TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2238945
BY ASHBOURNE PHARMACEUTICALS LIMITED
TO REGISTER A TRADE MARK IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 51787
BY MUNDIPHARMA LABORATORIES GMBH

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2238945 by Ashbourne Pharmaceuticals Limited to register a trade mark in Class 5

AND

IN THE MATTER OF Opposition thereto under No 51787 by Mundipharma Laboratories GmbH

BACKGROUND

1. On 11 July 2000, Ashbourne Pharmaceuticals Limited applied to register the trade mark "Zabtram" in Class 5. The application was accepted and published for the following goods:

> "Pharmaceutical preparations and substances, all for human use"

2. On 4 December 2000, Mundipharma Laboratories GmbH filed notice of opposition against the application. The ground of opposition is under section 5(2)(b) of the Act because the trade mark applied for is confusingly similar to the opponents' earlier registered trade marks "Zytram" and is applied for in respect of identical or similar goods to those covered by the earlier trade marks. In particular the opponents have a UK registration No 2103460 for pharmaceutical preparations and substances all for human use and a CTM No 616680 for pharmaceutical preparations for the treatment of pain; analgesics; anti-piretics; anti-inflammatory preparations.

3. The applicants filed a Counterstatement in which the ground of opposition is denied.

4. Both sides seek an award of costs.

5. Both parties submitted evidence in these proceedings. In accordance with Trade Marks Registry practice, I reviewed the case and advised the parties that, in my view, it was not necessary for a hearing to be held to decide the matter. The parties were, however, reminded of their right to be heard. In the event neither side requested a hearing. Written submissions were received from Elkington & Fife (their letter of 4 June 2002) on behalf of the opponents.

6. Acting on behalf of the Registrar and after a careful study of the papers, I give this decision.

7. Section 5(2)(b) is 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."

8. In determining the question under section 5(2), I 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.

The evidence

9. The opponents filed evidence in the form of a statutory declaration from Fiona Merle Crawford. Ms Crawford explains that she is a Registered Trade Mark Attorney and a partner at Elkington and Fife, a firm of Patent and Trade Mark Attorneys. She has practised in the field of Trade Marks for some twenty four years. Ms Crawford refers to the following Exhibits to her declaration:

- Exhibit FMC1 (a): The December 1999 issue of the "Similar Names" List which is dated and supplied on a monthly basis by the National Pharmaceutical Association to its members throughout the UK. The aim of the list is to inform pharmacists of commonly dispensed drugs whose names can be easily confused if in a hurry or the prescription is badly written.

- Exhibit FMC1 (b): Details regarding the activities of the National Pharmaceutical Association from its web site at www.npa.org.

- Exhibit FMC1 (c) Article from the British Medical Journal in 1998, Issue 317 dated 26 September 1998 (pages 863-864) entitled "Legibility of Doctors' Handwriting: Quantitative Comparative Study". The study suggests that "doctors, even when asked to be as neat as possible, produce handwriting that is worse than that of other professions. This provides supportive evidence for the commonly held belief that the legibility of doctors' handwriting is unusually poor".

- Exhibit FMC1 (d) Article entitled "Drugs in Use-Drug names which sound or look alike" from 8 September 1979 Issue of the Pharmaceutical Journal. This article lists drug names which have been mistaken for one another.

- Exhibit FMC1 (e) Item from the National Pharmaceutical Association NPA Supplement No 605 dated 6 February 1979 entitled "Watch for these Names". Again, potentially confusable drug names are listed.

- Exhibit FMC1 (f) Item from the British Medical Journal of 6 October 1979 entitled "Drug Names that look or sound alike", together with further contributions on this topic published in the British Medical Journal of 27 October 1979, 17 November 1979, 19 and 26 January 1980 and 2,9 and 23 February 1980 under the heading "Drug Names and look-alikes or sound-alikes in each case". These items again list

potentially confusable drug names together with examples from practitioners as to drugs that had been confused, e.g isoprenaline with apresoline, thyroxine for thymoxamine.

