

**IN THE MATTER OF INTERNATIONAL (UK) TRADE MARK REGISTRATION
NO. 725794 IN THE NAME OF PASTEUR MERIEUX MSD
S.N.C AND AVENTIS PASTEUR MSD S.N.C AND APPLICATION FOR A
DECLARATION
OF INVALIDITY NO. 16025 BY H.LUNDBECK A/S**

TRADE MARKS ACT 1994

**IN THE MATTER OF International (UK) Trade Mark Registration
No. 725794 in the name of Pasteur Merieux MSD S.N.C. and Aventis Pasteur MSD
S.N.C. and Application for a Declaration of Invalidity No. 16025
by H.Lundbeck A/S**

BACKGROUND

1. On 19 July 1999 Pasteur Merieux MSD S.N.C. and Aventis Pasteur MSD S.N.C. (the applicants) applied to protect the mark MENIVACT in the United Kingdom in Class 5 under the provisions of the Madrid Protocol, on the basis of a registration in France for the following specification of goods:

Class 5 - Pharmaceutical products, vaccines

2. The application was accepted and was protected in the United Kingdom on 31 December 1999. On 28th May 2002, H. Lundbeck A/S, (the 'applicant') filed an application for a declaration of invalidity of the registration. The statement of grounds accompanying the application can be summarised as follows:

- a. The applicant is the registered proprietor of Community Trade Mark Registration no.733329 for MENITAC, covering goods in Class 5, the registration has a filing date of 27 January 1998.
- b. International registration No.725794 should be cancelled under the provisions of Section 47(2)(a) of the Trade Marks Act 1994, on the grounds that the marks are similar, and the goods claimed are identical or similar to the goods used in the applicant's earlier trade mark. Therefore, there exists a likelihood of confusion on the part of the public including the likelihood of association with the earlier trade mark.
- c. In comparing the marks, both contain the identical four letter string MENI-. The marks both contain the letters AC and T and both end in a phonetically similar - ACT and AC. Therefore it is contended that the two marks are similar, visually, phonetically and, to the extent they have no meaning, conceptually.
- d. In relation to the goods, these are identical given that the goods of the earlier right are wholly contained within the specification of registration 725794 or if not it is contended that >pharmaceutical preparations acting on the Central nervous System= are very similar to both >pharmaceutical products= and >vaccines=. All of these products have the same trade channels, the same trade outlets and the same end users.

- e. The applicant seeks to invalidate trade mark 725794 and seeks an award of costs.

3. The registered proprietors did not file a Form TM8 and counter-statement under rule 33(2) of the Trade Marks Rules 2000 to defend their registration.

4. The applicant for invalidity filed evidence in support of their application on 21 August 2002. A hearing was offered but no request was made and therefore this decision is taken from the papers on file.

Applicants' Evidence

5. This consists of a witness statement dated 20th August 2002 and three exhibits by Stephen Richard James a registered trade mark attorney and a partner of R.G.C.Jenkins & Co, the applicants=trade mark attorneys.

6. Details of the applicants' earlier registration, CTM registration no 733329, are exhibited at exhibit SRJ1. The details take the form of a printout from the Office for Harmonisation in the Internal Market website.

7. Exhibited at SRJ2 are copies of three decisions taken from the OHIM website, in which trade marks PLATIGREN and PLATAGEN, URAPLEX and URATEX, and EUCERIN and EUDERMIN were viewed by that office as confusingly similar. Mr James contends that in each case any differences seen between the marks lay in the middle or end of the marks.

8. Exhibited at SRJ3 is an appeal board decision in Glaxo Group Ltd v Medrel GmbH whereby the marks TEMPOVATE and EMOVATE were viewed as confusingly similar, and the appeal board comment on the criteria that should be followed when comparing marks. The relevant comments are set out in paragraph 51 of the decision. Also exhibited at SRJ3 is an earlier registry decision in PRURIDERM TM (1985 RPC 187) and a High Court decision in Pfizer v Eurofood (2000 ETMR 187).

9. Mr James, when comparing the two marks, states the following points should be borne in mind:

- \$ The possible adverse consequences which could flow from confusion which, in the case of pharmaceutical products, could be particularly dangerous.
- \$ The identity of Class 5 products in issue which may offset any perceived lesser degree of similarity between the two marks.
- \$ MENITAC is an earlier trade mark with a highly distinctive character leading to a broader area of protection in terms of what constitutes a similar trade mark.
- \$ The lack of meaning of the two marks which means that the prefix MENI- is extremely strong and distinctive in trade mark terms, which should mean greater likelihood of confusion between the two marks.

