DECISION OF THE TRADE MARKS REGISTRY

TRADE MARKS ACT 1994

APPLICANT: SPECIAL PRODUCTS LIMITED

APPLICATION No. 2286676

CLASS 5

AND

OPPONENTS: AMERICAN HOME PRODUCTS CORPORATION

OPPOSITION No. 90483

EPISTAT

BACKGROUND

Trade Mark in issue

1. On 27th November 2001 Special Products Limited of Special Products Limited of Orion House, 49 High Street, Addlestone, Surrey, KT15 1TU Great Britain applied to register the mark EPISTAT.

Specification of goods

2. Registration is sought in respect of:

> Class 5: Pharmaceuticals for the treatment of epilepsy.

History

3. The registration is opposed by the American Home Products Corporation. There is only one ground of opposition, that under s. 5(2)(b). The opponents are the proprietors of registration No. 2270483, in respect of 'Pharmaceutical preparations', applied for on 18th May 2001, for the mark EPTISET.

4. The ground is denied by the applicants. Both sides seek an award of costs.

HEARING

5. At the conclusion of the evidential stages of this opposition, the parties were notified that an oral hearing was unnecessary. The parties agreed, but provided written submissions, which I refer to in the body of this decision.

EVIDENCE

Opponents' evidence in chief

6. This consists of a witness statement by Ms. Penelope Ann Nicholls, of the opponents' legal representatives D. Young & Co. This amounts to no more than a certified copy of the opponents' registration details for mark No. 2270483, EPTISET.

Applicants' evidence

7. A witness statement is provided by Mr. Graham Alan March, the applicants' Technical Director. He states that he has searched for any reference to a pharmaceutical product being sold under the applicants' mark, and adds:

> "3. I looked in the March 2002 Edition (43rd) of the British National Formulary and could not find EPTISET listed. It is not therefore a medicinal product or a medicinal foodstuff (gluten-free bread etc) licensed in the UK.
>
> 4. I looked in the latest (33rd Edition) of The Martindale Complete Drug Reference and could find no reference to EPTISET. That book lists all the licensed medicinal products worldwide.

5. I contacted the Medicines Information Department of Great Ormond Street Hospital and they did an on-line search of MEDEX. That is a data base of medicinal products and diseases. Again, no reference to EPTISET could be found.

6. I searched for EPTISET on the internet using the Yahoo, AOL, MSL and Ask Jeeves search engines. No reference could be found. It may, however, be sold as an unlicensed medicine. Those medicines cannot be advertised and, consequently, are not listed in medicinal reference books.

7. I concluded that EPTISET is not licensed as a medicinal product anywhere in the world.

8. EPISTAT, on the other hand, is in actual use in the United Kingdom as a trade mark for a product containing Midazolam which is used to prevent epileptic fits progressing into a single epileptic fit or series of fits that continue for 30 minutes or more. That condition is associated with high morbidity and mortality. EPISTAT is a highly specific treatment that is to be administered to a patient five minutes after the start of an epileptic fit to prevent that fit continuing. I should explain that it is not given earlier because it is highly sedative and its administration may not be necessary since about three-quarters of all epileptic fits cease naturally after about five minutes. Of those that continue longer than 5 minutes, 96% progress to *status epilepticus*. EPISTAT has been on the market in the UK since July 2002. It has gained very rapid acceptance since it is effective within 6-10 minutes (well before any serious brain damage occurs) and is easy to administer. It is currently sold as an unlicensed medicine at the request of Alder Hey Hospital and Great Ormond Street Hospital. However, a joint venture is in place with the Institute of Child Health (The London University academic arm of Great Ormond Street Hospital) with a view to carrying out the clinical trials necessary to obtain product licences for EPISTAT in the UK, France and Germany.

9. There has been no actual confusion with EPTISET or with any registered or generic pharmaceutical product. Doubtless this is because the current licensed treatment is 'STESOLID' (Diazepam 10 mg rectal tubes). One of the reasons for the success of EPISTAT is that it is administered intrabuccally (between the gums and cheek) whereas the rectal tubes necessitate undressing the patient, who may be kicking violently and in a public place.

10.Because EPISTAT has its strong sedative property it will not be sold as a general sales list medicine (GSL) and there is no chance that the public could buy this instead of EPTISET (if the latter were to be available) by mistake. On the contrary, EPISTAT will be prescribed initially by a hospital consultant and then dispensed from the hospital pharmacy. The family GP and local retail pharmacy will then continue the care until the next review, as they do with STESOLID, which is also highly sedative and, therefore, a prescription only product (POM)."

