TRADE MARKS ACT 1938 (AS AMENDED) AND THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION **m** 1582474
BY DALLAS BURSTON ASHBOURNE LIMITED
TO REGISTER THE MARK **DICLOTARD** IN CLASS 5

AND

IN THE MATTER OF OPPOSITION
THERETO UNDER OPPOSITION **m** 42375
BY WARNER-LAMBERT COMPANY

TRADE MARKS ACT 1938 (AS AMENDED) AND THE TRADE MARKS ACT 1994

IN THE MATTER of trade mark
application **m**1582474 by Dallas Burston Ashbourne Ltd

and

IN THE MATTER of opposition
thereto under opposition **m** 42375
by Warner-Lambert Company

DECISION

Dallas Burston Ashbourne Ltd applied on 22 August 1994 under section 17(1) of the Trade Marks Act 1938 to register the mark DICLOTARD in class 5 in respect of:

"Pharmaceutical preparations and substances; all included in Class 5."

Following advertisement for opposition purposes, the application was opposed by Warner-Lambert Company (hereafter "Warner-Lambert").

I summarise the grounds of opposition as follows:-

- Sections 9, 10 - The mark applied for lacks the distinctiveness required for registration in Part A, and lacks the capability of distinguishing required for registration in Part B.

- Sections 12(1) - The opponent is the proprietor of registered trade mark 1509058 (DICLOMAX RETARD) for the same goods, and therefore use of the applicant's mark is likely to deceive or cause confusion.

- Section 11 - By virtue of the opponent's reputation in the mark DICLOMAX RETARD, use of the applicant's mark is likely to deceive or cause confusion.

- Section 17(1) - It is alleged that the applicant did not have a bona fide intention to use the mark DICLOTARD at the date of application.

- Section 17(2) - The opponent also asks the Registrar to refuse the application in the exercise of his discretion.

In response, the applicant filed a counterstatement in which some of the statements made in the notice of opposition are admitted, most notably the existence of the opponent's prior registration, but denying each of the grounds pleaded. The applicant also states that the opponent gave no notification of an intention to oppose, prior to the opposition being filed.

Both parties seek an award of costs in their favour.

Both parties also filed evidence in these proceedings, and the matter came to be heard on 5 November 1997. At the hearing, the opponent was represented by Mr Guy Tritton of Counsel, instructed by Gill Jennings & Every. The applicant was represented by Ms Emma Himsworth of Counsel, instructed by Chris J Tillbrook & Co.

By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. Nevertheless, these proceedings having begun under the provisions of the Trade Marks Act 1938, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, and unless otherwise indicated, all references in the remainder of this decision are references to the provisions of the old law.

Opponent's Evidence (Rule 49)

The opponent filed a statutory declaration, dated 2 April 1996, by David John Sidwick and two supporting declarations by Philip Warren Harris and Morris Jonathan Brown.

Mr Sidwick is a Product Group Manager with Parke Davis & Company Ltd (hereafter "Parke Davis"), a wholly owned subsidiary of Warner-Lambert, a position he has held since December 1993. He confirms that Parke Davis is licensed to use the mark DICLOMAX RETARD, and he provides details of the registered user agreement. Parke Davis has been marketing a product under the trade mark DICLOMAX RETARD since February 1993, and a similar product DICLOMAX SR since April 1995. Details of the dosage, administration and packaging of these products are exhibited to Mr Sidwick's declaration.

The product sold under the mark DICLOMAX RETARD is a Diclofenac Sodium formulation, used primarily as an anti-inflammatory pain reliever. It is prescribed for rheumatoid arthritis, osteoarthritis, low back pain, acute musculo skeletal disorders such as periathritis, tendonitis and a range of other specific medical conditions, as well as generally for the control of pain and inflammation in orthopaedic, dental and other minor surgery. Mr Sidwick says that DICLOMAX RETARD is widely prescribed both in hospitals and general practice surgeries. He provides the following advertising figures:

Year	**£**
1993	589,000
1994	268,000
1995	209,000

In addition to this advertising, Parke Davis has run a DICLOMAX "Logical Conclusions" competition. The questions and literature associated with this competition are appended at exhibit 3 to Mr Sidwick's declaration. They show that the literature was prepared in October 1995, and the closing date for the competition was 17th November 1995.