- Exhibit FMC1 (g) Article from "Drugs and Therapeutics Bulletin" of 7 October 1985 published by The Consumers Association entitled "Confusing Drug Names" The article again highlights the problem of confusable drug names and calls for more effort to be made to avoid drugs being named in a manner likely to confuse and that drug companies should name new products so that they cannot be confused with names already in use. The article also calls for doctors to recognise that one source of confusion is in the pharmacist misreading the prescription and accordingly the drug name should be written clearly and correctly.

- Exhibit FMC1 (h) Article from The American Medical Association dated May/June 1997 entitled "Prescription Errors-Legibility and Drug Name Confusion". The article cites several examples of actual cases of confusion and makes a number of recommendations to limit the number of errors being made, in relation to illegible handwriting. These include: typed pre-printed prescription pads; staff assistants with excellent penmanship can write prescriptions during the patient encounter; complete instructions on each prescription; encourage pharmacists to call if they see any discrepancy in a prescription; encourage patients to bring their prescription medications with them to their office visits; careful verbal patient education about the name and purpose of all drugs being prescribed at the time of the office visit is essential.

- Exhibit FMC1 (i) November 1999 article from Medical Advisor News entitled "Mistaken Identity" in which Pfizer Inc and GHD Searle and Co's concern regarding the similarity of the Celebrex brand name to the Celexa and Cerabyx names has heightened, although they are getting ready to launch a direct-to-consumer campaign for Celebrex.

- Exhibit FMC1 (j) Article from the 3 March 1997 Issue of "Drug Topics" entitled "Deadly Dispensing". In the article it is stated "there are a number of pressure points that can snap the dispensing chain..interruptions that destroy concentration, the sheer volume of prescriptions being generated by managed care, a physician's carelessly penned Rx, and drug names that look or sound alike".

- Exhibit FMC1 (k) Notice produced by the Centre for Medical Education and Prevention entitled "Prescription Errors due to similar medication names" obtained from the web site "Aceology Medical Review". The notice is medical information made simple for patients and consists of a list of confusable names. The patient is advised that if they take any of the listed medications, to pay attention to the medication bottle's label and to question the pharmacist if the colour, size or shape of the medication has changed.

- Exhibit FMC1 (l) A copy of pages downloaded from the FDA web site entitled "Making It Easier to Read Prescriptions". The report advised that the FDA had

received various reports on medication errors as a result of look alikes in handwriting. The FDA review each report and if necessary, may call for a manufacturer to change a products labelling and packaging, or even its name. Examples of look-alike names and the approximate number of reports are: NORVASC and NAVANE-35 reports; LEVOXINE and LANOXIN- 25 reports; PRILOSEC and PROSAC-12 reports. The web site makes the following recommendations: If handwriting is illegible, use a computerised medication order system. Otherwise, print or type prescriptions; write out instructions rather than use ambiguous abbreviations; avoid vague instructions such as "take as directed".

- Exhibit FMC1 (m) Article from PJB Publications Limited's September Issue of SCRIP entitled "US CELEBRAX Dispensing Errors Persist".

- Exhibit FMC1 (n) A number of pages downloaded from the website www.voiceoftheinjured.com with regard to the incidence of prescription errors due to similar drug names as follows: prescription errors due to similar drug names; wrongful death complaint filed against Eckerd Corporation and Kristi M Parham; illegible scripts cause misfilled prescriptions; pharmacists and pharmacies make prescription errors that kill or injure; drug store prescription errors lead to illness, deaths and lawsuits; frequently asked questions; misfilled prescriptions. In the article mentioned above-"Pharmacists and Pharmacies make prescription errors that kill or injure", it is reported that "in a study of 500 Pharmacist malpractice claims conducted by Pharmacists Mutual Insurance Company, the following types of errors were identified: Wrong drug dispensed-52%; Wrong strength dispensed-27%; Wrong direction given-7.4% for a total of 86.4% of errors that could have been prevented".

- In assessing likelihood of confusion between ZABTRAM and ZYTRAM, Ms Crawford explains that she conducted a number of investigations on the 29th May 2001 to determine the prevalence in the UK of pharmaceutical Trade Marks having the form Z*TRAM. The outcome of these investigations are detailed in Exhibit FMC2, FMC3 and FMC4.