10. This concludes the summary of the applicants' evidence.

LAW

11. Section 47(2)(a) provides:

*“(2) The registration of a trade mark may be declared invalid on the ground –
(a) that there is an earlier trade mark in relation to which the conditions set
out in section 5(1), (2) or (3) obtain,”*

12. As the respective marks are not identical, I must assume that the applicant, in turn, relies on section 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. I should also confirm that the applicants' trade mark, CTM 733329, having a filing date of 27th January 1998, is an earlier trade mark in accordance with section 6(1)(a).

APPLICATION OF THE LAW

14. Despite having been notified of the application for invalidity the action has been uncontested by the registered proprietor. It does not follow that the uncontested nature of the action will automatically lead to a successful application for invalidity. The onus is on the applicant for invalidity to prove why the registration should be declared invalid.

15. I am mindful of the decision in the Firetrace Case [2002] RPC 15, where the hearing officer stated:

“It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”@

16. The reason that the hearing officer arrived at this view is the statutory presumption in section 72 of the Act which states:

“In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade

mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it. @

17. With this in mind, I now turn to consider whether the statement of grounds and evidence provided by the applicant is sufficient, prima facie, to allow the application for invalidity.

18. The European Court of Justice has identified a number of factors relevant in finding a likelihood of confusion. I will rely on the following factors in this case:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors, *Sabel BV v Puma AG* [1998] ETMR 1 para 22;
- (b) the matter must be judged through the eyes of the average consumer who rarely has the chance to make direct comparisons between marks and must instead rely on an imperfect picture he has kept in his mind, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77 para 27;
- (c) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, *Sabel v Puma* para 23;
- (d) 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 v Puma* para 24.

Comparison of goods

19. The applicants' specification is "pharmaceutical preparations acting on the central nervous system". The goods of the registration are "pharmaceutical products, vaccines". So, insofar as the goods of the registration include pharmaceutical preparations acting on the central nervous system, the goods are identical. Plainly, however, the specification of the registration is far broader than the applicants' specification. The applicant says that if identity is not accepted, then the goods of the registration are nevertheless similar in that they have the same channels of trade, the same outlets and the same end users. On a prima facie basis I accept this submission. I should add that I have no reason to suppose that either the applicants' protection, or the goods of the registration, are limited to prescription only pharmaceuticals. I must assume that the notional coverage of both trade marks takes in both 'over the counter' medicines and prescription only. On a prima facie basis, then, I regard the goods of the registration as identical to or similar to those of the applicant's earlier trade mark.

Comparison of the marks

20. The applicant has directed me to a number of decisions from the OHIM website. Likelihood of confusion has been found in *PLATIGREN* and *PLATAGEN* (Decision 435/2000), *URAPLEX* and *URATEX* (Decision 2470/2001), and *EUCERIN* and *EUDERMIN* (Decision 108/1999). The OHIM Appeal Board Decision in Case R 1178/2000-

1 (EMOVATE and TEMPOVATE) has also been referred to. In the present case there is, in my view, a high level of phonetic similarity as the first two syllables are exactly the same and the endings can also sound very similar. As an ending, 'VACT' is quite easily confused with 'TAC' as the final 'T' in 'VACT' is apt to be blurred or omitted altogether. Visually, the marks are also very similar, particularly so on the basis of average consumers' imperfect recollection. Finally, and most tellingly in this particular case, I believe MENITAC is an inherently strong mark. Because of the apparent absence of any descriptive reference or allusion to the goods, the term MENITAC is apt to be regarded as an invented word. I agree with the applicants that the term 'MENI', in particular, has inherent trade mark strength in relation to the goods, (see factors (c) and (d) in para 18 above). So, taking account of imperfect recollection and the inherent strength of the applicants' mark I find that, prima facie, the applicants have established that the respective marks are similar.

21. My findings above apply whether the 'average consumer', spoken of in factor (b) of para 18 above, is a health professional or a purchaser of medicines over the counter.

Global assessment

22. Taking global account of the relevant factors I have identified (see factor (a) in para 18 above), I have come to the view that there is a prima facie likelihood of confusion under section 5(2)(b).

Conclusion

23. I conclude that the registration shall be declared invalid and deemed never to have been made in accordance with section 47 of the Act, adapted by Article 13 of The Trade Marks (International Registration) Order 1996 as amended.

Costs

24. The applicant has requested costs. I would like to deal with this in a supplementary decision and invite both parties to make written submissions on costs within one month from the date of this decision.

Dated this 02 day of April 2003.

Edward S Smith

**Acting for the Registrar
The Comptroller General**