O-206-07

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2380802 BY MERZ PHARMA GMBH & CO KGAA TO REGISTER THE TRADE MARK SAKIRA IN CLASS 5

AND

IN THE MATTER OF OPPOSITION NO 93457 BY INTERSANTE GMBH

TRADE MARKS ACT 1994

IN THE MATTER OF Application No. 2380802 by Merz Pharma GmbH & Co KGaA to register the Trade Mark Sakira in Class 5

and

IN THE MATTER OF Opposition No. 93457 by Intersanté GmbH

BACKGROUND

1. On 20 December 2004 Merz Pharma GmbH & Co KGaA applied to register the mark SAKIRA. The applicant claims an international priority date of 3 November 2004.

2. The specification of goods has been amended during the course of the proceedings to:

> "Pharmaceutical preparations; pharmaceutical products for use in aesthetic dermatology, namely injectable gel preparations."

3. Opposition was filed by Intersanté GMBH on 25 May 2005 citing a single ground of opposition under Section 5(2)(b) based on its earlier Community Trade Mark No. 3830718, SALFIRA. That mark was filed on 12 May 2004 (and so is an earlier trade mark) and completed its registration procedure on 8 August 2005. On that basis it is not subject to a requirement of proof of use (per the Trade Marks (Proof of Use, etc) Regulations 2004).

4. The amendment referred to above did not result in the opposition being withdrawn. However, in the light of the applicant's amended specification it will be sufficient if I record that the opponent's registration includes, in addition to goods in Classes 3 and 10, the following goods in Class 5:

> "Pharmaceutical, veterinary and sanitary preparations, diagnostic preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides."

5. The applicant filed a counterstatement denying similarities in both marks and goods and that the registration would be contrary to Section 5(2)(b).

6. Only the opponent has filed evidence. Neither side has asked to be heard. The opponent indicated that it did not intend to file written submissions. The applicant filed written submissions under cover of a letter dated 11 June 2007 from Marks &

Clerk, its professional advisors. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Opponent's evidence

7. Evidence has been filed in the form of a witness statement by Rolf-Dieter Haspel of Intersanté GmbH. He has worked for the opponent for nine years but does not say in what capacity.

8. He exhibits:

1	-	detail of his company's trade mark registration
2	-	a copy of the decision (and translation thereof) in opposition proceedings between the parties in France which was in favour of Intersanté.
3	-	a copy of the decision (and translation thereof) in opposition proceedings between the parties in Switzerland which was also in favour of Intersanté.

9. Mr Haspel says that his company currently uses the mark SALFIRA for hand creams, lipsticks and body lotions, products that he claims are used by the general public and dermatologists.

10. In relation to the goods of the application he says that the products would usually be used by professionals rather than by the general public although the professionals in question may not possess formal medical/surgical qualifications. Those placing orders for the product are likely to be assistants or clerical staff and might not be familiar with the products in question. He expresses concern about the consequences of confusion given that Merz's products are said to be injectable.

The law - Section 5(2)(b)

11. The relevant part of the statute reads as follows:

> "(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."

12. I take account of the guidance from the following well known cases from the European Court of Justice – *Sabel BV v Puma AG* [1998] ETMR 1, *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc.* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77, and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

The applicant's submissions

13. The applicant has quite properly referred me to the guiding principles from the above cases. In so far as the specific circumstance of this case are concerned it says

> "It is a well established principle that the average consumer places greater emphasis on the beginning of a mark. In this respect, the first syllable of the Earlier Right consists of the 3 letters SAL whilst the first syllable of the Contested mark consists of 2 letters only SA. The letter "K" in the 2nd syllable KI in the Contested Mark has a striking impact since it is a strong and hard letter. The letter "F" in the 2nd syllable FI of the Earlier Right is much softer. Accordingly, the 2nd syllable in the Contested Mark produces a strong sound and has a marked impact on the overall phonetic impression of the mark. There are distinct phonetic differences between the marks concerned which clearly outweigh any similarities.
>
> Although the marks concerned share a number of letters in common, namely, the letters SA I RA, the difference in the marks because of the additional letters "L" and "F" in the Earlier Right and the letter "K" in the Contested Mark, cannot be overlooked when making a visual comparison of the marks. The Applicant would contend that there are distinct visual differences between the marks concerned, which clearly outweigh any similarities.
>
> Neither mark has a conceptual meaning. However, there is an argument that the prefix "sal" calls to mind or suggests that the products sold under the mark may contain "salicylic acid."

