TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2061715
IN THE NAME OF TAKEDA CHEMICAL INDUSTRIES, LTD

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 45542 IN THE NAME OF
SOLVAY DUPHAR B.V.

TRADE MARKS ACT 1994

IN THE MATTER OF application No 2061715 in the name of Takeda Chemical Industries, Ltd

and

IN THE MATTER OF opposition thereto under No 45542 in the name of Solvay Duphar B.V.

Background

On 20 March 1996, Takeda Chemical Industries, Ltd, of 1-1 Doshomachi 4 - Chome, Chuo-ku, OSAKA 541, Japan, applied to register the trade mark EMILVA in Class 5 in respect of the following goods:

> Pharmaceutical preparations and substances; all for humans; all included in Class 5
> .

On 30 September 1996 Solvay Duphar B.V. filed notice of opposition to this application. The grounds of opposition are in summary:-

1.	**Under Section 3(1) (a)**	Because the mark applied for is not capable of distinguishing the goods of the applicant from those of the opponent.
2.	**Under Section 5(2)(b)**	Because the mark applied for is similar and is to be registered for goods identical to those of the opponents prior registration such that there exists a likelihood of confusion on the part of the public and a likelihood of association with the opponent's mark
3.	**Under Section 3(3)(a)**	Because it is in the public interest that neither Doctors nor patients should be confused by the use of similar trade names for pharmaceutical products which may have different effects.

The trade mark referred to in the grounds of opposition is as follows:
`

Number	**Mark**	**Class**	**Specification**
2039487	ENLIVA	Class 5	Pharmaceutical preparations and substances"

The opponents ask that the application be refused and that costs be awarded in their favour.

The applicants filed a counterstatement in which they denied the above grounds, save for the fact that the opponent is the registered proprietor of UK Registration No. 2039487. They also request an award of costs in their favour.

Both sides filed evidence in these proceedings. The matter came to be heard on 6 March 2000, when the applicants were represented by Mr Michael Edenborough of Counsel, instructed by Forrester Ketley & Co, their trade mark attorneys, the opponents were represented by Ms Fiona Clark of Counsel, instructed by Lloyd Wise Tregear & Co, their trade mark attorneys.

Opponents' Evidence

This consists of a Statutory Declaration dated 11 April 1997, and executed by Sheila Jane Wallace of Lloyd, Wise Tregear & Co. Ms Wallace states that she is a Registered Trade Mark Attorney and that she is the attorney responsible for this case.

Ms Wallace refers to exhibit A which consists of the results of a search of United Kingdom trade marks register for marks in Class 5 having the suffix "VA", and which shows that 73 trade marks have this suffix. Ms Wallace comments that of these the opponents trade mark is the most similar to the applicants' mark.

She next refers to exhibit B which consists of an extract fro the BRITISH NATIONAL FORMULARY (hereinafter referred to as the BNF) which she says dates from September 1996 and is a joint publication of the British Medical Association and the Royal Pharmaceutical Society of Great Britain. The publication constitutes a list of pharmaceutical products in use in the United Kingdom and she notes that no product bearing the mark EMILVA is listed.

Ms Wallace goes to exhibit C which is an extract from the April 1997 Edition of Chemist and Druggist monthly Price List, Vol. 38, No. 4, saying that this publication covers a broader range of goods that the BNF and notes that there is no entry for a product bearing the mark EMILVA. She concludes her Declaration by making some observations about the likelihood of public confusion and association between the opponents' mark and the applicants' mark.

Applicants' Evidence

This consists of two Statutory Declarations. The first is dated October 1997, and comes from Hiroshi Akimoto, PH.D of Takeda Chemical Industries Ltd, the General Manager of the Intellectual Property Department of Takeda Chemical Industries Ltd a position that he has held since 1994. He confirms that he is fully conversant with the English language, that he is authorised to make this Declaration on behalf of his company and that the facts contained herein are either from his own knowledge or taken from the company records.

Mr Akimoto refers to exhibit HA1 which is a copy of the advertisement of the application published in the Trade Marks Journal.

He states that he has read the Statutory Declaration by Sheila Jane Wallace, and notes the search carried out in respect of trade marks with the suffix "-Va". He states that his company's Trade Mark EMILVA is pronounced with the initial letter "E" being soft and the stress falling upon the second syllable, which is in contrast with the opponents' mark ENLIVA which has the stress upon the first syllable, namely "EN" which is hard. He comments that there are several marks included in exhibit A which are pronounced with a similar intonation to that of the opponents' mark, and he lists nine examples.

Mr Akimoto states that no products bearing the Trade Mark EMILVA have yet been marketed in the United Kingdom.

