

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

TRADE MARKS REGISTRY

Tribunal Room 3
Harmsworth House
13-15 Bouverie Street
London, EC4Y 8DP

Thursday, 18th September 2003

B e f o r e:

MR. GEOFFREY HOBBS QC
(Sitting as the Appointed Person)

In the Matter of the TRADE MARKS ACT 1994

and

In the Matter of UK Trade Mark Application No. 2286676
EPISTAT in Class 5 by SPECIAL PRODUCTS LIMITED

and

In the Matter of an Opposition thereto under No. 90483 by
AMERICAN HOME PRODUCTS CORPORATION (NOW WYETH)

(Computer-aided Transcript of the Stenograph Notes of
Marten Walsh Cherer Ltd., Midway House,
27/29 Cursitor Street, London, EC4A 1LT.
Telephone No: 0207 405 5010. Fax No: 0207 405 5026.)

MISS FIONA CLARK (instructed by Messrs. Charles Russell,
London EC4) appeared on behalf of the Applicant.

MR. THOMAS MITCHESON (instructed by Messrs. D Young & Co.,
London EC4) appeared on behalf of the Opponent.

MR. D. LANDAU appeared on behalf of the Registrar of Trade Marks.

D E C I S I O N

1 THE APPOINTED PERSON: On 27th November 2001, Special Products
2 Limited applied to register the word **EPISTAT** as a trade mark
3 for use in relation to "pharmaceuticals for the treatment of
4 epilepsy" in Class 5. It was not suggested that the word had
5 acquired a distinctive character through use as a trade mark
6 in the United Kingdom prior to the date of the application
7 for registration.

8 On 16th April 2002, American Home Products Corporation
9 opposed the application under section 5(2)(b) of the
10 Trade Marks Act 1994 on the basis that use of the mark
11 applied for would conflict with the rights it had acquired
12 through prior registration of the trade mark **EPTISET** for use
13 in relation to "pharmaceutical preparations" in Class 5.

14 The earlier trade mark was registered in the
15 United Kingdom under number 2270483 as of 18th May 2001.
16 The trade mark does not appear to have been used. Even so,
17 the registration is entitled to the benefit of the
18 presumption of validity contained in section 72 of the
19 1994 Act.

20 The question for consideration under section 5(2)(b) is
21 whether there are similarities in terms of the marks and
22 goods in issue that would have combined to give rise to a
23 likelihood of confusion if the earlier and later marks had
24 been used concurrently in the United Kingdom in relation to
25 goods of the kind for which they were respectively registered

1 and proposed to be registered in November 2001.

2 In paragraphs 26 et seq of its Judgment in the Canon
3 case, the European Court of Justice held that there can be
4 no likelihood of confusion in the sense required by
5 section 5(2)(b) if it does not appear that the public could
6 believe that the goods or services covered by the trade marks
7 in issue come from the same undertaking or economically-
8 linked undertakings. When, as in the present case, the marks
9 in issue are not identical, they need to be distinctively
10 similar in order to be capable of inducing such a belief in
11 the mind of the average consumer of the goods or services
12 concerned.

13 The purpose of the assessment is to determine the net
14 effect of the given similarities and differences. For that
15 purpose, the Tribunal is required to assume that the average
16 consumer will be exposed to concurrent use of the rival marks
17 in relation to goods of the kind specified for protection by
18 the applicant on the one hand and by the opponent on the other.

19 With the agreement of the parties, the opposition was
20 determined without recourse to a hearing. In the result, the
21 application was refused for the reasons given in a written
22 decision issued by Dr. Trott on behalf of the Registrar of
23 Trade Marks on 24th April 2003.

24 His decision was properly informed by reference to the
25 principles laid down in the case law of the European Court of

1 Justice for the determination of objections under
2 section 5(2)(b). His findings, as summarised by me, were as
3 follows:

4 (1) The specification of the opponent's earlier trade
5 mark covered the goods of interest to the applicant. The
6 opposition therefore fell to be determined on the basis that
7 the goods in issue were identical.

8 (2) The opponent's mark **EPTISET** was a seven-letter
9 invented word which inherently possessed a relatively high
10 degree of distinctive character.

