O-347-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2291512
BY RANBAXY LABORATORIES LIMITED
TO REGISTER THE TRADE MARK:**

OMERAN

IN

CLASS 5

AND

**THE OPPOSITION THERETO
UNDER NO 90732
BY ASTRAZENECA AB
BASED UPON THE EARLIER TRADE MARKS:**

OMEPRAL

OMEPAL

Trade Marks Act 1994

In the matter of application no 2291512
by Ranbaxy Laboratories Limited
to register the trade mark:
OMERAN
in class 5
and
the opposition thereto
under no 90732
by AstraZeneca AB

BACKGROUND

1) On 31 January 2002 Ranbaxy Laboratories Limited, which I will refer to as Ranbaxy, applied to register the trade mark **OMERAN**. The application was published for opposition purposes in the "Trade Marks Journal" on 20 March 2002 with the following specification of goods:

pharmaceutical and medicinal preparations for human and veterinary use.

The above goods are in class 5 of the International Classification of Goods and Services.

2) On 20 June 2002 AstraZeneca AB, which I will refer to as Astra, filed a notice of opposition to the application. Astra is the owner of the following United Kingdom trade mark registrations:

- No 2117046 of the trade mark OMEPRAL. The application was filed on 28 November 1996 and the trade mark was registered on 20 June 1997 for the following goods:

  pharmaceutical preparations for the treatment of gastro-intestinal disease.

- No 2246351 of the trade mark OMEPAL. The application was filed on 22 September 2000 and the trade mark was registered on 23 February 2001 for the following goods:

  pharmaceutical preparations and substances.

The goods of both registrations are in class 5 of the International Classification of Goods and Services.

3) Astra is only opposing the following goods of the application:

pharmaceutical and medicinal preparations for human use.

4) Astra states that it has not used either of its trade marks in the United Kingdom and, therefore, will rely upon normal and fair manner of use in relation to the goods covered by its registrations.

5) Astra states that OMERAN is similar to both OMEPRAL and OMEPAL. The suffixes of

Astra's trade marks are meaningful in the context of pharmaceuticals. –PRAL and –PAL are similar to the suffix of Ranbaxy's trade mark – RAN. All the trade marks share the prefix OME- followed by a one syllable suffix. Conceptually, none of the trade marks has a dictionary meaning. Thus, the similar construction of Ranbaxy's trade mark increases the likelihood of confusion between the trade marks.

6) Astra states that the goods for which Ranbaxy is seeking registration are identical or similar to those of its earlier registrations.

7) Consequently, registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act) as there is a likelihood of confusion.

8) Astra states that it is seeking refusal of the application. However, in paragraph 2 of its grounds of opposition it only attacks some of the goods. Consequently, any refusal will be limited to these goods. Astra seeks an award of costs.

9) Ranbaxy filed a counterstatement. It denies that the suffixes of Astra's trade marks are similar to –RAN. Ranbaxy states that there are a significant number of United Kingdom and Community trade marks in existence which commence with the prefix OME- and attaches a schedule of these. These are for the trade marks: OMEGA, OMEGA, OMEGADERM, OMEGAVEN, OMEGA (a pending application), OMEPAZOM (in the name of Astra), OMECOL, OMEOCOMPLEX, OMECLAR, OMEODRENA, OMEROS (pending) and OMEROS and device (pending).

10) Ranbaxy denies that any of the goods of the trade marks are identical or similar.

11) Ranbaxy seeks the rejection of the opposition and an award of costs.

12) Both sides filed evidence.

13) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing, so I am making this decision from the documentation before me. Astra filed submissions. Ranbaxy did not file submissions. However, a large part of its evidence is, in fact, submission rather than evidence of fact. I take into account the submissions of Astra and the submission parts of Ranbaxy's evidence in coming to my decision.

EVIDENCE

Evidence of Astra

14) This is in the form of a witness statement by Sarah Janella Barr who is a partner in Wildbore & Gibbons, the trade mark attorneys for Astra in this case.

15) Ms Barr refers to the claim of Ranbaxy that there are a significant number of United Kingdom and Community trade marks which commence with the prefix OME-. Ms Barr refers to the words of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 where he stated:

> "Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g.* MADAME Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence."

Ms Barr states that she arranged for investigations to be undertaken using the Internet in order to ascertain the use of the trade mark registrations and applications listed by Ranbaxy. She exhibits at SJB/1 a table of results compiled from data available from Internet sites. The investigations looked particularly at the EMIMS website. This website is operated by the publishers of MIMS (the "Monthly Index of Medical Specialities") which is an independent publication designed as a prescribing guide for general practitioners in the United Kingdom.

