

O-224-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2322203  
IN THE NAME OF PEACH ETHICAL LIMITED t/a PEACH  
PHARMACEUTICALS**

**AND**

**IN THE MATTER OF APPLICATION FOR A  
DECLARATION OF INVALIDITY NO. 81907  
THERE TO BY WARNER-LAMBERT COMPANY LLC**

**IN THE MATTER OF** trade mark registration No. 2322203  
in the name of Peach Ethical Limited t/a Peach Pharmaceuticals

**AND**

**IN THE MATTER OF** application for a Declaration of Invalidity  
No. 81907 thereto by Warner-Lambert Company LLC

## **BACKGROUND**

1. The trade mark “DALPROFEN” was filed on 30 January 2003, has been registered since 4 July 2003 under number 2322203 and stands in the name of Peach Ethical Limited t/a Peach Pharmaceuticals. It is registered in respect of:

Class 05:

Analgesic preparations.

2. On 27 October 2004, Warner-Lambert Company LLC filed an application for a declaration of invalidity of the registration. The action was filed on Form TM26(I) together with the appropriate fee. The statement of grounds accompanying the application set out the grounds of action, which are under sections 47(2)(a) and 5(2)(b) of the Act as the applicant claims that use of the registrant’s mark is likely to cause confusion on the part of the public, which includes the likelihood of association with the applicant’s earlier trade mark.

The applicant gave details of its earlier trade mark registration as an exhibit to the statement of grounds, this was listed as “CALPROFEN”, which has been registered since 28 March 2003 under number 2282158 and stands in the name of Warner-Lambert Company LLC. It is registered in respect of:

Class 05:

Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; medicinal preparations and substances; vaccines and sera.

3. On 1 November 2004 a copy of the application for invalidation and the statement of grounds were sent to the address for service recorded on the register. The consequences of failure to defend the registration were set out in the letter, namely that the application for declaration of invalidity could be granted in whole or in part. Under Rule 33(6) a period of six weeks was set for the filing of a defence of the registration, this period expiring on 13 December 2004.

4. On 17 December 2004 the registered proprietor, through their agent, submitted a Form TM8 and counterstatement, claiming in the covering letter that they had not received the application for invalidation until 5 November 2004 and therefore they were filing the defence within the specified period of six weeks.

5. On 11 January 2005 the registry responded, reiterating the wording of Rule 33(6) which states:-

“(6) The proprietor shall, within six weeks of the date on which he was sent a copy of Form TM26(I) and the statement by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat him as not opposing the application.”

As the six week period set for filing a defence commences upon the sending of the Form TM26(I) and statement of grounds, and not when the recipient receives them, the documents received by the registry were out of time and could not be admitted into these proceedings. Under Rule 68(3) the period set under Rule 33(6) cannot be extended and therefore these proceedings continued undefended. The registered proprietor did not contest this decision or request a hearing.

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

7. 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.”

8. The reason that the Hearing Officer arrived at this view is the statutory presumption 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.”

9. With this in mind, on 11 January 2005, the Registrar wrote to the applicant’s representative inviting him to file any evidence or make any submission which he felt would support his client’s application to, 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.

10. On 7 March 2005 the applicant for invalidity provided a written submission giving their opinion of the case against the registered proprietor. They did not request a hearing and therefore the decision will be taken on the basis of the papers filed.

11. In their submission the applicant argued, citing the statement of grounds, that their registration, which was filed on 2 October 2001 and registered on 28 March 2003, qualified as an earlier trade mark 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 *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] 45 FSR 77 were met in this case. In their assessment of the similarity of the marks they addressed the visual, phonetic and conceptual similarity, noting in particular that they differ only in their first letter. In addressing the similarity of the goods they referred to a decision by the Registrars' Hearing Officer, *Glaxo Group Plc v Allergan Inc.* (SRIS O/414/01), a number of decisions by the Appointed Persons, *H Lundbeck A/S v Omega Farma EHF* (SRIS O/208/02), *Glaxo Group Plc v Allergan Inc.* (SRIS O/293/02) and *EPTISET/EPISTAT* (SRIS O/312/03), and the OHIM Opposition Division, *Coversyl/Coviracil* (1302-2002 of 30 April 2002) and *Dona/Giona* (3405-2002 of 26 November 2002), and Boards of Appeal, *Choay SA v Boehringer Ingelheim International GmbH* [2001] ETMR 693.

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

## DECISION

13. 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.

(3) . . . .

(4) . . . .

(5) . . . .

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

“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.”

14. 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.

15. The marks to be compared are:-

Applicant's mark

Registered proprietor's mark

CALPROFEN

DALPROFEN

16. The marks differ only in as far as the first characters are different, in one it is a letter C and in the other a letter D, both marks have nine letters, the second to ninth being the same in each case, ALPROFEN, and as such they are regarded as visually similar. From the phonetic perspective each mark is composed of three syllables, the second and third being identical. The first syllable is different, but again only in as far as the first letter, however this syllable has the same vowel and ending sound such that overall the two marks have a significant aural similarity. Both marks have the suffix PROFEN, which in regard to pharmaceutical products is likely to bring to the mind of consumers a relationship to the well known analgesic Ibuprofen, and thus there is a conceptual similarity. I take note of a statement by the Registrars' Hearing Officer in *Glaxo Group Plc v Allergan Inc* (BL O/414/01) at paragraph 17:

“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 pharmaceuticals 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.”

As the mark in suit is registered for “analgesic preparations” which are commonly available over the counter to the general public, and the applicant’s trade mark is registered for all pharmaceutical products, I take this, the general public, to be the relevant consumer group. Taken as a whole there is a high level of similarity between the marks.

17. The mark in suit is registered for “analgesic preparations” which is a quite specific pharmaceutical preparation. The applicant’s mark is registered for a range of products in Class 5, which includes amongst others “pharmaceutical preparations” and “medicinal preparations and substances” both of which are general terms and would encompass the specific term “analgesic preparations”. Therefore I regard the goods as identical.

18. I have found that there is a high degree of similarity at the visual, aural and conceptual levels between the registered proprietor’s and applicant’s marks. I have also found the respective goods to be identical. I consider that taking account of all the criteria, as I am required to do under the relevant jurisprudence, there is the level of similarity between the respective trade marks and identity of goods sufficient to lead to a likelihood of confusion on the part of the relevant public. The application for a declaration of invalidity consequently succeeds.

19. Taking the above findings into account I declare the registered proprietor’s registration to be invalid. I direct that it be removed from the register and in accordance with Section 47(6) of the Act the registration is deemed never to have been made.

20. As to costs, the applicant for invalidity has been successful, and I order Peach Ethical Limited t/a Peach Pharmaceuticals to pay them £600. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 4<sup>th</sup> day of August 2005**

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