

TRADE MARKS ACT 1994

**IN THE MATTER OF
INTERNATIONAL TRADE MARK REGISTRATION NO. 719637
SEEKING PROTECTION IN THE UNITED KINGDOM
AND STANDING IN THE NAME OF OMEGA FARMA EHF**

**AND IN THE MATTER OF
OPPOSITION NO. 70282 THERETO
BY H. LUNDBECK A/S**

**AND IN THE MATTER OF AN APPEAL
TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST THE DECISION OF MR. M. KNIGHT
DATED 9 NOVEMBER 2001**

DECISION

Introduction

1. By a request dated 14 September 1999, Omega Farma ehf (“the applicants”) sought to extend the protection of International Trade Mark Registration No. 719637 to the United Kingdom.
2. International Trade Mark Registration No. 719637 is for the mark OROPRAM and protection was requested for “medicine and medicinal products intended for human therapy” in Class 5 of the International Classification.
3. Following publication of the request in the Trade Marks Journal by the registry in accordance with article 10(1) of the Trade Marks (International Registration) Order 1996 as amended, H. Lundbeck A/S (“the opponents”) on 5 April 2000 filed notice of opposition to the conferring of protection under article 10(2) of the Order.
4. The opponents grounded their opposition under section 5(2)(a) and (b) of the Trade Marks Act 1994 (“the TMA”) relying on their earlier Community Trade Mark SEROPRAM registered under No. 000034405 with a filing date of 16 May 1996 in respect of “medical preparations” in Class 5.
5. The parties waived their rights to attend an oral hearing and on 9 November 2001, Mr. Mike Knight, Principal Hearing Officer, acting on behalf of the registrar issued a decision in the opposition based on the parties’ pleadings, the opponents’ evidence and written submissions provided by the applicants.

The Opponents' Evidence

6. The evidence in support of the opposition consisted of two statutory declarations of Stephen Richard James of R.G.C. Jenkins & Co., the opponents' trade mark attorneys. The main points to emerge from Dr. James' first declaration dated 18 December 2000 are in summary:
 - (a) SEROPRAM is the brand name under which the opponents market the anti-depressant drug citalopram in Austria, France, Greece, Italy and Spain.
 - (b) SEROPRAM is not used by the opponents in the United Kingdom to identify citalopram.
 - (c) Allowance must be made for the introduction of parallel imported SEROPRAM products into the United Kingdom market.
 - (d) Citalopram is used to treat major depression and panic disorders. At least under the brand name CIPRAMIL, citalopram is available from the opponents in tablet and drops, solution forms.
 - (e) The string "PRAM" appears in the generic and brand names of several drugs listed for the United Kingdom in the Chemindex Database, 2000. Dr. James points, in particular, to the generic drug doxapram marketed in the United Kingdom under the brand name DOPRAM. DOPRAM is used as a ventilatory stimulant to treat acute respiratory failure and following anaesthesia.
7. Dr. James' second declaration dated 4 April 2001 exhibits a copy photograph of a tub belonging to the applicants containing 28 OROPRAM 10 mg tablets. Dr. James says that the tablets are on sale in Iceland and consist of the active ingredient citalopram hydrobromide. In his view, the tub confirms the applicants' intention to use OPOPRAM in the United Kingdom for the drug citalopram. He comments: "This is precisely the drug and dosage form that the trade mark SEROPRAM is used to identify".

The Applicants' Written Submissions

8. In a letter dated 14 August 2001, the applicants through their trade mark attorneys Abel & Imray offered the registrar the following submissions:
 - (a) Although the suffix -PRAM might not exclusively be linked in pharmaceutical terms with citalopram, when used in connection with that drug, it will be readily understood that the suffix -PRAM is derived from citalopram.
 - (b) If, as contended by the opponents, the prefix SERO- brings to mind the mode of action of citalopram (a Selective Serotonin Reuptake Inhibitor) OROPRAM is distinguishable because its prefix does not bring to mind this mode of action.

- (c) Abel & Imray had been advised that by a decision dated 12 April 2001, the German Patent and Trade Mark Office rejected an opposition based on Community Trade Mark No. 000034405 to the extension of International Registration No. 719637 to Germany.

The Hearing Officer's Decision

9. Since the respective trade marks were clearly not identical, the hearing officer rejected the opposition under section 5(2)(a) of the TMA. There is no appeal against that part of Mr. Knight's decision.

