

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 705950
BY MEDSYM ARZTESERVICE INFORMATIONS – UND
VERANSTALTUNGSDIENST GMBH
TO REGISTER A TRADE MARK IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 70281
BY ASTA MEDICA AKTIENGESELLSCHAFT**

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**IN THE MATTER OF Application No. 705950
by Medsym Arzteservice Information – und
Veranstaltungsdienst GmbH to register a
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**IN THE MATTER OF Opposition thereto
under No. 70281
by Asta Medica Aktiengesellschaft**

BACKGROUND

1. On 30 November 1998 Medsym Arzteservice Information – und Veranstaltungsdienst GMBH (Medsym) applied to protect the trade mark Pulmojet in Class 5 of the register under the provisions of the Madrid Protocol on the basis of registration in Germany, for the following specification of goods:

“Medicines for inhalation purposes”.

2. The application was subsequently published in the Trade Marks Journal and on 5 April 2000 Asta Medica Aktiengesellschaft (Asta) filed Notice of Opposition against the application on the following grounds (as subsequently amended):

(i) Under Section 5(2)(a) of the Act because the mark is identical to the following earlier international trade mark owned by the opponent which is registered for similar goods and there exists a likelihood of confusion on the part of the public –

NO.	MARK	SEARCH SIGNIFICANT DATE	GOODS
699045	PULMOJET	29 January 1998 (International Priority Claim Date)	Class 10: Surgical, medical and dental apparatus and instruments

(ii) Under Section 3(6) of the Act because the application was made in bad faith as the applicant knew that use and registration of the mark in suit by the applicant would be likely to cause confusion and prejudice Asta’s legitimate business interests. Furthermore, under this ground the opponent claims that the applicant has no intention to use the mark applied for due to the nature of the applicant’s business which the opponent states, is in the field of business consulting and marketing.

3. The applicant filed a Counterstatement, denying the above grounds, stating that the written forms of the mark are different and that the respective goods are not similar. Furthermore, the applicant denied the bad faith ground and stated that the intention is to use the mark for medicines for inhalation purposes.

4. Both parties filed evidence and asked for an award of costs in their favour. Neither party requested a hearing.

Opponent's evidence

5. This consists of two witness statements, one each from Elizabeth Mary Cratchley and Ulrike Lindenfeld – Stober dated 5 January 2001 and 2 January 2001 respectively.

6. Ms Cratchley is the Patent and Trade Mark Attorney who was handling this opposition on behalf of the opponent.

7. In relation to the applicant's submission that PULMOJET is not identical to Pulmojet since the written forms are different, Ms Cratchley states that it has been the practice in the UK, at least during the last thirty years, to regard trade marks in capital letters as being identical with the same word having the initial letter only capitalised. In support, Ms Cratchley refers to the case of *Betty's Kitchen Coronation Street Trade Mark* [2000] RPC at page 840 where it is stated at line 49 that "normal and fair use of a mark can, of course, include variation in presentation such as different typefaces". She adds that the two marks are also spelled the same way and pronounced the same way.

8. Ms Lindenfeld-Stober is a trade marks paralegal of Asta (the opponent).

9. Ms Lindenfeld-Stober submits that there is a high risk of confusion between the goods of the application and the goods covered by the opponent's registration since both kinds of goods can be commercialised through the same trade channels and directed to the same consumer groups. She states that inhalers for administering pharmaceutical substances fall within the opponent's specification of goods and adds that if the identical trade mark is used on inhalers and on medicines for inhalation purposes, there will be confusion to the public who may well believe that the Pulmojet inhalation medicines are manufactured by the same company that makes the PULMOJET inhalers.

10. Ms Lindenfeld-Stober goes on to state that in 1998 ASTA noticed the publication of MEDSYM's application for Pulmojet in Germany in Classes 5 and 10 and wrote to them on 17 August 1998 asking them to withdraw their application and in their reply of 19 September 1998 Medsym's attorneys responded that Medsym were willing to renounce their trade mark for goods in Class 10 but as to the goods in Class 5 they argued that the goods would not be regarded as similar to the opponent's goods in Class 10. She explains that ASTA Medica refused Medsym's proposal for co-existence and on 21 October 1998 ASTA Medica filed opposition to Medsym's German application in Classes 5 and 10 on the basis of ASTA Medica's German registration in Class 10. Ms Lindenfeld-Stober states the opposition is still pending. She adds that it can

therefore be seen that well before 30 November 1998, the date of their international registration, Medsym were aware of ASTA Medica's International Registration for PULMOJET.

