

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION
NO 701332 AND THE REQUEST BY
DR AUGUST WOLFF GMBH & CO ARZNEIMITTEL TO PROTECT
THE TRADE MARK PSORIMED IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 70140 BY DIOMED DEVELOPMENTS LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION
NO 701332 AND THE REQUEST BY**

5 **DR AUGUST WOLFF GMBH & CO ARZNEIMITTEL TO PROTECT
THE TRADE MARK PSORIMED IN CLASS 5**

AND

10 **IN THE MATTER OF OPPOSITION THERETO UNDER
NO 70140 BY DIOMED DEVELOPMENTS LIMITED**

15 **DECISION**

On 10 September 1998 Dr August Wolff GmbH & Co Arzneimittel, on the basis of a registration held in Germany, requested protection in the United Kingdom of the trade mark PSORIMED under the provisions of the Madrid Protocol. The international registration is numbered 701332 and protection was sought in Class 5 for "medicines, chemical products for medical and sanitary use, pharmaceutical drugs and preparations, disinfectants".

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.

On 8 July 1999 Diomed Developments Limited filed notice of opposition to the conferring of protection on this international registration. They say they are the proprietors of the mark PSORIDERM in Class 5 in respect of pharmaceutical preparations and substances, all for use in the treatment of psoriasis. This registration is numbered 1098521 and has a filing date of 11 July 1978. The opponents say they have been using the mark PSORIDERM since 1964. Objection is said to arise under Section 5(2) and Section 5(4)(a).

The opponents also say that "by virtue of the opponent's earlier use and registration of a similar trade mark in the United Kingdom and the substantial goodwill that they enjoy in that similar trade mark, the mark applied for is not capable of distinguishing the applicant's goods from those of the opponent. Registration of the mark applied for would, therefore, be contrary to the provisions of Section 1(1) and 3(1)(a) of the Trade Marks Act 1994."

Yet further grounds are said to arise under Section 3(3)(b) and 3(6). The wording used closely follows the wording of the Act itself but without further explanation or substantiation of the claims.

Finally the opponents claim that their mark is entitled to protection under the Paris Convention as a well known mark. In practice this does not appear to put them in a different or better position than they are already in under Section 5(2).

The international registration holders filed a counterstatement denying the above grounds and suggesting that the PSORI prefix would be seen as a descriptive indication.

Both sides as for an award of costs in their favour.

Both sides filed evidence.

The parties were offered the opportunity to be heard. Neither side has asked for a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Opponents' evidence

The opponents filed statutory declarations by Michael Yarrow, their Managing Director. The main points to emerge from his declarations are that:

S Diomed first adopted the trade mark PSORIDERM in the United Kingdom in 1964 in respect of a coal tar preparation (in cream form) to treat psoriasis. In subsequent years the range was extended to include a bath emulsion and scalp lotion.

S during the past five years sales of goods bearing the trade mark PSORIDERM in the United Kingdom have been fairly constant, averaging about 16,000 packs per annum, with an annual value (ex-works) of approximately £60,000 per annum. It is suggested that this is a significant sum in the specialist area of applications for treating psoriasis and represents a significant proportion of total UK sales for such products

S the amount spent by Diomed on advertising and promotion of products bearing the trade mark PSORIDERM, including the use of sales representatives, amounts to a total of approximately £100,000 over the last five years.

S Diomed's PSORIDERM products have been promoted directly to doctors by way of direct mailing and sales representatives. Goods bearing the mark PSORIDERM have been exhibited at annual meetings of the British Association of Dermatologists and have been advertised in the following medical publications: "General Practitioner"; "MIMS"; British Journal of Dermatology"; "Chemist and Druggist".

S sales have been made in major towns and cities throughout the UK

S marketing material is exhibited at MY/2

Much of the remainder of Mr Yarrow's declaration is taken up with submissions regarding the respective marks, the state of the UK register and the position in the market place. In relation to the latter Mr Yarrow says that the only other PSORI- mark currently in use is PSORIN. He supports this contention with an extract from 'Chemist & Druggist' for December 1999 and IMS for October 1999 (Exhibit MY/3). He suggests that, contrary to the international

registration holders' claim, PSORI has no clear meaning and is not directly descriptive of anything. He acknowledges that it might be taken as alluding to the skin disease psoriasis but says he is not convinced that most consumers would necessarily make this connection.