Since the launch of DICLOMAX RETARD, total UK sales are given by Mr Sidwick as:

Year	£	Total Units
1993	1,337,938	214,162
1994	2,092,555	264,674
1995	3,027,772	367,901

Although Mr Sidwick does not explain what constitutes a unit, I have assumed for the purpose of considering the evidence that one packet of 28 capsules is considered to be, in sales terms, one unit.

Mr Sidwick then goes on to explain that all pharmaceutical products must obtain a Product Licence from the Medicines Control Agency, and that investigations conducted on behalf of Parke Davis have shown that no Product Licence had been granted to DICLOTARD at the date of application. This, he says, suggests that the applicant did not have a bona fide intention to use the mark DICLOTARD at the date of application.

Mr Sidwick then says that as a general rule, drug companies choose names for their products which clearly differentiate their products from those of their competitors. However, in this case he points out that the applicant's mark DICLOTARD consists of elements found entirely within his company's mark, DICLOMAX RETARD; in particular the first and the last syllables. He suggests that the applicant's mark could be seen as shortened version of DICLOMAX RETARD. Finally, Mr Sidwick states that he could quite easily mistake DICLOMAX RETARD and DICLOTARD, and at the very least, the medical profession and/or the public could assume that DICLOTARD is made under licence fromWarner-Lambert or Parke Davis.

Mr Harris is a registered trade mark attorney and a partner in the firm of Gill Jennings & Every. He represents the opponent in these proceedings. In his declaration, Mr Harris says that he has on several occasions confused the marks DICLOMAX RETARD and DICLOTARD, even to the extent of getting them mixed up in the notice of opposition which he prepared on behalf of the opponent.

The second supporting declaration is by Professor Brown - Professor of Clinical Pharmacology at Cambridge Adenbrooks Hospital - a position he has held since 1986. Prior to 1986, he was the senior lecturer and consultant in Pharmacology at the Hammersmith Hospital. He has been an MD for twenty years, and also holds an MA, MSC and FRCP.

Professor Brown declares that he has known of Warner-Lambert's DICLOMAX RETARD products for some ten years. He says that he is not aware of Dallas Burston Ashbourne's

product, DICLOTARD, but that he is concerned that there would be a risk of confusion between the two marks. He identifies the similarities between the marks and goes on to say:

> "I think it is possible that practitioners might consider that DICLOTARD was a version of DICLOMAX RETARD perhaps with subtle differences."

In particular, Professor Brown says that both marks have, overall, a similar sound and feel and would appear to indicate a "slow release" formulation of Diclofenac sodium. He concludes by saying:

> "... it is possible pharmacists and other medical staff could mistake a prescription for one as a prescription for the other product."

Applicant's Evidence (Rule 50)

The applicant's evidence comprises a statutory declaration, dated 6 December 1996, by Martyn A Bilbie with three supporting declarations. Mr Bilbie is the Director of Business Development at Dallas Burston Ashbourne and its associated group trading companies (the Ashbourne Group), including in particular Ashbourne Pharmaceuticals Limited. He has been employed by the Ashbourne Group since 1986 and has held his current position since 1991.

Mr Bilbie's responsibilities include the applicant's range of Diclofenac products (eg DICLOTARD) which he says were scheduled for launch in December 1996. He recites the history of the DICLOTARD trade mark application, noting that when the application was examined, no prior conflicting marks were cited and that the mark was held to be distinctive of the applicant's goods and suitable for registration in Part A of the register.

He then confirms that the Medicines Control Agency (MCA) approved the product for use in the UK, and also approved the proposed brand name DICLOTARD for use in relation to the generic name **Diclofenac**. Product licence PL 11102/0005 was granted by the MCA on 4 January 1996 - a copy is exhibited to Mr Bilbie's declaration.