- Exhibit FMC2 consists of a print-out of the outcome of searches conducted on Dialog-file no. 126 (UK Trade Marks) and file No 227 (Community Trade Marks). This revealed that the only marks (in any class) on the UK and Community Trade Marks Registers having the form "Z*TRAM" are ZYTRAM of the Opponent's UK and Community Registrations and ZABTRAM of the present UK Application.

- Exhibit FMC3 consists of a print-out of the outcome of searches conducted on Dialog-file No 446 (IMSworld Product Launches), together with information sheets regarding the content of the IMSworld Product Launches file. The IMS file monitors launches of new ethical pharmaceutical product introductions internationally and covers 50 major world markets. The searches revealed two product launches of ZYTRAM around the world (in Korea and Spain) for tramadol containing analgesic preparations, and none for ZABTRAM. No products of any sort have been launched in the UK whose Trade Mark has the form Z*TRAM (where "*" represents from one to four letters). Apart from ZYTRAM, the only other product that has been launched

anywhere in the world with a mark having this form is "ZUMATRAM", which was launched in Indonesia. This mark is also in respect of a tramadol analgesic preparation.

- Ms Crawford further explains that she researched the content of the May 2001 edition of eMIMS, the CD-ROM version of MIMS, which is widely used in prescribing by medical practitioners. This publication does not contain any entry for a proprietary or generic preparation having a name of the form "Z*TRAM" in either of its two sections devoted respectively to over-the-counter and prescription preparations. Furthermore, there is no generic product listed having even the suffix "-TRAM", and the only proprietary name listed in this publication having this suffix is OSTRAM, for which there were two entries. Exhibit FMC4 consists of a print-out of these entries for OSTRAM, from which it will be seen that it is only sold as a powder in sachets for the treatment of osteoporosis.

10. In reply, the applicant filed a witness statement by Katherine Lindsay Gifford Nash, a technical assistant at Urquhart-Dykes & Lord (the applicants' agents) dated 6 September 2001. The following relevant points emerge from this statement:

- the applicants are planning to use the trade mark ZABTRAM for an analgesic preparation that contains tramadol. As tramadol is an analgesic used for relieving acute pain, it will be a prescription only medicine.

- in reference to the opponents' assertion that their product sold under the trade mark ZYTRAM, will be used in relation to tramadol containing analgesics, Ms Nash argues that neither parties products will be available for purchase "over the counter" and will be prescription only. In the opinion of Ms Nash, the fact that skilled medical professionals will be the only personnel to dispense the product supports the argument that the risk of confusion or imperfect recollection will be very small.

- Ms Nash contends that the majority of doctors are now using a computer software package for generating a required prescription. Once generated the prescription is then printed. A printed prescription removes the possibility of a pharmacist being unable to read the prescription, and the "legendary poor" handwriting is not therefore a significant factor. Furthermore, patients records are now generally computerised. If a patient requires a repeat prescription and their regular doctor is unavailable, another doctor can call up their records to see what drug they were previously prescribed, thus reducing the possibility of confusion arising when the patient cannot recall the exact name of the drug they were previously prescribed.

- Ms Nash goes on to give opinion evidence in that she does not consider the two trade marks ZABTRAM and ZYTRAM to be confusingly similar, contending that in the case of pharmaceutical trade marks, the same criteria should be applied as in any other case. Ms Nash mentions the OHIM's First Board of Appeal decision in Choay S.A. v Boehringer Ingelheim International GmbH [2001] ETMR 693 as support for this contention.

Ms Nash refers to Exhibits KLGN1 and KLGN2 both of which show results of searches conducted by the applicants for trade marks ending in the suffix "tram". The following were found to be used/registered in the UK: OSTRAM, MAXITRAM, PARATRAM AND ULTRAM. In the opinion of Ms Nash, the results of the searches show that, in the UK, there are other marks in the marketplace and on the Trade Marks Register, for pharmaceutical preparations that have the suffix "tram", and that the suffix is therefore non-distinctive.

- Ms Nash also argues that it is well known that pharmaceutical trade marks often have the same ending, particularly when the products sold under those marks have a common active ingredient. In this case the suffix "tram" suggests that analgesics sold under these marks include as an active ingredient, tramadol or a derivative thereof. According to Ms Nash therefore, it is the first part of these marks that is the most important. The remainder of the witness statement contains opinion evidence from Ms Nash that the two trade marks in question are not similar. I will return to this where appropriate later in my decision.

