

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2247435
IN THE NAME OF BIOVEX LTD**

AND

**IN THE MATTER OF OPPOSITION NO 52184 THERETO
BY NOVARTIS AG**

BACKGROUND

1. On 4th October 2000, Biovex Ltd applied to register the mark ONCOLYSE in Classes 5 and 10 for the following goods:

Class 5:

Pharmaceutical preparations and substances; vaccines; diagnostic preparations, viral preparations.

Class 10:

Diagnostic apparatus; medical testing apparatus; medical apparatus and instruments.

2. The application was published for opposition purposes in the Trade Marks Journal and on 22nd February 2001 Novartis AG filed Notice of Opposition. In summary, the grounds are:

1. The opponent is the registered proprietor of Trade Mark Registration No. 2226928 ONCOLAR, which is an earlier trade mark under the provisions of Section 6(1)(a) of the Trade Marks Act 1994.
2. Application No. 2247435 for the mark ONCOLYSE should be refused, insofar as Class 5 goods are concerned, under the provisions of Section 5(2)(b) of the Trade Marks Act 1994 on the grounds that the marks are similar because of the identity of the ONCOL- component of the marks ONCOLYSE and ONCOLAR, and because of the visual and phonetic similarity of these marks when considered as a whole. In addition, the specification of goods in respect of Trade Mark Registration No. 2226928 ONCOLAR covers goods which are identical with, or similar to, the "*pharmaceutical preparation and substances; vaccines; diagnostic preparations, viral preparations*" in respect of which Trade Mark Application No. 2247435 ONCOLYSE is applied for.
3. The applicant filed a counterstatement admitting the existence of the opponent's earlier registration, but not its validity, and denied all the other grounds.
4. Both sides seek an award of costs.

5. Both sides have filed evidence and agreed that the matter can be decided from the papers. Both sides were provided with the opportunity to file written submissions. The opponent did file such submissions. I have taken these and all the other papers filed in the case into account in reaching the decision which follows.

OPPONENT'S EVIDENCE

6. This comprises two witness statements, together with exhibits, by Dr Colin Duncan, a registered pharmacist, and Jane Harlow, a trade mark agent in the firm of D Young & Co, who act for the opponent.

7. In his witness statement dated 10th September 2001, Dr Duncan says that in 1999 he established a company called DiscDrive to market a software package used to carry out searches against brand names of pharmaceutical preparations in use within the United Kingdom.

8. Dr Duncan states that having carried out a search of his database (results shown as Exhibit CD1) there have been only two medicines on the UK market which contain the prefixes ONCOL- or ONCO- as part of their trade mark, namely "OncoTICE" and "Oncovin". "OncoTICE" is used for the treatment of bladder cancer, whilst "Oncovin" is used to treat leukaemia, malignant lymphomas and certain other cancers. In addition, the product "Onkotrone" is used to treat breast cancer, lymphoma and leukaemia. Dr Duncan concludes by observing that it does not appear that the prefixes ONCO- or ONKO- are used in association with generic brands.

9. In her witness statement of 5th April 2002, Jane Harlow refers to evidence (submitted as Exhibit JH1) which comprises copies of e-mail correspondence between herself and Miss Bronwen Thomas of the Medicine Control Agency (MCA). Miss Thomas confirms that there are three current UK Marketing Authorisations for products whose licensed name contains the prefixes ONCO- or ONKO, namely those identified by Dr Colin Duncan's database search.

10. Ms Harlow explains that the MCA is responsible for regulating the quality, efficacy and safety of human medicines. This is achieved through a system of licensing of medicines. Ms Harlow says that an MCA Marketing Authorisation is normally necessary before medicines can be prescribed or sold. Exhibit JH2 gives details concerning the origins of the MCA and its role in regulating medicines.

11. Ms Harlow points out that it is also possible to obtain a licence for medicines through the European Licensing system, regulated by the European Agency for the Evaluation of Medicinal Products (EMA). Exhibit JH3 provides extracts from EMA's web site, which includes a list of products that have been granted EMA authorisations and none of these products contain the ONCO- or ONKO- prefix. Ms Harlow adds that marketing authorisations that have been granted centrally by EMA are also registered with the MCA and consequently ONCO- or ONKO- prefixed human pharmaceutical products with an EMA Marketing Authorisation would have been revealed by the MCA search.