16) Ms Barr states that the EMIMS website failed to reveal use of any of the trade marks referred to by Ranbaxy. Further searches were conducted on the Internet using the GOOGLE search engine in order to locate the trade marks themselves or the websites of their owners. Ms Barr exhibits at SJB/2 copies of the web pages as reviewed in the course of the investigations. She states that it will be seen that the following trade marks were found in use:

1. OMEGADERM – a nutritional supplement for animals.
2. OMEGAVEN – a liquid emulsion for application to the skin.
3. OMECOL – food products.
4. OMEOCOMPLEX – detergent oil.
5. OMEROS – a product to inhibit inflammation and pain associated with arthroscopy.

Of these only numbers 1 and 3 may possibly be in use in the United Kingdom.

Evidence of Ranbaxy

17) This consists of a witness statement by Aidan John Robson who is a partner in Reddie & Grose, who are acting for Ranbaxy in this case.

18) Mr Robson states that it is his understanding that Ranbaxy intend to use the trade mark OMERAN on a product which will be in tablet or capsule form, containing omeprazole, and for the treatment of gastric ulcers. Mr Robson states that a search of Astra's website has not revealed any use of OMEPAL anywhere in the world. He states that there is an indication that the trade mark OMEPRAL is being used for gastrointestinal diseases. He exhibits a copy of pages from the website.

19) Mr Robson states that OMERAN and OMEPRAL use the active ingredient omeprazole and so it is not surprising that they use the prefix OME. He states that to the extent that the trade mark OMEPAL covers similar goods to those of the application, the goods of relevance to be considered are pharmaceuticals for use in the treatment of gastrointestinal diseases containing the active ingredient omeprazole. He states that the prefix is derived directly from

the active ingredient omeprazole and Astra in not entitled to a monopoly in this.

DECISION

Likelihood of confusion - section 5(2)(b) of the Act

20) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

> "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."

Section 6(1)(a) of the Act defines an earlier trade mark as:

> "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"

21) The trade marks upon which Astra relies are earlier trade marks in the terms of section 6(1)(a) of the Act.

22) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

Comparison of goods

23) Mr Robson has made various comments in his evidence about what the comparison of the goods should be. The goods of the application have not been limited in any way. The comparison that has to be made is between the goods as applied for and the goods as registered. The goods of the application which are under attack are: *pharmaceutical and medicinal preparations for human use.* The goods of the earlier registrations are: *pharmaceutical preparations for the treatment of gastro-intestinal disease* (OMEPRAL) and *pharmaceutical preparations and substances* (OMEPAL). Ranbaxy makes what can only be described as the astonishing claim, in its counterstatement, that the respective goods are neither identical nor similar. I am afraid that I do not understand how *pharmaceutical preparations and substances* does not encompass *pharmaceutical and medicinal preparations for human use*. I also fail to understand how *pharmaceutical and medicinal preparations for human use* does not encompass *pharmaceutical preparations for the treatment of gastro-intestinal disease.* Ranbaxy has not limited its specification, although it has had amply opportunity so to do during the opposition period. In the absence of any limitation, as the application encompasses the goods of OMEPRAL, I must consider the respective goods as identical. Indeed, if what Mr Robson states about the proposed use of OMERAN is correct, they could end up being for virtually the same use and using the same active ingredient. (Although, of course, OMEPRAL is not limited to any particular ingredient or ingredients.)

24) I have no hesitation in finding that the goods of the respective trade marks are identical.

Comparison of trade marks

25) I take into account the matter must be judged through the eyes of the average consumer of the goods in question (*Sabel BV v Puma AG* page 224) who is deemed to be reasonably well informed and reasonably circumspect and observant. Ms Barr in her submissions states:

> "The Hearing Officer is invited to take account of the fact that the goods concerned in this case are "*pharmaceutical preparations*" and that the consequence if confusion should arise could be extremely serious."

