TRADE MARKS ACT 1994

IN THE MATTER of application 2232168
by BioVex Ltd

and

IN THE MATTER of opposition thereto under no 51528
by Immunex Corporation

Background

1. On 11th May 2000 NeuroVex Ltd (the company later changed its name to BioVex Ltd) applied under the Trade Marks Act 1994 to register the mark IMMUNOVEX for the following specification of goods:

> Class 5:
> 'Vaccines for infectious diseases and cancer'.
>
> Class 10:
> 'Diagnostic apparatus; medical testing apparatus; medical apparatus and instruments; all relating to vaccines for infectious diseases and cancer'.
>
> Class 42:
> 'Medical and scientific research; discovery and design of pharmaceutical and therapeutic preparations; all relating to vaccines for infectious diseases and cancer and none of the aforesaid services relating to immunologic research and development'.

2. This was not the original specification of goods applied for; the specification above is an amended specification put forward during opposition proceedings.

3. The application was accepted and published. On 9th October 2000 Immunex Corporation ('the opponents') filed notice of opposition to the application. The sole ground of opposition is s. 5(2)(b). The opponents are the registered proprietors of UK registration 1483944 IMMUNEX, filed on 27th November 1991, with a specification which comprises:

> 'Pharmaceuticals; all included in Class 5'.

and a Community Trade Mark ('CTM') registration 241109 IMMUNEX, filed on 26th April 1996, with a specification which reads:

> Class 5
> 'Pharmaceuticals for the treatment of autoimmune diseases, healing wounds and cancer'.

Class 16
'Paper, cardboard and goods made from these materials, not included in other classes; printed matter, instructional and teaching material (except apparatus)'.

Class 42
'Immunologic research and development services for others'.

4. Both registrations are earlier trade marks for the purposes of an opposition based on s. 5(2)(b) (see s. 6(1)(a)). The grounds of opposition were denied in a counter statement filed on 4th January 2001. Both parties requested costs.

5. The matter proceeded through the evidence rounds and now stands to be decided on the basis of the papers on file as neither party has requested to be heard. As well as the evidence on file I have received written submissions dated 4th January 2002 from the opponents' agent, Mr. Ian Buchan of Eric Potter & Clarkson, which I will take into account in due course but first, as is customary, I will review the evidence.

THE EVIDENCE

6. For the opponents, Valoree Dowell (Vice President, Communications) of Immunex Corporation, and Dr. John William Ward have given evidence, both in the form of Witness Statements. Dr. Ward is currently a Consultant Clinical Pharmacologist to the University Hospitals of Leicester NHS Trust. He is registered as both a Pharmacist and a Physician with the relevant professional bodies.

7. For the applicants, Robert Coffin, the Research Director of BioVex has provided a Witness Statement.

The opponents' evidence

8. Miss Dowell says that the opponents have been using the IMMUNEX trade mark since 1988 in connection with research and development and the subsequent manufacture and sale of pharmaceutical compounds for a wide variety of diseases including oncology treatment. Exhibit EF1 comprises copies of slides used at a presentation at the Nasdaq European Life Sciences Forum in London in May 2000. The slides essentially show the growth potential and stages of development and approval of various products (marketed under trade marks such as ENBREL) involved in the treatment of various conditions including rheumatoid arthritis, multiple sclerosis and asthma, as well as 'pipeline opportunities' in the field of cancer. Exhibit EF2 is a series of press articles appearing in UK newspapers reporting on the opponents' activities in the biotechnology field, including forging links with UK companies to potentially commercialise human monoclonal antibodies for example. In 1991 it is reported that the company was expecting to receive a US patent for a product which boosts a cancer patient's white blood cells following chemotherapy or bone marrow transplant. The opponents are described as (Exhibit VD2) '..one of the largest biotechnology companies in America'.

9. Dr Ward's evidence takes the form of a response to Mr. Coffin's submission that the opponents' goods are different from the applicants goods. In particular, that the opponents are:

(a) not in the business of selling vaccines (which is the applicants' interest) and

(b) in the business of selling medicinal products used to treat rheumatoid arthritis, asthma and multiple sclerosis.