APPLICANT'S EVIDENCE

12. This consists of a witness statement dated 15th November 2001 by Robert Coffin, Research Director of BioVex Limited, together with exhibits.

13. Mr Coffin says his company chose a trade mark having the prefix ONCO because the allusion ONCO has in his company's field to matters relating to tumours and its appearance in such words as "oncology" meaning the study of tumours. Mr Coffin explains that his company operates in the gene therapy field and intends to use the mark ONCOLYSE in particular for vectors for the treatment of a wide range of tumours. Mr Coffin states that because his company's products are extremely specialised, they will not be easily confused with any other products as they will only be dealt with by extremely knowledgeable people and only used under the most carefully controlled conditions.

14. Mr Coffin says trade marks having the prefix ONCO are extremely common on the Trade Marks Register in Class 5. Exhibit RC1 lists these marks.

15. Mr Coffin refers to the Witness Statement of Dr Colin Duncan (for the opponent). Mr Coffin says two medicines on the UK market have the prefix ONCO as part of their trade mark, namely OncoTICE and ONCOVIN, and in addition there is ONKOTRONE. Mr Coffin observes that all of these trade marks are used for treating cancer and believes that even if these are the only ONCO- products on sale in the UK, this establishes that no one proprietor can have exclusive rights to all trade marks having the prefix ONCO.

16. Mr Coffin says he accepts that Dr Duncan will be adept at searching his own database but ONCO marks are extremely widely used. Mr Coffin refers to exhibit RC2 containing samples of the results of an internet search and concludes that there are vast quantities of materials concerning trade marks having the prefix ONCO for pharmaceutical preparations which are almost invariably used for treating cancer. Whilst he acknowledges that many of these products emanate from the USA, he says that pharmaceuticals are used by major drug companies worldwide and certainly some of the material relates to marks in the UK, for example, ONCOVEX, ONCOLYM and ONCONASE. Mr Coffin says this shows how commonly ONCO marks are chosen for pharmaceutical products and how confusion between them is unlikely.

17. Mr Coffin says he believes that the trade marks ONCOLYSE and ONOCOLAR can be distinguished easily even if considered without taking into account any of the surrounding circumstances. However, taking into account the meaning of the combining form ONCO, the number of trade marks having the prefix ONCO on the register and in use, and the sophisticated nature of the products in question, Mr Coffin says it is inconceivable that the trade marks will be confused.

OPPONENT'S WRITTEN SUBMISSIONS

18. These submissions are provided in a letter dated 20th June 2002 from Ms Harlow of D Young & Co., the opponent's trade mark attorneys. Ms Harlow reiterates that Trade Mark Application No. 22247435 ONCOLYSE should be refused on the ground that the mark is objectionable under the provision of Section 5(2)(b) of the Trades Marks Act 1994 (but only

insofar as it relates to Class 5).

19. Regarding the similarity of the marks, Ms Harlow observes that the opponent's mark begins with the identical ONCOL- prefix and both of the marks ONCOLYSE and ONCOLAR comprise three syllables, the first two being identical. It is a widely accepted principle that the end of a mark is often dropped or slurred in pronunciation and accordingly, the beginnings of marks are considered more important for the purposes of comparison. Account should be taken of the visual, oral and conceptual similarity of the respective marks, together with their overall impression, bearing in mind the distinctive and dominant components. Ms Harlow submits that because the ONCOL prefix is the dominant element of both marks and bearing in mind "imperfect recollection", the respective marks could be confused.

20. Concerning the goods, Mr Harlow says identical goods are covered by the respective marks. The "*pharmaceutical preparations*" specified in the opponent's trade mark registration are identical to the applicant's "*pharmaceutical preparations and substances*". In addition, the item "*pharmaceutical preparations*" also encompasses "*vaccines*" and "*viral preparations*". As regards "*diagnostic preparations*", Ms Harlow says these are likely to be used by the same medical professionals that will eventually prescribe the drugs used to treat disease, and use of a similar mark in respect of those goods could result in confusion.