14. In relation to the opponent's evidence as to the decisions of the French and Swiss Trade Mark Offices, the applicant says that it is a long established and well known principle that decisions of foreign registries have no binding effect in the UK. Finally it notes that the opponent has not filed evidence of use and so cannot benefit from an enhanced level of protection due to reputation.

DECISION

Similarity of Goods

15. The applicant's written submissions do not address the issue of similarity of goods in any detail. It had previously been denied that identical or similar goods were involved. On the basis of the specifications set out at the start of this decision (in the case of the applicant the amended version) there can be little doubt that identical goods are involved. Both contain the term pharmaceutical preparations. To the extent that the applicant's specification contains a more narrowly itemised set of

pharmaceutical products, these goods are simply a sub-set of the broader term. Professor Annand, sitting as the Appointed Person, in *Galileo Trade Mark* BL O/269/04, held that:

> "I believe that overlapping specifications satisfy the test for identical goods or services in Section 5(1) of the TMA. There is no necessity for such specification to co-extend".

16. The reasoning behind that finding can be found at paragraphs 13 to 15 of her decision. The same reasoning must apply where the question arises in the context of Section 5(2)(b).

Similarity of Marks

17. The authorities require a comparison of the respective marks to be made from a visual, aural and conceptual standpoint.

18. It will be convenient to deal with conceptual consideration first. It is generally to be expected that consumers will find it easier to differentiate where ordinary words of the language are concerned. Conversely, where consumers are unable to ascribe any meaning to words, as will usually be the case with invented words, small differences may be insufficient to differentiate. The applicant here concedes that neither mark has a conceptual meaning but says "there is an argument that the prefix "sal" calls to mind or suggests that the products sold under the mark may contain "salicylic acid"". No evidence has been provided to suggest that that is the case or that the relevant public will have that understanding even if it is the case. I regard it as a matter of speculation. It follows that I regard the competing marks as invented words with no conceptual meaning or allusive reference to the respective sets of goods.

19. Visually, the marks are of roughly equal length being composed of six and seven letters respectively. As the applicant notes in its written submissions the marks have the letters SA IRA in common but differ in respect of the intervening letter(s). That suggests a reasonable but not the highest degree of visual similarity between the marks.

20. Phonetically, both marks consists of three syllables. There may be some doubt as to precisely where the syllable breaks will occur. I note that the counterstatement refers to the prefixes as being 'sak' and 'sal' whereas the applicant's written submissions refer to the first syllables as being 'sa' and 'sal'. I doubt that whatever subtle differentiation is being hinted at will be apparent in speech. The applicant is, however, right to point to the different sounds created by the hard 'K' of its own mark and the softer 'LF' sound of the opponent's mark. I disagree with the applicant in terms of the consequences and the conclusion that the phonetic differences clearly outweigh any similarities. On the contrary, taking the marks as wholes I find that from a phonetic perspective the construction and rhythm of the words (attributable in large measure to the common vowel sounds) creates a reasonably high degree of phonetic similarity.

21. As to the relative importance of these elements, it seems probable that most non-prescription pharmaceuticals are purchased on the basis of a visual inspection of the

goods not least because the purchaser will wish to reassure him/herself that the product is suitable for treating the ailment concerned, that it is in the preferred form (powder/tablet/liquid etc), that it offers the required dosage level, that it has no adverse side effects etc. On the other hand with more common ailments the purchaser may be acting on the basis of verbal recommendation from a third party or advice from a pharmacist. Aural considerations should not therefore be discounted.

Distinctive character of the marks

22. The opponent has made no claim to enhanced distinctive character through use of its mark. The matter rests on the inherent qualities of the earlier trade mark. It is generally held that words that have no allusive references to the goods are higher up the scale of distinctiveness. That is particularly so with invented words and is the case here.

The average consumer

23. Both specifications cover pharmaceutical preparations at large without restriction as to whether such goods are for specialist use only by professional medical staff, available on a prescription only basis, or available for purchase over the counter at retail outlets without the need for a prescription. The applicant's amended specification also covers "pharmaceutical products for use in aesthetic dermatology, namely injectable gel preparations". The fact that the product is injectable may suggest that it is more likely to be administered by medical professionals rather than the patient him/herself.

