

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2244557
BY Y2K SHIPPING & TRADING INC
TO REGISTER THE TRADE MARK:**



IN CLASS 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 52765
BY PFIZER PRODUCTS INC
BASED UPON THE EARLIER SIGN:**

VIAGRA

TRADE MARKS ACT 1994
IN THE MATTER OF Application No 2244557
by Y2K Shipping & Trading Inc
to register the trade mark:



in class 5
IN THE MATTER OF Opposition thereto under No 52765
by Pfizer Products Inc

Background

1) On 21 July 2000 Y2K Shipping & Trading Inc (Y2K) applied to register the above trade mark. The application was published with the following specification:

herbal capsules to enhance the energy, vitality and sexual performance of males

The goods are in class 5 of the International Classification of Goods and Services. The application was published on 23 May 2001.

2) On 27 June 2001 Pfizer Products Inc (Pfizer) filed a notice of opposition to this application.

3) The opponent states that he is the proprietor of United Kingdom trade mark registration no 2048286 of the trade mark **VIAGRA**. This registration was filed on 11 December 1995 and registered on 16 August 1998 in respect of:

pharmaceutical and veterinary preparations and substances

The goods are in class 5 of the International Classification of Goods and Services.

4) The opponent states that the respective trade marks are similar and encompass identical or similar goods and, therefore, there is a likelihood of confusion. Consequently, registration of the trade mark in suit would be contrary to section 5(2)(b) of the Act.

5) The opponent states that he has used the trade mark VIAGRA extensively in the United Kingdom since September 1998 in respect of goods in class 5 and has, as a result, built up a large reputation and goodwill in the trade mark. The opponent states that in view of the reputation enjoyed in the trade mark VIAGRA, use of the trade mark in suit would, without due cause, take unfair advantage of, or be detrimental to the distinctive character or the repute of the earlier trade mark. This represents an objection under section 5(3) of the Act. The opponent states that he has also built up substantial common law rights in the trade mark VIAGRA. Consequently, use of the trade mark in suit is liable to be prevented by virtue of the law of passing-off and so its registration would be contrary to section 5(4)(a) of the Act.

6) The opponent requests that the application is refused and seeks an award of costs.

7) The applicant filed a counterstatement in which the grounds of opposition were denied.

8) The applicant states that the TRIAGRA trade mark and device is a registered trade mark in India. He states that TRIAGRA and VIAGRA are essentially different even though the ending sounds the same. He states that there are numerous words in the English language where if a V is changed for the letters TR the word has a completely different meaning. He lists such words.

9) The applicant states that VIAGRA has no logo whilst TRIAGRA does. He goes on to state that the two products look different and have different packaging. The applicant states that his product costs considerably less than VIAGRA and that unlike VIAGRA it is not a prescription medicine. He states that there is no possibility of confusion between the respective trade marks. The applicant claims that a head executive of Pfizer had admitted that no confusion has ever arisen between the two trade marks.

10) The applicant states that the two products have different constituents. He states that according to the Indian manufacturers the words VIA AGRA were known to Indian travel agents for many years. He states that, "The saying went: "When visiting India, come Via Agra and you'll see man's greatest erection for a woman." It is not improbable that Pfizer, the manufacturer of Viagra, which has offices in India adopted the trade mark Viagra from the Indian saying".

11) Only the opponent filed evidence.

12) The matter came to be heard on 25 September 2002 when the opponent was represented by Mr Christopher Morcom QC, instructed by Venner Shipley & Co. The applicant was not represented and did not furnish written submissions.

Opponent's evidence

13) This consists of two witness statements. The first is made by Douglas Brian Reynolds. Mr Reynolds is director of a firm of private investigators. Mr Reynolds was instructed to find out if the trade mark TRIAGRA was in use in the United Kingdom. He made various attempts by telephone and the Internet to obtain the TRIAGRA product from the applicant. Despite various telephone calls he failed to obtain the product and was advised by "Raj" on 15 November 2000 that Y2K had not supplied any of the product to the United Kingdom.