Mr Bilbie explains that the DICLOTARD name was chosen to refer, albeit obliquely, to the generic name of the active ingredient (Diclofenac). Similarly, the 'TARD' element refers to the slow release properties of the product.

The Diclofenac sodium formulation was developed and patented by Ciba Geigy, and branded as VOLTAROL. Following the expiry of patent protection, numerous branded and unbranded versions of Diclofenac (in both regular and slow release formulations) have entered the market, but VOLTAROL remains the market leader with 23% of a total UK market of around six million issued scripts. According to Mr Bilbie's evidence, the opponent's DICLOMAX RETARD and DICLOMAX SR products represent 3.75% of this market. He says that 73% of the scripts are written generically - that is, by specifying the generic ingredient rather than any particular brand.

Mr Bilbie says that it is standard practice to use the descriptive terms RETARD or the recognised abbreviation SR (Sustained or Slow Release) to designate such variations of the standard formulation. Apart from the opponent's brands, he refers to the following Diclofenac products which are all available in the UK:

DICLOFLEX RETARD	FLAMRASE SR
LOFENSAID RETARD	VOLSAID RETARD
VOLTAROL RETARD	VOLTAROL SR

He goes on to explain that Diclofenac in the relevant formulation has always been a Prescription Only Medicine (POM), that is, it is only available by prescription from a qualified medical practitioner. It is not available 'Over the Counter' (OTC). Thus according to Mr Bilbie, the patient as consumer does not and cannot make a purchase direct; neither can the patient choose, select or discriminate directly between Diclofenac products by brand. The choice is made either by the doctor when writing out the prescription (a "branded script"), or, if the doctor prescribes the drug using its generic name (a "generic script"), the pharmacist or dispensing doctor may choose either a generic (or unbranded) product or any of the branded equivalents.

Mr Bilbie then goes on to explain the pricing arrangements for branded and generic drugs. In brief, when the doctor prescribes a drug by using its generic name, the pharmacist is paid according to a tariff determined by the Prescription Pricing Authority. For the relevant Diclofenac formulation, the current tariff uses the market price of the opponent's DICLOMAX RETARD. In other words, regardless of what the Pharmacist uses to fill a generic prescription for Diclofenac, he will be paid according to the market price of DICLOMAX RETARD. Thus Mr Bilbie explains that his product (DICLOTARD) would not be chosen, where freedom of choice prevails, without an economic advantage.

Returning to the applicant's chosen brand name, Mr Bilbie says that there are numerous examples of the practice of signalling the underlying generic (Diclofenac) by using the DICLO prefix. He says some of the following examples predate the opponent's product licence:

DICLOVOL RETARD DICLOVOL SR	Product Licence Holder Arun Pharmaceuticals Ltd
DICLOFENAC SODIUM RETARD DICLOFLEX RETARD DICLOZIP	Product Licence Holder Farmitalia Carlo Erba Ltd

Other branded generics for Diclofenac include FLAMRASE, LOFENSAID RETARD, RHUMALGAN, RUMAFEN, VOLRAMAN, VOLSAID RETARD, ISCLOFEN.

According to Mr Bilbie, the applicant's chose DICLOTARD to complement their existing portfolio of TARD brands, which include:

IBUTARD	INDOTARD	MESALATARD
NIFEDOTARD	PENTOXITARD	PROPATARD
SALBUTARD	VERAPATARD	ZEMTARD
ISOTARD	MONOISOTARD	MONONITROTARD

DICLOZIP is another of the applicant's brands for a Diclofenac sodium preparation. Mr Bilbie points out that DICLOZIP was registered as a trade mark with effect from 27 October 1990, and as such it predates both of the registrations relied upon by the opponent in these proceedings. He contends that the opponent, in subsequently adopting its DICLOMAX RETARD and DICLOMAX SR brands, has recognised the commonality of the DICLO prefix, and the ability of competing DICLO brands to co-exist without confusion.

Examples of the packaging of the applicant's products, DICLOTARD and DICLOZIP are exhibited to Mr Bilbie's declaration. He also outlines his company's intentions with regard to promoting DICLOTARD. Presumably due to its recent launch, no advertising or sales figures are given.