21. In response to the applicant's statement that it intends to use the trade mark ONCOLYSE in particular for vectors for the treatment of a wide range of solid tumours, and these products are extremely specialised and will not be easily confused with any other products, Ms Harlow says this is irrelevant as the comparison to be made is between the respective marks and the goods specified in respect of them. Furthermore, the claim that marks having the prefix ONCO are commonly registered in Class 5 is also not relevant since it has not been demonstrated that such marks are actually in use within the UK.

22. Ms Harlow refers to the applicant's claim that ONCO prefixed marks are commonly used in respect of pharmaceutical preparations. With regard to the various internet materials, Ms Harlow points out that the applicant admits that many of these products emanate from the USA and are therefore irrelevant. As demonstrated in the opponent's evidence, only three current UK marketing authorisations for products whose licensed name contains the prefixes ONCO- or ONKO have been granted, namely ONCOVIN, ONCOTICE and ONKOTRONE. Accordingly, Ms Harlow says, the other marks revealed by the applicant's internet search cannot be in use in the UK, in the sense that they are not marketed or available for prescription. Ms Harlow observes that each of the marks ONCOVIN, ONCOTICE and ONKOTRONE is clearly less similar to ONCOLAR than is ONCOLYSE. However, she concludes, the use of these marks within the UK is irrelevant because the comparison which has to be made is between ONCOLAR and ONCOLYSE.

DECISION

23. The only ground of opposition is under Section 5(2)(b) of the Act and the relevant part is reproduced as follows:

"5.-(2) A trade mark shall not be registered if because -

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

24. The term "earlier trade mark" is itself defined in Section 6 and the relevant part is reproduced as follows:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,"

25. I am satisfied that the opponent's trade mark is an earlier right on the basis of the above and go on to consider matters against 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.

26. The applicant's and the opponent's marks and specifications are set out below for ease of reference:

| | Applicant | Opponent |
|--------------|--|-----------------------------------|
| Marks | ONCOLYSE | ONCOLAR |
| Goods | Cl 5: Pharmaceutical preparations and substances; vaccines; diagnostic preparations, viral preparations. | Cl 5: Pharmaceutical preparations |

Comparison of the goods

27. I consider that the goods covered by the respective specifications are identical except for “diagnostic preparations” in the applicant’s specification, which although being goods of a similar nature to pharmaceuticals, and sharing similar channels of trade, have different uses and only a limited overlap of users. These goods therefore share some similarity to pharmaceuticals but are not identical goods.

Who is the average consumer for pharmaceuticals?

28. In assessing whether the degree of similarity between the respective marks is sufficient to give rise to a likelihood of confusion it is necessary to consider who the average consumer is.

29. Neither party has adduced any evidence showing use of their marks. The applicant states that its goods are to be used in particular for vectors for the treatment of a wide range of tumours, although the specification has not been so limited. It is difficult to imagine the applicant’s mark being used in relation to pharmaceuticals that are not connected with the

identification, prevention or treatment of tumours. I therefore intend to determine the matter on this basis. I will return to the matter of the wider scope of the applicant's specification later.

30. Insofar as goods for the identification, prevention and treatment of tumours is concerned, the average consumer is likely to be a medical professional. I believe that the involvement of a medical professional is at least sufficient to avoid any greater likelihood of confusion between prescription drugs than would be the case for over-the-counter products.

Comparison of the marks

31. In her analysis of the marks Ms Harlow, for the opponent, says that both ONCOLYSE and ONCOLAR comprise three syllables, the first two being identical. Ms Harlow goes on to conclude that because, in her view, the ONCOL prefix is the dominant element of both marks and bearing in mind imperfect recollection and the visual, phonetic and semantic similarities of the marks when considered as wholes, the respective marks could be confused.

32. Mr Coffin views ONCOLYSE as having the prefix ONCO and says this was chosen because of its allusion to matters relating to tumours and its use in such words as "oncology", meaning the study of tumours.

33. Both sides refer to other marks which contain the prefixes ONCO and ONKO. The opponent says there have only been two medicines on the UK market which contain the prefixes ONCO, namely "OncoTICE" and "Oncovin", whereas the applicant urges me to consider the presence of the many marks on the register and on internet web sites which include the prefix ONCO.