24. Mr Haspel suggests that, whilst this latter category of goods may be used by professionals, they may not possess formal medical/surgical qualifications. He goes on to say that those placing orders are likely to be assistants or clerical staff and may not be familiar with the products in question. No evidence on the point has been filed by either side. Mr Haspel has not said what position he holds in his company or what background knowledge he brings to bear so I am unable to say what basis he has for these claims. I am left to speculate on the reality of the position. That is a somewhat unsatisfactory state of affairs in a product area that Hearing Officers are unlikely to be familiar with.

25. I can see some force to the suggestion that the injectable nature of the goods might point to the need for professional intervention but the position is by no means certain. Diabetic patients, for instance, are able to perform their own insulin injections. Individuals with certain allergies are also able to self-inject adrenalin. Beyond that I do not know how common such practices are. There is, however, nothing to limit the availability of the injectable gel preparations to a prescription only basis. With some hesitation, therefore, I find that the average consumer for the goods of the respective specifications must be taken to include both medical professionals and the public at large and possibly also (if the opponent is right) an intermediate range of semi-skilled intermediaries without formal medical or surgical qualifications.

26. In case C-412/05P, *Alcon Inc v OHIM*, the ECJ has held that, where pharmaceutical products are concerned even if they are of a kind that are normally available on prescription, the perception of the end user must be taken into account in

addition to that of the healthcare professional. Moreover, it is possible for a likelihood of confusion to exist for one consumer group but not the other. Case T-256/04, *Mundipharma AG v OHIM*, is an example of a case where that was indeed the outcome. In that case the CFI's finding was based in part on the fact that the conceptual content of the marks in question (RESPICUR/RESPICORT) would result in them having a weaker distinctive character for professional users. However, the descriptive/allusive make-up of the marks would not necessarily be apparent to end consumers with the result that there was a likelihood of confusion for this group.

27. As to the level of attention that is likely to be paid by the respective consumer groups, the greater familiarity that professional users are likely to have with pharmaceutical products coupled with the attention they can be expected to pay to prescription items points to a greater ability to discriminate between competing products. The level of attention and knowledge of end consumers will no doubt depend on the seriousness of the ailment or illness that is to be treated. Generally speaking a measure of care is to be expected in the selection of pharmaceutical products though they will not bring to bear the level of knowledge and ability to differentiate that can be expected of professional users..

Likelihood of confusion

28. In addition to the factors considered above I bear in mind that in the global appreciation of the matter imperfect recollection must be allowed for. It arises in two ways in the circumstances of this case and these goods. Firstly, the risk of imperfect recollection is greater in the case of invented words because the consumer has no clear point of conceptual differentiation. In this respect the European Courts have held that for conceptual considerations to counteract visual and aural similarity at least one of the marks must have a clear and specific meaning so that the public is capable of grasping it immediately (see *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH*, Case T-292/01 and *Ruiz-Picasso and Others v OHIM* ,Case C-361/04 P).

29. Secondly, many pharmaceutical products may be the subject of occasional rather than regular purchase. Consumers may, therefore, encounter the competing marks sequentially rather than concurrently and with varying but potentially lengthy periods between purchases. In these circumstances precision of recollection is likely to be eroded over time.

30. In all the circumstances and bearing in mind the interdependency principle set out in *Canon v MGM* (paragraph 17) I consider that there is a likelihood of confusion if, as is possible within the scope of the respective specifications, the respective marks are used in relation to identical goods. I base that finding on the position with regard to end consumers and, if the opponent is right, intermediary users who may not have formal medical/surgical qualifications. If I am wrong in that, the opponent cannot be any better placed so far as medical professionals are concerned for the reasons given above.

31. The opposition thus succeeds under Section 5(2)(b). In coming to that view I have not been influenced by the opponent's evidence as to the outcome of proceedings between the parties in other jurisdictions, as to which see the

observations of Geoffrey Hobbs QC, sitting as the Appointed Person in *Zurich Private Banking*, BL O/201/04. Whilst the outcome has been the same I consider that there are differences of emphasis between those decisions and this one that no doubt reflect the different linguistic considerations that come into play for each of the tribunals.

Costs

32. The opponent has been successful and is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of **£1000**. 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 23rd day of July 2007

M REYNOLDS
For the Registrar
The Comptroller-General