Finally, Mr Bilbie concludes his evidence with a critical review of the opponent's evidence. As one might imagine, there are a number of areas where Mr Bilbie disagrees with statements made in the opponent's declarations but I do not feel it necessary to refer to them in detail as part of this summary.

The first of the applicant's supporting declarations is by Marianne Slattery. Ms Slattery is a professional assistant with the firm of Chris Tillbrook & Co, European Patent and Trade Mark Attorneys, who act for Dallas Burston Ashbourne. Her evidence relates to a search of the UK Trade Marks Register for marks incorporating the DICLO element or close variants. The following marks were found in class 5:

DICLOZIP[1]	DICLOCIL[1]	DICLOTEC[1]
DICLOPHLOGONT[1]	SLO-DICLO[1]	DICLOGEN[1]
DICLOFLEX[1]	DICLOMAX	DICLOMAX RETARD
DICLOTAB	DICLOVOL	DICLODUR
DICLOLIQ	DICLOFLAM[2]	DICLORAL[2]
DICLOFENOR[2]	DICLOTOB[3]	

[1]The registrations of these marks predate those relied upon by the opponent.

[2]These marks were advertised, but not registered at the time of the search.

[3]The status of this application at the time of search was 'Pending'.

Ms Slattery supplemented her search by looking through a number of pharmaceutical publications - the British National Formulary (BNF), and MIMS (an independently written publication described as a prescribing guide for general practitioners). She also made enquiries of the Medicines Control Agency and obtained a listing of 123 licensed Diclofenac products in diverse proprietorship, including sub-licensed variations. Of these, Ms Slattery says that 26 represented products identified generically, but the following brands incorporated the DICLO prefix:

DICLOTARD (the applicant's brand)

DICLOFLEX - Licensed to Farmitalia

DICLOVOL SR & DICLOVOL RETARD - Licensed to Arun Pharmaceuticals Ltd

DICLOMAX SR & DICLOMAX RETARD (the opponent's brands)

The applicant's second supporting declaration is by Dr David Alston of Pytchley Court Health Centre, Northampton. Dr Alston has been a medical practitioner at the health centre since 1988. Before that, he had experience of the pharmaceutical industry with Boehringer Ingelheim Kg and more recently with Searle UK as a member of various advisory committees. He lists his professional qualifications - MBBS DRCOG MRCGP (Barts 1976).

In addition to being a medical practitioner, Dr Alston is licensed by Northamptonshire Family Health Service Authority to run a pharmaceutical dispensary in connection with his medical practice. He is aware of numerous Diclofenac products marketed under the approved generic name. He is also aware of the applicant's DICLOZIP product (launched October 1990) and the opponent's DICLOMAX and DICLOMAX RETARD products. He confirms that he also knows about the applicant's present application for the mark DICLOTARD (by which I presume he is referring to the trade mark application rather than the MCA licence application).

Perhaps the most significant part of Dr Alston's evidence is found at paragraph 4. For convenience I reproduce it in full.

> "I am confident that there is no likelihood that I would be confused in practice between pharmaceutical preparations sold under the Opponents' designations DICLOMAX and DICLOMAX RETARD and pharmaceutical preparations sold under the Applicants' brand name DICLOTARD."

Dr Alston then continues by expressing his opinion of the distinctiveness of DICLOTARD as a trade mark. He also confirms that it is common practice to use a brand name which signals, albeit obliquely, the generic name of the active ingredient. He says that the medical profession recognise this, and that use of a common DICLO element does not of itself give rise to confusion. Dr Alston concludes with the emphatic statement:

> "I consider that it is <u>not</u> possible ... for a prescribing medical practitioner, pharmacist or dispensing doctor to mistake a prescription for the Applicants' DICLOTARD product as a prescription for the Opponents' DICLOMAX and DICLOMAX RETARD products."

