

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 224269 and in the matter of an Opposition thereto.

ROWEX LTD.

Applicant

MERCK & CO. INC

Opponent

Application for registration

1. On 2 May, 2002, Rowex Ltd., an Irish company of Newtown, Bantry, Co. Cork made application (No. 2002/00937) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the word AVASTAT as a trade mark in respect of goods in Class 5, namely, *“pharmaceutical preparations and substances”*.
2. The application was accepted for registration and advertised accordingly under No. 224269 in Journal No. 1951 on 18 September, 2002.
3. Notice of opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 16 December, 2002 by Merck & Co. Inc, a corporation organised and existing under the laws of the State of New Jersey, United States of America of One Merck Drive, P.O. Box 100, Whitehouse Station, New Jersey, United States of America. The Applicant filed a counter-statement on 5 March, 2003 and evidence was subsequently filed by the parties under Rules 20 and 21 of the Trade Marks Rules, 1996 (“the Rules”).
4. The matter became the subject of a Hearing before me, acting for the Controller, on 16 November, 2006 following which the Applicant requested that the specification of goods be amended to read *“prescription only pharmaceutical preparations and substances for the treatment of hypercholesterolaemia”*. That amendment was accepted and advertised in Journal No. 2061 on 13 December, 2006 and the Opponent was notified accordingly pursuant to rule 26(1)(i). On 4

January, 2007, the Opponent informed the Controller pursuant to Rule 26(1)(ii) that it maintained its opposition to the application, notwithstanding the amendment.

5. On 31 January, 2007 the parties were notified 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 in response to a request by the Opponent in that regard pursuant to Rule 27(2) filed on 20 February, 2007.

Scope of the opposition

6. The opposition is based on the Opponent's proprietorship and use of the trade mark AGGRASTAT, which is registered as of 17 July, 1995 under No. 171450 in respect of goods in Class 5, namely, "*pharmaceutical preparations; dietetic substances adapted for medical use; pharmaceutical preparations for the treatment of cardiovascular disorders; disinfectants; all included in Class 5*". On the basis of that registration and its use of the trade mark AGGRASTAT, the Opponent raises objection against the present application under Section 10 of the Act, specifically Section 10(2)(b) and Section 10(4)(a). The notice of opposition includes grounds of opposition under other sections of the Act also but none of these has been particularised or substantiated in any way and I am satisfied that they may simply be disregarded.

The evidence¹

Rule 20

7. Evidence submitted by the Opponent under Rule 20 consisted of a statutory declaration (and Exhibits DSG1-DSG6), dated 20 May, 2004 of Debra A. Shelinsky Greene, its Assistant Counsel, Trade Marks and Copyrights. She says that,
 - the trade mark AGGRASTAT is used in respect of a pharmaceutical product, typically a concentrate for solution for infusion, used in the treatment of small heart attacks and unstable angina, which was launched in the State in October,

1999 and which contains the active ingredient tirofiban hydrochloride, an agent that prevents blood clots from forming, thereby reducing the risk of heart attack and the need for heart surgery,

- sales of goods under the trade mark in the period October, 1999 to December, 2002 amounted to approximately €85,000,
- approximately €132,000 was spent on advertising and making the mark known in the State in the period October, 1999 to May, 2004.

Rule 21

8. Evidence submitted by the Applicant under Rule 21 consisted of a statutory declaration (and Exhibit BW-H1) dated 8 March, 2005 of Brigitte Wagner-Halswick, its Managing Director and a statutory declaration (and Exhibit AR1) dated 1 March, 2005 of Alison Ryan, Trade Mark Agent of Anne Ryan & Co.

9. Ms. Wagner-Halswick says that,

- the Applicant intends to use the trade mark AVASTAT in connection with an anti-cholesterolaemic drug, hence the use of the suffix STAT, as in LIPOSTAT, which is also in the general category of statin drugs,
- the product to be sold under the mark will be in tablet form and not in the form of a solution for infusion and will be intended for long term use, as is common with anti-cholesterolaemic/anti-lipidaemic drugs.

10. Ms. Ryan says that she carried out a search of the Register of Trade Marks for trade marks in Class 5 having the suffix STAT, which disclosed 52 such marks, 13 of which were indicated as having been removed or withdrawn.

