

## TRADE MARKS ACT, 1996

### Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 214594 and in the matter of an Opposition thereto.

YAMANOUCHI EUROPE B.V. Applicant

ALMIRALL-PRODESFARMA S.A. Opponent

#### **The application**

1. On 9 July, 1999, Yamanouchi Europe B.V., a Besloten Vennootschap organised and existing under the laws of the Kingdom of the Netherlands of Elisabethhof 19, 2353 EW Leiderdorp, The Netherlands made application (No. 1999/02303) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the word ASAMAX as a Trade Mark in Class 5 in respect of *pharmaceutical preparations and medicines, all for human use*.
2. The application contained a claim, under Section 40 of the Act, to a right of priority on the basis of an application for registration filed on 28 January, 1999 at the Benelux Trade Mark Office, the registration authority for the combined territory of Belgium, the Netherlands and Luxembourg.
3. The application was accepted for registration and advertised accordingly under No. 214594 in Journal No. 1889 on 3 May, 2000.
4. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 27 July, 2000 by Almirall-Prodesfarma S.A. of Ronda del General Mitre, 151, 08022 Barcelona, Spain. The Applicant filed a counter-statement on 2 November, 2000 and evidence was, in due course, filed by the parties under Rules 20, 21, 22 and 23 of the Trade Marks Rules, 1996.

5. The Opposition became the subject of a Hearing before me, acting for the Controller, on 3 July, 2006. The parties were notified on 5 September, 2006 that I had decided to dismiss the opposition and to allow the mark to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat.

### **Notice of Opposition**

6. In its Notice of Opposition the Opponent states that it is the proprietor of the trade mark ALMAX which it has used in relation to pharmaceutical preparations and related goods and which is registered as a Community Trade Mark under No. 387175 in Class 5 in respect of a special pharmaceutical product used for neutralising gastric hyperacidity. It then raises objection against the present application under the following Sections of the Act:

- Section 8(1)(b) – *mark devoid of any distinctive character,*
- Section 8(3)(b) – *mark of such a nature as to deceive the public,*
- Section 8(4)(a) – *use of mark prohibited by enactment or rule of law,*
- Section 8(4)(b) – *application for registration made in bad faith,*
- Sections 10(1) and 10(2) – *likelihood of confusion on the part of the public,*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of Opponent's mark,*
- Section 10(4)(a) – *use of mark liable to be prevented by virtue of rule of law protecting an unregistered trade mark,*
- Section 6(1) – *mark not a trade mark within the statutory definition,*
- Sections 37(2) and 42(3) – *Applicant does not use or intend to use mark in relation to goods covered by application.*

### **Counter-Statement**

7. In its Counter-Statement the Applicant denies each and every one of the grounds of opposition raised against the application and admits only that the Opponent is the proprietor of Community Trade Mark No. 387175 but it does not admit the validity of that registration.

## The evidence

### *Rule 20*

8. Evidence filed by the Opponent under Rule 20 consisted of a Statutory Declaration (and 3 exhibits) dated 20 September, 2001 of Manuel Bellostas Sanchez and Manuel Lopez Gonzalez, legal representatives of the Opponent, who state as follows:

- (i) The Opponent was founded in 1943 and is a leading company in the pharmaceutical industry, concentrating for the most part on the development of new therapeutic agents affecting the regulation of gastrointestinal motility – *extract from the industry publication “Promoting Production” exhibited, in which the Opponent is identified as the market leader in the Spanish pharmaceutical industry.*
- (ii) In addition to its Community Trade Mark Registration No. 387175 dated 12 November, 1996, the Opponent has registered the mark ALMAX in a number of European countries including Ireland<sup>1</sup>.
- (iii) The Opponent’s mark ALMAX is well known and has been acknowledged as a well-known mark by the Spanish Patent and Trade Mark Office in a Resolution dated 14 December, 1995 in the matter of AMVAX –v- ALMAX – *copy of a translation of the decision in question exhibited.*

### *Rule 21*

9. Evidence filed by the Applicant under Rule 21 consisted of a Declaration (and Exhibit YE1) dated 21 August, 2002 of J.A. de Heus and J.W. Schotel, officers of the Applicant company. Those persons state as follows:

- (i) There are numerous trade marks in Class 5 containing the suffix “MAX” - *results of a search of the Irish Register exhibited.*

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<sup>1</sup> Registration No. 115135 dated 10 April, 1995

- (ii) The Applicant's trade mark ASAMAX already co-exists with the Opponent's ALMAX on the Trade Mark Registers of a number of countries, including Benelux, Greece, Germany, France and Italy.