11. The opponents also filed evidence in reply in the form of a statutory declarations from Susan Claire Woods dated 5 March 2002 and a second from Fiona Merle Crawford dated 1 March 2002. Ms Woods explains that she is employed as Head of Regulatory Pharmaceutics by Napp Pharmaceuticals Limited, a post she has held since 1999 and is also a practising pharmacist and since 1996 has regularly acted as a locum at a retail pharmacy. The following relevant points emerge from this declaration:

- Ms Wood confirms that she has read and understood the statutory declaration of Fiona Merle Crawford dated 6 June 2001 and the witness statement dated 6 September 2001 of Katherine Lindsay Gifford Nash submitted in these proceedings. In relation to the witness statements of Ms Nash, Ms Wood makes the following observations:

- That although Ms Nash states that she is employed as a "technical assistant" for the applicants Trade Mark Attorneys, there is no indication of what this job entails and whether Ms Nash has any knowledge of pharmacy or medical requirements or practices. In particular, Ms Nash does not appear to have any form of academic qualification or practical experience in the pharmaceutical or medical fields upon which to base her statements.

- In reply to Ms Nash's contention that the opponents are planning to use their mark "ZYTRAM" for analgesics containing tramadol and that this product will be prescription only medicine, Ms Woods states that there is no such statement regarding the opponents' use in the evidence of the opponents, beyond a reference (in para 13 of Ms Crawford's declaration) to its use for a preparation in the "same class of preparations" as analgesics. Ms Woods points out that in any case, the trade mark application for ZABTRAM covers all pharmaceutical preparations and substances, whether sold over the counter (OTC) or as a prescription only medicine (POM), including as a Controlled Drug.

- Ms Wood disagrees with Ms Nash's argument that prescription production,

transcription and dispensing errors have been consigned to the past with the introduction of computerised prescription preparations and of computerised patients records. Ms Wood makes further criticisms, pointing out that although Ms Nash states that the "majority of doctors" use prescription preparation software, she does not indicate the source of this information nor whether it is only general practitioners she is referring to or whether hospital doctors are included. In addition, Ms Nash does not quantify the number of doctors using computer systems for patients records nor indicate how many of these interface with prescription preparation software. Ms Nash also fails to quantify the number of prescriptions and patient notes which are still handwritten.

- Ms Wood goes on to refer to exhibit SCW1 which are extracts (pages 1 and 60) from a report prepared by the Department of Health published in June 2000, entitled "An Organisation with a Memory". The report states on page 60, that 25% of all adverse incidents in litigation claims in General Medical Practice arise from medication errors, and that of these, the common ones include "prescribing and dispensing errors". Ms Wood argues that only these errors which cause substantial harm to the patient warrant litigation and consequently the above figure does not represent all the medication errors that are reported or that occur, and any such incident is to be regretted and that all reasonable steps should be taken to avoid human error, including the avoidance of similar proprietary names.

- Exhibit SCW2 consists of copies of an editorial article downloaded from the British Medical Journal website entitled "Computer Based Prescribing", published in November 1995. The article indicates that "Almost all general practice receptionists in Britain use computers to generate repeat prescriptions, and two-thirds of general practitioners use computers to prescribe during consultations. By comparison, few hospital doctors use computers". Of the computers used for prescribing, the systems range from the most basic form for producing repeat prescriptions to sophisticated systems which assist the GP's decision making process and are said to improve accuracy. Ms Wood argues that although most GPs' receptionists prepare repeat prescriptions on computers, unless the patients' records are also computerised, these lay people are still left interpreting handwritten patients' notes in order to do so. A drug name error entered into a computerised repeat prescription system may not be questioned by the doctor signing the prescription, particularly where there is a locum or member of a busy practice with a number of doctors sharing patient care.

- Ms Wood claims it is clear from this article that only those computerised prescribing systems that are linked with computerised patients records are effective in avoiding prescription errors and then only if used correctly. The articles states "Computerise based tools assist prescribing in various ways, including by increasing legibility and routinely checking for potential interactions. Some general practitioners, however, find these checks over-inclusive or too slow (even 10 seconds delay is too long during a consultation) and turn them off". In relation to hospital practice, the article states "Hospital clinicians may be put off using these tools by insufficient space in clinic rooms, lack of funds to install computer work stations at every bedside, and previous experience with inadequate systems".

