

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION
No 2161785 IN THE NAME OF
NORBROOK LABORATORIES LIMITED**

AND

**IN THE MATTER OF A DECLARATION OF
INVALIDITY THERETO UNDER No 11593
BY PHARMACIA & UPJOHN LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Trade Mark
Registration No 2161785 in the name
of Norbrook Laboratories**

and

**IN THE MATTER OF an Application
for a declaration of invalidity thereto
under No 11593 by Pharmacia Limited**

BACKGROUND

1. On 25 April 2000, Pharmacia & Upjohn Limited of Crawley, England applied for a declaration of invalidity of registration No 2161785 standing in the name of Norbrook Laboratories Limited. The registration is in respect of the trade mark **GLUTALYTE** which stands registered for the following goods in Class 5:

“Veterinary preparations and substances: chemical preparations for veterinary purposes”.

2. The Registration dates from 21 March 1998.

3. The grounds of the action are as follows:-

- **under the provisions of section 47(2) of the Act**-the applicants contend that the mark should be declared invalid under:

- Section 5(2)(b) of the Act in that the mark is confusingly similar to the applicants' earlier trade mark registration No 1059779 for the trade mark LUTALYSE which is registered in Class 5 in respect of “pharmaceutical preparations”.

- Section 5(4)(a) of the Act in that the applicants have made substantial use of their earlier trade mark and have acquired a considerable reputation in the goods sold under the trade mark LUTALYSE, namely veterinary prescription products since at least 1976.

4. The registered proprietors filed a counterstatement which in essence consists of a denial of all of the grounds on which the invalidation action is based.

5. Both sides seek an award of costs. Both sides filed evidence. The matter came to be heard on 14 February 2002, when the registered proprietors were represented by Mr Guy Burkill of

Her Majesty's Counsel, instructed by Fitzpatrick's; the applicants were represented by Mr R A Blum, Trade Mark Attorney of Gill Jennings & Every.

Applicants' Evidence

6. This consists of a Statutory Declaration by John Graham Lee dated 11 January 2001. Mr Lee states that he is the Finance Director of Pharmacia Limited. He has been employed by them since 1 July 1980 and is authorised and competent to make the declaration on their behalf. The information provided is from his own knowledge or has been provided for him from Company records.

7. Mr Lee explains that his Company is the registered proprietor in the United Kingdom of trade mark registration No 1059779 LUTALYSE in Class 5 registered in respect of "pharmaceutical preparations" and that his Company has traded in goods under the trade mark LUTALYSE in the United Kingdom for over 20 years since 1976. These goods are a prostaglandin which has four major therapeutic uses in relation to cattle, horses and pigs: it can be used i) to improve conception; ii) to treat chronic inflammation of the uterus; iii) to induce abortion and iv) to induce parturition. Product literature is exhibited.

8. Since 1994 sales of the products sold under the trade mark LUTALYSE in any one year have not amounted to less than £289,068 per annum. The average sales figures from 1994-2000 are £421,793 per annum, (though it is not altogether clear whether these sales are only in the United Kingdom I infer that they are).

9. The products sold under the trade mark LUTALYSE have been advertised and promoted to the tune of £180,625 per annum in the years 1994 - 2000. Advertising literature is exhibited.

10. Mr Lee goes on to advise that on 6 April 2000, the applicants' trade mark agents instructed a firm of private investigators, to conduct investigations into the precise goods of interest sold under Norbrook's trade mark GLUTALYTE; they identified a re-hydration preparation which is particularly used in relation to calves.

11. Mr Lee believes that there is an additional concern with the products sold under the GLUTALYTE trade mark and those sold under the LUTALYSE trade mark. Both are clearly veterinary products, administered by veterinarians and farmers and both are used in relation to cattle, particularly dairy cattle. If one product were to be mistaken for the other, this would have serious implications; both the animal being treated and the person administering the product could be adversely affected.