*Rule 22*

10. Evidence filed by the Opponent under Rule 22 consisted of a Statutory Declaration dated 7 March, 2003 of Jorge Salvat Filomeno and Manuel López Gonzalez, legal representatives of the Opponent, which does not, in my opinion, contain any additional relevant facts but questions the Applicant's claim to have registered its trade mark in Germany.

*Rule 23*

11. Evidence filed by the Opponent under Rule 23 consisted of a Declaration dated 16 October, 2003 of C.J.C. Laurent and J.W. Schotel, officers of the Applicant company, who respond to the Opponent's evidence under Rule 22 by exhibiting details of the Applicant's International Registration No. 711484 for the trade mark ASAMAX, which they say has been extended to Germany.

**The hearing**

12. At the Hearing the Applicant was represented by Ms. Carla MacLachlan, Trade Mark Agent of MacLachlan & Donaldson. The Opponent was not represented.

**The issue**

13. While a wide range of grounds of opposition to the registration of this mark have been cited in the Notice of Opposition, most of these have not been supported by any evidence or argument whatsoever. That is certainly the case in respect of the objections under Sections 6, 8, 37 and 42 of the Act I find it unnecessary to do more than say that the opposition under those Sections is dismissed as unsubstantiated.

14. As to the objections under Section 10, the case under subsection (1) of that Section cannot stand as the opposed mark is clearly not identical with the earlier mark cited by the Opponent. With regard to the objection under subsection (3) of section 10, the only evidence filed in support of the Opponent's claim that its

earlier mark enjoys a reputation in the Community appears to be the decision of the Spanish Trade Mark Office dated 14 December, 1995 referred to at paragraph 8(iii) above. In the absence of any information as to the basis on which that decision was reached, I cannot accept it as a statement of fact for the purposes of the present proceedings and I am left to conclude that the Opponent has not established that its mark enjoys the requisite reputation to ground the objection under Section 10(3). Turning, lastly, to the objection under subsection (4) of Section 10, again the Opponent has filed no evidence to suggest that its mark has been used or is known in the State and it cannot, therefore, claim that it could prevent the use of the Applicant's mark through an action for passing off.

15. Of all of the grounds raised in the Notice of Opposition, it is the case, therefore, that a *prima facie* case exists only in respect of the ground raised under Section 10(2) of the Act and that is the only ground of opposition that requires detailed consideration and determination. I address that ground of opposition below.

***Section 10(2)(b) – is there a likelihood of confusion on the part of the public?***

16. Section 10(2)(b) of the Act reads as follows:

*“A trade mark shall not be registered if because –*

*.....*

*(b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.”*

17. The question of whether a likelihood of confusion exists as between two trade marks must be appreciated globally, taking into account all factors relevant to the circumstances of the case<sup>2</sup>, including the extent of the similarity between the respective marks and the respective goods, the degree of distinctiveness of the

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<sup>2</sup> European Court of Justice in *Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV* (Case C-342/97) paragraph 18

earlier mark, the nature of the goods in question and the likely perception of the average consumer of those goods. For the purposes of this decision, I have found it useful to first look at each of these factors individually before attempting a global assessment of the likelihood of confusion.