The applicant's third and final supporting declaration is by Professor S S Davis of Danbiosyst, Albert Einstein Centre, Nottingham. Professor Davis describes himself as the 'Lord Trent Professor of Pharmacy' at Nottingham University, a position he has held since 1975. He runs a large research group, studying novel drug delivery systems. Professor Davis has co-edited seven books and published over six hundred papers, though he does not state the subject matter of these books and papers. He says that as a result of his academic research and professional experience, he is familiar with the pharmaceutical industry, the prescribing of medicines, and branding practice. The remainder of Professor Davis' evidence is pretty much the same as Dr Alston's. In particular he also says:

> "I am confident that there is no likelihood that I would be confused between pharmaceutical preparations sold under the Opponents' proprietary names DICLOMAX and DICLOMAX RETARD and pharmaceutical preparations sold under the Applicants' brand name DICLOTARD."

and concludes:

> "Finally, I consider that it is <u>not</u> possible, for a dispensing doctor or pharmacist to mistake a prescription for the Applicants' DICLOTARD product as a prescription for the Opponents' DICLOMAX SR and DICLOMAX RETARD products."

<u>Opponent's Evidence in Reply (Rule 51)</u>

The opponent filed a second, brief statutory declaration by Professor Brown in reply to the applicant's evidence. The purpose of this second declaration is to clarify a statement made by Professor Brown in his earlier evidence. He originally declared that he knew of Warner-Lambert's DICLOMAX RETARD products for some ten years. Mr Bilbie, in his evidence for the applicant, criticised this statement, pointing out that according to Mr Sidwick DICLOMAX RETARD and DICLOMAX SR were not launched until February 1993 and April 1995 respectively. Professor Brown seeks to clarify the position in this later declaration by saying that he has been aware of DICLOMAX RETARD for some years and the opponent's Diclofenac drugs for a much longer period.

That completes my review of the evidence filed in these proceedings. I now turn to consider the grounds of opposition.

Section 17(1)

Before launching this opposition , the opponent made enquiries at the Medicines Control Agency (MCA) and learned that the applicant had not been granted a product licence for DICLOTARD. However, it was common ground at the hearing that the MCA has since granted the applicant a product licence in respect of DICLOTARD. Consequently Mr Tritton confirmed that he was not pursuing this ground of opposition. I therefore formally find that the opposition under section 17(1) fails.

Sections 9 and 10

The opponent has not addressed this ground of opposition in evidence, neither did Mr Tritton refer to it during the course of his submissions. It is clear to me that DICLOTARD qualifies prima facie for registration according to section 9, and in the absence of any evidence to the contrary I do not intend to interfere with the examiner's decision to accept this mark. I therefore find that the opposition under section 9 and section 10 fails.

Section 11

Section 11 reads as follows:-

> "11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

The established test for objection under section 11 is set down in Smith Hayden & Co Ltd's Application [1946] RPC 101 as adapted by Lord Upjohn in the Bali trade mark case [1969] RPC 496. Adapted to the matter in hand, the Smith Hayden test may be expressed as follows:

> "Having regard to the user of the mark DICLOMAX RETARD is the tribunal satisfied that if DICLOTARD is used in a normal and fair manner in connection with pharmaceutical preparations such will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?"

It is clear from the evidence, and it was common ground at the hearing, that the goods in issue are the same. The opponent has been using the mark DICLOMAX RETARD in connection with Diclofenac Sodium preparations. Although the applicant has applied to register the trade mark DICLOTARD for the broader specification of pharmaceutical preparations and substances, they have been granted a product licence by the MCA to use the mark for a Diclofenac Sodium preparation. Thus in order to determine the question of confusion, I need only consider the two marks used for identical goods.

The opponent has been using the mark DICLOMAX RETARD since February 1993 and the advertising and sales figures provided in evidence are fairly substantial. On the other hand, the applicant had not commenced use of DICLOTARD at the date of application (22 August 1994), although they have since launched DICLOTARD in December 1996. As far as section 11 is concerned, I am satisfied that the opponent has established the earlier use. Ms Himsworth did not question the extent of the opponent's prior use, nor the reputation which the opponent claims to have established as a result. Rather, both Counsel were agreed that the fundamental question to be determined is whether or not confusion is likely if the applicant continues to use DICLOTARD for the same goods.

