satisfied that the mark applied for, GLYCOMED, if used in a normal and fair manner in connection with the relevant goods, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons. Consequently the opposition under section 11 also fails.

5 *Registrar's Discretion - Section 17(2)*

I turn now to the issue of the Registrar's discretion. Section 17(2) of the Act states:-

“Subject to the provisions of this Act, the Registrar may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right.”

10 In his submissions Mr Watkins referred me to “Kerly's Law of Trade Marks and Trade Names” (twelfth edition) which deals with the exercise of discretion. In particular he referred me to the following passage at page 34:-

15 “1. An application to register “Jardex” for a poisonous disinfectant was refused by reason of the existence of a registration of “Jardox” for meat extract: the goods were not so similar that registration was forbidden by section 12, but it was right to exercise the Registrar's discretion against the applicant since the two articles might come to be used in close proximity (in hospitals, perhaps) and confusion could have very serious consequences: *Edward* (1945) 63  
20 RPC 19 *cf. Sterwin v. Brocades* (1979) RPC 481, a passing-off case involving rival pharmaceutical products, where the Court granted a declaration although the likelihood of damage to the plaintiffs was “minimal”, since confusion might be serious to patients.”

In essence, Mr Watkins submitted that the Registrar's discretion should be exercised in the opponent's favour because of the risk to public health if the incorrect pharmaceutical product was prescribed or dispensed.

25 By long established practice, the Registrar takes a particularly strict view of marks proposed for registration in Class 5 because of the possible danger to the public if any confusion should arise. There are, therefore, numerous instances of registrations proposed for Class 5 which the Registrar has refused in the exercise of his discretion under section 17(2). There are however a number of factors which suggest that such an adverse exercise of discretion is unnecessary and inappropriate in this case.

30 First, it has to be admitted that the mark has survived both the scrutiny of a trade mark examiner in the Registry and, as a result of my decisions above, opposition under sections 11 and 12 in these proceedings. On neither occasion was confusion considered to be likely.

More significantly however, there is no evidence in these proceedings to demonstrate *how* the health of the public will be at risk even if there were confusion between these marks.

35 Mr Talseth concludes his declaration with the following paragraph:-

“12. Since the products in question are pharmaceuticals that are administered to human patients there is also a very strong likelihood that confusion will lead to accidental mis-use of products and consequent potentially fatal effects.”

However, as far as I am aware Mr Talseth is not medically qualified to assess the consequences of accidental mis-use in this case. It seems to me that accidental mis-use of pharmaceutical preparations will not invariably result in “potentially fatal effects”. For example, the opponent’s evidence establishes that NYCOMED contrast media is extremely safe and produces very few side effects. One of the brochures exhibited to Mr Talseth’s evidence describes the opponent’s Omnipaque contrast media (sold under the house mark NYCOMED) as “... clinically proven as very safe and comfortable”. The same brochure continues:-

“Even those patients who are most at risk — the very young, the very old or the very sick — show remarkably little reaction to Omnipaque. Side effects are not only less frequent, but also less severe. This high level of general tolerability makes Omnipaque extremely safe in use compared to ionic media. In addition, patient comfort is dramatically increased. Pain and distress is minimal, and nausea and vomiting — commonplace with conventional media — is markedly reduced.”

Mr Watkins submitted that there was a significant danger if GLYCOMED contrast media did not share the same characteristics as his client’s products. But even if I assume that the applicant proposes to use the mark on ‘conventional’ contrast media, it appears that the potential consequences — nausea and vomiting — however unpleasant to the patient, are described by the opponent in marketing literature as “commonplace”.

It is possible to envisage a more serious situation if the applicant were to use the mark GLYCOMED in relation to toxic substances which might be fatal if swallowed or injected after being mistaken for the opponent’s contrast media. However, as I have indicated above in my consideration of the section 11 issue, the pattern of use shown in the evidence suggests that the opponent’s contrast media is not specified solely by reference to the house mark NYCOMED, but more likely by, or in association with, the brand name, eg Omnipaque.

In all the circumstances, and taking the best view I can of the matter, I have come to the conclusion that it would not be appropriate to refuse this application in the exercise of the Registrar’s general discretion.

The applicant, having been successful in these proceedings, is entitled to a contribution towards the costs of defending the application. I therefore order the opponent to pay the applicant the sum of **£435**.

**Dated this 24<sup>th</sup> day of June 1999**

**Mr SJ Probert  
Deputy Director  
For the Registrar, the Comptroller-General**