- Exhibit SCW3 consists of pages 1,5 and 10 of a recent Audit Commission report entitled "A Spoonful of Sugar" on Medicines Management in NHS Hospitals (published in December 2001). The report highlights that "medication errors happen too often and their effects on patients and on NHS costs can be profound"(page 1) and that it is still the case that "handwritten prescriptions ....contribute to errors as they may be illegible, incomplete and subject to transcription errors".(page 5). It also finds that "computerised prescribing and health records have been shown to eliminate three-quarters of medication errors, but they are only used in a few hospitals" (page 10) and that "many errors could be eliminated through use of computer technology and automation" and that a "national approach is needed to introduce these systems"(page1).

- Ms Wood argues that even if the marks ZYTRAM and ZABTRAM are both used for POMs and prescriptions are computer generated, confusion between these marks is likely to arise because of their substantial similarity. Confusion can occur not only in the generation of prescriptions but also in their dispensing.

- In support of this Ms Wood claims that the production of computer generated prescriptions generally entails the practitioner (or receptionist, in the case of repeat prescriptions), selecting the desired preparation name from a menu on his computer screen. Imperfect recollection could therefore result in confusion where the drugs are listed alphabetically (ZABTRAM coming before ZYTRAM) or where the computer program employed is not up to date and lists only one of these two preparations.

- In relation to Ms Nash's assertion that "legendary poor handwriting of doctors is not therefore a significant factor", Ms Wood asserts that this appears to lose sight of the still large number of handwritten prescriptions produced by those general practitioners not using computer generation in their surgeries. Ms Wood advises that at the pharmacy where she works, 15-20% of prescriptions are handwritten. Further Ms Nash does not take into account that the vast majority of hospital prescriptions are handwritten, nor does she consider those prescriptions produced for "Controlled Drugs" , which by law, must be handwritten. Exhibit SCW4 shows a copy of the requirements of the Misuse of Drugs Regulations 2001.

- Ms Wood further argues that in the pharmacy, all prescriptions, whether printed or handwritten, have to be inputted into a computer, and errors are likely to occur if products have similar names.

- Exhibit SCW5 consists of an up to date list of "Similar Names" issued to pharmacists by the National Pharmaceutical Association, which lists "those commonly dispensed drugs whose names can be easily confused, because of their similarity". Some names that are considered confusable are: "AMANTADINE with CIMETIDINE; ALUPENT with ATROVENT; AMOXYCILLIN with AMPICILLIN; APRESOLINE with ISOPRENALINE".

- Ms Wood argues that there is no support for Ms Nash's assertion that the suffix

"tram" in a trade mark in the UK would be seen to indicate the presence of "the active ingredient tramadol, or a derivative thereof". Exhibit SCW6 consists of a copy of the World Health Organisation's "Guidelines on the Use of International Non-Proprietary Names (INNs) for Pharmaceutical Substances" dated 1997. This explains on page 1 that an INN "identifies a pharmaceutical substance or active pharmaceutical ingredient by a unique name that is globally recognised and is public property" and on page 6 that "usually an INN consists of a random, fantasy prefix and a common stem; substances belonging to a group of pharmacologically related substances show their relationship by the use of a common stem" and that a list of these common stems used in the selection of INNs may be found in Annex 3. Annex 3 does not list "tram" as being a common stem, either as a prefix or suffix, indicating the active ingredient tramadol or, indeed, any other substance. On this basis, Ms Wood therefore argues that the suffix "tram" in ZYTRAM has no recognisable meaning in the UK and cannot be ignored or given a reduced significance when assessing the likelihood of confusion between the two marks.

