

O-368-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2384045
BY RENOVO LIMITED TO REGISTER THE TRADE MARK KLARYX
IN CLASS 5**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 94251
BY SANOFI-AVENTIS**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2384045
By Renovo Limited to register the Trade Mark
KLARYX in Class5**

and

**IN THE MATTER OF Opposition thereto under No. 94251
by Sanofi-Aventis**

BACKGROUND

1) On 10 February 2005, Renovo Limited, of The Incubator Building, 48 Grafton Street, Manchester, M13 9XX applied under the Trade Marks Act 1994 (the Act) for registration of the trade mark KLARYX in respect of the following goods in Class 5:

“Pharmaceutical preparations; wound healing preparations; preparations for the prevention, reduction, inhibition or treatment of scarring; preparations for the treatment, reduction, inhibition or prevention of fibrosis; preparations for the treatment, inhibition or prevention of the development of fibrotic conditions; preparations for use in connection with elective surgery; preparations for the treatment, reduction, inhibition or prevention of dermal wounds; preparations for the treatment, reduction, inhibition or prevention of dermal scarring; preparations for the treatment, reduction, inhibition or prevention of dermal fibrotic conditions; preparations for the treatment of damaged ligaments, tendons or cartilage; preparations for the promotion of re-epithelialization; preparations for the treatment of chronic wounds; preparations for the treatment of burns; preparations for the treatment, reduction, inhibition or prevention of ulcers or pressure sores; preparations for the treatment, reduction, inhibition or prevention of adhesions and strictures; preparations for the treatment of cardiovascular and vascular restenosis; preparations for the treatment of the eye; preparations for the treatment of nerves.”

2) On 29 March 2006, Sanofi-Aventis of 174 Avenue de France, 75013 Paris, France filed notice of opposition to the application, the grounds under Section 5(2)(b) of the Act based upon the opponent’s own Trade Mark No. 2068394 for PLAVIX. This Trade Mark was applied for on 1 April 1996 and is an earlier trade mark within the meaning of Section 6A of the Act and is registered for the following goods in Class 5:

“Cardiovascular products included in Class 5.”

3) The applicant subsequently filed a counterstatement denying that the respective trade marks are similar. It contends that the respective trade marks are both visually and aurally different. It also contends that the respective goods are not similar, especially when the high degree of knowledge of the user of such goods is considered. The applicant also puts

the opponent to strict proof of use of the trade mark PLAVIX in respect of cardiovascular products.

4) Both sides filed evidence in these proceedings. Neither requested to be heard but both sides filed written submissions in lieu of a hearing. Both sides ask for an award of costs. After careful consideration of the papers, I give this decision.

Opponent's Evidence

5) This takes the form of a witness statement by John Tarplee and is dated 8 December 2006. Mr Tarplee is the Director of the Cardio-Vascular Business Unit of Sanofi-Aventis. Mr Tarplee discloses annual sales figures for the PLAVIX product in the UK. These figures range from £365 in 1998 to £189,333 in 2006. Advertising spend for the same product is also disclosed for the years 1998 to 2005 and ranges from £371,256 to £797,741 a year.

6) Mr Tarplee attaches to his witness statement the following exhibits:

- JT1 extract from the British Heart Foundation's website referring to the PLAVIX trade mark.
- JT2 sales invoices referencing the sale of products bearing the trade mark.
- JT3 a spread sheet referencing adverts placed for the trade mark.
- JT4 copies of adverts for products bearing the trade mark.
- JT5 an invoice relating to sponsorship by PLAVIX of the Primary Care Cardiovascular Society.
- JT6 copies of packaging bearing the trade mark.

Applicant's Evidence

7) This is a witness statement by Andrew Kay dated 11 June 2007. Mr Kay is Executive Commercial Director of Renovo Limited.

8) Mr Kay contends that the use of the opponent's trade mark is very different to the intended use of the applicant's trade mark and that the respective products do not have the same medical purpose. He notes that the disclosed turnover is not high for products bearing the PRAVIX trade mark, particularly by comparison to the associated advertising spend. Mr Kay notes that no samples have been provided of the adverts recorded on the spreadsheet presented as exhibit JT3 and that this exhibit does not assist.