5 **International Registration Holders' Evidence**

10 The international registration holders filed an affidavit by Hans-Jürgen Köhler and a statutory declaration by Jill Matchett. Herr Köhler says he is an authorised officer of Dr August Wolff GmbH & Co. He says that the mark PSORIMED has been used in Germany since 1934. He supplies (JK-2) information on PSORI prefixed marks in Germany. I do not find this material to be of assistance so far as the UK market is concerned. The same exhibit (JK-2) does, however, contain an extract from an unnamed publication showing marks in use in the UK these being PSORIDERM (the opponents' mark), PSORIGEL and PSORIN. He exhibits packaging (JK-3) showing that the product is specifically used in the treatment of psoriasis and various English language articles relating to psoriasis (JK-4). He says that "in my experience, a large percentage of pharmaceutical marks are formed by taking an abbreviation of either the essential active substance of the preparation or the treatment area [i.e. the illness] which is then combined to a further contraction [often relating to the mode of operation involved, etc.]. Therefore, in the present case, my Company took the contraction Psori [as various other businesses have also done] from the illness psoriasis."

He concludes with statistics on the diagnosis of psoriasis from which he concludes that the opponents' sales are not particularly significant.

25 Ms Matchett is the international registration holders' UK trade mark attorney. She exhibits:

- 30 JM-1 - a copy of an in-use search report in respect of PSORI prefixed marks in Class 5. The information yielded appears to cover the position worldwide. I note that marks with a UK country reference are PSORIN, PSORIGEL, PSORIDERM and PSORIGON
- JM-2 - the results of a search for PSORI prefixed marks on the UK Trade Marks register in Class 5
- 35 JM-3 - an extract from the Oxford Dictionary of Medicines which gives a definition of psoriasis and lists a number of PSORI prefixed products used in the treatment thereof. I note that these are PSORIDERM, PSORIGEL and PSORIN.

40 That concludes my review of the evidence.

Although the opponents have raised objections under Sections 3(1)(a) (and 1(1)), 3(3)(b) and 3(6) they have not fully explained the basis of their claims. The only one of these grounds which is expressed in terms which go beyond rehearsing the wording of the Act is that based on Section 3(1)(a) as recorded in my above summary of the grounds. However, from the

explanation given it appears in reality to be a relative ground dressed up as an absolute ground. In practice I can see no basis for any of the objections based on Section 3 of the Act and accordingly dismiss those grounds.

5 Section 5(2) appears to be the principal ground of attach the Section reads:

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

- 10 (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,
- 15 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

As identical marks are not involved sub paragraph (b) applies here.

20 I take into account the guidance provided by the European Court of Justice in *Sabel BV v Puma AG* (1998 RPC 199 at 224), *Canon v MGM* (1999 RPC 117) and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BC* (1999 ETMR 690 at 698).

It is clear from these cases that:-

- 25 (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors.
- 30 (b) the matter must be judged through the eyes of the average consumer, of the goods/services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the change to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind;
- 35 (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.
- 40 (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;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- 45 (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

(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);

5 (h) 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.

10 Both the opponents' mark (PSORIDERM) and the international registration holders' mark (PSORIMED) are registered or offered for protection for goods which, albeit described in slightly different terms, are pharmaceutical products. In fact the evidence on both sides shows that the specific goods of interest are for the treatment of psoriasis (a skin disease). Identical goods are, therefore, involved. The likelihood of confusion, falls to be determined primarily
15 by reference to the similarity of the marks taking into account the distinctive character of the earlier trade mark arising from its inherent characteristics and the use that has been made of it. My view of the opponents' earlier trade mark can be summarised as follows:

20 S there is no evidence that PSORI is an abbreviation for psoriasis. That element is not, therefore, wholly descriptive

