

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2277425  
BY PFIZER PRODUCTS INC.  
TO REGISTER A TRADE MARK IN CLASS 5**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 80522  
BY F. HOFFMAN-LA ROCHE A.G.**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
BY THE APPLICANT  
AGAINST THE DECISION OF MR. J. MACGILLIVRAY  
DATED 8 APRIL 2003**

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**DECISION**

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**Application No. 2277425**

1. Application No. 2277425 was filed by Pfizer Products Inc. (“the Applicant”) on 8 August 2001 to register the trade mark EVARISE in Class 5 for pharmaceutical and veterinary preparations and substances.
2. Following advertisement, the application was opposed by F. Hoffman-La Roche A.G. (“the Opponent”) on 3 January 2002. The Opponent invoked section 5(2)(b) of the Trade Marks Act 1994 (“the TMA”) to the effect that because of the similarity of EVARISE to the Opponent’s earlier trade mark EVONISE and the identity or similarity of the goods covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association.
3. EVONISE is the subject of International Registration No. 692134 protected in the United Kingdom as of 18 November 1997 in Class 5 for pharmaceutical, veterinary and sanitary preparations. EVONISE therefore qualifies as an earlier trade mark within the meaning of section 6 of the TMA.
4. No evidence was filed on either side. No hearing was requested but both parties made written submissions to the Hearing Officer.

**The Hearing Officer’s Decision**

5. After a review of the parties’ submissions and the relevant law including the case law of the Court of Justice of the European Communities (“ECJ”) on the equivalent Article 4(1)(b) of Council Directive 89/104/EEC (“the Directive”), the Hearing Officer found in favour of the Opponent that Application No.

2277425 should be refused. The Hearing Officer concluded (at paragraphs 27 – 29):

“27. On a global appreciation, taking into account all the relevant factors, I have come to the following conclusions:

- (i) the respective marks are visually similar and to a lesser degree aurally similar;
- (ii) the customer for the goods is not necessarily a specialised or sophisticated customer and the goods are not necessarily purchased with great care or consideration.

28. Considering the position in its totality I believe there is a likelihood of confusion on the part of the public. In reaching this conclusion I have borne in mind that an average customer rarely has the chance to make direct comparisons between marks, but must instead rely upon the imperfect picture of them he has kept in his mind.

29. The opposition under Section 5(2)(b) is successful.”

### **The Appeal**

- 6. On 6 May 2003, the Applicant filed notice of appeal to an Appointed Person under section 76 of the TMA 1994 against the decision of the Hearing Officer. Alleging one legal and two factual errors on the Hearing Officer’s part, the Applicant claims that the decision should be set aside and an order for costs made in the Applicant’s favour.
- 7. The Opponent chose not to be represented at the hearing of, nor to make any written submissions on, the appeal. A letter from Forrester Ketley & Co., the Opponent’s trade mark attorneys, to the Treasury Solicitor dated 13 January 2004, explains that the Opponent is anxious to minimise costs in the belief that the Hearing Officer’s decision is correct.
- 8. Mr. Ashley Roughton of Counsel appeared before me on behalf of the Applicant at the hearing of the appeal on 14 January 2004.

### **The Grounds of Appeal**

- 9. The Applicant accepts first (expressly), the identity of the goods in Class 5 and second (impliedly) that prescription and non-prescription pharmaceutical and veterinary products are covered.
- 10. The legal error identified by Mr. Roughton is that the Hearing Officer assessed the aural, visual and conceptual similarity of the marks, in effect, out of context and failed to pay sufficient regard to all the circumstances of the case.
- 11. Mr. Roughton referred me to Case C-342/97 *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV (LLOYD/LOINT’S)* [1999] ECR I-3819, which

was a reference by the Landgericht München I to the ECJ on the interpretation of Article 5(1)(b) of the Directive (concerning infringement but in substantially identical terms to Article 4(1)(b) Directive and section 5(2)(b) TMA). Addressing the relevance of aural similarity between mark and sign, Advocate General Jacobs said (Opinion, 29 October 1998, paragraph 18):

“18. In the context of the present case it may be helpful to add the following. First, with reference to Question 1, it is clear from the ruling in *SABEL* that the likelihood of confusion must be assessed globally in the light of all relevant factors. Contrary to the view expressed by Lloyd, it may therefore be relevant, depending on the circumstances, to consider not only the degree of aural similarity of the mark and the sign but also the degree (or absence) of visual and conceptual similarity. In the absence of visual or conceptual similarity it would be necessary to consider whether, having regard to all the circumstances including the nature of the goods and the conditions in which they were marketed, the degree of any aural similarity would of itself be likely to give rise to confusion.”

Further, the ECJ observed in its judgment (22 June 1999, paragraphs 18, 26 and 27<sup>1</sup>):

“18. According to [the case-law of the Court of Justice], likelihood of confusion on the part of the public must be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, to that effect *SABEL*, paragraph 22).