Opponents' evidence in reply

8. A further witness statement from Ms. Angela Claire Thornton-Jackson, also of the opponents' legal representatives. Ms. Thorton-Jackson makes the following comments about the applicants' evidence:

"a) The Witness Statement of Graham Alan March, dated 11 September 2002, refers at paragraphs 3 - 7 of his enquiries to discover whether the trade mark EPTISET is in use in the United Kingdom. At paragraphs 8 - 10, he details the way in which the trade mark EPISTAT is used in the United Kingdom.

However, it is my submission that the manner of use of the trade mark EPISTAT and the lack of use of the trade mark EPTISET (according to Mr March's enquiries) is, in fact, irrelevant to the present opposition proceedings. UK trade mark registration number 2270483 EPTISET is registered in respect of pharmaceutical preparations at large and, accordingly, the Registry is obliged to take into account potential use of the trade mark in relation to pharmaceutical preparations for all applications, including pharmaceuticals for the treatment of epilepsy.

b) On this basis, it is admitted that confusion between the trade marks EPTISET and EPISTAT is highly likely, particularly if both trade marks were to be used on identical goods, even where these are administered by healthcare professionals. Both trade marks are invented terms, which increases the likelihood of imperfect recollection when calling the marks to mind. For this reason, the minor differences between the trade marks would be insufficient to avoid a likelihood of confusion.

c) The Registrar is obliged to consider normal and fair use of each trade mark in respect of all the goods and services for which they are registered. This would necessarily include considering use of UK trade mark registration number 2270483 EPTISET in connection with pharmaceuticals for the treatment of epilepsy. The Applicant's evidence that the trade mark EPTISET is currently not in use according to their enquiries is therefore irrelevant for this purpose."

Written submissions

9. These appear in two letters from the parties representatives. The opponents' submissions, as set out in a letter dated 28th March 2003, dismiss the applicants' 'state of the register' evidence (which accompanied their Counterstatement) as it fails '.. to show that any of the marks cited are in actual use'. For this reason I do likewise.

10. The opponents also refer to the same case law as is cited at paragraph 14 below. They add the following quotation from a decision of the Appointed Person, *OROPRAM* (BL O/20802):

"24. In the applicants' own admission the prefix of OROPRAM suggests oral delivery. That coupled with the degree of similarity in the marks, the identity of the goods and the high distinctiveness of SEROPRAM, leads me to conclude that the average consumer is likely to consider that "medicine and medicinal products intended for human therapy" offered under the mark OROPRAM originate from the opponents or an undertaking economically linked to the opponents in the sense that they are different products in the same range (*Wagamama Ltd v. City Centre Restaurants plc* [1995] FSR 713). Thus contrary to the view of the hearing officer, I believe that the opposition case under section 5(2)(b) of the TMA is made out.

25. I have arrived at this view without engaging in the debate whether a higher or lower threshold needs to be reached before confusion can be established in conflicts between

pharmaceutical trade marks. For my own part, I do not believe that different standards exist or are necessary to exist. The test of likelihood of confusion is flexible enough to allow each case to be judged according to its own peculiar facts. Relevant considerations may include those mentioned by the First Board of Appeal in *TEMPOVATE/EMOVATE, EUMOVATE*, *supra*, namely that some medicinal products are administered over the counter without prescriptions, some consumers resort to self prescription and professionals are often overworked and may write prescriptions in hardly legible handwriting (although drugs may be prescription only, professionals may be on hand to assist choice with OTC products and pharmacists usually check illegible prescriptions)."

11. They also refer to visual, phonetic and semantic similarities between the marks; I consider their comments below. Finally, they state:

> "Notwithstanding that some of the people currently handling the drug will be medical professionals, others, such as those involved in the distribution chain, the hospital dispensary, administration and accounts staff and patients themselves will not be medically qualified. Although it is accepted that the drugs are likely to be dispensed by prescription (though of course there is no such restriction in the specifications of goods) it is perfectly possible that if the range is extended and regulations relaxed, such drugs could be bought in the future by patients direct. Accordingly the relevant public (and the appropriate standard of care to be attributed to those using the marks) will not necessarily be restricted to those in the medical profession. The Opponent further submits that, whilst accepting the observations of Prof. Annand cited above, it is to be remembered that the consequences of prescribing the wrong drug to a patient may be rather more serious than selecting the wrong product from the supermarket shelf."

