

O-149-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2635788
BY
AJANTA PHARMA LIMITED
TO REGISTER THE TRADE MARK**

KAMAGRA

IN CLASS 05

AND

**THE OPPOSITION THERETO
UNDER NO 104645
BY
PFIZER INC.**

Background and pleadings

1. Ajanta Pharma Limited (“the applicant”) has applied to register KAMAGRA as a trade mark in Class 05 for *pharmaceutical and veterinary preparations and substances*. The application was filed on 21 September 2012 and was published for opposition purposes on 21 December 2012.

2. Pfizer Inc. (“the opponent”) opposes the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) to the application achieving registration. It bases its section 5(2)(b) and (5)(3) grounds of opposition upon its earlier trade mark VIAGRA, which is registered as a Community Trade Mark (number 233890). The opponent relies upon “pharmaceutical preparations, in particular, preparations for the treatment of erectile dysfunction.” The earlier mark is subject to the proof of use provisions because it had been registered for more than five years at the date on which the application was published¹. The opponent has made a statement of use in relation to the goods relied upon. The wording used in the pleadings and statement of use is ‘in particular’, whereas the opponent’s written submissions use the word “namely” (“pharmaceutical preparations, namely preparations for the treatment of erectile dysfunction”). “In particular” and “namely” do not have equal effect. The former is used in the description of goods to indicate an example; the latter means a restriction to the goods which follow “namely”.

3. Sections 5(2)(b) and 5(3) state that:

“(2) A trade mark shall not be registered if because –

....

(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.”

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

4. Under section 5(2)(b) of the Act, the opponent claims that the marks are highly similar because of the identical ending –AGRA. The opponent claims that, although the marks are both invented words, the prefix KAM alludes to the KAMA SUTRA, the

¹ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004. The opponent’s mark completed its registration procedure on 21 April 1998.

Hindu text on sexual intercourse. It is claimed that this increases the similarity of the marks because VIAGRA is universally associated with treatments for erectile dysfunction, thereby creating a conceptual similarity and association with the earlier mark. The opponent claims that the goods are identical or similar and that where the goods are not used to treat erectile dysfunction, under established case law such products are similar to those of the opponent owing to the uses, users, trade channels, nature of products being the same or similar. The opponent claims that this is also the case in respect of veterinary preparations and substances.

5. Under section 5(3) of the Act, the opponent claims that use of the applicant's mark takes unfair advantage of the opponent's reputation by free-riding to generate interest in the mark, thereby saving on promotion. The opponent also claims that use of the applicant's mark will lead to blurring and dilution of the distinctiveness of the opponent's mark, leading to a possible reduction in sales because the consumer's ability to associate VIAGRA immediately with the opponent will be diminished.

6. The opponent requests that the reputation and fame of the trade mark VIAGRA be accepted on the basis of judicial notice.

7. The opponent bases its claim under section 5(4)(a) upon its use of the sign VIAGRA since September 1998, throughout the UK, on pharmaceutical preparations, particularly for the treatment of erectile dysfunction. The opponent claims a huge amount of goodwill and reputation in the sign and that in view of the similarity between VIAGRA and KAMAGRA, for identical/similar goods, there would be misrepresentation because consumers will believe that the goods and marks are linked, e.g. as a brand extension, with damage to the opponent ensuing from loss of sales.

8. The applicant denies that the marks are similar. It states that there are a significant number of trade mark registrations for pharmaceuticals with the suffix AGRA and that consumers can distinguish between them. The applicant denies that there is a likelihood of confusion; it denies that use of its mark would take unfair advantage or cause detriment to the distinctive character of the opponent's mark; and denies that there would be misrepresentation and damage.

9. In relation to proof of use of the opponent's mark, the applicant says:

"The Applicant's acknowledge that the Opponents have made use of VIAGRA in connection with preparations for the treatment of erectile dysfunction. However, the Applicants do not accept that VIAGRA has been used on pharmaceutical preparations other than those for erectile dysfunction and the Opponents are put to strict proof thereof."

10. The applicant also says this, in the context of its denial of the section 5(4)(a) ground:

"Whilst it is not denied that VIAGRA has a reputation for pharmaceuticals for the treatment of erectile dysfunction...".

11. Both parties are professionally represented and have filed evidence. The parties were given the choice of having a decision made from the papers or following a hearing. Both parties filed written submissions in lieu of a hearing. I make this decision on the basis of the papers filed.