This seems to me an oblique way of arguing that that standards to be applied to pharmaceutical products are different from those applied to other goods. This is a matter that has been addressed in various decisions. Mr Reynolds in BL 0/308/03 gave a run through of various of these decisions and I am happy to adopt his words:

> "20. The debate as to whether a higher or lower threshold should, or needs to be applied in relation to pharmaceutical products is not a new one. As Mr Charlton has pointed out, the Appointed Person (Professor R Annand) approved the following statement of the Registry Hearing Officer in Glaxo Group Plc v Allergan Inc (BL O/414/01 and BL O/293/02):
>
> > "16. It seems to me that the role of the Registrar is to apply the Trade Marks Act 1994 and its subordinate legislation to the proceedings brought before her. Other provisions and authorities exist for the licensing of pharmaceuticals and in my view, it is not the role of the Trade Marks Registry to stray into these areas. Under the provisions of the Act and acting on behalf of the Registrar I must consider whether there exists a likelihood of confusion if the applicants' and opponents' trade marks are used in respect of the goods for which they are respectively applied for and registered. I must find a likelihood of confusion not merely a possibility of confusion; Reactor at page 290."
>
> 21. In H Lundbeck A/S and Omega Farma EHF (BL O/208/02), Professor Annand, again sitting as the Appointed Person, said:
>
> > "I have arrived at this view [on the merits of the appeal] 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)."

22. I note, too, that in Choay S A v Boehringer Ingelheim International GmbH [2001] ETMR 693, a similar conclusion was reached in relation to the standard of the test to be applied. The OHIM Board of Appeal observed that:

> "In some Member States the view is taken that a likelihood of confusion should be accepted more readily in the case of medicines on account of the serious consequences that can ensue if the patient takes the wrong products. In other countries the view is taken that pharmaceutical trade marks will not be confused so easily because the consumer has the assistance of qualified professionals and is particularly attentive to the differences between marks for pharmaceutical products because of the importance of taking the right product. In the Board's view, the conflicting considerations which underlie these opposing views are likely to cancel each other out in many cases, with the result that no special criteria need be applied to trade marks for pharmaceutical products."

23. Nevertheless there remains the question of what considerations and circumstances bearing on the pharmaceutical industry are relevant and to be borne in mind in addressing the issue of likelihood of confusion. In Glaxo Group Ltd v Bayer Aktiengesellschaft, O/199/02 I indicated 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 prescription 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.
>
> 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 failure 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."

24. Many of the considerations I am asked to take into account here were raised in that earlier case. Indeed many of the examples of mistakes occurring in drug names were

> referred to there and must, I think, be well known within the industry (ISORDIL/PLENDIL, DEMEROL/ROXANOL, PITRESSIN/PITOCIN etc).
>
> 25. I, therefore, regard the above conclusions as being broadly applicable in the current case including the fact that, absent specific evidence to the contrary, I must make allowance for the fact that the average consumer may be medical professionals and/or the public at large.
>
> 26. I am inclined to think that visual appreciation of pharmaceutical marks is of particular importance given that pharmacists will generally be working from a prescription (which may be typed or hand written) from a medical professional and that over the counter medicines may be selected from displays in a chemists shop, supermarket or other such outlets. Equally oral usage and references must be allowed for. Members of the public may choose to put their requirements to a pharmacist or shop assistant and Mr Cox refers to the practice of doctors telephoning prescriptions to chemists or pharmacists."

I see no need to comment or add to the above. In this case, the respective goods cover over-the-counter medicines as well as prescription medicines.

26) Before comparing the trade marks I will deal with elements of the submissions of Ranbaxy. Ranbaxy has argued that there are various products that begin with OME and then that the *British Sugar plc v James Robertson & Sons Ltd* finding does not catch it. Where it is argued that an element is common amongst various trade marks, the absence of use is telling. If a common element is not known to the public, the public will not be used to distinguishing products by reference to other elements. Trade marks sitting on a register do not "train" the public. Hence, the relevance of the *British Sugar plc v James Robertson & Sons Ltd* finding. Astra has shown that there has been an absence of use in relation to pharmaceutical products in the United Kingdom and so the *British Sugar plc v James Robertson & Sons Ltd* finding does catch Ranbaxy. I note that various of the trade mark registrations/applications which Ranbaxy refers to commence with or are the word omega. The average consumer is going to be aware of the word omega and not going to divide it up into ome and ga. If there was a huge number of trade mark registrations and applications for the relevant goods commencing with OME (and not omega), this could be indicative that OME is a non-distinctive element. There is not. Ranbaxy by relying upon state of the register evidence has forced Astra into filing evidence in reaction. This shows that, contrary to Ranbaxy's claim, trade marks beginning with OME appear to be absent in the United Kingdom for pharmaceutical products. Ranbaxy also makes a claim that *British Sugar plc v James Robertson & Sons Ltd* does not apply to unused trade marks. Of course it does, it is part of global appreciation of what would happen in the context of normal and fair use of the trade marks.