10. Mr. Knight then moved on to consider the objection under section 5(2)(b) of the TMA, which reads:

“A trade mark shall not be registered if because ... 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 a likelihood of association with the earlier trade mark.”

11. Mr. Knight set out at paragraph 12 of his decision a list of factors to be taken into account in deciding whether there exists a likelihood of confusion amongst the relevant public for the purposes of section 5(2)(b) of the TMA. The factors derive from the guidance provided by the Court of Justice of the European Communities in *Sabel BV v. Puma AG*, Case C-251/95 [1997] ECR I-6191, *Canon Kabushiki v. MGM Inc.*, Case C-342/97 [1998] ECR I-5507, *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel BV*, Case C-342/97 [1999] ECR I-3830 and *Marca Mode CV v. Addidas AG and Addidas Benelux BV*, Case C-425/98 [2000] 2 CMLR 1061. It is accepted on appeal that Mr. Knight correctly directed himself as to the applicable law. Accordingly I shall not set out the factors, which are in any event well known.

12. The operative part of Mr. Knight's decision rejecting the opposition under section 5(2)(b) is set out at paras. 13 – 17:

“13. As indicated above, the likelihood of confusion between the respective trade marks must be considered globally taking account of all the factors set out above. In that connection, I consider that the goods covered by the respective specifications are identical. The applicants' specification is for medicine and medicinal products intended for human therapy whilst the opponents' Community trade mark is registered for medical preparations. In my view these can not be separated. Therefore, despite the fact that the evidence indicates that the applicants and the opponents use their trade mark in respect of pharmaceutical products containing citalopram neither specification of goods is so limited. Therefore, I consider the matter on the basis of notional and fair use across the range of goods for which the trade mark is registered and is sought to be registered (*React* [2000] RPC at page 288).

14. Submissions have been made to the Registrar in recent cases where the goods in question in the proceedings have been pharmaceuticals. Set out below are comments by the Registrar's Hearing Officer in the matter of an application by Allergan Inc. and opposition No. 50441 by Glaxo Group Ltd [SRIS – 414 – 01].

“15. This is not a new debate to trade mark law and Mr. Wilkinson referred me to an article written by Jane Mutimear “OHIM's Approach to Pharmaceutical Oppositions” [2001] 134 Trademark World at page 26. As the title suggests, this article analyses the approach taken by the Office for Harmonisation in the Internal Market in several oppositions to Community Trade Marks which cover pharmaceutical products. The article suggests that at present OHIM adopts a higher threshold before confusion can be found. The article is critical of that approach pointing to the potential consequences to public health when two pharmaceuticals are confused. At the hearing reference was also made to a recent decision of OHIM'S Third Board of Appeal *Admirall Prodesfarma SA v. Mudipharma AG* (Case R 622/1999-3). This case concerned the trade marks CODIDOL and CODEROL for pharmaceutical goods in class 5. The Third Board of Appeal upheld the decision of the opposition division and found that there was likelihood of confusion. The parties in that case advanced similar arguments to those before me. The Board did not express a view as to the correct approach but concluded:

“Furthermore, even if, as the applicant argues, the Board were to apply a higher threshold for a finding of likelihood of confusion, that would not be sufficient to counter the Board's finding in the present case.”

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 and not merely a possibility of confusion; *React* at page 290.”

15. Taking account of all of the above I therefore need to decide whether the respective trade marks are similar such that there exists a likelihood of confusion on the part of the public. The relevant public in this case may be doctors, pharmacists as well as the public at large, purchasing over the counter pharmaceutical products.

16. Visually, the two trade marks have the same suffix, as Mr. James points out in his evidence. But I am unable to determine whether any of the relevant public would associate that suffix, PRAM, with citalopram. Indeed, Mr. James' own evidence indicates that that suffix is not exclusively associated with a single pharmaceutical entity and therefore that suffix will have no meaning in pharmaceutical terms to anyone as far as I can tell. The prefix in each case is different, in the applicants' trade mark it is ORO and the opponents' it is SERO. Looking at the respective trade marks as a whole therefore I reach the view that visually they are different. Aurally, whilst each consists of two syllables the different prefixes result in different pronunciations thus, in my view, when considering that aspect the trade marks are also not similar. I then go on to consider notwithstanding the differences I have already indicated, whether there are, nevertheless, some conceptual similarities between the respective trade marks. Having ruled out that the suffixes indicate a common generic compound and that the prefixes are different I reach the view that there are no conceptual similarities between the two trade marks.

