TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2238903
BY ASHBOURNE PHARMACEUTICALS LIMITED
TO REGISTER THE TRADE MARK ZOPAX IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO UNDER No. 51753
BY GLAXO GROUP LIMITED

TRADE MARKS ACT 1994

IN THE MATTER OF Application No. 2238903
by Ashbourne Pharmaceuticals Limited
to register the Trade Mark ZOPAX in Class 5

AND

IN THE MATTER OF Opposition thereto under No. 51753
by Glaxo Group Limited

DECISION

1. On 11 July 2000 Ashbourne Pharmaceuticals Limited applied to register the mark Zopax in Class 5 for a specification which initially read 'pharmaceutical preparations and substances all for human use'. As a result of the applicants filing a Form TM21 the specification now reads 'pharmaceutical preparations and substances for the treatment of depression'. The application is numbered 2238903.

2. On 23 November 2000 Glaxo Group Ltd filed notice of opposition to this application. They are the proprietors of the mark ZOVIRAX under No. 1081183. This registration has a filing date of 19 July 1977 and is an earlier trade mark within the meaning of Section 6 of the Act. It is registered for a specification of goods which reads 'pharmaceutical, medicinal, veterinary and sanitary preparations and substances'. The opponents base their objection on Section 5(2)(b) of the Act. They also say that their ZOVIRAX mark has been used since 1981 and is currently available both on prescription and 'over the counter' for the treatment of genital herpes and cold sores respectively. It is said to be the most widely prescribed anti-herpes drug available on the market.

3. It is not entirely clear from the opponents' statement of grounds whether they also rely on Section 5(4)(a) of the Act. I note that there are several references to goodwill in circumstances which may be consistent with an objection based on the law of passing off.

4. The applicants filed a counterstatement denying the above claims. I note that in doing so they appear to recognise that a claim under Section 5(4)(a) is to be inferred from the language of the opponents' statement of grounds. For reasons which I will give below I do not think this slight uncertainty about a possible Section 5(4)(a) objection is likely to have a material effect on the outcome of the action.

5. Both sides have asked for an award of costs in their favour.

6. A Registry Hearing Officer reviewed the papers and indicated that it was not thought a hearing was necessary. Nevertheless the parties were reminded of their right to be heard or to file written submissions. In the event neither side has asked for a hearing or filed written submissions beyond those contained in the evidence.

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

Section 5(2)(b)

8. Section 5(2)(b) reads as follows:

> "5.-(2) A trade mark shall not be registered if because -
>
> (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

9. 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] E.T.M.R. 1, *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*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* 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*, paragraph 23;

(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*, paragraph 23;

(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*, 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*, 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*, paragraph 26;

(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*, 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*, paragraph 29.

Similarity of goods

10. The applicants' specification has been amended to reflect the particular purpose of the product of interest, namely a pharmaceutical preparation for the treatment of depression. The applicants do not say how it is to be administered, ie. whether in pill, tablet or other form. It is unlikely to be in the form of a cream which is how the opponents' goods are primarily sold (though I note that the evidence also refers to tablets, suspensions and other formulation). However the different nature, purpose and intended patient base do not really assist the applicants because the test is a notional one. Whilst the opponents' current use of their mark is in relation to a treatment for ailments which are quite different from those for which the applicants' products would be used I must make due allowance for the unrestricted nature of the opponents' specification and the fact that they could, within the terms of that specification, extend their actual use to a broader category of goods. On that basis the respective sets of goods must be considered to be the same.

Distinctive character of the opponents' earlier trade mark

11. The distinctive character of an earlier trade mark is a factor to be borne in mind in coming to a view on the likelihood of confusion (Sabel v Puma, paragraph 24). That distinctive character can arise from the inherent nature of the mark or be acquired through use.

12. As with many pharmaceutical trade marks, the opponents' ZOVIRAX mark is an invented word with no obvious descriptive significance in the context of the goods. It, therefore, carries a high degree of inherent distinctive character.