Evidence

12. The opponent's evidence comes from Tiffany Trunko, its Vice President and Assistant General Counsel; from Heather MacDonald, its Senior Corporate Counsel; and from Alasdair MacQuarrie, a trade mark attorney from the firm Gill Jennings & Every LLP, the opponent's professional representatives in these proceedings. Ms MacDonald's and Mr MacQuarrie's evidence is in reply to the applicant's evidence. The applicant's evidence comes from Deodatta Bhagwant Pandit, its General Manager (Legal) and Company Secretary.

13. In view of the applicant's recognition in its counterstatement that the opponent has used and has a reputation in its mark VIAGRA for pharmaceutical preparations for treating erectile dysfunction, it is unnecessary to document this aspect of the opponent's evidence. In any event, it is common knowledge that VIAGRA has a reputation for treating this condition and I take judicial notice of that fact.

14. However, the opponent claims use, reputation and goodwill in pharmaceutical preparations at large, a claim which has been challenged by the applicant. I will look at the opponent's evidence from this perspective.

Affidavit of Tiffany Trunko

15. Ms Trunko states that VIAGRA was launched in September 1998. At paragraph 2.3, Ms Trunko states:

“VIAGRA is a trademark used for a drug with the active ingredient sildenafil citrate to treat male erectile dysfunction.”

16. There is no evidence provided in relation to goods other than as described by Ms Trunko.

17. Ms Trunko has also provided some evidence in relation to the applicant. Exhibit TT28 includes extracts from the applicant's website which claims:

“We also have a significant global presence in the Male Erectile Dysfunction (MED) segment though our key brand KAMAGRA...”²

The KAMAGRA product, as it appears on the website, is shown below³:

² Page 627 of the opponent's evidence.

³ Page 630 of the opponent's evidence.



Witness statement of Deodatta Bhagwant Pandit

18. Ms Pandit gives evidence about an agreement reached between the parties in India on 14 January 2008, which she exhibits at DBP-1. She draws attention to clauses 6(a) and 8 of the Agreement which read:

“TRADE MARK “KAMAGRA”: The Plaintiff [an affiliate of the present opponent] shall have no objection to the use of the trade mark KAMAGRA by the Defendant [the present applicant] in relation to its medicinal products including the product of Sildenafil Preparation. The Defendant shall use the trade mark KAMAGRA in respect of its medicinal products and the Plaintiff hereby accords its consent for the same.”

“That the parties undertake to the Hon’ble Court to abide by the terms and conditions set out in the agreement and not to dispute the same hereinafter in future.”

I also note clause 6(h) which states:

“ENTIRE AGREEMENT: This Agreement has settled the present suit based upon passing off relating to Trade Mark and trade dress as alleged by the Plaintiff in the present proceedings alone, and does not in any way restrict the Plaintiff’s (or any of its affiliates’) independent rights to enforce their patent and/or other legal rights in sildenafil citrate or the product VIAGRA against the Defendant.”

19. Ms Pandit states there was an earlier agreement from 2000 which included an obligation that her company would not use KAMAGRA, but that this was superseded by the 2008 agreement. Ms Pandit states that the 2008 agreement shows that the opponent consented to the use of her company's KAMAGRA trade mark and that there are no territorial restrictions, nor any obligation upon her company not to seek to register KAMAGRA.

20. Ms Pandit makes reference to the applicant's registration of KAMAGRA in other jurisdictions and to a third party's trade mark which she states was not attacked by the opponent. It is not necessary to go into further detail about these marks.

21. Ms Pandit provides an extract from Collins English Dictionary⁴ which gives two definitions of KAMA. The first definition given is that KAMA is the name of a river in the "E Soviet Union"; the second definition is that KAMA is the name of the Hindu god of love. The only comment which Ms Pandit makes in relation to this evidence is that there is no equivalent conceptual meaning in VIAGRA.

Affidavit of Heather MacDonald

22. Ms MacDonald is an attorney, admitted to the bar of the State of New York since 1997. She gives evidence in reply to Ms Pandit's evidence regarding the agreement. Ms MacDonald states that the opponent did not consent or acquiesce to the applicant's use or registration of KAMAGRA in the UK:

"3.2 By way of background, in or about 2001, Pfizer filed a lawsuit in the High Court of Delhi at New Delhi alleging, among other things, passing off against Ajanta's KAMAGRA trade mark. In or about 2002, Pfizer filed an appeal in that action. During the pendency of those proceedings the parties engaged in discussions before a mediator at the Delhi High Court and Mediation Center at which tentative settlement terms were agreed by counsel, but were subject to confirmation by the parties by a formal written settlement agreement. The parties never signed a formal settlement agreement and a final settlement was not reached.