14) The second declaration is by Keith Stephen Ruddock. Mr Ruddock is a patent and trade mark attorney employed by Pfizer Limited in the United Kingdom. He states that VIAGRA is used in the treatment of erectile dysfunction. He states that Pfizer has never promoted VIAGRA as an aphrodisiac and/or as a product to be used recreationally. Mr Ruddock states that Pfizer has invested considerable time and effort in disassociating VIAGRA from products which claim to be VIAGRA alternatives or which claim to have a VIAGRA like effect. However, the success of VIAGRA has resulted in many people trying to capitalise on the name in one or another form for commercial purposes.

15) Mr Ruddock goes on to comment on the reputation of VIAGRA and various documents are exhibited in support of this reputation. I accept that VIAGRA enjoys an enormous reputation in relation to pharmaceutical products for use in relation to erectile dysfunction, and also did so at the date of the filing of the application in suit, on the basis of judicial notice. The fame of the brand is such that it appears in the Collins English Dictionary published in 2000 and is even in the spell-check dictionary of the word processing system that I am using to write this decision! VIAGRA is now part of the common lexicon. If I did not accept the fame of VIAGRA on the basis of judicial notice the evidence furnished by the opponent, which includes numerous newspaper cuttings from before the date of the application, would have convinced me of the fame. I consider that VIAGRA is a household name owing to the enormous reputation it has in relation to pharmaceutical products to counter male impotence.

16) Mr Ruddock states that Pfizer successfully opposed registration in the United States of America of the word trade mark TRIAGRA, which was filed by the same applicant. He states that the United States Trade Mark Trial and Appeal Board entered a default judgement in favour of the opponent on 17 May 2001. He exhibits at KSR9 an extract from the United States Trade Mark and Trial Board website in confirmation of this. Pfizer has also taken legal action against the applicant in the United States of America on the basis of trade mark infringement and dilution on account of use of the trade mark TRIAGRA and device. On 25 September 2000 Pfizer obtained a temporary restraining order followed by a preliminary injunction which obliged the applicant to change his trade mark and alter his website. Mr Ruddock states that the case has not been concluded.

17) Mr Ruddock states that the United Kingdom trade marks register does not contain any registration in class 5 which ends with the letters “iagra” other than the trade mark VIAGRA. He exhibits a copy of a search report in verification of this.

18) The other matters in Mr Ruddock’s statement can best be described as representing submissions rather than evidence of fact. I will say no more about them here but take them on board in reaching my decision.

Decision

Likelihood of confusion

19) Section 5(2)(b) of the Trade Marks Act 1994 states that a trade mark shall not be registered if because:

“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.”

20) Section 6(1)(a) of the Act defines an earlier trade mark as:

“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,”

21) The trade mark upon which the opponent relies falls within the parameters of section 6(1)(a) and is, therefore, an earlier trade mark.

22) 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] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 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 BV* 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 132, 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 224.

Comparison of goods

23) The goods of the earlier registration are: *pharmaceutical and veterinary preparations and substances*. The goods of the application in suit are: *herbal capsules to enhance the energy, vitality and sexual performance of males*. The goods for which Pfizer has a reputation are pharmaceutical products to counter male impotence.

24) The European Court of Justice held in *Canon*, in relation to the assessment of the similarity of goods and/or services, that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

25) In relation to the *Canon* test I will consider pharmaceutical products to counter male impotence in relation to the goods of the application in suit. Both sets of goods are aimed at the sexual performance of males. The purpose and the end user are, therefore, the same. The evidence of Pfizer shows that their goods are supplied in capsule form, as are the goods of the application in suit; their natures and method of use are, therefore, the same. Owing to the similar purpose of the respective goods, they could be substituted for each other. Consequently they are in competition.

26) I consider that the respective goods fall squarely within the parameters of the *Canon* test. I have no doubt that the respective goods are similar to a high degree. Mr Morcom argued that the goods are in fact identical. I am not certain of this; one set of goods being pharmaceutical and the other herbal. However, I would not go so far as to say Mr Morcom was incorrect. The degree of similarity of the respective goods is so great that I do not consider that whether the respective goods are similar or identical affects the outcome of this case; taking into account all other factors in the global assessment that I need to make.

