

O-314-06

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 823874
AND THE REQUEST BY ZENTIVA A.S
TO PROTECT THE TRADE MARK
ZENRA
IN CLASS 5**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 71249
BY PFIZER PRODUCTS INC.**

BACKGROUND

1) On 15 March 2005, Zentiva a.s.(hereinafter the applicant), of U Kabelovny 130, CZ-102 37 Praha 10-Dolni Mecholupy, Czech Republic on the basis of its international registration based upon its registration held in the Czech Republic, requested protection in the United Kingdom of the trade mark ZENRA under the provisions of the Madrid Protocol. Protection was sought for the following goods in Class 5: “Anti-hypertensive pharmaceutical preparation and ACE inhibitor containing active substance Ramipril.”

2) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

3) On 10 October 2005 Pfizer Products Inc. of Eastern Point Road, 06340-5146 Groton, United States of America filed notice of opposition to the conferring of protection on this international registration. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Effective date	Class	Specification
CENRAL	CTM 2563807	05.02.02	5	Pharmaceutical and veterinary preparations and substances; all included in class 5.
CENRAL	2291574	01.02.02	5	Human pharmaceutical preparations for the treatment of central nervous system diseases and disorders.

b) The opponent claims that the goods are identical and/or similar and that the marks are confusingly similar. The mark therefore offends against Section 5(2)(b) the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent’s claims and also puts the opponent to proof of use.

5) Neither side filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 25 October 2006 when the opponent was represented by Mr Philip Harris of Messrs Gill Jennings & Every and the applicant was represented by Ms Harland of Messrs Reddie & Grose.

DECISION

6) The only ground of opposition is under section 5(2)(b) which reads:

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

(a)....

- (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.”

7) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

8) The opponent is relying upon two trade marks CTM 2563807 which has an effective date of 5 February 2002 and UK Trade Mark No. 2563807 which has an effective date of 1 February 2002. Both are clearly earlier trade marks.

9) In determining the question under section 5(2)(b), I take into account the guidance provided 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] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux B.V.* [2000] E.T.M.R 723. It is clear from these cases that:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;

- (b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*;

- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*;

- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux B.V.*;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

10) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

11) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert

for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

12) The opponent has not provided any evidence of use and cannot benefit from an enhanced level of protection due to reputation. I also have to consider whether the opponent’s marks are inherently distinctive. The opponent’s marks consists of the same word CENRAL. The marks are registered for goods in Class 5, and appear to be inherently distinctive.

13) I shall first consider the specifications of both parties. For ease of reference these are as follows:

Applicant’s specification	Opponent’s specifications
Anti-hypertensive pharmaceutical preparation and ACE inhibitor containing active substance Ramipril	CTM 2563807: Pharmaceutical and veterinary preparations and substances; all included in class 5.
	2291574: Human pharmaceutical preparations for the treatment of central nervous system diseases and disorders.

14) In carrying out the comparison of the specifications of the two parties I take into account the factors referred to in the opinion of the Advocate General in *Canon* [1999] ETMR 1. In its judgement, the ECJ stated at page 6 paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

15) Ms Harland, for the applicant contended that the comparison should be based only on the opponent’s UK trade mark specification. She contended that the reason for the difference between the opponent’s specifications was that the system at OHIM allowed a wider specification than permitted by the UK Registry. I do not accept this contention and cannot artificially restrict the opponent’s lawfully registered specification. The CTM specification provides the opponent with its strongest case and, clearly, that specification encompasses the applicant’s goods. For the purposes of the global assessment the goods must be considered to be identical.

16) In considering the marks of the two parties I shall refer to the opponent’s marks in the singular as they are identical. The marks of the two parties are as follows:

Applicant’s mark	Opponent’s mark
ZENRA	CENRAL

17) Mr Harris contended that the marks were of similar length and shared the central four letters, ENRA, and that these two syllables are distinctive and dominant components suggesting a common origin. I agree that the marks are of similar length

being five and six letters long respectively. I also accept that they share the four letters, ENRA. However, I do not accept that these form distinctive and dominant components. I do not accept that I should so conveniently overlook the difference in the initial letters of the marks nor that the opponent's mark ends in the letter "L". There are visual differences which to my mind outweigh the similarities.

18) Phonetically, Mr Harris contended that despite starting with different letters the difference could easily be lost in pronunciation. He claimed in his skeleton argument at paragraph 24 "that difference in sound can easily be lost in the pronunciation of the first syllables ZEN- and CEN-. Thus phonetically the first syllables are very similar." He also contended that "25. The suffixes RA and RAL can also be pronounced in a very similar fashion. Ra- will be heard as -RUH; -RAL as RUHL. Furthermore, a L placed at the end of a word has a tendency to be lost or swallowed, which would leave the observer of [sic] recipient of the marks to determine the difference between ZENRA/"ZENRUH" and CENRA/"CENRUH". I was referred to two OHIM cases, B568123 and B605792 where it was held that the letters "Z" and "S" are phonetically similar. Mr Harris contended that an extension of "S" to "C" was acceptable.

19) I do not accept the contention that the letters "Z" and "C" are phonetically similar. In normal use of the English language there is a distinct difference between the two letters particularly when they proceed the letters "EN". "ZEN" is a recognisable term relating to Buddhism, whilst "CEN" will be pronounced as in the word CENTRAL. One is a droning sound the other a hissing sound. Nor do I accept that the letter "L" will be swallowed, or tailed off into oblivion. In such a short word the letter will be recognised and pronounced. Even allowing for noisy environments I believe that the differences in pronunciation will be obvious.

20) Neither mark has a conceptual meaning despite the contentions of Ms Harland to the contrary.

21) I must also consider the average consumer for the types of goods covered by the specifications of both parties. In my opinion, they would fall into two camps. The professional group of doctors, nurses and pharmacists and secondly the general public. I take both groups to be reasonably well informed and reasonably circumspect and observant. In my view, medication is neither provided nor taken without considerable care by all concerned. Although I must take into account the concept of imperfect recollection. Mr Harris contended that the environment which in a shop, dispensary or hospital ward could be very noisy. He also sought to persuade me that the patients receiving medication would be ill and therefore could suffer from reduced cognitive, visual or aural ability or recollection and may not therefore be as circumspect or observant as the average consumer for other types of goods. Whilst I accept that there is some force in this view I also have to consider that medications are often obtained by relatives or carers and that noisy environments also play a part in aural comparisons of all marks.

22) Taking account of all of the above when considering the marks globally, I believe that, despite the goods being identical, there is not a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the

opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

COSTS

23) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1,500. This sum 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 6th day of November 2006

**George W Salthouse
For the Registrar,
the Comptroller-General**