3.3 In March 2009, based on statement of counsel which was derived from an application by Pfizer to withdraw its appeal and suit, the Appeal Court issued an order whereby the Appeal Court did not enforce the purported settlement agreement. There is now produced and shown to me marked **Exhibit HM1** a copy of Pfizer's application to withdraw the appeal which expressly reserves Pfizer's right to pursue any and all claims against Ajanta's use of the mark KAMAGRA outside India, a copy of which was available with the Applicant at the time of passing of the order dated 18 March 2009, and marked **Exhibit HM2** a copy of the Order of the Appellate Court of the High Court of Delhi, relating to the suit."

⁴ Ms Pandit does not state which edition of Collins English Dictionary is exhibited at DBP-5, but the reference to the Soviet Union indicates that it is not recent. Nothing turns upon this.

Mr MacQuarrie's witness statement

23. Mr MacQuarrie adduces a copy of a decision issued by the First Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (R1845/2012-1) concerning the opponent's opposition to the applicant's application for the Community Trade Mark KAMAGRA (9640483). The opponent was successful under Article 8(5) of the Community Trade Mark Regulations⁵, which is equivalent to Section 5(3) of the Act. I note that the Board of Appeal remarked that the scope of the 2008 agreement was limited to the territory of India.

Decision

24. Section 6(A) Act states:

“(1) This section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if—

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes—

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

⁵ Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

25. The onus is on the opponent to prove genuine use of its mark between 22 December 2007 and 21 December 2012, in relation to the statement of use it has made, because section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

26. As already said, use has been accepted by the applicant in relation to preparations for the treatment of erectile dysfunction. This accords with Ms Trunko’s description of the opponent’s use. There is no use on any other type of pharmaceutical goods. Therefore, the opponent may rely upon the following goods, as a fair description⁶ of its use of VIAGRA:

Pharmaceutical preparations for treating erectile dysfunction.

27. I will begin with the opponent’s claim under section 5(3) of the Act. The conditions of section 5(3) are cumulative. Firstly, the opponent must satisfy me that VIAGRA has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must establish that the level of reputation and the alleged similarities between the marks will cause the public to make a link between VIAGRA and KAMAGRA, in the sense of the VIAGRA being brought to mind by KAMAGRA. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the two types of damage claimed will occur. These are:

(i) that the applicant’s mark will erode or ‘dilute’ the distinctiveness of the opponent’s mark so that the latter’s capacity to act as a sign of trade origin will be diminished (detriment to the distinctive character of the earlier mark);

⁶ As per the decision of the General Court in *Reckitt Benckiser (España), SL v OHIM Case T-126/03 (Aladin)*.

(ii) that the applicant will find it easier to sell its goods because of the link made with the opponent's mark, thereby riding on the coat tails of the opponent's promotional efforts and the power, reputation and prestige of the opponent's mark (the later mark will take unfair advantage of the distinctive character or repute of the earlier mark.)

If either of these types of damage is proven, the section 5(3) ground of opposition will be successful unless, notwithstanding the damage, the applicant shows that it has "due cause" to use its mark.

VIAGRA's reputation

28. The level of reputation necessary for a section 5(3) ground was described by the Court of Justice of the European Communities ("CJEU") in *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 950:

"23. ... In so far as Article 5(2) of the Directive, unlike Article 5(1), protects trade marks registered for non-similar products or services, its first condition implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.

24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."

29. The applicant does not deny that VIAGRA has a reputation for pharmaceuticals for the treatment of erectile dysfunction. This is a common knowledge; it is a household name and is well-known to a significant part of the public, even amongst those who have no call to use the medication. Ms Trunko gives evidence that VIAGRA had a UK market share of 51.5% in 2012. It is beyond dispute that the distinctiveness and reputation of VIAGRA for pharmaceuticals for the treatment of

erectile dysfunction is of a very high level. In *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH*, case C-301/07, the CJEU stated:

“Article 9(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the European Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

Given what I have said above about the reputation of VIAGRA, it is clear that the mark is well-known in a substantial part of the EU.

30. The next consideration is whether the public will make a link between the marks. The relevant public is the adult public and is deemed to be reasonably well informed and reasonably observant and circumspect⁷.

31. In *Adidas-Salomon AG, Adidas Benelux BV v Fitnessworld Trading Ltd* [2004] E.T.M.R. 10, the CJEU stated:

“29 The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).

30 The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

32. For there to be a link between the marks, there is, therefore, no requirement that the marks will be confused. *Adidas* states that I must consider the matter globally, taking into account all relevant factors; the General Court later described the assessment in the following way, in *Ella Valley Vineyards (Adulam) Ltd v OHIM* Case T-32/10:

“38. The global assessment seeking to establish the existence of a link between the marks at issue must, in so far as the visual, phonetic or conceptual similarity of the signs at issue is concerned, be based on the overall impression given by the signs, account being taken, inter alia, of their distinctive and dominant elements (judgment of 16 May 2007 in Case T-137/05 *La Perla v OHIM Worldgem Brands (NIMEI LA PERLA MODERN CLASSIC)*, not published in the ECR, paragraph 35, and judgment of 25

⁷ *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07), paragraphs 35 and 36.