11 (3) The applicant's mark **EPISTAT** was also a
12 seven-letter invented word which inherently possessed a
13 relatively high degree of distinctive character.

14 (4) The nature of the goods in issue did not give rise
15 to any special considerations in the assessment of the
16 likelihood of confusion: see the decision of Professor Annand
17 sitting as the Appointed Person in OROPRAM Trade Mark
18 (SRIS 0/208/02).

19 (5) The length, structure and lettering of the marks in
20 issue rendered them distinctively similar from a visual,
21 phonetic and conceptual point of view (although I think it is
22 fair to say that he took the view that the degree of phonetic
23 similarity was perceptibly less than the degree of visual
24 similarity).

25 (6) The marks were not easily distinguishable; that,
26 together with the overlap in the goods in issue, gave rise to

1 a real likelihood of confusion of the kind proscribed by
2 section 5(2)(b).

3 In the light of these findings he rejected the
4 application and ordered the applicant to pay the opponent
5 £1100 as a contribution towards its costs of the Registry
6 proceedings.

7 On 6th June 2003, the applicant gave notice of appeal
8 to an Appointed Person under section 76 of the Trade Marks
9 Act 1994 contending, in substance, that the hearing officer
10 had erred, first, by giving insufficient weight to the
11 differences between the marks in issue and, secondly, by
12 overstating the propensity of their similarities to bring
13 about a convergence of perceived or remembered identity of
14 trade origin.

15 It was contended that he fell into error in these
16 respects because he failed to carry out the required
17 assessment from the perspective of the relevant average
18 consumer. It was accordingly submitted that the opposition
19 should be rejected and the application should be allowed to
20 proceed to registration.

21 These contentions were developed in argument before me.
22 In particular, Counsel for the applicant focused on paragraph
23 26 of the hearing officer's decision where he observed as
24 follows:

25 "I find it hard to believe that a treatment
26 for the acute symptoms of epilepsy would

1 ever be purchased by patients directly.
2 However, I do not believe that the
3 applicants' evidence precludes completely
4 the role of non-medical professionals in
5 the administration process in the manner
6 in which was so self evident in my own
7 **PROLONID** (BL 0/428/00) decision. Further,
8 the applicants' submissions fail to address
9 the confusion that might arise as a
10 consequence of the public believing that the
11 respective goods come from the same or
12 economically-linked undertakings (Canon,
13 paragraph 29). The opponents' specification
14 does not exclude pharmaceuticals that are
15 similar to the applicants products, for
16 example, that might be used as less dramatic
17 treatments of epilepsy. The likelihood exists
18 here, in my view, that the products might be
19 considered to originate from the 'same stable'."

20 It was submitted, first, that in this paragraph the
21 hearing officer had considered the wrong class of persons to
22 be representative of the relevant average consumer and had
23 therefore misunderstood the attributes of the persons whose
24 perceptions he should be taking into account for the purposes of
25 the required assessment; secondly, that his observation at
26 the end of the paragraph referring to 'same stable' confusion
27 implicitly, but insufficiently, recognised that the rival

1 marks were not so similar that one would be mistaken for
2 the other; and, thirdly, that his comments concerning the
3 applicant's evidence and submissions indicated that he was
4 adopting a burden or standard of proof which was adverse to
5 the applicant and unwarranted by the principles of law and
6 procedure that he was supposed to be applying.

7 I do not consider that there is any substance in
8 these criticisms. In my view, the hearing officer did not fall
9 into the error of assessing the likelihood of confusion by
10 reference to the perceptions of the wrong class of average
11 persons. According to my reading of the decision, paragraph
12 26 forms part of a group of paragraphs beginning at paragraph
13 24 where the hearing officer is addressing an argument which
14 had been advanced on behalf of the applicant. The argument was
15 to the effect that in the particular field of medicine in which
16 the applicant intended to use its mark, its product would be
17 regarded as so specialised and all people involved in the
18 administration and use of it would be so knowledgeable that
19 confusion would be unlikely to occur.