Mr Akimoto next refers to exhibit B to Ms Wallace's declaration noting that there are two trade marks listed in the BNF which he considers to be similar to the opponents' trade mark. He says that it is clear from exhibit C that ENLIVE is used in respect of a nutritional drink. Mr Akimoto explains the reasons why his company approached the opponents prior to the filing of the opposition in the United Kingdom, and to avoid the opposition his company offered to restrict the use and registration of the trade Mark EMILVA to "cardiovascular agents" but that this was not accepted.

He concludes his Declaration saying that his company is prepared to restrict the specification of goods of the application and that a form has been filed requesting a limitation of the specification so as to read "cardiovascular agents".

The second Statutory Declaration is dated the 5 March 1998 and is executed by Shigeru Enomoto. Mr Enomoto states that he is a pharmacist employed by Takeda Chemical Industries Ltd, that he has held this position since 1973 and that he is conversant with the English language. He states that the facts contained in the declaration come from his own knowledge, from the company records, or from information published in referred Scientific Journals. He confirms that the opinions expressed in the declaration are his own and are based upon personal experience.

Mr Enomoto refers to the negotiations between the two parties and the differences in the proposed areas of use. He states that the products to which the marks are intended to be applied are designed to treat different medical complaints and therefore they are not competitors with each other.

He comments that the pharmaceuticals the marks will be used on are not normally available on open access shelves but rather only available from a trained pharmacist. He states that the chances of a pharmacist making the wrong selection are exceedingly small because pharmacists' are trained to avoid such errors.

Opponent's Evidence in Reply

This consists of two Statutory Declarations. The first is dated 7 October 1998 and executed by Daniel Broens of C J Van Houtenlaan 36, Weesp, The Netherlands. He states that he is the Director of the Legal and Trade Marks Department of Solvay Pharmaceutical B.V., formerly Solvay Duphar B.V., a position that he has held since 1994. He states that he is fully

conversant with the English language, that he is authorised to make this declaration and that the facts contained herein are from his own knowledge or from the company records.

Mr Broen refers to trade mark no. 2039487 ENLIVA, and to exhibit DB1 which consists of a copy of the registration certificate for that trade mark.

Mr Broen next refers to Mr Akimoto's Statutory Declaration. He comments and disputes Mr Akimoto's assertions about the pronunciation of the marks EMILVA and ENLIVA and the nine other marks referred to by Mr Akimoto, and suggests that Mr Akimoto has misread EMLA as EMILA which, he says illustrates how easy it is for marks which are visually similar to be misread, even for a skilled professional such as Mr Akimoto..

Mr Broen goes to exhibit DB2 which consists of a letter dated 2 October 1997 addressed to his company from Ms Jane Renilson of MR Pharms enclosing a copy of a letter dated 23 September 1997 and a draft Statutory Declaration which she had received from Forrester Ketley & Co, the applicant's agent. Mr Broen states that it is apparent from this letter that Ms Renilson was at this time a Formulary Pharmacist working in the Pharmacy Department of the East and Midlothian NHS Trust, and that they had approached Ms Renilson with a view to seeking her assistance in support of their client's application. Mr Broen states that it is clear from Ms Renilson's unsolicited letter dated 2 October 1997 to his company that she felt such support would be inappropriate and that two such similar names should not be used in medicines.

Mr Broen disagrees with Mr Enomoto's assertions that it is unlikely that a single patient would be suffering from complaints affecting both his cardiovascular and central nervous system and that, even if this were the case, the chances of a pharmacist making the wrong selection are small, which he says is also contrary to the views expressed by Ms Renilson.

Mr Broen concludes his Declaration by giving his views on the consequences of confusion.

The second Statutory Declaration is executed by Jane Renilson, a Formulary Pharmacist employed by The East and Midlothian NHS trust, a position she has held since July 1993. She states that she is currently working in the pharmacy department of the Liberton Hospital and that she qualified as a pharmacist in 1981. She states that she has never worked for Solvay Duphar or any of its associated companies.

Ms Renilson confirms that the facts contained in the Declaration are from her own knowledge or are derived from information published in Scientific Journals. She states that the opinions expressed are her own and based on her personal experience in a hospital pharmacy department. She states that this declaration is made in support of the opposition made by Solvay Dupahar B.V.

She refers to the letter she received a letter from Forrester Ketley & Co in September 1997, a copy of which is shown as exhibit JR1. She gives her impressions on reading the letter and that she decided to write to Solvay Duphar, a copy of her letter is also shown as exhibit JR1. Ms Renilson states that she was approached by Ms Wallace to ask whether she would be prepared to make a statutory declaration on behalf of the opponent to which she agreed.

Ms Renilson then provides some information about the central nervous system and cardiovascular agents and their different uses, and makes some observations about the consequences if Solvay Duphar BV were to apply the mark ENLIVA to a cardiovascular agent. She concludes by giving her view on the similarity of the respective marks.