9) Mr Kay notes that the samples of adverts provided as exhibit JT4 illustrate use of a stylised form of the trade mark PLAVIX and contends that no use of the word only trade

mark has been established. He submits that much of the declared advertising expenditure must also relate to the stylised form of the trade mark. He asserts that this stylised form of the trade mark is even further removed from the applicant's trade mark and is not confusable with it.

10) It is acknowledged that the opponent sponsored the Primary Care Cardiovascular Society in 2006, but that the nature of this sponsorship is not known from the exhibits filed or the prominence of the trade mark PLAVIX in this sponsorship.

Opponent's Evidence in reply

11) This is a further witness statement by John Tarplee and is dated 4 September 2007.

12) He provided revised annual turnover figures for PLAVIX products explaining that the earlier figures were incorrect as a result of a systematic typographical error. The revised figures range from £365,000 in 1998 to £189,333,000 in 2006 and reflect a thousand-fold increase on the figures originally disclosed.

13) Mr Tarplee concedes that use of the trade mark is in a slightly stylised form, but that the trade mark is essentially a plain trade mark with immaterial differences from the trade mark as registered.

DECISION

Proof of use

14) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services...”

15) The requirements for “genuine use” have been set out by the European Court of Justice in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and in its reasoned Order in Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar S.A.* [2005] ETMR 114.

16) In *Ansul*, the European Court of Justice held as follows:

“35. ... ‘Genuine use’ therefore means actual use of the mark....

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user...

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be

marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns...

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

17) In *La Mer* the ECJ held as follows:

21. ... it is clear from paragraph [39] of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case by case assessment which it is for the national court to carry out....

...

25. In those circumstances it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down.

18) John Tarplee, in his witness statement of 8 December 2006 provided annual sales figures for the years 1998 to 2006 inclusive. These figures are challenged by Andrew Kay in his witness statement of 11 June 2007. This challenge led to Mr Tarplee providing revised figures in his witness statement of 4 September 2007. These revised figures are a thousand-fold increase upon the originally declared figures and are not questioned further by Mr Kay. These substantial figures are at such a level as to demonstrate genuine use, subject to analysis of the other relevant factors. As such, these figures need play no further part in my analysis of whether genuine use of the trade mark has been demonstrated for the purposes of Section 6A of the Act.

19) Eighteen invoices are provided as exhibits with Mr Tarplee's witness statement illustrating numerous sales of products described as PLAVIX to a number of customers between the years 2001 and 2005. In many cases, these invoices relate to the sale of packs numbering into the hundreds and with one invoice recording the sale of five thousand packs. This level of sales is a further indication of genuine use.

20) The evidence provided by Mr Tarplee illustrates that the trade mark PLAVIX is used on a pharmaceutical product for the prevention and treatment of cardiovascular disease. This use is narrower than the *cardiovascular products* listed as the specification of goods, which could include non-pharmaceutical products such as herbal remedies.

21) Andrew Kay, in his witness statement of 11 June 2007, submits that each and every use of the trade mark PLAVIX is in a stylised form and not as registered and as such, fails to establish any use of the trade mark relied upon in the proceedings. The *Bud and Budweiser Budbrau* [2003] RPC 25 court of appeal decision provides me with some guidance on how to approach this issue:

“.....The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

22) The trade mark, as the claimed use shows, consists of the word PLAVIX in an unremarkable typeface where the letter “P” is in uppercase and the other letters in lowercase. The dot over the letter “I” is represented by ball-like device with three “speed lines” extending backwards over the letter “V”. All the exhibits filed are black and white photocopies and I am unable to comment on whether the differences of shading of some letters in some exhibits are differences of shading or differences of colour.

23) Having identified the points of difference, I must go on to consider if they alter the distinctive character of the trade mark as registered. I have identified the points of difference as being typeface and the device-like dot over the letter “I”. I find that the first of these differences is of no consequence and it is generally accepted that a trade mark applied for in ordinary typeface is not restricted in terms of colour or at least a normal typeface. The second difference identified is that of the device element resembling a ball that replaces the dot over the letter “I” and the “speed lines” extending from this device. The ball device is in proportion to the letters forming the word, that is, it is of a size and shape similar to that of the dot it replaces. It therefore is of little impact when considering the overall impression created by the trade mark. The “speed lines” have a similarly small impact, again, because of their size in proportion to the word element of the trade mark.