11. Next, Ms Lindenfeld-Stober points out that ASTA also opposed Medsym's International Registration in Sweden on the basis of IR No. 699045 and she adds that this resulted in total refusal of the Medsym International Registration in Sweden.

12. Ms Lindenfeld-Stober notes that from Medsym's counterstatement that Medsym have an intention to use their mark for medicine for inhalation purposes by licensing the mark to third parties. The opponent regards this as being highly dangerous since to inhale a medicine which was not prescribed would be detrimental to health.

Applicant's evidence

13. The applicant's evidence comprises two witness statements, one each by James Garnet Morgan and Christian Schmidt, both dated 6 April 2001.

14. Mr Morgan is a trade mark and patent attorney who is acting for the applicant in these proceedings.

15. In relation to Ms Cratchley's comments on whether the marks Pulmojet and PULMOJET are identical, Mr Morgan states that the use of small case letters and large case letters does not seem to amount to the use of different typefaces but he adds that the applicant is happy to abide by the Registrar's decision in *Betty's Kitchen Coronation Street Mark* (2000) RPC, page 840, line 49.

16. Turning to the proceedings before the German Patent Office on the opposition to Asta's application to register Plumojet in Classes 5 and 21 in Germany in the face of Medsym's registration in Class 10, Mr Morgan points out that the German Office found that there was no danger of confusion and a copy of the decision of the German Patent Office of January 5 2001 is at Exhibit JGM to Mr Morgan's statement. Mr Morgan goes on to state that, accordingly there can be no question of Medsym having acted in bad faith by lodging their application for international registration 705950.

17. Going to Asta's opposition Medsym's mark in Sweden, Mr Morgan states that the refusal of Medsym's application is only a provisional refusal which Medsym is disputing.

18. Mr Schmidt is a German patent attorney acting for the applicant in these proceedings.

19. Mr Schmidt explains that Medsym is a company providing services to other firms working in the pharmaceutical field and that one such firm, with which Medsym has particularly close relationships is GGU Gesellschaft fur Gesundheits-und Umweltforschung GmbH (GCV) with offices in Frankfurt and Munich, Germany. The aforesaid services comprise administrative work, such as salary and wage administration, administration of financial services and trade mark administration. These are services which the companies served by Medsym, such as GGU, prefer to outsource so that they can concentrate on their core business. GGU, for example, works in the fields of marketing, product development and testing of pharmaceutical products.

Mr Schmidt continues by stating that GGU in turn also offer their services and products to a variety of companies active in the pharmaceutical field such as the companies Mundipharma GmbH, Limburg, Germany, Dr Willmar Schwabe Arzneimittel GmbH, Karlsruhe, Germany and Dr August Wolff GmbH & Co Bielefeld, Germany.

20. Mr Schmidt explains that the intention in the present case is to use the Pulmojet name for a variety of medicines for inhalation purposes. The intention is for the actual product name to consist of the word element “Pulmojet” together with a description of the specific medicine or a specific trade mark designating such specific medicine. The specific medicines which will be marketed in association with the name “Pulmojet” – subject to the trade mark dispute with Asta Medica AG being satisfactory resolved – will all be medicines which have been approved by the relevant authorities and which are manufactured by or under license from the pharmaceutical companies with which Medsym is associated, such as Mundipharma and which are manufactured by or under licence from pharmaceutical companies such as those listed above. Furthermore it is noted that GGU itself manufactures pharmaceutical products for their own purposes and/or for third parties, such as the pharmaceutical companies named above.

21. Next, Mr Schmidt states that the medicines referred to in Section 5 above are only available by prescription. He adds that a medical practitioner issuing a prescription for any of the intended medicines will thus specify the product by a name involving the name element “Pulmojet” and a name relating to the specific medicine involved. Simply for this reason there will be a clear distinction in use between the “Pulmojet” medicines in Class 5 intended to be sold by or on behalf of the partner companies of Medsym, or their licensees, and the goods in Class 10 such as those covered by the trade mark registration of the opponents.