Comparison of signs

27) The signs to be compared are:

Earlier registration

VIAGRA

Trade mark in suit



28) The applicant submitted in his counterstatement that VIAGRA could actually be derived from VIA AGRA. He attached to his counterstatement a copy of an un-sourced photocopy in relation to this assertion but no evidence. I can see no reason why a British consumer should divide VIAGRA into two and then add an extra “a”. There is no evidence to support this as a likelihood. I consider that it is inherently improbable. I consider VIAGRA and TRIAGRA, in the absence of any evidence to the contrary, to be invented words with no conceptual association. The horse device, in relation to the goods, is in my view likely to have an association with sexual prowess.

29) The trade mark in suit includes the device of a horse as well as the word TRIAGRA in a lozenge shape. VIAGRA and TRIAGRA both end with the same five letters, this is the extent of their visual similarity.

30) Phonetically VIAGRA and TRIAGRA have the same endings; they differ in their beginnings. It is a commonplace in the comparison of trade marks that the beginnings of words are usually more important than the ends. In this case the difference in the beginnings is not reinforced by a different conceptual association. Owing to the common ending I consider that there is a low degree of phonetic similarity between the respective trade marks.

31) In his counterstatement the applicant referred to various English words, such as vim and trim, “interchanging V with TR or vice versa which denote different matters”. I do not consider that this has a bearing on this case as neither VIAGRA nor TRIAGRA has a meaning; the substitution of “v” for “tr” does not change the conceptual association of the respective trade marks. It is common for the names of medicines to be written. It is also common for them to be requested verbally to people working behind pharmacy counters. In my opinion, in relation to the respective goods, the phonetic aspect of similarity is more important than the visual aspect.

32) Considering all aspects of the respective trade marks, I have come to conclusion that they have a low degree of similarity.

Conclusion

33) The word VIAGRA in relation the goods for which it is registered is an invented word with no allusion to the nature of the goods. I consider it a particularly distinctive trade mark by nature. In my global assessment of the conflicting trade marks I take into account the following:

- that VIAGRA is a household name
- the proximity or identity of the respective goods
- the low degree of similarity between the signs
- that the public, although reasonably circumspect, seldom have the chance to compare trade marks side by side and are so prey to imperfect recollection

34) The opponent has referred to state of the register evidence; the absence of other trade marks ending in -IAGRA. In *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 Jacob J stated:

An particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.@

In my view, therefore, the state of the register evidence does not assist the opponent.

35) The applicant has referred to no confusion having arisen between the respective products. The evidence of Mr Reynolds, which has not been challenged, shows that the applicant's product has not been sold in the United Kingdom. Consequently, the absence of confusion tells me nothing. The claims about the different selling practices of the respective goods can also have no relevance when there has been no use in the United Kingdom of the applicant's trade mark. Even if that were not the case I would need to consider normal and fair use of the trade mark as applied for in relation to the goods of the specification. There is no restriction as to price nor to the form of the capsule; equally there is no restriction as to the price of VIAGRA and nothing that precludes the changing of the shape or colour of the product – subject to satisfying any statutory requirements in relation to licensed medicines. The applicant also refers to the colouring of his packaging. The application is not subject to a colour claim and so in normal and fair use could be used in a variety of colours. The applicant claims that his trade mark is registered in India. There is no evidence as to this. Even if this is the case this does not affect my considerations in relation to the United Kingdom. If I give no weight to the state of the United Kingdom register I can certainly give no weight to the alleged state of the register in India.

36) In reaching a decision as to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in *Canon*:

“Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *Sabel*, paragraphs 16 to 18).”

37) In this case, having made a global assessment, I consider that such a risk does exist and I, therefore, find that there is a likelihood of confusion.

Section 5(3)

38) Section 5(3) of the Act states:

“A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

39) I have already decided that the respective trade marks have a low degree of similarity.

40) The European Court of Justice have clearly set out the parameters in relation to reputation in *General Motors Corporation v Yplon SA Case C-375/97* [2000] RPC 572:

“Article 5(2) of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory.”