12. The second statutory declaration from Ms Crawford, confirms that Ms Crawford has read and understood the witness statement of Ms Nash, dated 6 September 2001. In paragraph 1 of this statement Ms Nash indicates that in a situation in where both ZYTRAM and ZABTRAM are used "for tramadol containing analgesics", "neither of these products will be able to be bought over the counter" and that "both products will need to be prescribed by a doctor and subsequently dispensed by a pharmacist". Exhibit FMC5 is a copy of pages downloaded from the website Rx-to-OTC Switch at www.rxtootcswiotch.com, which discusses how the status of drugs changes from prescription only medicines (POM) to over the counter (OTC) drugs in various countries. As regards the UK it indicates that there were 11 POM to OTC switches in the four year period from 1995 to 1998 inclusive, and gives as specific examples of such POM to OTC switches, ZANTAC to GAVISCON. It is indicated that as OTC drugs, ZANTAC and GAVISCON are still sold with the "support of the pharmacist". Should ZABTRAM and/or ZYTRAM products have a similar OTC status, it is difficult to see how the support of a pharmacist could avoid errors, such as a customer requesting ZABTRAM in mistake for ZYTRAM or vice versa, or a request for ZYTRAM being mis-heard as one for ZABTRAM or vice versa, arising where both products are analgesics/analgesics containing tramadol. In such a situation, any query raised by the pharmacist as to what the drug is required for or what it contains, would not bring to light the error.

13. That concludes my review of the evidence. It will be apparent from the above that a substantial body of evidence has been filed bearing on circumstances and practice in the medicines' field. Submissions have also been offered in relation to the goods considered to be of particular interest in this case. Before considering the application of trade mark law to this case it will be useful to draw together my main findings based on this evidence. These are as follows:

- the medical profession has long been aware that errors can, and do, occur in the prescribing and dispensing of medicines;

- the reasons are variously attributed to poor handwriting, the pressured

circumstances in which prescribing/dispensing takes place, poor communication between prescribers and pharmacists, collateral factors such as similar packaging etc;

- the errors relate to pharmaceutical names, dosages, wrong directions to patients etc;

- efforts have been made to alleviate the problem through greater use of computerised or pre-printed prescriptions, improved liaison between prescribers and dispensers, better patient education etc;

- but problems persist with a significant percentage of prescriptions still being handwritten particularly in hospitals;

- various controls exist over pharmaceutical names according to whether proprietary or non-proprietary names are involved but these controls operate independently of the trade mark registration system - see Exhibit FMC1 - Section (vii);

- the suffix -TRAM is said to be an abbreviation for tramadol, an active ingredient in analgesics;

- there is insufficient evidence to establish that the reference to tramadol will generally be recognised or understood;

- it is possible for drugs to change from being prescription only to being available over the counter although the number of incidences of this happening suggest it is a relatively infrequent occurrence.

Distinctive character of the opponents' mark

14. The opponents' earlier trade mark, in common with the vast majority of pharmaceutical names, is an invented word. The applicants have sought to suggest that the suffix -TRAM alludes to the active ingredient 'tramadol'. That may be the case but the relevant question seems to me to be whether the average consumer would recognise that this is the case. There is no evidence to support a clear finding that relevant classes of consumers (medical professionals or the general public) would be familiar with tramadol and understand that the suffix of the mark was intended to allude to it. In all probability some medical professionals would, but on the material before me it would be unsafe to rely on even this much. On the other hand Annex 3 to Exhibit SCW6 to Ms Woods' declaration suggests that -TRAM is not a 'common stem'. In terms of distinctive character I therefore, take the view that the opponents' earlier trade mark is an inherently strong one.

Comparison of goods

15. It is suggested that the applicants' goods will only be available on prescription but their specification is not limited in this way. I am required to consider the matter on a notional

basis. On that basis it is clear that both parties' specifications cover identical goods, that is to say pharmaceutical preparations and substances. The matter turns critically, therefore, on the marks themselves.

Comparison of marks

16. I am required to consider the matter from the point of view of visual, aural and conceptual similarities and to judge the matter through the eyes of the average consumer who is deemed to possess the attributes referred to in the Lloyd case. I have taken the view that, on the basis of the specifications as they currently stand, the goods are not limited to prescription only medicines. The average consumer will, therefore, include the public at large as well as medical professionals. Had the goods in question been prescription items, then the focus of the average consumer test would primarily have been medical professionals (GPs, hospital consultants and the like). The latter might have been expected to be more aware of the ingredient tramadol and hence the allusion to it in the mark. However taking, as I consider I must, a broad view of the average consumer I must assume that -TRAM would not be accorded less weight on the basis that it alludes to a key ingredient of the goods.