22. Mr Schmidt confirms that the German Patent Office’s decision on the opposition by Asta Medica AG to Medsym’s German trade mark 398 30 356, the German Patent Office has concluded that there is no danger of confusion between medicines in Class 5 and goods in Class 10. He concurs with this view. Mr Schmidt adds that this is particularly so since, as explained above, the name Pulmojet will always be used with a supplementary accepted designation of the precise medicine involved which will further ensure that instances of confusion do not arise. He goes on to state that medicines available on prescription can only be supplied by authorised dispensing chemists who will be well aware that the name Pulmojet is used with a range of different medicines and will thus always look carefully at the complete name before dispensing a particular product to a customer and since medical apparatus such as inhalers are also issued by dispensing chemists on prescription, a danger of confusion does not exist even if an inhaler is marketed by a third party under the name PULMOJET since the dispensing chemist will be well aware that the inhaler with the name PULMOJET is one thing and the medicines involved are another and must be identified by Pulmojet together with an additional designation of the specific medicine.

23. This completes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

24. Firstly, I go to the ground of opposition based upon Section 5(2) of the Act which 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.”

25. An earlier right is defined in Section 6, the relevant parts of which state:

“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,”

26. The applicant contends that the respective marks of the applicant and opponent are not identical because the mark in suit is presented with a capitalised letter P and the remainder in small case, ie. Pulmojet, whereas the opponents registration is presented in upper case ie. PULMOJET. The applicant has drawn attention to the case of *Betty's Kitchen Coronation Street* Mark [2000] RPC, page 840 line 49 where it is stated by the Registrar's Hearing Officer that:

“normal and fair use of a mark can, of course, include variation in presentation such as different typefaces

27. However, in the above comments of the Hearing Officer were made in the consideration of normal and fair use of a mark and not the issue of identity of marks under Section 5.

28. If I find that the respective marks are identical the relevant Section 5 ground is Section 5(2)(a). However, if they are not, this opens up the prospect of Section 5(2)(b).

29. The issue as to whether marks are identical or similar was considered in opposition No. 44755 by The Baywatch Production Company to an application for the word BAYWATCH by Mr Gananath Wimalal Ediriwira; 0-051-01. In fact the applicant's mark was the word BAYWATCH represented in what the Appointed Person on appeal described as capital letters in different sizes. The Registry's Hearing Officer had held that the fact that one of the marks was

presented in upper or lower case or a combination of both will not normally have a bearing on whether the marks are identical. The Appointed Person on appeal took a different view. He said:

“I am not satisfied that the marks are identical. I think it is important in the context of section 5(2) that the word “identical” is given its normal English meaning, since under section 5(2)(a), if the trade mark used is identical and is used in relation to identical goods or services, an absolute monopoly is granted. Just as there is an important distinction between anticipation and obviousness in patent law, so also there is an important distinction between identity and similarity for trade mark law. Here there is a plain difference. The earlier registered mark consists solely of capital letters in the same size. The mark opposed consists of capitals in different sizes. They are therefore not identical.”

30. Turning to the marks before me in the present case, they consist of the identical word presented in a straightforward manner, without any stylization present. While the BAYWATCH decision, mentioned above, takes a strict approach, the actual position in relation to the respective marks in that case and the respective marks in the present case differs. In the BAYWATCH case the applicant’s mark was presented as capital letters in differing sizes. It seems to me that such presentation of a word is unusual and to some (if slight) degree stylized, whereas in the present case both representations of the word PULMOJET are totally straightforward and readily/obviously interchangeable. In effect, I believe the registration of PULMOJET or Pulmojet would grant the exact, same monopoly in that word.

31. In my view PULMOJET and Pulmojet comprise identical trade marks and opposition under Section 5(2)(a) of the Act as opposed to Section 5(2)(b) is appropriate. I would add that, if I am wrong and the marks are not identical, the respective marks must be extremely closely similar on a visual basis, identical in oral use and conceptually identical.

32. In approaching my decision I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;

- (c) 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;
- (d) 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;
- (e) account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*, paragraph 29.
- (f) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, page 224;
- (g) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 333, paragraph 29.

33. As the marks are identical and fully distinctive in relation to the relevant goods, the test is whether there are similarities in goods which would create a likelihood of confusion. This involves a consideration of the category of goods in question, how they are marketed and the customer for the goods.

34. There is no evidence that either the applicant's or opponent's mark has been used in the UK prior to the relevant date. Accordingly, I must limit my comparisons to assume normal and fair use on all goods covered within the respective specifications.