March 2009 in Case T-21/07 *L'Oréal v OHIM – Spa Monopole (SPALINE)*, not published in the ECR, paragraph 18).”

33. The marks are:

Opponent's mark	Applicant's mark
VIAGRA	KAMAGRA

34. The marks are visually and phonetically similar to the degree that they both contain the letters AGRA as the second and third of the three syllables in each mark. The first syllable in the opponent's mark looks and sounds very different to the first syllable in the applicant's mark. There is no conceptual similarity: VIAGRA is an invented word with no evocative connotations, and KAMAGRA is also an invented word, although there may be an evocation of Kama (Sutra) for goods used in relation to sexual intercourse. Overall, there is a modest level of similarity between the marks⁸. There is no one element which is dominant in either mark.

35. The purchasing process of the parties' goods will include both direct purchase by the consumer and prescription by medical practitioners, and the parties' marks will be encountered on both a visual and an aural basis. The applicant has cover for pharmaceutical and veterinary preparations and substances at large, which includes the opponent's goods. In relation to those goods covered by the application which are not for use in the treatment of erectile dysfunction, I note the decision of the General Court ("GC") in *Kureha Corp v OHIM* Case T-487/08:

“75 It is clear that, in the present case the goods covered by the marks at issue are of the same kind, namely pharmaceutical products, they are directed at the same consumers, namely health professionals and patients, and they use the same channels of distribution, namely health centres and chemist's shops. The only differences between them are their therapeutic indications.

76 In those circumstances, it must be held that the similarities outweigh the differences and that the goods at issue are therefore similar; the applicant's exclusion of drugs 'administered intravenously or used in the treatment of heart conditions' from the list of goods referred to in the application for the mark is, in that regard, irrelevant.

77 Contrary to the Board of Appeal's assertion in paragraph 9 of the contested decision, the Court does not however consider that the goods in question display a high level of similarity, because their therapeutic indications differ greatly.”

⁸ The opponent's section 5(2)(b) pleading that its reputation increases the level of similarity between the marks is misconceived; see *Ravensburger AG v OHIM*, T-243/08.

There is a degree of similarity between the parties' pharmaceutical goods, even where there is a difference in therapeutic indication. In relation to veterinary preparations for use in treating reproductive problems in animals, there is a similarity in nature and purpose with those for humans. There is a low degree of similarity between the opponent's goods (for humans) and other types of veterinary preparations owing to the entirely different channels of trade and the ultimate application on animals rather than humans.

36. The CJEU said, in *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07), that if the later mark would call the earlier mark to mind, this is tantamount to the existence of a link. The other factors considered by the CJEU are as follows, from the same judgment:

“31 In the absence of such a link in the mind of the public, the use of the alter mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

...

41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.

44 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.

45 However, the fact that the conflicting marks are identical, and even more so if they are merely similar, is not sufficient for it to be concluded that there is a link between those marks.

46 It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.

47 The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which that mark was registered. That may be either the public at large or a more specialised public (see *General Motors*, paragraph 24).

48 It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

49 Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

50 Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.

51 It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.

52 In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

53 For the purposes of assessing where there is a link between the conflicting marks, it may therefore be necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark.

54 Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.

55 Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration.

56 In that regard, in so far as the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that mark and, therefore, its distinctive character are all the stronger if that mark is unique – that is to say, as regards a word mark such as INTEL, if the word of

which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets – it must be ascertained whether the earlier mark is unique or essentially unique.

57 Finally, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, *inter alia*, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and Case C-533/06 *O2 Holdings and O2 (UK)* [2008] ECR I-0000, paragraph 59).

58 However, as is apparent from paragraphs 27 to 31 of the judgment in *Adidas-Salomon and Adidas Benelux*, implementation of the protection introduced by Article 4(4)(a) of the Directive does not require the existence of a likelihood of confusion.

59 The national court asks, in particular, whether the circumstances set out in points (a) to (d) of Question 1 referred for a preliminary ruling are sufficient to establish a link between the conflicting marks.

60 As regards the circumstance referred to in point (d) of that question, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link.

61 As regards the circumstances referred to in paragraphs (a) to (c) of that question, as is apparent from paragraph 41 to 58 of this judgment, they do not necessarily imply the existence of a link between the conflicting marks, but they do not exclude one either. It is for the national court to base its analysis on all the facts of the case in the main proceedings.

