

**TRADE MARKS ACT 1994**

**In the matter of application no.2122010  
by Hyal Pharmaceutical Corporation  
to register a Trade Mark in Class 5**

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF APPLICATION TO REGISTER TRADE MARK NO 2122010 IN CLASS 5 IN THE NAME OF HYAL PHARMACEUTICAL CORPORATION**

On 28 January 1997 Hyal Pharmaceutical Corporation of 2425 Skymark Avenue, Mississauga, Ontario, LW4 4Y6, Canada, applied under the Trade Marks Act 1994 to register the trade mark **SOLARASE** in Class 5 in respect of:-

“Pharmaceutical preparations and substances”

Objection was taken to the mark under Section 5(2) of the Act in respect of the following marks:

<b>Number</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
1330109	SOLARAY	5	Vitamins; herbs; minerals; combinations of vitamins and minerals; digestive enzymes; acidophylus substances; polyunsaturated fatty acids; glandular supplements and herb blends; all for dietary use in capsule and tablet form; gelatin capsules; all included in Class 5
1472299	TOLERASE	5	Pharmaceutical preparations and substances, all for the reduction of lactose intolerance and being available without prescription; all included in Class 5.

At a hearing at which the applicants were represented by Mrs Smaggasgale of Mathys & Squire, their trade mark agents, the objections under Section 5(2) were maintained. Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of decision and the materials used in arriving at it.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Section 5(2) of the Act reads as follows:-

- 5(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.

The mark applied for and the earlier marks raised as an objection are not identical, and consequently, Section 5(2)(a) does not apply.

Dealing first with the question of whether the goods of the application are the same or similar to those covered by the earlier marks raised as an objection. The applicants are seeking registration in Class 5 for “Pharmaceutical preparations and substances” at large. The citation numbered 1472299 is registered in Class 5 for a specification of “Pharmaceutical preparations and substances, all for the reduction of lactose intolerance and being available without prescription”. There cannot be any doubt that the goods of this cited mark are contained within the applicants' specification of goods.

The citation numbered 1330109 is also in Class 5 and is registered for the following goods:-

Vitamins; herbs; minerals; combinations of vitamins and minerals; digestive enzymes; acidophylus substances; polyunsaturated fatty acids; glandular supplements and herb blends; all for dietary use in capsule and tablet form; gelatin capsules; all included in Class 5

In determining whether the specification of cited mark includes goods which are similar to those contained within the specification of the application, I am guided by the decision in the Treat trade mark case (1996 RPC 281). In his decision, Mr Justice Jacob was of the view that the following factors need to be considered when deciding 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-service consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or likely to be, found on the same shelves.

As I have said earlier in this decision, the applicants are seeking registration in Class 5 for “Pharmaceutical preparations and substances”. Collins English Dictionary gives the following meanings for “Pharmaceutical”:-

Pharmaceutical:- *adj.* of or relating to drugs or pharmacy

Drug:- *n.* any synthetic or natural chemical substance **used in the treatment, prevention or diagnosis of disease**

From these definitions it is apparent that the specification covers goods for use in the treatment, prevention or diagnosis of disease. In considering the uses of the goods covered by the application, I refer to the definitions in Collins English Dictionary

Vitamin:- *n.* any group of substances that are essential in small quantities for use in the normal functioning of metabolism in the body. They cannot usually be synthesized in the body but they occur naturally in certain foods; **insufficient supply of any particular vitamin results in a deficiency disease**

Vitamin D:- *n.* pl of D vitamins. any of the fat soluble vitamins including calciferol and cholecalciferol, occurring in fish liver oils (esp cod liver oil), milk, butter and eggs; **used in the treatment of rickets and osteomalacia**

acidophilous milk:- *n.Med.* Milk fermented by bacteria of the species *Lactobacillus acidophilus*, **used in treating disorders of the gastrointestinal tract**

From these definitions it is apparent that vitamins and acidophylous (acidophilous) substances are used in the prevention and/or treatment of disease, and I do not believe it unreasonable to assume that glandular supplements could also be for the same purpose. It is well established that herbs are used in medicine, a view supported by an entry of “Medicinal herbs” in the Guide to the International Classification of Goods and Services. I am therefore led to the conclusion that the goods covered by the cited mark are for the same use. The fact that the goods covered by the cited mark are limited to being “all for dietary use in capsule and tablet form” does not change this.