24) I do not consider that these points of difference are sufficient to alter the trade mark's distinctive character, and I accept the exhibits as being an illustration of genuine use on pharmaceutical products for the prevention and treatment of cardiovascular disease. I also note that a number of the exhibits illustrate use of the word only trade mark where it is referred to in the text, for example where the prescribing information of the product is

provided. These occurrences further strengthen my view that genuine use has been demonstrated.

Section 5(2)(b)

25) The opposition is founded upon Section 5(2)(b) of the Act. This reads:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, 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.”

26) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice 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 B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [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 services, 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,*

(h) 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,*

(i) 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 BV,*

(j) 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.*

The average consumer

27) Firstly, I turn to the question of how the average consumer would judge the respective trade marks. In *Armour Pharmaceutical Co v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-483/04* the Court of First Instance stated:

“79 The Court finds that the level of attention of the average consumer of pharmaceutical preparations must be determined on a case-by-case basis, according to the facts in the case-file, especially the therapeutic indications of the goods in question. Likewise, the Court finds that, in the case of medicinal products subject to medical prescription such as those being considered in the present case, that level of attention will generally be higher, given that they are prescribed by a physician and subsequently checked by a pharmacist who delivers them to the consumers.”

28) The applicant, in its written submissions of 2 November 2007, contends that in this case, the relevant consumers “are knowledgeable users who would exercise an amount of care, thought and deliberation when purchasing these specialised goods”.

29) There is no indication that the pharmaceutical products of the application are available only on prescription or only for specialised use by medical professionals and so I must take into account that they could be purchased over the counter or from the shelf in a pharmacy or supermarket by the general public and may be of low cost. The evidence

illustrates that the trade mark PLAVIX is used on a pharmaceutical product, but there is no indication as to whether this product is available on prescription only and I must consider that this too can be purchased by the general public in the same way as some other pharmaceuticals products used in the treatment and prevention of cardiovascular disease such as aspirin. I consider the relevant consumer for the products could be both the medical specialist and the public at large. It can be extrapolated from the invoices provided in the opponent's exhibit JT2 that the opponent's product is not of the lowest cost suggesting that a reasonable degree of care is taken when purchasing but no further evidence is provided that supports or weakens this suggestion.

30) I conclude that the goods of the earlier registration and many of those of the application may be of a specialised nature, requiring a reasonable degree of care to be taken when purchasing, but not the greatest degree of care particularly in respect to the applicant's goods that can be of low cost.

Comparison of goods

31) I intend to approach the comparison of goods question based upon this narrower scope upon which the opponent has demonstrated genuine use, namely pharmaceutical product for the prevention and treatment of cardiovascular disease.

32) In its written submissions, the applicant limits the list of goods by removing the general phrase *pharmaceutical preparations* and the specific term *preparations for the treatment of cardiovascular and vascular restenosis* and I will limit my analysis to the amended list of goods.

33) The opponent, in its written submissions, proposes the view that the healing preparations, the subject of the applicant's trade mark, "might well be confusingly similar to cardiovascular products, particularly if the healing preparations are to be used for the heart or circulatory system". In its written submission, the applicant contends that "there is no likelihood of commercial confusion between the respective goods..."

34) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law. In *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281, Mr Justice Jacob commented:

"...I think the following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular

whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive.

This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

35) The revised list of goods of the Applicant’s trade mark consists of a wide range of “preparations” for various medical purposes. All these preparations include pharmaceutical products and therefore there is, at this level of generality, a degree of similarity with the opponent’s goods. In its written submission, the opponent contends “that healing preparations might well be confusingly similar to cardiovascular products, particularly if the healing preparations are to be used for the heart or circulatory system”. I agree with this statement. Some goods have a higher degree of similarity and may be identical, for example *preparations for the treatment, reduction, inhibition or prevention of [] strictures* may have applications to veins and arteries. The opponent also contends that other goods listed may have similar applications and in particular, it cites *preparations for the treatment, reduction, inhibition or prevention of fibrosis*. The applicant’s submission confirms that fibrotic conditions can exist in a cardiovascular scenario when it refers to “...fibrotic tissue (that) forms in the wall of the blood vessel.” By extension, I find that *preparations for the treatment, inhibition or prevention of the development of fibrotic conditions* must also cover such applications and that both terms cover goods that are at least highly similar to the goods of the earlier trade mark.