That concludes my review of the evidence insofar as it is relevant to these proceedings

Decision

At the hearing before me Ms Clark advised that she did not intend to pursue the ground under Section 3(1)(a).

In her submissions Ms Clark made reference to an objection under Section 3(3)(a) which she said was based on the grounds of public interest. Mr Edenborough objected to the inclusion of what he considered to be a new ground of opposition. Mr Edenborough is correct insofar as Section 3(3)(a) is not specifically mentioned in the statement of case, and it is well settled that in the interests of justice and fairness an opponent should particularise the basis of their objection. However, paragraph 4 of the statement of grounds does set out the objection in sufficient detail and I took the view that this did not constitute a new ground.

There is no evidence which goes to this objection and Ms Clark's submissions were brief and based essentially on the potential consequences of a consumer confusing the two marks and receiving the wrong medication, linking this to the previous Registry practice on what were called "danger citations". Section 3(3)(a) is an absolute ground for objection which goes to the inherent features of the trade mark and I see nothing in the mark itself or the evidence which supports this ground. The question of the respective parties rights and likelihood of confusion is more properly dealt with and will be decided by my findings under Section 5(2)(b) and I dismiss the ground under Section 3(3)(a).

With this in mind I turn to the ground founded under Section 5(2)(b). That section reads as follows:

> **5.-(1)** A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected
>
> **(2)** A trade mark shall not be registered if because-
>
> **(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.

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

In my determination of the likelihood of confusion I look to the approach adopted by the European Court of Justice in SABEL v. PUMA 1998 RPC 199 at 224, Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. Case C-39/97) and in Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV (1999 ETMR 690 at 698). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the visual, aural and conceptual similarities of the marks must be based upon the overall impressions created by the marks bearing in mind their distinctive and dominant components;

(c) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(d) the matter must be judged through the eyes of the average consumer, who normally perceives a mark as a whole and does not proceed to analyse its various details;

(e) 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.

The opponents' mark is registered in respect of "pharmaceutical preparations and substances". The applicants are seeking to register their mark in respect of the same description of goods but qualified as being "all for humans". At the hearing Mr Edenborough indicated that the applicants would be prepared to limit the goods covered by the application to "cardiovascular agents" although as these still fall within the ambit of the description "pharmaceutical preparation or substance" such a limitation does little to assist. As identical goods are involved the matter therefore falls to be determined by a comparison of the respective marks taking into account any other relevant factors.

The respective marks are:

Applicant's mark	Opponent's mark
EMILVA	**ENLIVA**

The marks are clearly not identical so the question is one of similarity. While the consideration of the likelihood of confusion requires a composite approach, it is inevitable that in reaching a

decision reference will be made to the similarity of individual elements of the marks, which is the approach taken by both Mr Edenborough and Ms Clark.

Both marks consist of fairly short words of the same length. They share the same initial letter, which, with the second letters being phonetically and visually similar combines to create a degree of visual and aural similarity in the first syllable. The third and fourth letters are the same, albeit reversed, with both marks sharing the same two letter suffix. Mr Edenborough referred to the evidence to show that the suffix VA is common to pharmaceutical names, arguing that they should be disregarded for the purpose of comparison, an approach which I consider to be at odds with the above cases.

In the case of pharmaceuticals available on prescription the visual appearance will be of most significance. In such cases the average consumer will be a well trained pharmacist used to dealing with similar sounding and looking names although Ms Clark argued that given the difficulty in reading some handwriting there was still a potential for confusion. Ms Clark also mentioned the situation where a patient admitted to hospital may be asked for details of prescribed medication which she says make aural similarity of importance, although I consider it an unlikely scenario that medication would be prescribed on the basis of a statement from a patient. However, the goods are not limited to those available on prescription only and the average consumer may be the public at large, where the visual appearance of the names will be of most importance in cases of self selection, and the aural similarity for situations where the item is asked for.

In Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV the European Court of Justice said:

> "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* [1968] E.C.R.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 accordingly to the category of goods or services in question."

When placed side by side it is obvious that there are differences although I would take the view that there are more similarities than differences. That the earlier mark is an invented word with a high degree of inherent distinctiveness and that it is to be used in respect of goods which are not ordinary, everyday items is also very relevant. With the above in mind I find that I come to the view that there is a likelihood of confusion, particularly when allowance is made for imperfect recollection, a position reinforced by my having to continually check which mark belongs to the applicants and which to the opponents. Accordingly, I find the opposition under Section 5(2)(b) to be successful.

The opposition having been successful I order the applicant to pay the the sum of £835 as a contribution towards their costs. This sum is to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23 day of March 2000

Mike Foley
for the Registrar
The Comptroller General