27) Ranbaxy also claims that OME will be seen as being directly allusive of omeprazole. It puts in no evidence to support this claim. It is not shown that OME is an abbreviation for omeprazole or that the public would analyse the trade marks and then deduce that one part of them related to omeprazole. None of the goods are limited to containing omeprazole. Ranbaxy's proposition is predicated upon the basis that the goods contain omeprazole and that the average consumer would know this and be aware of it. That average consumer is, amongst others, the person walking into Boots or Tesco. I doubt that he or she is likely to be aware of the existence of omeprazole. Ranbaxy's premise is also based upon the idea that consumers indulge in the philological analysis of trade marks. The average consumer normally perceives

a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). 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* page 224). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 BV* page 84, paragraph 27).

28) Astra has stated in its grounds of opposition that the suffixes –PRAL and –PAL are meaningful in the context of pharmaceuticals. No evidence has been adduced to substantiate this claim. It is certainly not something of which I am aware. Consequently, I cannot accept that the suffixes of Astra's two trade marks are meaningful for pharmaceuticals.

29) The trade marks to be compared are:

Astra's trade marks:	**Ranbaxy's trade mark:**
OMEPRAL	**OMERAN**
OMEPAL	

Astra's trade marks cannot be treated as a job lot. I will identify relevant differences in my analysis. Taking into account my findings about the arguments of Ranbaxy and Astra about the distinctiveness of the beginnings and the ends of the trade marks, I do not consider that any particular parts of the trade marks can be considered to be distinctive and dominant elements.

30) All of the trade marks begin with OME. I consider that this likely to be pronounces as two syllables. I would envisage that OME would be pronounced as OMEE or OMAY. Each trade mark is of three syllables and the first two in each will be pronounced in the same fashion. In the final syllable of OMEPRAL and OMERAN, the r and a sounds are the same. In OMEPAL only the a sound is the same. It is likely in oral use that the final syllable will be less clearly pronounced than the first two syllables. Taking all these matters into consideration, I consider that the respective trade marks all enjoy a good deal of phonetic similarity. OMEPRAL being, in my view, phonetically closer than OMEPAL to OMERAN,

31) The trade marks are invented words. They have no conceptual associations either to draw them closer or push them apart.

32) Visually the trade marks obviously share various letters. The first letters being identical. It is necessary to bear in mind that the public rarely has the opportunity to compare trade marks directly. In this case there are no conceptual hooks which the public can grab hold of. Consequently, there is more opportunity for the vagaries of imperfect recollection to come into play. I consider that there is some visual similarity between the respective trade marks. Again, I consider that the greater similarity resides with OMEPRAL because of the common presence of the letters r and a.

33) I consider that each of the trade marks of Astra is similar to that of Ranbaxy and that OMEPRAL is closer than OMEPAL.

Conclusion

34) In deciding if there is a likelihood of confusion I have to take into account various factors. The distinctiveness or otherwise of the earlier trade mark is of importance as there is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49). In this case the earlier registrations are invented words with no allusion to the goods. I consider that they enjoy a good deal of inherent distinctiveness.

35) The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the respective goods are identical.

36) The relevant consumer for the goods in question can be anyone. If one takes the "bottom" level it is the purchaser of an over-the-counter medicine. This customer will take some care, I believe, in the choice of pharmaceutical products, whether they be for gastro-intestinal problems or are analgesics. However, in this case the customer would be faced with identical goods, similar trade marks which have no conceptual association to aid the memory and earlier trade marks that are distinctive. **Taking all these factors into account, I consider that there is a likelihood of confusion in respect of each of Astra's trade marks.**

37) Astra's opposition is not against all of the goods of the registration. Ranbaxy should file, within one month of the expiry of the appeal period from this decision, a form TM21 to amend the specification to read:

pharmaceutical and medicinal preparations; all for veterinary use.

If no form TM21 is filed within the period set the application will be refused in its entirety. (If an appeal is filed the period for filing the form TM21 will be one month from the final determination of the case, if the appeal is unsuccessful.)

38) Astra is to be commended for the clear focus and economy of is opposition. It has not sought to bring in needless grounds of opposition, it has made no foolish claims about its earlier trade marks. The evidence it filed was solely a reaction to the counterstatement of Ranbaxy.

COSTS

39) AstraZeneca AB having been successful is entitled to a contribution towards its costs. I order Ranbaxy Laboratories Limited to pay AstraZeneca AB the sum of £1200. 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 12th day of November 2003

David Landau
For the Registrar
the Comptroller-General