

TRADE MARKS ACT 1994
IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 744742
AND THE REQUEST BY BAYER AKTIENGESELLSCHAFT
TO PROTECT A TRADE MARK
IN CLASS 5

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 70579
BY PHARMACIA & UPJOHN S.A.

BACKGROUND

1) On 13 October 2000, Bayer Aktiengesellschaft of Leverkusen, D-51368, Germany, on the basis of an International registration based upon a registration held in Germany, requested protection in the United Kingdom of the trade mark MIRIVAIR under the provisions of the Madrid Protocol. An International priority date of 14 April 2000 was also claimed.

2) The international registration is numbered 744742 and protection was sought for the following goods in Class 5 "Pharmaceutical preparations and substances, diagnostic preparations for medical use".

3) 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.

4) On 23 April 2001 Pharmacia & Upjohn SA c/o Credit Eurpeen 52, route d'Esch 1470, Luxembourg 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 Community Trade Mark (CTM) 000892802 MIRVIVA which is registered for the following goods in Class 5 "Pharmaceutical preparations". The opponent's mark was filed on 28 July 1998. The marks are very similar both visually and phonetically as they have six common letters. The goods are identical or similar. The application therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

5) The applicant subsequently filed a counterstatement accepting that the opponent is the proprietor of CTM 892802, but denying that the mark applied for is confusingly similar. They point out that the applicant's mark second syllables differ and that the suffixes AIR and VA are distinctive elements and differ conceptually with the applicant's mark having a clear connection with respiratory products.

6) Both sides ask for an award of costs.

7) Both sides filed evidence in these proceedings and the matter came to be heard on 11 September 2002, when the applicant was represented by Ms Wong of Messrs Carpmiels &

Ransford, whilst the opponent was represented by Mr Blum of Messrs Gill Jennings & Every.

OPPONENT'S EVIDENCE

8) The opponent filed a witness statement, dated 17 September 2001, by Robert Alan Blum the opponent's Trade Mark Attorney. Mr Blum states that in his view the marks are visually similar as they are of similar length and share six common letters. He also claims that the marks are phonetically similar as each consists of three syllables and share the same prefix MIR. They also share an "emphatic consonant V in the middle of the marks". Mr Blum claims that the goods are identical or very similar and that there exists a "likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

APPLICANT'S EVIDENCE

9) The applicant filed a witness statement, dated 23 January 2002, by Anne Wong the applicant's Trade Mark Attorney. Ms Wong claims that the applicant's mark is visually distinguishable from the opponent's mark. She also breaks each mark down into three syllables as follows:

MI-RI-VAIR
MIR-VI-VA

10) Ms Wong states :

"The second syllable of each mark is -RI and -VI respectively. The letters 'R' and 'V' are visually very distinctive letters. The suffixes -VAIR and -VA also differ substantially, the former having twice as many letters and containing the word 'AIR' which immediately brings to mind respiratory products. The suffix -VA does not suggest any such association with respiratory products. Viewed in their entireties these marks are visually distinctive."

11) Ms Wong admits that the marks share six letters but she claims that it is the arrangement of the letters which is important in determining confusability. She also claims that the marks are not phonetically similar as the breakdown she provides above shows. She claims that the opponent's mark breaks into two parts "MIR-VIVA". She states that the second part VIVA brings to mind the concept of "life" as in English the word means "long life". She provides other examples of words containing VIVA, such as vivacious, vivacity and vivace. She contrasts this with the end of the applicant's mark which is the word AIR which, when used on pharmaceutical preparations implies a connection with respiratory products. Ms Wong provides details of nine other trade marks on the UK Register which start with the letters MIR and have Class 5 specifications. A copy of the search is provided at exhibit ANW2.

OPPONENT'S EVIDENCE IN REPLY

12) The opponent filed a second witness statement by Mr Blum, dated 17 April 2002. He repeats his assertions that the marks are similar. However, he also points out that "even if the

Registrar does not consider MIRVIVA and MIRIVAIR to be as similar visually, phonetically and conceptually as I believe they are, the identity and similarity of the goods would offset this and mean that there is still a significant likelihood of confusion. The fact that the marks are so similar only serves to increase this likelihood of confusion.”

13) Mr Blum states that the first three letters of the marks are identical whilst the next two are reversed. He also claims that the fourth letter of the applicant’s mark is the letter ‘I’ which is “a visually unobtrusive letter and at a quick glance, MIRIV could easily look like MIRV, the beginning of the opponent’s mark.” Mr Blum comments that marks are not analysed in detail as Ms Wong has attempted to do but are seen by the average consumer as a whole. He also disagrees with virtually all of Ms Wong’s contentions.