12. The applicants' submissions appear in a letter from Ms. Sofia Arenal of Mewburn Ellis. This refers to the same case law as that of the opponents. However, the letter also contains much evidence, not argument which, at this stage in the proceeding, absent any request for its admission, I must ignore. However, Ms. Arenal then states:

> "The opponent has submitted (at 3. i of the statement of grounds) that there is a tendency in speech for the ending of words to be slurred. In this way they seek to gloss over the significant differences in the suffixes of each mark i.e., 'SET' as opposed to 'STAT'. Since both the marks in question are relatively short, it is artificial to dismiss the second half of each mark when comparing whether they are confusingly similar. Furthermore, the opponent's emphasis on possible slurring of the end of the marks is perhaps a tactic to avoid drawing attention to the fact that their mark has a very unusual prefix 'EPTI' which is not very easy to pronounce, and would therefore cause someone to take more care than usual when trying to say, write or read their mark EPTISET, which is an awkward word and quite different from the trade mark EPISTAT which flows much more easily.
>
> Dr March's witness statement in support of the application is made by one experienced in the field (note his name appears on the attached product literature), while both of the statements made on behalf of the opponents have been by trade mark attorneys. While they may be excellent trade mark attorneys they do not claim to have particular knowledge of healthcare in general nor specifically of epilepsy treatments.

It is significant that no challenge has been made by the opponent to the applicant's use of the mark in the UK: no doubt this is a) because the opponent has shown no evidence of proprietary interest (under any mark) in the treatment of epilepsy and b) because it realises that such a challenge would fail in law.

Furthermore it is clear from the evidence that the 'fair and normal use' referred to in the opponent's witness's statement does not, in the present case, include any use in a field of treatment in which there could be any real risk of confusion on the part of 'healthcare professionals' even if the marks were similar - which they are not."

LAW

13. The relevant section of the Act is:

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

APPLICATION OF THE LAW: s. 5(2)(b)

14. The case law relevant to s. 5(2)(b) has been set out recently in several decisions of the European Court of Justice (ECJ), in particular: *Sabel BV v Puma AG* [1998] ETMR 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* Inc [1999] ETMR 1 and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77, and can be summarised as follows:

> (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel*, paragraph 22;
>
> (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV*, 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*, paragraph 27;
>
> (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel*, 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*, 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*, 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*, 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*, 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*, 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*, paragraph 29.

Comparison of goods

15. The opponents state that the applicants goods, 'Pharmaceuticals for the treatment of epilepsy' are subsumed by their own specification of 'Pharmaceutical preparations', and they are right. It is established law that I must only consider the goods as they are set out in the registration, that is, I must assume notional and fair use of the respective marks for the goods/services within the full width of the registered mark's specification (see *Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280). The Registrar will compare mark against mark and specification against specification, and that is what I must consider here.

16. In fact, I do not believe that the applicants themselves resile from this view, though they argue that confusion is unlikely for reasons other than the similarity of the goods (see below).

17. In summary, despite the very specific nature of the applicants' goods, I consider the goods at issue identical. In other words, I must treat the marks - the opponents' as well - as if they both appear on drugs for the treatment of epileptic fits.

The similarity of the marks

18. There are similarities between the marks: as the opponents point out in their written submissions visually the marks each begin with the letters EP, there is a central I and there are the S and T vowel combinations at the end of each mark. The applicants stress the 'significant' differences in the suffixes, i.e. 'SET' as opposed to 'STAT'. Ms. Arenal points out that both the marks are relatively short, and this '..it is artificial to dismiss the second half of each mark when comparing whether they are confusingly similar'.

19. Conceptually, there is no obvious connection between the marks: both are 'made up'. One might suggest that the applicants EPI- prefix refers to 'epilepsy', but if it does, this signification is not shared by the opponents' mark. The opponents do refer to 'semantic similarities' between the two marks which, in their view, will lead the relevant public into believing that the drugs emanate from the same stable. They do not explain what these similarities are, nor why they should have this effect. They then (with some degree of contradiction) add:

> "The likelihood of confusion is further aggravated due to the fact that both of respective trade marks are invented terms with no obvious meaning. Hence, there is an increased likelihood of imperfect recollection when calling the mark to mind, as there is no conceptual tag by which to identify the marks. Furthermore by its invented nature the EPTISET mark is inherently distinctive, and this factor should be taken into account when assessing the overall likelihood of confusion."