S nevertheless PSORI may be taken to allude to the condition to be treated. It is not an arbitrary choice of prefix

25 S the DERM element is, or may be taken to be, a reference to dermatology (the branch of medicine concerned with skin and its diseases)

S in totality the mark is an invented combination but one whose derivation may be apparent to some people
30

S the parties have conflicting positions as to any enhanced reputation attaching to the opponents' mark through use. Sales of 16,000 packs per annum with a value of £60,000 does not strike me as more than a modest trade in the absence of any reliable evidence as to the overall size of the market for psoriasis treatments (the international registration holders estimate the market at 1.8 million packs but the basis for this claim is questionable).
35

40 The parties have also focussed on surrounding circumstances, in particular the state of the Trade Marks Register and the position in the market place. I regard the international registration holders' claims as to the state of the Register to be of very little assistance save insofar as there is supporting evidence showing that any of the marks are in use (see Beck, Koller & Co Ltd's application 1947 64 RPC 76).

45 There is some common ground between the parties so far as the position in the market place is concerned. Both sides agree that a mark PSORIN is in use. The international registration holders have also identified a mark PSORIGEL (Exhibits JK-2 and JM-1). There is also a reference to PSORIGON in JM-1 but no indication as to whether this mark is used in relation

to a treatment for psoriasis. On the strength of this material I take the view that the opponents do not have the field to themselves with PSORI prefixed marks but there are only two or three other such marks in use.

5 The ECJ cases referred to above also make it clear that the matter must be judged through the eyes of the average consumer. Who is the average consumer for the goods at issue here? Neither side has made it clear in their evidence how the goods are sold, that is to say whether they are only used in hospitals, on prescription from GPs or freely available as over the counter (OTC) treatments at chemists and other outlets. The evidence suggests that psoriasis comes in varying degrees of severity and that a wide range of treatments are available. Exhibit 10 JM-3 suggests that the PSORIN product on the market is available without a prescription. The example of the PSORIDERM product at MY/3 is a scalp lotion ('a therapeutic shampoo'). There is nothing to suggest that it is anything other than an over the counter product which could be purchased by any adult. This is not to say that the use of more specialist treatments is not controlled by medical professionals but it would seem that for milder forms of the 15 ailment the general public can purchase treatments direct.

With the above observations in mind I turn to the marks themselves, that is PSORIDERM and PSORIMED. The words are of roughly equal length and clearly have a significant part of the 20 marks in common. The suffixes -DERM and -MED can both be said to have medical connotations. They also have the letters D, E and M in common which adds to the overall visual similarity and is an aspect of appearance which may come into play in the context of imperfect recollection.

25 However, the ECJ authorities caution against over analysis of marks. It is the impression left by the marks that I must consider. I have no doubt that they can be distinguished on a side by side comparison. But bearing in mind that marks are not usually encountered in such circumstances I am of the view that they create a visually similar overall impression.

30 Aurally I consider the similarity to be somewhat less strong but dependent on how much importance the average consumer would attach to the first element of the mark. That brings me to conceptual similarity. I have found that whilst the respective marks are invented combinations they nevertheless allude to the condition to be treated. It seems to me that that allusive quality is unlikely to be lost on medical professionals whose appreciation of the marks will, therefore, be adjusted accordingly. I am by no means confident that the general public 35 would approach the marks in the same way. That is not to say that the common prefix PSORI would in itself lead to confusion. But taking into account the other features of the marks and the surrounding circumstances set out above I consider that there is a likelihood of confusion. The opposition succeeds under Section 5(2).

40 In the light of this finding I do not need to go on and consider the ground under Section 5(4). Suffice to say that, if on appeal I was found to be wrong in relation to Section 5(2), I do not consider the opponents could succeed under Section 5(4).

45

As the opposition has been successful the opponents are entitled to a contribution towards their costs. I order the international registration holders to pay them the sum of £635. 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.

5

Dated this 21 day of November 2000

10

15

M REYNOLDS
For the Registrar
the Comptroller-General