*The respective marks*

18. The marks in question are ALMAX and ASAMAX. On a visual comparison, those words are similar insofar as they have 4 letters in common and those letters are arranged in the same order in each word. In addition, each word begins with the same letter and each ends with the combination MAX. While there is a visual difference between the L in the earlier mark and the SA in the mark put forward for registration, that difference is not particularly striking because of where the respective elements appear in the marks. Aurally, the marks are somewhat similar because of the MAX sound but the opening parts of the marks are clearly different, AL or ALL (depending on pronunciation) in the one case and ASA in the other. On an overall phonetic comparison, it may be noted that the Applicant's mark consists of two syllables only while the Opponent's has three. Conceptually, the MAX element of each mark is likely to evoke the concept of "maximum" but, since neither word in its entirety has any specific meaning, I think it fair to say that the marks are neither similar nor dissimilar from a conceptual aspect. On an overall assessment and having regard to the overall impression created by the respective marks, I would say that they are more than moderately similar but not highly similar.

*The respective goods*

19. The Opponent's earlier Community Trade Mark is registered in Class 5 in respect of "*a special pharmaceutical product used for neutralising gastric hyperacidity*". The goods of the present application are as set out at paragraph 1 above, viz., pharmaceutical preparations and medicines, all for human use in Class 5. The latter specification of goods must be seen as including the specific pharmaceutical product in respect of which the Opponent's mark stands registered, namely, a product for neutralising gastric hyperacidity. For that reason, the respective goods must be treated as identical and the assessment of the likelihood of confusion must

be made in the context of the specific product for which the earlier mark is registered.

*Distinctiveness of the earlier mark*

20. It is established that the more distinctive a mark is, whether inherently or because of the use made of it, the more likely it is that there will be confusion if a similar mark is subsequently used in relation to similar goods<sup>3</sup>. In the present case, the Opponent's mark ALMAX is an invented word and, as such, must be regarded as inherently distinctive. I cannot ascribe to it any additional factual distinctiveness that it may have acquired through use as the Opponent has not provided me with any details of the extent of the use that has been made of the mark in this jurisdiction (e.g., sales and promotional figures)

*The circumstances of the trade and the average consumer*

21. Gastric hyperacidity, whether chronic or acute, is, I suspect, a relatively common ailment and one in respect of which sufferers may be expected to have regular recourse to pharmaceutical treatments. I have no evidence before me as to whether such products are available on prescription only, over the counter at pharmacists or openly available through supermarkets and the like. However, neither the goods of the earlier trade mark or those of the application for registration are limited to prescription-only pharmaceuticals and I think it would be wrong, therefore, to factor in an element of professional involvement in the normal purchasing scenario. I have decided to assume, rather, that the goods in question will be purchased directly by the end consumer without the assistance or intervention of a doctor or pharmacist. That leads to the assumption of a higher risk of confusion than would otherwise be the case as a doctor or pharmacist may be expected to exercise particular care in the dispensing of medicines. Nevertheless, the very nature of the goods themselves is a significant factor in reducing that risk as the average person must be expected to consider carefully whether or not to purchase a particular pharmaceutical product and not to simply purchase such goods *willy nilly* by reference solely to brand name.

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<sup>3</sup> European Court of Justice in Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) paragraph 24

*Likelihood of confusion*

22. Having regard to the factors that I have outlined above, I have come to the conclusion that, notwithstanding the admitted similarities between the respective trade marks, there is not a likelihood of confusion on the part of the public such as would warrant refusal of the application for registration. In my opinion, the trade marks are not so close in terms of their appearance or pronunciation as to suggest that they are likely to be confused by the average person exercising the care that may be expected of someone choosing a pharmaceutical product. Everyone knows that such products must be chosen with care and I do not find it plausible to think that the average person would be inclined to select a pharmaceutical product on the basis of his recollection that its name was “*something MAX*” or even “*A something MAX*”. Even allowing for imperfect recollection, nevertheless, the words ASAMAX and ALMAX are not so similar, on an overall assessment, as to be likely to be mistaken one for the other. In making that assessment, I have had regard to the fact that the opening parts of word trade marks tend to be of greater importance in creating their overall identity and the fact that there are clear differences between the opening parts of the marks in this case is sufficient, in my view, to sway the argument in favour of acceptance of the application, albeit that it is a close call.

23. For the reasons that I have outlined I have decided to dismiss the opposition and to allow the mark to proceed to registration.

Tim Cleary

acting for the Controller

26 September, 2006