13. The opponents have filed evidence which I assume is in part intended to establish that this distinctive character has been further enhanced through use. The evidence comes in a witness statement by James A Thomas, Vice President and Trade Mark Counsel for Glaxo SmithKline. He describes his company's product in the following terms:

> "ZOVIRAX is effective against infections caused by the herpes simplex virus including herpes labialis (coldsores), genital herpes and herpes encephalitis. It is also effective against infections caused by the varicella zoster virus including chickenpox and shingles.
>
> ZOVIRAX which features aciclovir as its active ingredient, was the world's first anti-viral treatment for coldsores when launched as a prescription only product in 1981. It is now widely available throughout the world both on prescription and over the counter."

14. Samples of packaging are exhibited at JAT2.

15. Worldwide sales in the year to December 1999 are said to have been £412 million. In support of the claim to a reputation in this country Mr Thomas exhibits a selection of newspaper articles (JAT3), advertisements (JAT4), a selection of television advertisements from 1997 onwards (JAT5), a pharmacists' information document (JAT6), and a Medicine Control Agency listing detailing the various formulations available (JAT7).

16. The evidence is short of detail on the sales' position in the UK though I note that the press cuttings in JAT3 lend support to the opponents' claim with references such as 'ZOVIRAX ..... has had no significant rival in the 12 years since its launch .....", "one of the 10 most prescribed drugs in the world", and "..... ZOVIRAX is the world's fourth largest selling drug ....." It is highly likely that this reputation extended to the UK. However, it would only be in relation to ZOVIRAX's reputation as a herpes/cold sore treatment. It would not extend to pharmaceutical preparations and substances at large.

Similarity of marks

17. Mr Thomas, on behalf of the opponents, submits that:

> "In addition to classic confusion, there is a risk of imperfect recollection between the marks due to their oral and visual similarity, in particular the ZO- prefix and the -AX suffix which distinguish the Opponents' mark and which are both included in the Applicant's mark. Taking this into account both within the medical community and amongst patients, I believe that there exists a risk of a likelihood of confusion on the part of the public, including a likelihood of association with ZOVIRAX."

18. Katherine Lindsay Gifford Nash of Urquhart-Dykes & Lord, the applicants' attorneys, has filed a witness statement which consists almost exclusively of submissions. Her main points in relation to the respective marks are that they are of unequal length and visually different; that the opponents' mark is a three syllable word with the stress on the second syllable whereas the applicants' mark is a two syllable word with the stress on the first syllable; and that, as both words are invented, there is no conceptual similarity.

19. 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. The opponents' goods are available both on prescription and over the counter. I note that Ms Nash says that the applicants' goods are intended to be only available on prescription. However there is no restriction in their specification reflecting this limitation. I bear in mind too, that it is possible for pharmaceutical products to change status from 'prescription only' to 'over the counter'. The average consumer in these circumstances must be taken to include both medical professionals and the public at large.

20. Visually the marks ZOVIRAX and Zopax have the first two and last two letters in common. They are, as Ms Nash suggests, of unequal overall length. Given the shortness of the word Zopax, the overall appearance is somewhat different.

21. On the basis of the pronunciation of ZOVIRAX in its advertisements contained in the video evidence (JAT5) it seems that it is the second syllable of the word that is stressed. I anticipate that it is the first syllable of Zopax that would be stressed though in the absence of evidence the point cannot be entirely free from doubt. Even allowing for slight variations in pronunciation I find that, whilst there are points of aural similarity, these do not extend to creating overall oral/aural similarity between the marks. Conceptually, neither word has an obvious meaning. They are both invented words but, beyond that, have no point of conceptual similarity. However conceptual considerations are likely to be considerably less important with words of this kind than visual and aural ones.