¹ review of the evidence confined to matters or relevant fact or claimed fact

The hearing and amendment of the application

11. At the hearing the Applicant was represented by the aforementioned Ms. Ryan. The Opponent chose not to attend or to be represented.

12. As well as referring to the visual and aural differences between the trade marks created by the V in AVASTAT as opposed to the GGR in AGGRASTAT, Ms. Ryan denied that there was any likelihood of confusion between them primarily on the basis of the fact that the goods in respect of which each is used or intended to be used are prescription-only drugs, which are prescribed and dispensed by skilled professionals exercising particular care. When I pointed out that the specification of goods covered by the application for registration was not confined to prescription-only drugs and could include common analgesics sold through general retail outlets, Ms. Ryan stated that it was clear from the evidence that neither the Applicant nor the Opponent used or intended to use its trade mark on such products. She further stated that the Applicant would restrict its specification of goods to make it clear that registration of its trade mark was sought only in respect of goods that would pass through the hands of persons under an obligation to exercise proper care, such that any likelihood of confusion with the Opponent's goods that might otherwise be said to exist would be obviated. As indicated in paragraph 4 above, the specification was subsequently restricted to prescription-only hypercholesterolaemia drugs.

Grounds of decision

Section 10(2)(b) – likelihood of confusion

13. Section 10(2)(b) of the Act prohibits the registration of a trade mark if, because it is similar to an earlier trade mark and would be registered for goods or services in respect of 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. Whether or not a likelihood of confusion exists in any given case must be determined, not in the abstract, but by reference to the practical realities of trade in the goods at issue. There is, therefore, no absolute standard against which a likelihood of confusion can be measured because the perceptions and behaviour of consumers necessarily differ from one area of commerce to the next. Thus, the European Court of Justice

(ECJ) has indicated in *Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV* (Case C-342/97) that “*the average consumer’s level of attention is likely to vary according to the category of goods or services in question*”. In the case of goods of the kind covered by the present application for registration, namely prescription-only pharmaceuticals, the level of attention that may be expected to be applied by the persons to whom such goods are directed is very high indeed. In *Sterwin A.G. v Brocades (Great Britain) Ltd.*, [1979] RPC 481, Whitford J observed that,

“When a drug is available only on prescription, confusion, if it is going to arise, is only going to arise among doctors and pharmacists. Doctors and pharmacists are trained to take very great care in their work and, in cases of doubt, to check before acting.”

14. While the evidence shows that the Opponent’s earlier trade mark has been used only in relation to a drug used in the hospital environment for the management of acute heart conditions, nevertheless it is protected, for the purposes of Section 10(2)(b), for all of the goods falling within the specification of the registration. That specification must be seen as including pharmaceuticals for the treatment of chronic hypercholesterolaemia, i.e., the very product in respect of which the Applicant seeks registration of its trade mark. For the purposes of the assessment of the opposition under Section 10(2)(b), it is necessary, therefore, to assume a notional fair use by the Opponent of the trade mark AGGRASTAT in respect of a drug for the treatment of hypercholesterolaemia and to consider whether confusion would be likely if the trade mark AVASTAT were also used in relation to such a drug, available only on prescription.
15. Having regard to the fact that the persons to whom the prescription and dispensing of such drugs is entrusted are doctors and pharmacists, respectively, it is necessary to consider the likely impact of the respective marks on the minds of persons in those professions to determine whether they are sufficiently similar as to render confusion likely. In this regard, I think it is correct to say that doctors and pharmacists must differ from the average person in terms of their behaviour as “consumers”, not only in the level of attention that they pay to the “selection”

(prescription and dispensing) of goods, but also in the way in which they perceive and interpret word trade marks as used in relation to the category of goods with which they are concerned, i.e. pharmaceuticals generally. It is quite common for such words to be derived from, or to make oblique reference to, the nature of the drugs on which they are used, very often suggesting their active ingredients. This is a phenomenon familiar even to non-medical persons from our exposure to common analgesics such as DISPIRIN (aspirin), NUROFEN (ibuprofen) and SOLPADEINE (paracetamol and codeine). It seems to me that doctors and pharmacists, being constantly exposed to pharmaceutical trade marks and having specific knowledge of generic or non-proprietary drug names, would be apt to subconsciously analyse product names and to subliminally assimilate the information conveyed or suggested by them. They would, in my opinion, constitute an exception to the general rule that the average consumer normally perceives a trade mark as a whole and does not analyse its various details².