17. Bringing all the above into consideration and bearing in mind in particular that the differences between the respective trade marks occur in the first syllables which ensure that visually and orally there are no similarities between the trade marks and having decided that there is no conceptual similarity I conclude that the respective trade marks OROPRAM and SEROPRAM are not similar such that if the applicants' trade mark was registered there would exist a likelihood of confusion on the part of the public which would include the likelihood of association with the opponents' earlier trade mark. Thus the grounds of opposition based on section 5(2)(b) are dismissed."

The Appeal

13. On 6 December 2001, the opponents gave notice to appeal to an Appointed Person under section 76 of the TMA. In their notice of appeal, the opponents ask that the decision of the hearing officer under section 5(2)(b) be set aside, that protection be refused to International Trade Mark Registration No. 719637 and that the opponents be awarded the costs of this appeal and of the opposition.
14. The opponents argue in summary that hearing officer erred in:
 - (a) finding for the purposes of comparison of the respective marks that SEROPRAM and OROPRAM each consisted of two syllables when in fact they each contain three syllables;
 - (b) not giving effect to the principle of interdependence of similarity of marks on the one hand and goods on the other hand as expressed by the Court of Justice in *Canon Kabushiki v. MGM Inc.*, supra. – the respective goods in the present case being identical;

- (c) failing to take into account the inherent distinctiveness of SEROPRAM for the goods in respect of which it is registered in accordance with the guidance of the Court of Justice in *Sabel BV v. Puma AG*, supra..
15. On appeal, the opponents relied on a decision of the First Board of Appeal in *TEMPOVATE/EMOVATE, EUMOVATE*, Case R 1178/2000-1, 14 February 2002 which they say marks a turning point in the perceived policy of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”) of requiring a higher standard of likelihood of confusion in conflicts between pharmaceutical marks. After the appeal hearing, the opponents also sent me a copy of a decision of the Third Board of Appeal in *FIG. MARK (THERMOBABY)/DERMOBABY*, Case R 744/2000-3, 27 February 2002. With respect, I found these cases of limited assistance. *TEMPOVATE/EMOVATE, EUMOVATE* involved a conflict between a CTM application and national marks in Austria, the Benelux, Germany, Italy and Portugal. The First Board noted that especially in Italy and Portugal accentuation would be on the syllable “VA” in the marks. Likewise, in *THERMOBABY/DERMOBABY*, the CTM conflict was sited in Portugal. Here, I am concerned with the perceptions of the average English-speaking consumer who is encountering the respective goods under the respective trade marks in the United Kingdom.
16. At the appeal hearing, the opponents were represented by Dr. James of R.G.C. Jenkins & Co. The applicants did not appear and were not represented.

Likelihood of Confusion – Section 5(2)(b) TMA

17. First Council Directive 89/104/EEC states at recital 10:
- “Whereas the protection afforded by the registered trade mark ...applies also in case of similarity between the mark and the sign and the goods or services; whereas it is indispensable to give an interpretation to the concept of similarity in relation to the likelihood of confusion; whereas the likelihood of confusion, the appreciation of which 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, constitutes the specific condition for such protection ...”
18. Recital 10 and the case law of the Court of Justice mentioned at paragraph 10 above make clear that it is insufficient in deciding a conflict under art. 4(1)(b) of the Directive (section 5(2)(a) and (b) of the TMA) merely to focus on dissimilar elements in the respective marks in question. Instead, the global assessment of likelihood of confusion must take into account all the relevant circumstances of the case including any association that can be made between the earlier and the later trade marks. That interdependence of particularly distinctive character, association and similarity of marks and goods or services was recently reaffirmed by A.G. Jacobs in his Opinion in *Davidoff & Cie SA*,

Zino Davidoff SA v. Gofkid Ltd, Case C-292/00, 21 March 2002. The nature of any association the relevant public might make between OROPRAM and SEROPRAM and what effect that association might have on likelihood of confusion for the purposes of section 5(2)(b) of the TMA seem not to have been addressed by the hearing officer in this case.