Registered Proprietors' Evidence

12. This consists of two Statutory Declarations. The first is that of Martin Murdoch dated 19 March 2001. Mr Murdoch states that he is the Financial Director of Norbrook Laboratories Ltd. He says that he has been employed by the company since 31 October 1988 and confirms that he is authorised and competent to make his declaration on its behalf. The information

contained comes from his own knowledge or from company records. The following points emerge from Mr Murdoch's declaration:

- Norbrook has traded in the goods under the mark GLUTALYTE in the United Kingdom since November 1998;
- the product which is sold over the counter under the trade mark is a powder which is a dietetic feed source of predominately electrolytes and easily absorbable carbohydrates. On dissolution in water it provides a high energy, electrolyte solution with added glutamine thereby providing a readily available nutritional source to help stabilise water and electrolyte balance in the recipient animals during periods of convalescence;
- the registered proprietors' evidence shows that their product is a POM. This is a legal category covering prescription only medicines which can only be sold or supplied by a retailer in accordance with a prescription given by an appropriate practitioner. Additionally, where the practitioner is a veterinary surgeon or veterinary practitioner, the name and address of the person to whom the POM is to be delivered must be stated. The prescription must also contain a declaration, by the practitioner, that the POM is prescribed for an animal in his/her care;
- it is noted that Pharmacia's gross sales in LUTALYSE are not less than £289,000 per annum but from 1994-2000 the average gross sales are £421,793. However there is no indication of unit price. Prostaglandins are expensive and therefore to state gross sales is not representative of units sold which may be much less than the actual gross figures would imply.

13. The second Statutory Declaration on behalf of the applicants is that of Allison Watson Fife dated 19 March 2001. Ms Fife states that she is a European Trade Mark Attorney employed by Fitzpatrick's Limited and has been in the employment of the firm and its predecessors since May 1991. She confirms she has the authority to speak for Norbrook Laboratories Limited. The declaration consists merely of opinion and argument put forward by Ms Fife as to why the respective trade marks are not confusingly similar from both visual and phonetical standpoints.

Applicants' Evidence in reply

14. This consists of a Statutory Declaration by the same John Graham Lee and dated 15 May 2001. He confirms that he has read the declarations of Mr Murdoch and Ms Fife and makes the following comments strictly in reply:

- In response to Mr Murdoch's inference that a prescription only medicine and a non-prescription are not confusable, Mr Lee asserts as a Financial Director that the two trade marks are similar and a vet may confuse the two and employ or instruct the use of one instead of the other. He also points out that it is also quite possible that a single animal could be receiving treatment with LUTALYSE and GLUTALYTE and so confusion of the two products, or quantities of dosage or frequency of dosage, in the treatment of one animal could quite easily occur. It is perfectly possible that the

LUTALYSE and GLUTALYTE products will be handled and dispensed by the same veterinary practitioner, nurse or practice assistant.

- Mr Lee advises that the unit price for the two normal LUTALYSE dosages are £31.37 and £17.61. Accordingly, the value of sales of the product represents an appreciable number of units of products.

15. That concludes my review of the evidence in so far as I think it necessary.

DECISION

16. The principal ground of the action under Section 47(2) is, in my view, based upon Section 5(2)(b) which states:

"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."

17. An earlier right is defined in Section 6 as follows:

"6.-(1)

- (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,"

18. The applicants trade mark is an earlier right. I therefore 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] E.T.M.R. 1, *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 7, 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 8, paragraph 24;
- (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 9 paragraph 29.

19. First of all, on the basis of notional and fair use of the applicants' and the registered proprietors' trade marks I regard the respective specifications of goods (pharmaceutical preparations and veterinary preparations and substances) which fall into Class 5 as being identical, or at worst similar. Neither side took a point on that before me. Matters hinge therefore on the similarity, or otherwise, of the respective trade marks themselves.