16. As regards the present case, I note that an extract from the February, 2005 edition of MIMS Ireland (Monthly Index of Medical Specialities) exhibited with the statutory declaration of Ms. Wagner-Halswick, filed as Applicant's evidence under Rule 21, contains, in the section entitled "Circulatory System, Hypercholesterolaemia – Lipidaemic", five entries in respect of drugs that are described as "statins", having active ingredients including fluvastatin, atorvastatin and pravastatin. The products in question are LESCOL XL, LIPITOR, LIPOSTAT, PRAVAMEL and PRAVITIN. Although only one of those product names contains the suffix STAT, nevertheless, I infer from the exhibit in question that statins are an established category of drugs used in the treatment of hypercholesterolaemia. In light of that fact, I take the view that a doctor of pharmacist encountering a drug intended for that purpose and having the suffix STAT in its brand name would make the assumption that the drug in question is another in that category. For this reason, I believe that the suffix STAT, whether in AGGRASTAT or AVASTAT, would convey as much about the nature of the drug in question as about its commercial origin. I would not accept, therefore that confusion of the kind with which the law on trade marks is concerned would be

² para 25 of ECJ decision in Case C-342/97, *Lloyd*, supra

likely to arise between the trade marks AGGRASTAT and AVASTAT used in relation to these particular drugs by reason only of the fact that each contains the suffix STAT.

17. Of course, the marks in question have more than just the suffix STAT in common. Each starts with the letter A and each has three syllables, all of which have the same sound, giving the words an identical aural progression. They are certainly words that would be likely to be confused with each other if anything less than special care is given to the way in which they are written or spoken. But special care must be expected to be taken by the persons concerned in this case and it cannot be said that the words are indistinguishable even if such care is taken. The letters V and G are noticeably visually different, whether in upper or lower case and the double G in the Opponent's mark accentuates that difference. The opening parts of the respective words sound somewhat different also and, while it could be argued that they are still susceptible of confusion through mishearing, that is hardly a practical likelihood in the context of prescription-only medicines.
18. On an overall assessment, I think that the fact that the mark seeking registration is to be used only in relation to prescription-only pharmaceuticals of the specific kind identified by the Applicant is sufficient to sway the balance of probabilities in favour of allowing the application to proceed to registration. The degree of care in prescribing and dispensing pharmaceuticals of that nature, together with the likely perception that the persons concerned would have of the respective product names, makes it unlikely that confusion would arise between them in practice. I would accept that the matter is not clear-cut and that the possibility of confusion cannot be ruled if sufficient care is not taken, but a likelihood of confusion should not be inferred on the basis that people who are under a strict duty of care may not always perform to the standard expected of them. For these reasons, I have decided that the objection under Section 10(2)(b) of the Act should not succeed.

Section 10(4)(a) – use liable to prevented by virtue of law of passing off

19. Section 10(4)(a) of the Act prohibits the registration of a trade mark the use of which is liable to be prevented by virtue of any rule of law protecting an

unregistered trade mark or other sign used in the course of trade, in particular the law of passing off. In order to succeed in its objection under this Section, the Opponent must show that, as of the date of filing of the present application for registration, it had established a reputation or goodwill under its trade mark AGGRASTAT such that the use by the Applicant of the mark put forward for registration in relation to any of the goods covered by the application would have constituted a misrepresentation to the relevant consumers as to the origin of those goods, leading or likely to lead to damage to the Opponent. The evidence adduced by the Opponent is to the effect that its trade mark has been used in relation to a drug for the treatment of small heart attacks and unstable angina, which operates by inhibiting the blood's natural tendency to clot. That is a very different kind of drug to that in respect of which the Applicant seeks registration of its trade mark and I cannot imagine that the use of the Applicant's mark on a cholesterol reducing drug would cause the skilled professionals to which the relevant products are directed to infer any connection whatsoever between that product and that of the Opponent. To my mind, there is no likelihood of any misrepresentation occurring or, therefore, of any damage being caused to the Opponent. Accordingly, I dismiss the opposition under Section 10(4)(a) of the Act also.

Tim Cleary
Acting for the Controller

2 March, 2007