19. Turning to a comparison of the marks, Dr. James' first criticism of the hearing officer's decision was that OROPRAM and SEROPRAM each consist of three syllables and not two (O-RO-PRAM and SE-RO-PRAM). I agree, although it is not evident whether Mr. Knight had in mind the prefixes or the marks as a whole when he said that each consisted of two syllables. Nevertheless, as Dr. James points out, Mr. Knight did not highlight that the marks have the strings RO-PRAM in common rather than just the suffixes –PRAM. The oral and visual differences between the two marks therefore reside in the first syllables O- and SE-. Visually one might add that SEROPRAM consists of eight letters whereas OROPRAM is made up of seven letters.
20. Dr. James did not challenge Mr. Knight's finding that conceptually both marks would be meaningless to the consumer. SEROPRAM and OROPRAM are registered or applied for in relation to "medical preparations" or "medicine and medicinal products intended for human therapy" respectively. When the marks are viewed across the specifications, it is true that conceptually they bear no meaning. However, the evidence suggests that both marks are or will be used to indicate anti-depressants containing citalopram. I cannot rule out the possibility that conceptually the consumer will make the link between the suffixes –PRAM and the generic citalopram.
21. The hearing officer made no finding as to the distinctive character of SEROPRAM. The recognition of the earlier trade mark on the market, whether that arises because of the inherent qualities of the mark or through use of the mark, is one of the factors that must be taken into account when determining likelihood of confusion. The more distinctive the earlier mark, the wider its penumbra of protection (*Sabel BV v. Puma AG*, supra., para. 24). SEROPRAM had not been used in the United Kingdom at the date of the request for extension of territorial protection for International Trade Mark Registration No. 719637 on 14 September 1999. Therefore, I have only the prima facie case to consider. I find that the mark SEROPRAM as a whole has high distinctive character for "medical preparations" irrespective of the fact that when encountered in connection with anti-depressants it may suggest to the consumer citalopram.
22. There can be no question that the respective goods in this case are identical. Dr. James referred me to the guidance of the Court of Justice in *Canon Kabushiki v. MGM Inc.*, supra., para. 17 to the effect that in the global assessment of likelihood of confusion, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods. Whilst Mr. Knight stated that he was taking the identity of the specifications into account, I am unable to tell from his decision exactly what effect he attributed to that identity.

23. Given the width of the specifications, I believe the hearing officer correctly identified the relevant public as doctors and pharmacists as well as the public purchasing over the counter pharmaceutical products. Dr. James urged me to consider that the average consumer may be a patient suffering from depression or panic disorder with a greater than normal propensity to imperfect recollection. I have been presented with no evidence to suggest that the consumer of anti-depressants should be regarded as any less reasonably observant or reasonably well informed or circumspect than the consumer of other pharmaceuticals. In any event, the specifications are not so limited.
24. In the applicants' own admission the prefix of OROPRAM suggests oral delivery. That coupled with the degree of similarity in the marks, the identity of the goods and the high distinctiveness of SEROPRAM, leads me to conclude that the average consumer is likely to consider that "medicine and medicinal products intended for human therapy" offered under the mark OROPRAM originate from the opponents or an undertaking economically linked to the opponents in the sense that they are different products in the same range (*Wagamama Ltd v. City Centre Restaurants plc* [1995] FSR 713). Thus contrary to the view of the hearing officer, I believe that the opposition case under section 5(2)(b) of the TMA is made out.
25. I have arrived at this view without engaging in the debate whether a higher or lower threshold needs to be reached before confusion can be established in conflicts between pharmaceutical trade marks. For my own part, I do not believe that different standards exist or are necessary to exist. The test of likelihood of confusion is flexible enough to allow each case to be judged according to its own peculiar facts. Relevant considerations may include those mentioned by the First Board of Appeal in *TEMPOVATE/EMOVATE, EUMOVATE*, supra., namely that some medicinal products are administered over the counter without prescriptions, some consumers resort to self-prescription and professionals are often overworked and may write prescriptions in hardly legible handwriting (although drugs may be prescription only, professionals may be on hand to assist choice with OTC products and pharmacists usually check illegible prescriptions).
26. I am also conscious of the fact that I may have reached a different outcome than that of the German Patent and Trade Mark Office. However, I have not been provided with a copy of that decision nor am I aware of the facts, evidence or arguments adduced in the German opposition. I have dealt in this case with the perceptions of the average United Kingdom consumer. Naturally, the German PTO would have considered the perceptions of the average German consumer.

Conclusion

27. In the result this appeal succeeds and refusal of protection to International Trade Mark Registration No. 719637 is upheld. Mr. Knight assessed the costs to be awarded to the successful party on opposition at £400. I direct that the applicants pay the opponents the sum of £400 in respect of the opposition and a further sum of £400 towards the opponents' costs of the appeal, to be paid on the same basis as indicated by Mr. Knight.

Professor Ruth Annand, 8 May 2002

Dr. S. R. James, R.G.C. Jenkins appeared on behalf of the opponents.

The applicants did not appear and were not represented.