20. The applicants and Mr Blum considered that the respective trade marks, LUTALYSE and GLUTALYTE were similar. They had the same number of syllables and letters, and that some letters were common to both. Mr Burkill submitted that the trade marks started with different letters and that visually and phonetically the two syllables (and two trade marks) were different.

21. Taking the two trade marks as wholes I do not consider that there is much similarity, aurally or visually, between the two trade marks. The fact that each contains two syllables and contain some letters in common are not significant factors. Not least because the two syllables of which both trade marks are comprised, will be pronounced differently even though each has some letters in common.

22. There is no conceptual similarity between them. The registered proprietors' GLUTALYTE trade mark alludes to the fact that the veterinary preparation sold under it contains Glutamin whereas the applicants' trade mark alludes to the lutalytic effect the pharmaceutical product is intended to have (and possibly the fact that it contains electrolytes for rehydration).

23. Therefore, even then taking into account the identity of the respective specifications I reach the view that the applicants' trade mark is not similar to the trade mark of the registered proprietor such that an informed and circumspect user of pharmaceutical or veterinary preparations would confuse one for the other or to associate the origin of the respective products. Thus the ground of the request for invalidation under Section 47(2) insofar as it is directed to Section 5(2)(b) is not made out and is dismissed.

24. I should record that in reaching the above decision I have had regard to the submissions made to me (and opinions expressed in evidence) about the dangers which might occur if confusion between the trade marks did occur. In a decision [BL 0/414/01] one of the Registrar's Hearing Officers has already indicated that there is no separate guidance to be applied in cases such as this involving pharmaceutical preparations, from that set out above. I say no more therefore about that issue.

25. I turn to the ground of invalidation based upon Section 5(4)(a). The statutory provision states:

"5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)"

26. The tests to be used by the Registrar have been set out at length by Mr Geoffrey Hobbs QC acting as the Appointed Person in *Wild Child Trade Mark* (1998) RPC 455.

27. Having found that the respective trade marks are not confusingly similar under the provisions of Sections 5(2)(b) in respect of the specifications of goods covered by the two registrations, an applicant for a declaration of invalidity is not likely to succeed under this head, unless some particular circumstance applies. In this case, I am prepared to consider the fact that the applicants claim to have an established reputation in their trade mark in respect of a pharmaceutical preparation used in the treatment of animals, provided on a prescription only

basis, (while the registered proprietor is relatively new to the same general market in respect of a dietetic feed source for animals) as a particular circumstance.

28. In the first place, I am not satisfied that the evidence of the applicants is sufficiently detailed (or in context) to establish that they have the reputation they claim (see the comments of Mr Justice Pumfrey in Reef Trade Mark (2002) RPC 19.

29. Secondly, there is nothing in the evidence, even when narrowing the focus to the actual goods on which the respective trade marks have been used, which enables me to infer the likelihood of confusion, or misrepresentation, even if the claim by the applicants to a reputation in their trade mark had been established. There is no independent evidence from veterinary practitioners or their assistants to show that, notwithstanding the differences in the signs, the way in which the particular products on which the signs are used, sold or dispensed is likely to give rise to misrepresentation.

30. Finally, and I do not place much relevance in this fact, despite the parallel use by the parties of their respective products in the same market place there has been no reported incidents of confusion.

31. I believe Mr Burkill to be correct when he submitted "The applicants' product is an injectable solution sold in small ampoules. The proprietor's product is a rehydration product sold as a powder to be dissolved in a large quantity of water and then administered orally. Nobody, medically qualified or not, would or could confuse them in the way suggested".

32. For the reasons given, the grounds of the application for a declaration of invalidity insofar as they are based upon Section 5(4)(a) are not made out.

33. The application for a declaration of invalidity in respect of trade mark registration No 2161785 has failed on both grounds and the registered proprietors are entitled to an award of cost. I order the applicants to pay to the registered proprietor the sum of £650. 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.

Date this 26 day of April 2002

**M KNIGHT
For the Registrar
the Comptroller-General**