10. On these grounds the applicants' allege that their goods are not the same as the opponents. This matter is central to the s. 5(2) ground, and I deal with it below, under the similarity of goods issue. There is no doubt that Dr. Ward is a witness 'friendly' to the opponents. However, he does evince some significant expertise (see paragraph 1.1 of his Statement). He is very definite in relation to the similarities between the goods and services, but his views have not been challenged, and I must give them due weight.

The applicants' evidence

11. Robert Coffin says that the company chose the trade mark IMMUNOVEX because 'immuno' alludes to the immune system and 'vex' to vectors, being 'vehicles or constructs that contain genetic information and are used in the delivery of that genetic information to a cell'. He states that the term 'immuno' being in common use in the medical and pharmaceutical field and, when this is added to the difference between IMMUNEX and IMMUNOVEX, he does not consider them confusable. He says that the respective uses that the marks would be put to relate to products in different areas: the opponents do not produce vaccines. Confusion is unlikely with such specialised products and the fact that highly qualified people will be dealing with them. He also notes that the opponents provide no evidence of use of the trade mark IMMUNEX in a trade mark, rather than company name, sense. In respect of cancer, brand names such as NOVANTRONE, THIOPLEX and METHOTREXATE are used.

THE DECISION

12. The sole basis of the opposition is s. 5(2)(b), which reads:

'(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'.

13. Before addressing this issue it is worth remembering that consideration under s. 5(2)(b) assumes notional and fair use of the respective marks for the goods/services contained within the specifications. The protection granted to the opponents is that bounded by the limits of their specification of goods, not by what they may actually be trading in at a given time. This is important in such a case as a key plank of the applicants' defence appears to be that the opponents have no interest in vaccine treatment (which may explain the limitations, by way of amendment, in their specifications). However, this is

not the issue that s. 5(2)(b) raises: the Registrar will compare mark against mark and specification against specification, and that is what I must consider.

14. With this in mind, I need to set out the case law relevant to s. 5(2)(b). This is 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] ETMR 1 and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77. I will cite to these cases as they become pertinent to my decision.

15. It is clear from *Sabel* (page 224) that the likelihood of confusion under s. 5(2)(b) must be appreciated globally, taking account of all relevant factors. In *Canon* (page 7, paragraph 17) the ECJ indicated that this implied some interdependence between them, in particular the observed similarities between the marks themselves and the goods specified, such that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks (and *vice versa*).

16. That said, it has been recognised by the ECJ that s. 5(2), (Article 4(1)(b) of the Directive) requires that similarity between the goods/services at issue be demonstrated. In particular in *Canon* (paragraph 22) the court stated:

> 'It is however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.'

17. This implies some 'threshold' requirement for similarity of goods below which, confusion cannot be reasonably expected. This seems to be the point made by Mr. Hobbs QC, sitting as the Appointed Person in *Raleigh International* [2001] RPC 11, where he stated:

> 'Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under s. 5(2) must be to determine the net effect of the given similarities and differences.'

18. In order to assess the similarity of the goods, I note the test set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at page 296; one must consider:

    (a) the uses of the respective goods or services;

    (b) the users of the respective goods or services;

    (c) the physical nature of the goods or services;

    (d) the trade channels through which the goods or services reach the market;

(e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and

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

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

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

20. In the *Treat* Decision, Jacob J stated that the list above could only give general guidance, and I accept that all these factors may not be relevant to the goods and services at issue. However, I intend to apply those that are where the goods or services specified are argued to be similar: in this respect I do not regard the test in *Jellinek* (1946) 63 RPC 59 – referred to by Mr. Buchan - as now being good law.

The class 5 goods.