20 I believe that in this group of paragraphs the hearing
21 officer was simply explaining in words of his own why he was
22 prepared to accept and apply the principle, noted earlier in
23 his decision by reference to the OROPRAM case, that there is no
24 special standard for assessing the likelihood of confusion in
25 cases involving pharmaceuticals. I certainly do not agree that

1 in paragraph 26 he was establishing a burden or standard of
2 proof different from that which the legislation requires.

3 So far as the concept of 'same stable' confusion is
4 concerned, it is clear that such confusion is no more acceptable
5 than 'mark for mark' confusion and the hearing officer was
6 entitled to proceed on that basis, as he did with reference to
7 "pharmaceuticals that are similar to the applicant's products,
8 for example, that might be used as less dramatic treatments of
9 epilepsy".

10 The applicant also took issue with the hearing officer's
11 view that the distinctive power of the marks in question was
12 somewhat front-loaded rather than evenly dispersed throughout
13 the marks as a whole. In this connection Counsel drew my
14 attention to the passages in his decision where he gave weight
15 to the possibility that the back ends of the marks would be
16 slurred in audible use. I think there is some substance in this
17 point, but not enough to undermine the hearing officer's
18 reasoning and approach.

19 The fact that the marks in issue are invented words does
20 have a bearing, in my view, on the question whether they are
21 sufficiently different to be readily distinguishable in ordinary
22 use.

23 The issue, as I see it, is whether the level of attention
24 and effort required to perceive and remember the differences
25 between the two distinctive marks is greater than people in the
26 relevant sector would actually bring to bear on them.

27 I do not think it would be right to proceed on the
28 assumption that everyone normally involved in the supply of
29 goods of the kind in issue in the present case would exercise a
30 particularly high level of perspicacity and attention to detail,
31 either when noting the use of the marks by others or when using

1 them for the purposes of dispensing or administering drugs or
2 arranging for further supplies to be procured.

3 My own view is that these marks are very close, so much
4 so that in the course of preparing for this hearing during the
5 last day or so I have found myself constantly checking and re-
6 checking which of the marks I was looking at in any given
7 context and whether the mark I was looking at was the opponent's
8 mark or the applicant's mark.

9 I consider that the hearing officer was fully justified in
10 concluding that the similarities between the marks, together
11 with the undeniable similarities between the goods covered by
12 the specifications in question, were likely to give rise to a
13 likelihood of confusion of the kind proscribed by section
14 5(2)(b).

15 In connection with the present appeal, the applicant has
16 submitted that the objection to registration could be overcome
17 by limiting the specification of goods covered by its
18 application to: "Pharmaceuticals for the treatment of tonic-
19 clonic epileptic seizures which are available on prescription
20 only, which are for administration via the buccal cavity and of
21 which the active ingredient is a member of the benzodiazepine
22 family."

23 It is suggested that in the context of such a specification
24 the applicant's mark would convey a stronger allusion to the

1 therapeutic purpose for which the relevant goods would be
2 supplied and used (that is to say for the purpose of treating
3 epilepsy) than might otherwise have been the case. It is further
4 submitted that the absence of any such allusion in the
5 opponent's mark would then be sufficient to prevent the two
6 marks in contention from being confusingly similar.

7 Again, it appears to me that this line of argument assumes
8 a level of perspicacity and attention to detail which is greater
9 than that which the average consumer, whose perceptions I am
10 required to consider, would actually bring to bear on the
11 matter.

12 In this sector, no less I think than in any other,
13 people would not normally take time to construe or unpack the
14 meaning of the trade marks which come to their attention in the
15 course of their everyday work.

16 The marks in issue are closely similar invented words.
17 Taken as a whole, they are not easy to distinguish from one
18 another. Despite the sharper degree of allusion that might be
19 conveyed by the mark **EPISTAT** if the goods of interest to the
20 applicant were more narrowly defined, I am not prepared to
21 accept that a limitation to the effect suggested would be
22 sufficient to dispel the likelihood of confusion which has been
23 found to exist by the hearing officer whose assessment I have
24 upheld.

25 For these reasons, the appeal will be dismissed.

26