34. The "state of the register" evidence suggests that ONCO is a relatively common feature in registered trade marks. However, in the absence of any specific evidence as to the use of these marks, I find this information to be of little assistance for the reasons set out by Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281.

35. The opponent's evidence does establish that there are already two pharmaceutical products on the UK market, both used for the treatment of tumours, which have the prefix ONCO-. I do not find this surprising because, as the applicant, points out, ONCO is not an arbitrary prefix but the beginning of the descriptive word "oncology." I therefore regard this prefix as having a very little distinctive character for drugs used in the treatment of tumours.

36. The opponent argues that ONCOL- should be viewed as the prefix of the respective marks. In my view, it is equally likely that the marks will be pronounced as ON-CO- LEES (or LIES) and ON-CO-LAR, as it is that they will be pronounced ONCOL-EES (or IES) and ONCOL-AR. However, given that the prefix ONCOL- accounts for even more of the descriptive word "oncology", I do not believe that much turns on the preferred pronunciation of the marks. In my judgement the average consumer is likely to understand either of these prefixes as an indication that the goods supplied under the marks are for use in the identification, prevention or treatment of tumours. Accepting the opponent's contention

about the extent to which the marks share a common prefix does not therefore increase the

distinctive similarity between them: in this connection, see the decision of Mr G Hobbs QC as Appointed Person in *Torre-mar* BL/0/207/02

37. This conclusion does not mean that the prefix of the respective marks can be excluded altogether for the purposes of comparison. It is well established that the average consumer compares marks as wholes. However, in comparing the marks as wholes it is appropriate to attach more weight to distinctive similarities and less weight to non-distinctive similarities. The suffix of the respective marks do not appear to be descriptive, and are quite different. This gives the marks as wholes a distinctively different look and sound.

Likelihood of Confusion

38. Millett L J stated in the case of *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283 at 288:

“Similarity is a matter of degree; and except in the case where there is absolutely no similarity at all between sign and mark (which is not this case) the question is whether the similarity is such as to be likely to cause confusion in the mind of the public. A degree of similarity is tolerable, the question is whether there is a confusing similarity.”

and at 290 he went on to observe:

“The more descriptive and the less distinctive the major feature of the mark, the less the likelihood of confusion.”

39. In these circumstances it appears to me that the degree of similarity between ONCOLYSE and ONCOLAR is insufficient to result in a likelihood of confusion on the part of the average consumer, even if both marks are used in relation to goods for the identification, prevention and treatment of tumours.

Unlimited Nature of Applicant’s Specification

40. Thus far I have been prepared to assume that the applicant’s mark will be used in respect of the goods for the identification, prevention and treatment of tumours. As will be clear from the reasoning set out above, the descriptive nature of the prefix ONCO(L)- in relation to such goods, played a decisive part in my conclusion that there exists no likelihood of confusion. However, as I noted earlier, the applicant’s specification is not currently limited to these goods.

41. The Registrar is bound by Article 13 of Directive EC/104/89, which obliges competent authorities to grant protection to a trade mark in respect of goods where no grounds for refusal exist. I have indicated in paragraph 40 above the extent to which I find that the trade mark is free from objection.

42. I will allow the applicant **14 days** from the date of this decision to submit a Form TM21 with a revised specification taking account of this decision. The simplest way of complying with the decision will be to add a suitable limitation to the end of the applicant’s existing

specification, but it is not for me to re-write the applicant's specification. I direct the applicant to send the opponent a copy of any Form TM21 it decides to file. The opponent will have the same period of time, commencing from the date of its receipt of the Form TM21, to file any written comments that it wishes on the revised specification.

43. If the specification is not amended so as to comply with this decision, the application will be refused in full.

COSTS

44. If the specification is revised, I will allow the parties 14 days to file written submissions on the question of how costs should be apportioned. If the application is refused in full because the applicant does not limit its specification so as to comply with this decision, the opposition will have succeeded and costs will follow the event. In either case, I will issue a subsequent Order dealing specifically with the costs of this opposition.

Dated this 11th day of November 2002

**Allan James
For the Registrar**