21. For the opponents Mr Buchan submits, in relation to the class 5 goods, that they are identical; that is, 'vaccines for infectious diseases and cancer' are encompassed within the term 'pharmaceuticals' in the opponents' UK registration, as well as being the same as 'pharmaceuticals for the treatment of autoimmune diseases, healing wounds and cancer' as in the CTM registration. I agree with this submission - the Class 5 goods are encompassed within the scope of the opponents' registrations. A vaccine is a pharmaceutical.

22. This conclusion is bolstered by the evidence of Dr. Ward, who has compared the parties' respective websites (Exhibit JWW1) and concludes that vaccines for infectious diseases and cancers are medicinal products which have the same or similar effects as the products marketed by the opponents and would be used in the same treatment area and are thus the same pharmaceutical goods. He previously notes that the strict regulatory approval regime makes no distinction between vaccines and non-vaccines.

23. It also appears to be the case that the applicants regard their products as a subset of pharmaceuticals. Their Class 42 specification refers to '..pharmaceutical and therapeutic preparations; all relating to vaccines..'. The Class 5 goods are identical.

The class 10 goods

24. The opponents contend that the goods in this Class are similar, both to the services in Class 42 and to the goods in Class 5. For ease of reference, I place them side by side:

Class 10: 'Diagnostic apparatus; medical testing apparatus; medical apparatus and instruments; all relating to vaccines for infectious diseases and cancer'.	Class 5: 'Pharmaceuticals for the treatment of autoimmune diseases, healing wounds and cancer'. (CTM registration) Class 42: 'Immunologic research and development services for others'.

25. Dr. Ward states:

> 'I note that Bio Vex are also intending to offer under their trade mark items of diagnostic and medical testing apparatus and medical and scientific research and diagnostic services. In my view these goods and services are inextricably linked with the pharmaceutical products themselves. It is possible to envisage that a physician could order diagnostic tests using diagnostic equipment for testing for the presence of an infectious disease or a cancer or for testing for the effect of a drug on that infectious disease or cancer. When ordering such tests he would have in mind a specific test or procedure. If, because of a confusion between similar names or similar tests and procedures, the wrong test was inadvertently applied by the technician or other person carrying out that test, then clearly there would be a risk of patient harm arising because under these circumstances the test would give a result which might mislead the physician in his further treatment of that patient.
>
> …..
>
> I am also of the view that the diagnostic apparatus, medical testing apparatus and medical and scientific research and diagnostic services are sufficiently related to the pharmaceutical products that if there is risk of confusion arising between the pharmaceutical products of Bio Vex and Immunex then there is a risk of confusion arising between the pharmaceutical products of Immunex and the apparatus and services of Bio Vex'.

26. Applying the relevant criteria espoused in *Treat*, I note that the physical nature of the items in Class10 and Class 5 are different: one is test apparatus, the other a pharmaceutical; the users, as the opponents point out, may be the same, i.e. doctors or nurses in hospital wards supplied by the hospital pharmacy and the channels of trade are the same, i.e. presumably purchasing officers in a hospital. I do not consider, unlike the opponents, however, that the purpose of the respective goods is the same. In a general sense it might be the treatment of patients with cancer – on that basis an oncology ward has the same purpose as an anti-cancer drug - but no one would say they are the same thing, or even similar. There is a danger in classifying goods at too high a resolution, as this can lead to absurd results.

27. It seems that the opponents' assertion of similarity in respect of the Class 10 goods derives its force largely from the fact that they are linked by the chain of handling the respective goods: hospital pharmacy, physician, cancer patient. These people are the same in the opponents' view; the same patient could be treated by the pharmaceutical products of the opponent as well the applicants' diagnostic test. The opponents also

note that their CTM registration covers immunological research and development services for others which would inevitably involve the use of diagnostic equipment such as that covered within the applicants' class 10 goods. As I understand the applicants' position, they do not dispute this; they simply say that their products are vaccines whereas the opponents' products are not. As I have stated, I am not convinced that the applicants' efforts to distinguish their products in terms of modality of treatment really helps their case, as my discussion of Class 5 goods demonstrates.