17. Visually there are clearly points of similarity between the marks in terms of the initial letter (Z) and suffix (TRAM). Z is also a less common letter at the start of words. Nevertheless it is artificial to single out particular letters or even letter combinations when the comparison must be of the marks as wholes. I find that the overall appearance of the words is such that they can be distinguished visually. It is possible that, in handwritten prescriptions, the words might be presented less clearly and/or in lower case lettering. But, as the applicants point out, that would result in an upward extension of the stem of the 'b' in Zabtram in contrast to a downward extension of the 'y' of Zytram.

18. Aurally, I consider that the stress is likely to be on the first syllable of each word and that the points of similarity are outweighed by the clear differences resulting from the contribution made by the different first syllables within the marks as wholes.

19. Conceptually, neither word has an obvious meaning. There is no point of conceptual similarity other than their inventedness. However, I am inclined to think that with marks of this kind conceptual considerations do not play a significant part in influencing consumer reaction. Visual and aural/oral considerations will be to the fore.

Likelihood of confusion

20. The question of whether there is a need for greater differentiation between trade marks in the pharmaceutical field has been considered in a number of cases (see for instance Cases O-414-01 and O-532-01). In the first of these cases the Hearing Officer reviewed the submissions made to him, inter alia, in relation to OHIM's approach where pharmaceutical trade marks are concerned and whether a higher or lower threshold for confusion should apply. He went on to say that:

> "It seems to me that the role of the registrar is to apply the Trade Marks Act 1994 and its subordinate legislation to the proceedings brought before her. Other provisions

and authorities exist for the licensing of pharmaceuticals and in my view, it is not the role of the Trade Marks Registry to stray into these areas. Under the provisions of the Act and acting on behalf of the registrar I must consider whether there exists a likelihood of confusion if the applicants' and opponents' trade marks are used in respect of the goods for which they are respectively applied for and registered."

21. In line with that general approach I came to the view in a more recent case (O-199-02) involving Class 5 goods that:

> "25. I must nevertheless take account of all relevant surrounding circumstances bearing on the trade in such goods and the nature and characteristics of the average consumer. Thus in the circumstances of this case I bear in mind that the goods may be available over the counter or by prescription (taking a notional view of the matter); that the average consumer may be medical professionals and/or the public at large; that handwritten prescriptions may be involved; that the public may be ordering/purchasing goods in the environment of a busy chemists shop. I also consider that, notwithstanding that a customer may have an ailment at the time, the average person is unlikely to be so careless in health issues that he or she will act in other than a reasonably circumspect and observant fashion.
>
> 26. This is not to say that the points made by Mr Thomas should be lightly dismissed. Clearly there can be and have been serious, and in some cases fatal, consequences of errors arising from failures in the prescribing/dispensing process. Nevertheless I do not think it is suggested that handwritten prescriptions or other 'risk factors' in the system generally result in problems. It is reasonable to assume that the overwhelming majority of prescriptions and purchases whether over the counter or through a medical professional result in the correct product being supplied. Whilst errors may be serious when they occur they are not typical of what happens. The position seems to me to be that the test in trade mark law terms should have regard to the normal range of circumstances found in the trade rather than seek to compensate for irregular or exceptional occurrences. I also bear in mind the guidance from the Lloyd Schuhfabrik case ((b) above) which requires me to assume that the average consumer is reasonably well informed and reasonably circumspect and observant."

I regard those conclusions as being broadly applicable in the current case.

22. I also bear in mind that the Act requires a likelihood of confusion. A mere possibility of confusion is not sufficient (see REACT Trade Mark [2000] RPC 285 at page 290). Taking the best view I can of the matter it seems to me that this is a case where identity of goods and points of similarity between the marks do not combine to create an overall likelihood of confusion. In reaching that view I have also considered the effect of imperfect recollection which I regard as of potential importance where invented words are concerned (as such words yield no ready meaning which might help to differentiate between them). In the event I have concluded that imperfect recollection does not operate in the opponents' favour. The opposition fails accordingly.

23. As the applicants have been successful, they are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £1250. 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 is unsuccessful.

Dated this 23RD day of July 2002

M REYNOLDS
For the Registrar
the Comptroller-General