20. Orally there is a difference between the marks, in that the opponents' mark would tend to be pronounced as 'EP-TE-SET'. While the applicants' is 'EP-E-STAT'. Thus both contain three syllables. The opponents suggest that 'EP-E' and 'EP-TE' are phonetically similar. And they refer to the tendency in speech for the endings of words to be slurred. Ms. Arenal's view is as follows:

> "..the opponent's emphasis on possible slurring of the end of the marks is perhaps a tactic to avoid drawing attention to the fact that their mark has a very unusual prefix 'EPTI' which is not very easy to pronounce, and would therefore cause someone to take more care than usual when trying to say, write or read their mark EPTISET, which is an awkward word and quite different from the trade mark EPISTAT which flows much more easily."

Seeing that the opponents' contention has been 'received wisdom' in trade mark case law for many years (*London Lubricants (1920) Limited's Application* (1925) 42 RPC 264 at page 279, lines 36-40, where it is stated: '.. the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and, in my judgment, the first syllable of a word is, as a rule, far the most important for the purpose of distinction'), I can't accept that the opponents' view amounts to no more than a 'tactic'. However, I have not ignored the Ms. Arenal's submission: I was myself forced to make some momentary study of the opponents' mark so as to determine its pronunciation. Certainly, the applicants' mark was easier to articulate on first encounter.

21. In summary, I must conclude that the marks are similar. In particular, I find them visually close enough to require some focus of attention to determine the differences between them.

Distinctive Character

22. It is now well established that a mark possessive of a highly distinctive character enjoys greater protection than one that does not (see point (f), above). As *Sabel* makes clear, this benefit can arise from nature or notoriety, that is, a mark with a substantial inherent capacity to distinguish, or one that is well known in the marketplace. The opponents' mark is not descriptive, and has, in my view, a significant inherent capacity to distinguish. They have not shown, however, that their mark is distinctive on the marketplace.

DECISION

23. I have determined that the goods at issue are identical and the marks similar. In many situations this might be enough to find for the opponents under s. 5(2)(b), particularly as a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods (*Sabel*, paragraph 23) . However, the case law counsels that a likelihood a confusion must be appreciated globally, 'taking account of the all the relevant factors' (*Sabel*, paragraph 22). And one of the most significant of these, in this case, is the circumstances surrounding administration of the drugs at issue.

24. The applicants, mainly in Mr. March's witness statement, argue that the field of medicine in which their product is used is so specialised that confusion in unlikely, principally when the procurement process for these drugs, and the active role of the medical administering professional, is considered. He states:

> "10. Because EPISTAT has its strong sedative property it will not be sold as a general sales list medicine (GSL) and there is no chance that the public could buy this instead of EPTISET (if the latter were to be available) by mistake. On the contrary, EPISTAT will be prescribed initially by a hospital consultant and then dispensed from the hospital pharmacy. The family GP and local retail pharmacy will then continue the care until the next review…"

25. In other words, the participation of the medical professional at every stage of the process whereby the drug reaches the patient would mitigate against confusion. However, the opponents make the following point:

> "Notwithstanding that some of the people currently handling the drug will be medical professionals, others, such as those involved in the distribution chain, the hospital dispensary, administration and accounts staff and patients themselves will not be medically qualified. Although it is accepted that the drugs are likely to be dispensed by prescription (though of course there is no such restriction in the specifications of goods) it is perfectly possible that if the range is extended and regulations relaxed, such drugs could be bought in the future by patients direct. Accordingly the relevant public (and the appropriate standard of care to be attributed to those using the marks) will not necessarily be restricted to those in the medical profession".

26. I find it hard to believe that a treatment for the acute symptoms of epilepsy would ever be purchased by patients directly. However, I do not believe that the applicants' evidence precludes completely the role of non-medical professionals in the administration process in the manner in which was so self evident in my own *PROLINID* (BL O/428/00) decision. Further, the applicants' submissions fail to address the confusion that might arise as a consequence of the public believing that the respective goods come from the same or economically linked undertakings (*Canon*, paragraph 29). The opponents' specification does not exclude pharmaceuticals that are similar to the applicants products, for example, that might be used as less dramatic treatments of epilepsy. The likelihood exists here, in my view, that the products might be considered to originate from the 'same stable'.

27. I have found the visual similarities between the marks to be very striking. The length of the marks is identical, and so (nearly) are the letters (but for the A and E). On this basis they are not easily distinguished. Taking this together with the similar or identical nature of the products at issue, I find that there is a likelihood of confusion between the marks, and the opposition succeeds.

COSTS

28. The opponents have succeeded, and are entitled to an award of costs. I order the applicants to pay them £1100. This 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 24 Day of April 2003

Dr W J Trott
Principal Hearing Officer
For the Registrar.