36) In the *Canon* judgment mentioned above, complementary use is identified as a further factor to be taken into accounts when assessing the similarity of goods. Exhibit JT1 of the opponent’s evidence consists of an extract of the British Heart Foundation’s website where the PLAVIX product is described as being “...often used after an angioplasty and stent insertion...” Many of the applicant’s remaining goods such as *preparations for the treatment, reduction, inhibition or prevention of adhesions* and *wound healing preparations* can have applications to cardiovascular surgery such as angioplasty and stent insertion. These goods are complementary to the PLAVIX product as they can be used in the treatment of the same ailments.

37) I have established earlier that the respective users are the same, namely medical practitioners and the general public. Having established that the respective goods are pharmaceutical preparations, the physical nature and trade channels are likely to be identical. In taking account of all these factors and those discussed above, I find that the respective goods are identical or highly similar.

Comparison of marks

38) I will now go on to consider the differences between the trade marks themselves and the impact of any differences upon the global assessment of similarity. The trade marks to be compared are:

Trade mark of Sanofi-Aventis	Trade mark of Renovo Limited
PLAVIX	KLARYX

39) The applicant, in its counterstatement, submitted that the co-existence of other similar trade marks on the register is evidence that members of the public would be able to distinguish between such trade marks. This does not tell me what is happening in the market place. The *British Sugar Plc* case confirmed that such “state of the register” evidence should be discarded when considering a particular trade mark.

40) The opponent, in its written submissions, maintains that the two trade marks are confusingly similar both visually and phonetically and the applicant, in its submissions, continues to identify the differences between the trade marks.

41) The average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the trade marks must, therefore, be assessed by reference to the overall impressions created, bearing in mind their distinctive and dominant components. Consequently, I must not engage in an artificial dissection of the trade marks, although I need to take account of any distinctive and dominant components. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but 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.

42) The trade marks must be considered in their entirety and in this case, I do not believe that the trade marks can be dissected into specific distinctive and dominant components. Sanofi-Aventis submit that the sound of the first syllables PLA and KLA in the respective trade marks are similar, the letters AR/AV are similar as the normal differences in pronunciation of the letters R and V are lost when combined with the same vowel, and that the endings IX/YX are phonetically identical. I accept this final point, but do not accept the second. Whilst the letter V may be softened by being preceded by the letter A, the letter R retains its original sound and the differences in pronunciation of this part of the respective marks is just one of a number of aural differences. The first trade mark starts with the syllable PLA or PLAV being noticeably different to the first syllable KLA or KLAR of the later trade mark. The second syllable of the respective trade marks are VIX and RYX or, as Sanofi-Aventis submit, possibly the phonetically identical IX and YX.

43) I recognise that there are some aural similarities between the trade marks, but I am mindful of the comments of the European Court of Justice in *Il Ponte Finanziaria SpA v Office for Harmonisation in the Internal market (OHIM)* Case C-234/06P:

“32. Even though it is conceivable that aural similarity alone could create a likelihood of confusion, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue...”

44) I note that the second, third and sixth letters are the same. The first letter of the respective trade marks are P and K, and are visually distinct of each other. The fourth and fifth letters are VI and RY respectively. These too, are visually distinct.

45) Taking account of all these similarities and differences, I consider that whilst there is a small amount of aural similarity between the trade marks, when viewed as a whole, they are visually distinct of each other. As they are both made up words, I consider that there is no conceptual similarity.

Likelihood of confusion

46) The nature of the respective goods is such that small differences in the trade marks will not diminish the possibility of confusion by the relevant public. But in taking a balanced view and adopting the global approach advocated by case law, I find that even where the goods are identical or similar, the differences in the respective trade marks are such that the relevant public will not confuse the marks or be led into believing that the respective goods originate from the same source. I find there is no likelihood of confusion and the opposition under Section 5(2)(b) fails.

COSTS

47) The opposition having failed, the applicant is entitled to a contribution towards its costs. I take into account the fact that the decision has been reached without a hearing taking place, though with written submissions having been prepared by the applicant. I award costs on the following basis:

Preparing & filing TM8	£300
Considering evidence in reply and filing evidence	£200
Filing written submissions	£200
TOTAL	£700

48) I order Sanofi-Aventis to pay Renovo limited the sum of £700. 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 19th day of December 2007

**Mark Bryant
For the Registrar,
the Comptroller-General**