At the hearing, I had the benefit of some excellent submissions from Counsel on this point of confusion. In particular both Counsel referred me to a number of very helpful decided cases.

For the applicant, Ms Himsworth took me to the **Butazone/Butazolidin**[4] case. In that case, the proprietor of the trade mark BUTAZOLIDIN sought an injunction to restrain the defendants from using the mark BUTAZONE for their brand of the same drug. The circumstances were also similar inasmuch as the generic name for the drug was Phenylbutazone. Mr Justice Waller found no evidence that pharmacists or doctors would be confused between BUTAZOLIDIN and BUTAZONE. He also approached the question as though he were a jury and found that the rather unusual ending ("zolidin") meant that the plaintiff's mark was highly unlikely to be confused with BUTAZONE. In the course of his submission to me, Mr Tritton remarked that his client would have had no difficulty if the applicant had applied for a mark with a similarly distinctive ending, eg DICLOZOLIDIN.
As it was, DICLOTARD starts and ends with the same syllables as the opponent's mark DICLOMAX RETARD.

Ms Himsworth also referred me to **Glaxo v Pharmax**[5]. Here the facts appear to be closer still. The plaintiff sought to restrain the defendant from using the name PREDENEMA on the grounds that it could be confused with their own name PREDSOL ENEMA. The particular point that Ms Himsworth took from this reported case concerned the extra care which pharmacists and doctors take when dealing with the names of drugs. At page 285, Fox J says:

> "... so far as confusion in the retail trade by the mere use of the name "Predenema" is concerned, the question is not whether an uninformed public would be misled: it is whether a body of professional persons directly concerned with such products, ie. the pharmacists, is likely to be misled. As to that, there is clear evidence that the standard practice of the profession is that, if there is any doubt about the identity of the product to be dispensed, the pharmacist must either check in the standard works of reference or ask the prescribing doctor."

The last of the authorities relied upon by the applicant is **GE Trade Mark**[6]. At page 321 and line 31, Lord Diplock says:

> "My Lords, where goods are of a kind which are not normally sold to the general public for consumption or domestic use but are sold in a specialised market consisting of persons engaged in a particular trade, evidence of persons accustomed to dealing in that market as to the likelihood of deception or confusion is essential. A judge, though he must use his common sense in assessing the credibility and probative value of that evidence is not entitled to supplement any deficiency in evidence of this kind by giving evidence to his own subjective view as to whether or not he himself would be likely to be deceived or confused."

In the GE case, the goods in question were large industrial machines and not pharmaceutical preparations. Nevertheless the underlying principle remains the same, that is, prescription only medicines (POM) are a specialised market and selection between brands is not usually left to the general public.

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[4]Geigy A.G. v Chelsea Drug and Chemical Company Limited [1966] RPC 64

[5]Glaxo Laboratories Ltd v Pharmax Ltd [1976] FSR 278

[6]GE Trade Mark [1973] RPC 297. (House of Lords)

Hence it was Ms Himsworth's submission that it is the evidence of doctors and pharmacists, and in particular those with experience of prescribing and dispensing drugs, to which I should have most regard in reaching my decision.

Mr Tritton took me first to two unreported decisions of the Registrar. In both of these cases the opponent was the registered proprietor of the mark HERPID for pharmaceutical preparations. The respective applicants in these cases had sought to register the marks HERPIRAX[7] and HERPESEN[8], also for pharmaceutical preparations. In each case the Hearing Officer decided that there was a realistic possibility of confusion with the earlier mark HERPID. Both of these decisions also quote the following passage, which I believe is equally relevant in this case, from the judgment of the Master of the Rolls, Lord Greene, in the **DIASIL/ALASIL** case[9]:

> "Of course, it is impossible to exclude entirely the risk of confusion. What we are concerned with are not unlikely cases which may happen once in a hundred years, but reasonable probabilities, and we have to ask ourselves in relation to those facts: Is there such a risk that a doctor or a chemist or the two of them in combination, by some carelessness in expression, some obscurity in handwriting, some slip of recollection or some careless mistake which you would not expect highly trained professional people to fall into, will refer to the product in such a way as will lead the court to say that there is a reasonable probability of confusion?
>
> In my opinion, there is not. It seems to me that, if one is really to give weight to such a risk, it involves attributing to those highly skilled, experienced and careful people to whom the legislature has entrusted, and to whom alone the legislature has entrusted, the precautions necessary under the Poisons Act, qualities of carelessness or incompetence which, although they may exist in a person here and there on occasions - that, of course, cannot be denied - are not usually found in that class of persons. We are not concerned with hypothetical possibilities, but with the ordinary practical business probabilities, having regard to the circumstances of the case."

In this regard, Mr Tritton sought to persuade me that I should not disregard the possibility of confusion of the general public, despite the fact that I am considering Prescription Only Medicines and not medicines available over the counter. For example, he suggested that where a patient has a long term (or recurring) medical condition, the patient may tell the doctor what brand they have previously taken for that condition. This was not an insignificant consideration according to Mr Tritton, because brand reassurance is an important factor in the pharmaceutical market and has no doubt contributed to the continued success (in terms of market share of issued scripts) of VOLTAROL despite losing (circa 1989) the monopoly protection originally afforded by patent protection.

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[7]In the Matter of Application **m** 1116820 by the Wellcome Foundation and Opposition **m** 16566 by WB Pharmaceuticals Ltd.

[8]In the Matter of Application **m** B1152035 by Biorex Laboratories Ltd and Opposition **m** 17296 by WB Pharmaceuticals Ltd.

[9]Bayer's Application [1947] 64 RPC 125 at page 137.

In their evidence on behalf of the applicant, Mr Bilbie and Ms Slattery emphasised the number of other marks on the register and being used in the market place beginning with the prefix DICLO. Responding to this evidence, Mr Tritton was careful to point out, using the applicant's own declarations, that the only evidence of significant use in the market place related to the market leader VOLTAROL and the opponent's DICLOMAX RETARD. With this in mind, he referred me to a decision of the Comptroller-General in the Matter of an Application by Harrods Ltd to Register a Trade Mark in Part B of the Register[10] where the Comptroller-General said:

> "Now it is a well recognised principle, that has to be taken into account in considering the possibility of confusion arising between any two trade marks, that, where those two marks contain a common element which is also contained in a number of other marks in use in the same market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those other features. This principle, however, clearly requires that the marks comprising the common element shall be in fairly extensive use and, as I have mentioned, in use in the markets in which the marks under consideration are being or will be used."

According to Mr Tritton's interpretation of the applicant's evidence, the market for branded Diclofenac Sodium preparations is divided between VOLTAROL (with 23% of issued scripts) and the opponent's DICLOMAX RETARD and DICLOMAX SR (with 3.75% of issued scripts). As 73% of scripts were issued generically, the corollary is that a mere 0.25% must account for all the other brands. Consequently, the appearance on the market of the applicant's DICLOTARD would be likely to be confused with the only other branded product having a DICLO prefix - the opponent's DICLOMAX RETARD.

However, the applicant's evidence on this point concerns the relative proportions of prescriptions issued for the various Diclofenac Sodium preparations on the market. It is not clear how this should be extrapolated to show actual use of the various brands. For example, according to Mr Bilbie, 73% of prescriptions for Diclofenac Sodium preparations are written generically. That is, the doctor specifies a Diclofenac Sodium preparation of the required dose, in a modified release[11] form if appropriate, and the dispensing pharmacist is allowed to fill the prescription with any of a number of equivalent preparations from different manufacturers, some of which would be branded, and others not. Thus of the 73% of generic scripts, a significant proportion may have been filled with VOLTAROL or DICLOMAX RETARD making their respective market shares considerably higher than the 23% and 3.75% figures quoted above. It is of course equally possible that a significant proportion of the generic scripts were filled with one or more of the other brands with DICLO prefixes.

However, Mr Tritton invited me not to speculate along these lines, but to stay with the evidence that had been filed. He did suggest that if a generic prescription is written, a

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[10][1935] RPC 65 at page 70.