62 The answer to point (i) of Question 1 and to Question 2 must therefore be that Article 4(4)(a) of the Directive must be interpreted as meaning that whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

63 The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.

64 The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and

- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
- the earlier mark is unique in respect of any goods or services,

does not necessarily imply that there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.”

37. Strength of reputation is one of the factors to be assessed in relation to the existence of a link, as is the relative longevity and overnight fame of VIAGRA; that it is unique (paragraph 56 of *Intel*); and that it has acquired such a reputation that it goes beyond the relevant public as regards the opponent’s goods⁹. The combination of the –AGRA similarities between the marks and the sizeable reputation and public awareness of VIAGRA means that even where there is a low degree of similarity between the goods, this will have little effect in offsetting any bringing to mind of VIAGRA, despite the different beginnings to the marks. The public, on seeing KAMAGRA in relation to pharmaceuticals and veterinary preparations and substances, will call VIAGRA to mind. A link will be made. I will go on to look at the third condition, which is whether damage will be caused, beginning with unfair advantage.

Unfair advantage

38. The applicant says nothing about its choice of mark. The CJEU described intention in *C-487/07 L’Oréal SA v Bellure NV*:

“Article 5(2) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark’s image.”

In paragraph 44 of that decision, the CJEU said:

"44. In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the

⁹ As per the judgment of the CJEU in *You-Q BV v Apple Corps Ltd* C-294/12 P.

circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of distinctive character of the mark, the Court has already held that, the stronger that mark's distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it. It is also clear from the case-law that, the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them (see, to that effect, *Intel Corporation*, paragraphs 67 to 69).

39. It must be surmised that, by adopting the –AGRA suffix, the applicant's mark is intended to be a reference to the famous VIAGRA mark. Although the specification applied for goes wider than the opponent's goods, the evidence shows that KAMAGRA is used on goods for erectile dysfunction. It is a legitimate inference that this cannot be mere coincidence¹⁰. Causing consumers to bring to mind VIAGRA gives the applicant a sales advantage it would not otherwise have had, and that advantage is intentional and unfair. **I find that use of KAMAGRA would take unfair advantage of the repute of VIAGRA. The opponent's section 5(3) ground succeeds under this type of damage.**

40. There is no "due cause" defence. The applicant has not explicitly pleaded one. In relation to the agreement, which is disputed by the opponent, even if it had been in force (which does not appear to be case from the evidence provided by the opponent), it gives no consent to the registration (as distinct from use) of KAMAGRA. Additionally, clause 6(h) of the agreement says:

"ENTIRE AGREEMENT: This Agreement has settled the present suit based upon passing off relating to Trade Mark and trade dress as alleged by the Plaintiff in the present proceedings alone [in India], and does not in any way restrict the Plaintiff's (or any of its affiliates') independent rights to enforce their patent and/or other legal rights in sildenafil citrate or the product VIAGRA against the Defendant."

This aspect of the applicant's case does not make a difference to my conclusion that the opposition succeeds under section 5(3) of the Act.

¹⁰ *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J: "80....It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

41. The opponent only needs to establish success under one type of damage. As its claim of unfair advantage has succeeded, I do not need to look at whether its claim of detriment to distinctive character also succeeds.

Outcome

42. The opposition succeeds under section 5(3) of the Act. The application is refused.

Other grounds

43. As I have found that the opponent has succeeded under section 5(3), there is no need for me to consider the other grounds of opposition.

Costs

44. The opponent has been successful and is entitled to a contribution toward the cost of the proceedings. The registrar normally awards costs from the published scale, as set out in Tribunal Practice Notice 4/2007. The applicant accepted in its counterstatement that the opponent has made use on, and has a reputation in, VIAGRA for pharmaceuticals for treating erectile dysfunction. The opponent's statement of use was made in respect of all pharmaceutical goods, but it clearly could not substantiate this claim. The opponent itself, in its written submissions, referred to the "large amount" of evidence which it had filed. I will cut down the evidence award because (i) the opponent did not need to file the amount of evidence it did because the applicant's acceptance of use and reputation did not require such a volume of evidence and (ii) the opponent should have been more realistic about the statement of use it made. I assess the cost award as follows:

Opposition fee	£200
Preparing a statement and considering the counterstatement	£300
Filing evidence and considering the applicant's evidence	£500
Written submissions	£300
Total	£1300

45. I order Ajanta Pharma Limited to pay Pfizer, Inc. the sum of £1300. 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 7th day of April 2014

**Judi Pike
For the Registrar,
the Comptroller-General**