The court also stated the following:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant factors of the case, in particular the market share held by the trade mark, the intensity, geographical extent

and duration of its use and the size of the investment made by the undertaking in promoting it.”

“The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.”

41) In this case I have no doubt that at the date of the filing of the application in suit, 21 July 2000, the opponent enjoyed the reputation required to underpin an objection under section 5(3); a reputation which relates to pharmaceutical products to counter male impotence.

42) Mr Morcom referred to the different positions adopted by Advocate Generals Jacobs and Colomer in relation to the issue of the objection under this section only relating to non-similar goods. In their opinions to the European Court of Justice the former has stated that the goods had to be dissimilar and the latter that the goods could be similar (*Davidoff & Cie SA and Zino Davidoff v Gofkid Ltd* (Case C-292/00) and *Arsenal Football Club plc v Reed* (Case C-206/01)). Section 5(3) of the Act puts into effect article 5(2) of First Council Directive 89/104 of December 21, 1988. Both article 5(2) and section 5(3) require the goods to be not similar. I consider that I must follow the written statute. **Consequently, as I have already decided that the respective goods are similar this ground of opposition must fail.**

43) I will, however, comment on the other aspects of section 5(3). Pfizer has emphasised in its evidence that VIAGRA is a licensed pharmaceutical product which, in the United Kingdom, is available only on prescription. There are possible side effects to VIAGRA for certain men and so its monitored prescription is essential to its safe use. It is emphasised by Pfizer that VIAGRA is not an aphrodisiac. The goods of the application in suit have not been licensed according to the counterstatement. According to the specification they are to “*enhance the energy, vitality and sexual performance of males*”. This is a vague claim but would appear to hint at aphrodisiac qualities. I can understand why Pfizer do not want their product, a respectable licensed pharmaceutical product, to be associated in any way with an unlicensed product which makes vague claims as to its effects. The very association with aphrodisiacs would be liable to lower the repute of VIAGRA, associating it with non-licensed quasi medicines. An association with Pfizer could also be detrimental if the TRIAGRA failed to fulfil its claims or, indeed, had harmful side effects. In my view an association between the two products would be liable to tarnish both the repute of VIAGRA and of Pfizer.

44) I consider that use of the trade mark in suit would be detrimental to the repute of VIAGRA.

45) The applicant could rely on the claim that he had due cause to use his trade mark. However, he put in no evidence and Neuberger J in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 held that it is for the applicant or alleged infringer to establish due cause. Indeed, the applicant has given no indication as to how he came up with the name TRIAGRA. Owing to the fame of VIAGRA and the nature of the goods of the trade mark in suit, the only inference that I can draw is that the applicant chose the trade mark in suit to ride on the coat tails of VIAGRA.

46) If I had not found that the respective goods are similar I would have had no hesitation for finding for the opponent under section 5(3) of the Act.

Passing-off

47) Section 5(4)(a) of the Act states:

“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,”

48) The opponent has already succeeded under section 5(2)(b) of the Act. I could, therefore, pass over considering the objection under this section of the Act. However, Mr Morcom requested that the decision should deal with this basis of the opposition. In this case I consider it worthwhile to consider the passing-off issue.

49) For a claim to passing-off to succeed the plaintiff needs to satisfy the classic trinity of requirements:

- that he has goodwill in his trade mark
- that there is a misrepresentation by the defendant (whether intentional or not)
- that he has been damaged or is likely to be damaged by the misrepresentation

50) The relevant date for passing-off purposes is the date of the behaviour complained of, which in the case of an unused trade mark is the date of filing - *Cadbury-Schweppes Pty. Ltd. v. The Pub Squash Co. Ltd* [1981] RPC 429. As the trade mark in suit is unused the relevant date is the date of the filing, 21 July 2000.

51) There is no doubt that Pfizer enjoyed goodwill in the trade mark VIAGRA in relation to pharmaceutical products to counter male impotence at the relevant date.

52) Would there be misrepresentation if the trade mark in suit were to be used? In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

Would the public believe that the opponent had made himself responsible for the goods of the applicant? I can readily imagine the public imagining that goods sold under the trade mark in suit might be a non-prescription or herbal version of his prescription pharmaceutical.