28. Then there is the evidence of Dr. Ward, who is convinced of the similarity between the Class 10 goods and those goods and services in the opponents' specifications. He is, in part, concerned about the dire clinical consequences of a confusion between the two marks in a medical context. In my view, this is not a matter for trade mark law. As Dr. Ward himself points out, there are very significant standards of safety which medicinal products must pass in the UK (paragraph 3.3 of his declaration): this is the proper forum for these issues – in my view such concerns are invisible to Trade Mark law. (For a more detailed discussion on this point, see Trade Mark Opposition Decision SRIS 0/414/01).

29. I think I must accept some degree of similarity between the opponents' goods and services, and the applicants' Class 10 goods. However, it is at the very limits of what can be described as similar goods, and very close to the 'threshold' beyond which confusion is unlikely.

The class 42 goods

30. The opponents' CTM covers 'immunological research and development services for others' in class 42, whilst the applicants' specification covers 'medical and scientific research; discovery and design of pharmaceutical preparations; diagnostic services; all relating to vaccines for infectious diseases and cancer.' I do not think it necessary to apply the *Treat* criteria in coming to the conclusion that I regard the applicants' services to be encompassed within the opponents'.

Summary of the similarity question

31. Having decided that the applicants' specification in its entirety is either the same or similar to the opponents' specification, I turn to a comparison of the respective marks.

The marks themselves; likely to confuse ?

32. I note from the case law that there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it (*Sabel* page 224); that is a mark with a significant reputation may attract greater protection than one without that reputation. I see little evidence that that is the case here with the opponents' mark. Mr. Coffin, on behalf of the applicants states:

> 'I have read the Witness Statements of Dr. John William Ward and Valoree Dowell lodged by the Opponents in these proceedings. It seems clear to me first of all that Immunex Corporation do not use IMMUNEX as a product name, rather if it is used as a Trade Mark at all, it is used as a House Mark. Thus, although Dr.

Ward states that Immunex Corporation do sell products for the treatment of cancer, the Trade Marks used for these products are e.g. NOVANTRONE, THIOPLEX and METHOTREXATE. Accordingly, no confusion would occur between the products in use, for example no confusion such as that described in paragraph 3.1 or 4.1 would occur. Indeed, Dr. Ward provides no evidence that IMMUNEX is used as a Trade Mark. It is apparently only used as a Company name'.

33. This supports my conclusion relating to the distinctiveness of the opponents' mark by reason of reputation on the marketplace. However, the fact that the mark is a 'house name' is irrelevant to the comparison under s. 5(2)(b); the opponents' rights in this matter rest on their registration, not on their use of the mark, or lack of it. If the applicants believe that the mark has not be used as a trade mark, they always have the recourse of revocation action under s. 46 of the Act.

34. Turning, now, to the marks at issue, the opponents have IMMUNEX and applicants want to register IMMUNOVEX. Mr Buchan submits that I should have regard to the following cases: *Aristoc Ltd v Rysta Ltd (1945) AC 68; Sabel BV v Puma AG [1998] RPC 199; Origins Natural Resources Inc v Origin Clothing Ltd [1995] FSR 280; Re: Smith Hayden and Co Ltd's Application (1946) 63 RPC 97 and Berlei (UK) Ltd v Bali Brassiere Co [1969] RPC 472.* He says that the *Aristoc* case teaches that the beginning part of a trade mark was generally the most important because, in the English language, speakers tend to slur the latter parts of trade marks. The other cases teach that when comparing two trademarks, it is the overall impression, length and appearance that matters, not a detailed dissection of the individual components. Insofar as these earlier UK cases are consistent with later ECJ jurisprudence then they still have relevance. However, nowadays it is established practice before the registrar that the ECJ cases listed above govern the approach to a comparison of conflicting marks under s. 5(2)(b). In particular, I note from *Sabel* and *Lloyd*:

- the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel* page 224), who is deemed to be reasonably well informed and reasonably circumspect and observant - but who 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* page 84, paragraph 27);

- the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel* 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* page 224).