Likelihood of confusion

22. The opponents have filed a second witness statement by Mr Thomas which addresses the circumstances in which pharmaceutical products are dispensed or used and which in his view should have a bearing on the likelihood of confusion. He exhibits a number of articles published by the British Medical Journal which suggest that stress levels and long working hours contribute to medical errors and that this problem is exacerbated by the use of similar drug names (Exhibits JAT 1 to 4 refer).

23. He also refers to the particular danger arising where one medical professional telephonically instructs another medical professional to provide a particular drug. Added to this he suggests that, because of the reputation enjoyed by his company's ZOVIRAX product, a medical practitioner who was already familiarity with ZOVIRAX, could mistakenly think that ZOPAX was a related product, a look-alike product or imperfectly recollect one product for the other.

24. Mr Thomas speculates on other circumstances that may arise e.g. a single patient or a family being prescribed both parties' products, and the consequences of taking the wrong medication.

25. He also refers to the fact that doctors are said to have notoriously bad handwriting. He exhibits (JAT5) a web-site extract showing confusion between TEQUIN/TEGRETOL and ISORDIL/PLENDIL. The latter has received particular publicity because it resulted in the

death of the patient (further web-site extract at JAT6). Other examples (from the U.S.) Of drug names that have been confused are NARCAN/NORCURON, PITRESSIN/PITOCIN, AMINODARONE/AMRINONE, DEMEROL/ROXANOL, COUMADIN/AVANDIA and NORVASC/NAVANE.

26. Mr Thomas says that computer programmes are now being written to overcome this problem and some doctors are now using voice dictation or typing out prescriptions (articles dealing with these issues are exhibited at JAT7 and 8).

27. Mr Thomas concludes his evidence by submitting that:

> "Even in the absence of actual confusion between the products, I believe that there are sufficient phonetic, visual and conceptual similarities between the ZOPAX and ZOVIRAX marks to lead the prescriber or end-user to conclude that both marks emanate from the same commercial undertaking, or to conclude that the ZOPAX product is produced under licence from, or associated with or otherwise endorsed by my company. This could lead to confusion which includes the risk of association."

28. Many of the points raised by Mr Thomas arose in an earlier case where Glaxo Group Ltd were the opponents (O-199-02) and Class 5 goods were involved. I indicated there that I thought it right to:

> "..... 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.
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> 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."

29. I have considered whether the approach I adopted in the above case still holds good in the light of the evidence now before me. I have concluded that there is insufficient reason for adopting a different view of the matter. It is clear that medication errors are recognised as being a significant problem. It is equally clear that there is no single cause for such errors. I note that one of the British Medical Journal articles (JAT4) talks about medication errors as covering "..... wrong drug, wrong dose, wrong rate of administration, wrong patient, wrong time .....". No doubt similar drug names contribute to the problem on occasions but that is just one of a complex mix of factors that contribute to mistakes being made. It is right to make due allowance for the normal circumstances of trade (as set out above) but I do not think the Trade Mark law should be used to compensate for the wider problems associated with prescribing, drawing up and administering pharmaceutical products. The test I have to consider is whether, having regard to similarities in the marks and goods, there is a likelihood of confusion. Applying that test and taking account of all relevant surrounding circumstances I find that there is no likelihood of confusion here. In reaching that view I have made due allowance for the enhanced degree of distinctive character that the opponents' mark enjoys in relation to the treatment of cold sores and herpes; the notional position in relation to the broader terms employed in the specification of the earlier trade mark; and the possibility of imperfect recollection which is likely to be higher in relation to invented words than dictionary words. The application fails under Section 5(2)(b).

Section 5(4)(a)

30. In practice this ground does not enhance the opponents' position beyond that pertaining in relation to Section 5(2). I have already taken the opponents' use into account in relation to the enhanced distinctive character of their mark. I can see no basis for finding that use of the applicants' mark would be a misrepresentation within the context of the passing off test when I have not found a likelihood of confusion for Section 5(2) purposes.

31. The opposition has failed. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £800. 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 22nd day of October 2002

M REYNOLDS
For the Registrar
the Comptroller-General