[11]"Modified Release" usually means that the drug is designed to release slowly, over a period of time, in the patient's system.

pharmacist would be unlikely to fill the prescription with a branded product because generic prescriptions are by their nature usually cheaper than branded alternatives. To some extent I appreciate that this is also speculation, albeit on a more rational basis. More significantly perhaps, if I accept that the majority of the 73% of generic scripts were filled with generic products, I must conclude (with reference to the quotation from Harrods above) that the DICLO prefix (ie. the common element) is in fairly extensive use. This follows, it seems to me, because the generic name for the drug is Diclofenac. In other words, those involved in the prescription and dispensing of this particular drug are already having to distinguish between the generic DICLOFENAC and the branded DICLOMAX RETARD. This inevitably weakens the opponent's case to some extent.

In the result, the conclusion I have reached is that because the goods in question are Prescription Only Medicines, I should have particular regard to the evidence provided by those with most experience in the field. This appears to me to be most clearly in line with the authorities brought to my attention and the circumstances of the case before me. Consequently I do not propose to apply the established test for confusing marks propounded by Parker J in Pianotist Co's Application [1906] RPC since the purpose of that test is to assist me to reach a decision as to whether or not I myself would be confused. Having regard to the words of Lord Diplock in the GE case, that would clearly be wrong in this case.

I return therefore to consider more closely the evidence of Doctor Alston, Professor Davis and Professor Brown.

The declarations of Doctor Alston and Professor Davis are worded very similarly, and the value of their evidence is perhaps reduced slightly as a result, but nevertheless they have both put their names to clear and unequivocal statements to the effect that they would not be confused between DICLOTARD and DICLOMAX RETARD. Indeed they go further and in each case state that they consider it is not possible for a doctor or pharmacist to mistake the one for the other.

On the other hand, Professor Brown (for the opponent) only admits that it is possible that pharmacists and other medical staff could mistake the one for the other. Clearly a possibility is not as strong as a likelihood, and under section 11 the opponent must satisfy the tribunal that use of the mark opposed would be likely to deceive or cause confusion, not merely that there is a possibility of deception or confusion. On this basis, the opposition under section 11 fails.

Section 12(1)

This section reads

> "12(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-
>
> a. the same goods,
>
> b. the same description of goods, or

c. services or a description of services which are associated with those goods or goods of that description."

The reference in this Section to a near resemblance is clarified by Section 68(2B) of the Act which says that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

Counsel in their submissions addressed me generally on the issue of likelihood of confusion and did not distinguish between section 11 and section 12. In each case, the only question to be decided (having regard to the facts of this specific opposition) is whether there is a likelihood of confusion. As I have already found in relation to section 11 that confusion is not likely, it follows that the opposition under section 12 must also fail.

Registrar's Discretion

There remains the matter of the Registrar's discretion. By long established practice, the Registrar takes a particularly strict view of marks proposed for registration in Class 5, because of the possible danger to the public if any confusion should arise. There are, therefore, numerous instances of registrations proposed for Class 5 which the Registrar has refused in the exercise of his discretion under Section 17(2). There are however a number of factors which suggest that such an adverse exercise of discretion is unnecessary and inappropriate in this case.

First, it has to be admitted that the mark has survived the scrutiny of both the Trade Marks Registry and the MCA. But perhaps more importantly, the reason for the Registrar's particular concern in relation to class 5 does not bear on the facts of this case. It was accepted that both marks are being used for the same pharmaceutical preparation. Thus in the event of confusion, a pharmaceutical company might lose a sale to one of its competitors, but the patient would still be dispensed the same drug, albeit from a different source. This potential *damage* to the interests of the opponent is no different to the potential damage in any other class of goods or service, and consequently I see no reason to exercise the Registrar's discretion against the interests of the applicant.

In the result, the opposition has failed and the applicant is entitled to a contribution to his costs. I therefore order the opponent to pay to the applicant the sum of **£650**.

Dated this 29th day of January 1998

S J Probert
Principal Hearing Officer
For the Registrar, the Comptroller-General