35. The average consumer in this matter is typically a professional working in a hospital. As Mr. Coffin points out, this type of individual will be highly qualified – thus significantly raising the level of circumspection and knowledge over that that might be expected by a consumer in a supermarket.

36. Mr. Coffin states that the prefixes IMMUN- or IMMUNO- are extremely common in the medical field and exhibits print outs from the register to establish this (Exhibit RC1). Of course, the evidence from the Register tells me nothing of the extent to which these prefixes are used on the marketplace, and is thus, as a rule, considered irrelevant (see *Treat* at page 305). However, I accept that IMMUN or IMMUNO are fairly descriptive (of the immune system or immunity etc.) and this reduces the distinctiveness of the two signs overall.

37. Mr. Coffin states that the 'VEX' suffix in the applicants' mark alludes to 'vectors', drawing its conceptual meaning away from that of the opponents, but I see nothing to suggest that it would have that connotation or effect. I would need to be convinced by evidence that the average health professional would view VEX as a clear, or even allusive, reference to 'vectors'.

38. Visually and aurally, as Mr. Coffin argued, following from use of the common prefix, the marks are readily distinguishable given their endings - OVEX and -EX. Further, IMMUNOVEX clearly has more syllables. However, both marks share the same beginning and ending, the only difference being the extra 'OV' syllable in the middle.

39. In my own view, there is a conceptual link provided by the marks, largely by virtue of the IMMUNO- and IMMUNE- prefixes. However, the tendency to take this as a unique identifier of the opponents' sign – and thus potentially associate the applicants' mark with theirs - is somewhat cancelled out by the familiarity of meaning of the prefix.

40. From the perspective of aural confusion, it was established under the 1938 Act that the beginnings of words are more important in assessing similarity than the ends (*TRIPCASTROID* [1925] RPC 264 at page 279). I consider that this is a reflection of human perception and so is not an issue that changes because of a change in the law. Therefore, it seems to me that this view is equally valid under the 1994 Act.[1] In *TRIPCASTROID* the argument was founded on the tendency for people to slur the ends of words. In consideration of this, it would seem that the average consumer in this case would thus rely on latter part of the marks in distinguishing them, not the prefixes.

41. This leave me with the –OVEX and –X parts of the marks as differentiating features. I am left with the impression that, taking the marks as a whole and bearing in mind that side by side comparison cannot be taken for granted, that confusion is a likelihood in this matter, where the goods at issue are identical (Classes 5 and 42). However, I do not believe that this will be so for the goods in Class 10, in consideration of the experience of the 'average consumer' at issue. The differences in the marks, taken together with the knowledge of the latter, would be, in my view, be enough to obviate confusion in that case.

42. The applicants have been partly successful. However, for their application to proceed, they must amend their specification of goods removing those in Classes 5 and 42. If

[1] It is also a position that OHIM follows, for instance in decision no 1126/2000 - Official Journal 10/2000 at page 1506.

they do not file a TM21 within one month of the end of the appeal period for this decision restricting the specification as set out above the application will be refused in its entirety.

43. As to costs, the opponents have been mostly successful, and I order the applicants to pay them £200. This sum is to be paid within seven days 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 19th Day of April 2002.

Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General

TRADE MARKS ACT 1994

IN THE MATTER of application N$^{o.}$ 2232168
by BioVex Ltd

and

IN THE MATTER of opposition thereto N$^{o.}$ 51528
by Immunex Corporation

SUPPLEMENTARY DECISION

My written decision in these proceedings, dated 19th April, contained a clerical error. It has been brought to my attention that the cost figure I awarded was incorrect. The necessary power to correct this is provided I believe by Part 40.12(1) of the Civil Procedure Rules which states:

> '40.12 - (1) The court may at any time correct an accidental slip or omission in a judgement or order.'

I therefore correct the final paragraph of my written decision in these proceedings to read as follows:

> 'As to costs, the opponents have been mostly successful, and I order the applicants to pay them £1100. This sum is to be paid within seven days 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 27 day of May 2002

Dr W J Trott
Principal Hearing Officer
For the Registrar
the Comptroller-General