35. In order to assess the similarity of the goods and services, I note the factors set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RP(C) 281 at page 296. Adapted to the instant case, it can be stated as:

- a) the uses of the respective goods;
- b) the users of the respective goods;
- c) the physical nature of the goods;
- d) the trade channels through which the goods reach the market;
- e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and

- f) the extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

36. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

37. The opponent submits that as their specification of goods includes medical apparatus, which encompasses inhalers, and as applicant’s goods comprise “medicines for inhalation purposes” there is a high risk of confusion.

38. Turning firstly to the uses of the respective goods, medicines for inhalation purposes are essentially substances used to treat or alleviate the symptoms of illness or disease whereas medical apparatus and in particular medical apparatus used to deliver medicines for inhalation purposes consist of engineered implements or appliances adopted to administer medicines. However, their uses can be said to overlap in that they are both designed with the aim of alleviating a particular illness or disease.

39. Secondly, it seems to me that the users of medicines for inhalation purposes and the users of inhalers are those individuals suffering from identical medical conditions e.g. asthma or diseased lungs. There is a direct overlap in this context.

40. Thirdly, I consider the physical nature of the goods. Medicines are essentially pharmaceutical substances usually in tablet, liquid or powder form, whereas medical apparatus (including inhalers) are engineered implements or appliances. In my view the physical nature of the goods differs.

41. Now I consider the trade channels through which the goods reach the market. While I have no real evidence before me on this point, it seems to me that medicines for inhalation purposes and medical apparatus (including inhalers) are highly specialised products which are likely to be produced by different undertakings. While the goods may ultimately be distributed through/by doctors, hospitals or pharmacists it has not been shown that the goods would share the same trade channels up to the distribution point given the fundamental differences in their physical nature and the specialisation of their manufacturers.

42. Next I go on to consider the extent to which the respective goods are competitive and it seems to me that while the respective goods may be complementary they are not sold as alternatives and as such they are not in direct competition. However, once again, I have no evidence on this point.

43. In the light of the above, while obvious differences exist I find that there is a degree of similarity in the respective goods. They share the same users, a common purpose and are complementary in use.

44. While the applicant submits that the goods of the applicant and opponent would be distributed by medical or pharmaceutical specialists only, the respective specifications are not so limited. Accordingly, I must assume that the notional coverage of the marks takes in both 'over the counter' goods and prescription only. The average customer could therefore be either an ordinary member of the public or a medical professional. In relation to purchases made by the public I do not believe that there are any special circumstances which suggest that the average customer pays a particularly high level of attention in the purchase of the goods. They are not casual "bags of sweets" cases but neither are they expensive purchases. However, I do believe the customer for the goods would be relatively discerning. Turning to the position where a medical practitioner is involved in the selection and prescription of the products, I would add that I do not believe that this would result in any greater likelihood of confusion. I am fortified in this view by the comments of Professor Annand, acting as the Appointed Person in the cases of Oropram/Seropram (O/208/02) and Allergan's Application (O/293/02) when she stated:

"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 maybe on hand to assist choice with OTC products and pharmacists usually check illegible prescriptions)."

CONCLUSION

45. On a global appreciation, taking into account all the relevant factors, I have come to the following conclusions:

- (i) the respective marks are identical;
- (ii) the respective specifications include goods which share a degree of similarity in that they share the same users, overall purpose and are complementary in use;
- (iii) while the customer for the goods is likely to be relatively discerning, the goods share sufficient similarity so that, if sold under the same brand name, the consumer is likely to consider that the applicant's medicines for inhalation purposes and the opponent's medical inhalers originate from the same undertaking or economically linked undertakings.

46. In reaching a decision in relation to the likelihood of confusion I have particularly borne in

mind the following comments of the European Court of Justice in Cannon:

“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).”

47. The opposition is successful under Section 5(2)(a) of the Act and as I have found for the opponent under Section 5(2) I have no need to consider the other ground raised. Suffice to say that I do not believe the opponent’s case under Section 3(6) to be any stronger than the Section 5(2) ground.

COSTS

48. The opponent is entitled to a contribution towards costs and I therefore order the applicant to pay the opponent the sum of £1,000. 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 15 day of May 2003

**JOHN MacGILLIVRAY
For the Registrar
The Comptroller-General**