14) That concludes my review of the evidence. I now turn to the decision.

DECISION

15) The only ground of opposition is under Section 5(2)(b) which is as follows:

“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.”

16) An earlier right is defined in Section 6, the relevant parts of which state

“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,

17) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [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* page 224;

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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.* page 84, paragraph 27;
- (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* page 224;
- (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* page 224;
- (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* page 132, paragraph 17;
- (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* page 224;
- (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* page 224;
- (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* page 732, paragraph 41;
- (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* page 133 paragraph 29.

18) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services 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 and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare

the mark applied for and the opponent's registration on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and/or services covered within the respective specifications.

19) The application is in respect of "Pharmaceutical preparations and substances, diagnostic preparations for medical use" in Class 5. The opponent's mark is registered for "Pharmaceutical preparations" in Class 5. Clearly the goods are identical, a point acknowledged by the applicant at the hearing.

20) I now turn to assess the similarity or otherwise of the trade marks which are as follows:

Applicant's mark	Opponent's mark
MIRIVAIR	MIRVIVA

21) In assessing the similarity of the two trade marks, I must consider the aural, visual and conceptual similarities and overall impression created.

22) Visually both marks are of similar length containing eight and seven letters respectively. Clearly they start with the same three letters. The visual similarity occurs at the beginning of the trade marks and so its visual impact is increased. It is accepted that the public attributes greater importance to the beginning of a word in identifying a sign than it does to the following components of the word. The endings of the words are different, although both contain the letter "V".

23) The applicant contends that whilst each mark consists of three syllables the syllables are different. The applicant provided a breakdown for each mark as follows: MI-RI-VAIR and MIR-VI-VA. Clearly there are a number of ways that these marks can be pronounced, some more similar than others. All the evidence regarding the pronunciation of the marks was provided by the Trade Mark Attorneys involved in the case. No evidence of how the public would pronounce the marks was provided. However, at the hearing Ms Wong seemed to be pronouncing the applicant's mark as MIR-I-VAIR. To my mind there are similarities in the beginnings of each mark although they clearly have different endings.

24) The applicant contended that conceptually the marks are dissimilar as the applicant's mark has at its end the word "AIR" which it is claimed would be seen as referring to respiratory products. Further, the applicant stated that the end of the opponent's mark "VIVA" would be seen as a reference to life. I do not accept either of these contentions. On the applicant's own evidence the end of the mark in suit would be pronounced as "VAIR" which in my opinion would be regarded as meaningless by the average consumer. The specification which is sought for the applicant's mark is not restricted to respiratory products and so it is possible that it could be used on pharmaceutical preparations which have nothing to do with respiratory problems. With regard to the opponent's mark, whilst it contains the word VIVA which means life to my mind this is hidden by the prefix MIR. All of the instances quoted by the applicant of words using VIVA had this element at the beginning of words. In my opinion both marks would be seen as invented words with no conceptual meaning.

25) I also have to consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, no evidence has been filed as to use of the mark in the UK. On the question of inherent distinctiveness the applicant claims that MIR is common start to trade marks for Class 5 products and supplies a list of nine such UK trade marks. However, I note that seven of these marks start with MIRA and two with MIRE. In the Torremar case [BL 0/207/02] Mr G Hoobs Q.C. acting as the Appointed Person stated that whether a consumer deems a mark to be origin specific or origin neutral:

“may be supported by evidence directed to the way in which the mode or element of expression has been used by traders and consumers more generally. In neither case can the proposition in contention be substantiated simply by evidence of entries in the register of trade marks; entries in the register do not in themselves affect the way in which marks are perceived and remembered.”

26) The opponent's mark appears to be a made up word and so I regard it as an inherently strong mark.

27) In assessing the degree of similarity between the marks and whether it is sufficient to give rise to a likelihood of confusion I must consider who the average consumer is and make appropriate allowance for imperfect recollection.

28) Both specifications include “Pharmaceutical preparations and substances”. Neither is restricted to those substances available only by prescription. It is therefore possible for the marks to be used on over the counter products. In which case the average consumer would be the general public. The applicant also has included in its' specification “diagnostic preparations for medical use”. Again there is no restriction on what these products could be. They could include pregnancy testing kits which are available to the general public.

29) On a global appreciation, notwithstanding the differences in the marks, the similarities between the marks coupled with the identical goods would, in my opinion, give rise to the likelihood of confusion. The ground of opposition in respect of Section 5(2)(b) succeeds.

30) The opposition having succeeded the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £2050. 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 14th day of October 2002

George W Salthouse
For the Registrar
The Comptroller General