26. For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question.

27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

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<sup>1</sup> Paragraphs 18, 26 and 27 are numbered 19, 27 and 28 in the Fleet Street Report of the judgment.

12. I accept that the aural, visual and conceptual similarity of the marks should be assessed in relation to the goods or services in question and through the eyes of the relevant buying public, as is indeed clear from Recital 10 to the Directive:

“[W]hereas it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion; whereas the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified ...”

13. However, I do not accept that the Hearing Officer failed to perform that exercise. Working through the decision, the Hearing Officer noted (paragraphs 20 to 26):
- (a) The marks covered identical pharmaceutical and veterinary products.
  - (b) The marks were both invented words comprising seven letters with the elements EV and ISE in common. Nevertheless the test was how the relevant buying public would perceive the marks overall. Being invented the Opponent’s mark was highly distinctive.
  - (c) In the light of overall impression and allowing for imperfect recollection, the marks as a whole possessed obvious visual similarity and scope for confusion.
  - (d) There was a lesser degree of aural similarity.
  - (e) The marks were invented. Although conceptual similarity was not in issue the unrecognisability of the marks as dictionary words might contribute to imperfect recollection.
  - (f) The specifications included prescription and non-prescription products that could be purchased over-the-counter at a supermarket or high street chemist, sometimes by self-selection. The average consumer ranged from the medical professional to the public at large. The level of attention devoted to purchases might not necessarily be high (but would not be inadvertent).
14. Expressly taking account of those factors, the Hearing Officer reached the conclusions set out at paragraph 5 of this judgment. I reject Mr. Roughton’s legal argument that the Hearing Officer placed undue emphasis on the aural, visual and conceptual comparison of the marks and failed to pay sufficient regard to all the circumstances of the case. Quite the contrary, the interdependence of the various factors to be taken into account in the overall assessment of the likelihood of confusion confirms the Hearing Officer’s conclusions. It is common ground that the goods covered by the mark applied for and the goods in the earlier trade mark are identical. As the ECJ has observed there may be a likelihood of confusion, notwithstanding a lesser degree of similarity between the trade marks, where the goods covered by them are very similar and the earlier trade mark is highly distinctive (*Lloyd*, paragraph 21).

15. The two factual errors the Hearing Officer is alleged to have made are:
- (i) As a matter of first impression, EVARISE and EVONISE are not similar.
  - (ii) The consumer pays a high level of attention to the purchase of pharmaceutical and veterinary products, which would avert any likelihood of confusion.
16. Starting from the proposition that the consumer pays more attention to the beginnings rather than the endings of word marks, Mr. Roughton says that the trade marks should be regarded as comprising two parts, EVAR-ISE and EVON-ISE. The ISE can be disregarded so that the proper comparison is between EVAR and EVON. The consumer would pronounce the Applicant's mark with a short "e" (EVAR) but the Opponent's mark with a long "e" (EEVON). Taking by way of analogy EVASTICK and EVOSTICK, there are marked differences between the marks and no likelihood of confusion.
17. No evidence was placed before the Hearing Officer as to how the public would approach the marks. The Hearing Officer rightly noted that both marks comprised seven-letter invented words commencing EV and ending ISE. He correctly instructed himself (paragraphs 18, 19, 21 and 22) that whilst it is permissible to have regard to the components of marks, the average consumer normally perceives a mark as a whole and does proceed to analyse its various details (*Case C-251/95 Sabel BV v Puma AG* [1997] ECR I-6191, paragraph 23). As a matter of overall impression, he considered that there was a higher degree of visual similarity than aural similarity. Conceptually neither mark provided a point of differentiation. I fail to see how the Hearing Officer can be said to have fallen into error in his analysis. Moreover, I am doubtful whether Mr. Roughton's analogy assists the Applicant's case.
18. Finally, it is said that the Hearing Officer attributed insufficient circumspection to the purchaser of pharmaceutical and veterinary products. Neither specification is limited to prescription-only preparations and would include products so diverse as ointment and vaccine available from a number of different outlets. The Hearing Officer clearly had in mind the range of possible purchasers. For over-the-counter purchases, he considered that the degree of circumspection would be higher than for every-day goods but lower than for expensive or sophisticated items. He did not think that the likelihood of confusion would be increased through the involvement of a medical practitioner (obviously Mr. Roughton did not challenge the latter). The Hearing Officer factored into his global assessment of likelihood of confusion the finding that "the customer for the goods is not necessarily a specialised or sophisticated customer and the goods are not necessarily purchased with great care or consideration." I do not believe he can be faulted in that regard.

## **Conclusion**

19. In the result, the appeal fails. The Opponent was not represented at the hearing and made no submissions on the Applicant's appeal. I therefore dismiss the appeal with no order as to costs.

Professor Ruth Annand, 6 February 2004

Mr. Ashley Roughton instructed by Gill Jennings & Every appeared as Counsel on behalf of the Applicant

The Opponent did not appear and was not represented