53) In *United Biscuits (UK) Limited v. Asda Stores Limited* [1997] RPC 513 Walker J stated:

“In the Harrods case Millett L.J. said at page 706, "Deception is the gist of the tort of passing-off, but it is not necessary for a plaintiff to establish that the defendant consciously intended to deceive the public if that is the probable result of his conduct. Nevertheless, the question why the defendant chose to adopt a particular name or get

up is always highly relevant. It is "a question which falls to be asked and answered": see *Sodastream Ltd. v. Thorn Cascade Co. Ltd.* [1982] R.P.C. 459 at page 466 per Kerr L.J. If it is shown that the defendant deliberately sought to take the benefit of the plaintiff's goodwill for himself, the court will not "be astute to say that he cannot succeed in doing that which he is straining every nerve to do": see *Slazenger & Sons v. Feltham & Co.* (1889) 6 R.P.C. 531 at page 538 per Lindley L.J."

In the *Harrods* case Millett L.J. (at page 712), approving what was said by Farwell J. in *British Legion v. British Legion Club (Street) Ltd.* (1931) 48 R.P.C. 555, characterised the connection rather more widely, as a suggestion that the plaintiff was in some way responsible for the defendant's goods or services. Plainly that includes the manufacturer of a supermarket's own-brand product, even if the supermarket shares that responsibility through its own-brand commendation.

Is it sufficient for a substantial part of the general public to be led to suppose, or assume, or guess at such a connection? In *Ewing* (1917) 34 R.P.C. 232 at page 238 Warrington L.J. put it in terms of what a customer "might well think" and went on to say,

"It seems to me that the plaintiff has proved enough. He has proved that the defendants have adopted such a name as may lead people who have dealings with the plaintiff to believe that the defendants' business is a branch of or associated with the plaintiff's business."

54) In this case I believe that the applicant was "straining every nerve" to make an association with VIAGRA and I feel that he has made the sort of connection that is a misrepresentation.

55) Use of the trade mark in suit could damage the reputation of Pfizer leading to a loss in sales and share value. The association with Pfizer could also divert sales away from the VIAGRA product to the product of the applicant; leading to a loss in sales. Consequently the opponent would suffer damage.

56) I consider that registration of the trade mark in suit would be contrary to section 5(4)(a) of the Act.

57) I have referred to the applicant riding on the coat tails of the opponent. This in itself is not contrary to trade mark law or the law of passing-off as long as there is enough distance between the goods and/or signs. Where there is not there is a likelihood of confusion and/or passing-off. I have not found against the applicant for his coat tail riding but because registration of his trade mark would be contrary to sections 5(2)(b) and 5(4)(a) of the Act.

58) The application in suit is to be refused in its entirety.

59) Mr Morcom made submissions that costs in respect of these proceedings should be off the scale. The applicant following the filing of the counterstatement has been silent and passive. He has put the opponent to the expense of filing evidence; not just in respect of the trade mark VIAGRA but also in respect of the alleged use of his trade mark. He did not attend the hearing or furnish written submissions. He did not even advise that he would not be attending the hearing. The applicant was content for the opponent to be put to time and expense in the defence of his trade mark whilst he did nothing. The applicant made the choice to file the

application in suit and then to continue with it following the opposition. The opponent had to be reactive, his decision to oppose and the costs arising there from were caused by the actions of the applicant. The applicant does not have to do anything other than file a counterstatement, that is the law. I do not think it can be the norm that costs should be off the scale simply because an applicant lets the onus rest fairly and squarely with the opponent. I do not feel that the circumstances of this case are so unusual or the actions of the applicant so unacceptable that I should make an award off the scale. However, I do feel that the circumstances of this case are such that the opponent should receive an award at the top end of the scale. The applicant made claims in his counterstatement that had to be investigated. The applicant did not advise that he would not be attending the hearing; so the opponent might have relied upon written submissions. **I, therefore, order the applicant to pay the opponent the sum of £3700. 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.**

Dated this 14th day of October 2002

**D.W. Landau
For the Registrar
the Comptroller-General**