From my own knowledge I am aware that it is not unusual to see pharmaceuticals, such as pain killers, sold alongside vitamins and complimentary medicines. While they may not be displayed on exactly the same shelf, they are commonly sold alongside each other or in close proximity in pharmacies, and, for non-prescription pharmaceuticals, in supermarkets. Customers with a minor ailment, for example, insomnia or a dietary disorder are presented with the option of trying a natural or herbal based remedy from a supermarket or pharmacy shelf as a precursor or alternative to seeking prescription pharmaceuticals from a medical practitioner. I therefore take the view that both the users of the goods and the trade channels are the same.

The final factor to consider is the physical nature of the respective goods. Both specifications cover goods that may be of synthetic or natural origin, be for the same use and considered to come under the description of a pharmaceutical. I therefore find that the physical nature of the respective goods to be the same.

Having found the respective users, uses, physical nature and trade channels of the goods to be the same, I must inevitably conclude that the goods covered by cited mark number 1330109 and the application to be similar.

Turning to the respective marks, since these are not identical, I must decide whether the mark of the application so nearly resembles the cited marks as to be likely to deceive or cause confusion on the part of the public. Although this matter is governed by the Trade Marks Act 1994, the principles to be used in the comparison of marks remain unchanged and in addressing the degree of resemblance I have adopted the principles for comparison stated by Parker J in the PIANOTIST trade mark case (1906) 23 RPC at page 777 which reads as follows:-

"You must take the two marks. You must judge of them both by their look and by their

sound. You must consider the goods and services to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods or services. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods or services of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion -that is to say -not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods or services -then you may refuse the registration, or rather you must refuse the registration in that case."

When placed side by side the differences between one mark and another may be quite apparent but the main idea left to the mind by both of them may well be the same. Lord Radcliffe in the *De Cordova and others v Vick Chemical Company* trade mark case (1951 68 RPC at page 106, lines 17-23 stated:-

"The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole".

In comparing the mark applied for with the mark of citation number 1330109, it is my view that there is a strong visual resemblance. Words appeal to the ear as well as to the eye and when spoken the marks are extremely similar in sound. When pronounced in the plural or possessive form, it is my opinion that the cited mark is phonetically indistinguishable from the mark applied for. Having already given my view on the similarity of the respective goods I am of the view that the degree of resemblance is such that there is a real and definite likelihood of confusion.

Turning to cited mark number 1472299. When considering the similarity of two marks, the proper test to be applied is to ask what is the overall impression created by the marks, and is that overall impression such that there is a risk of confusion or deception. While it is neither likely nor appropriate that the marks will be considered letter by letter, syllable by syllable, it is almost inevitable that a comparison will refer to elements of the marks in question.

There are differences in the marks, namely the first letter, which in the mark applied for is the letter "S" whereas in the cited mark it is the letter "T". There is also a difference in the consonant appearing in the second syllable which in the mark applied for is the letter "a" whereas in the cited mark it is a letter "e". It is my view that in a word of this length the visual impact of the difference in the second syllable will be lost and when spoken will be phonetically indistinguishable. I accept that a difference in the first letter of a word can in some instances serve to distinguish that word from another word identical in all other respects. Considering the degree of similarity of the marks as a whole, I do not consider that to be the case here, particularly when allowance is made for imperfect recollection. It is also, I believe, appropriate to take into account how the mark is likely to be used. Assuming normal and fair use in relation to the goods covered by this application, it is likely that the mark will be used in handwritten form on a prescription, which increases the possibility that differences could be lost or overlooked.

I therefore determine that this application is debarred from registration by Section 5(2) of the Act.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and Section 3(6) of the Act.

Dated this 21 day of September 1998.

**MIKE FOLEY**  
**For the Registrar**  
**The Comptroller General**