

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2177090
BY ALLERGAN INC**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 50441 BY GLAXO GROUP LIMITED**

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**IN THE MATTER OF Opposition thereto under No 50441
by Glaxo Group Limited**

Background

1. On 11 September 1998 Allergan Inc applied under the Trade Marks Act 1994 to register the trade mark MIRAGAN for a specification of goods which reads:

Class 5

"Pharmaceutical preparations for the treatment of glaucoma."

2. The application is numbered 2177090.

3. The application was accepted and published and on 26 November 1999 Glaxo Group Limited filed notice of opposition to the application. The statement of grounds accompanying the notice of opposition set out various grounds of opposition, however, those pursued at the hearing can be summarised as follows:

- (a) under section 5(2)(b) of the Trade Marks Act 1994 in that the trade mark the subject of the application is similar to the opponents' earlier trade mark IMIGRAN and is to be registered for goods identical or similar to the goods for which the earlier trade mark is protected;
- (b) under section 5(4)(a) of the Act, having regard to the opponents' prior common law rights in the earlier trade mark, the application is liable to be prevented by the law of passing off.

4. The applicants filed a counterstatement denying the grounds of opposition. Both side seek an award of costs. The matter came to be heard on 12 July 2001. The applicants were represented by Mr Douglas Campbell of Counsel, instructed by Carpmaels & Ransford. The opponents were represented by Mr David Wilkinson of Bristows.

Evidence

5. Both parties filed evidence in the proceedings. The opponents filed a single statutory declaration by Ms Lesley Jane Edwards, Head of Trade Marks at Glaxo Welcome plc. Glaxo Group Limited is a wholly owned subsidiary of Glaxo Welcome plc. This is dated 25 May 2000 and sets out the use that has been made of the trade mark IMIGRAN. I need not summarise the entirety of her evidence, but certain facts can be briefly stated. IMIGRAN is

used in relation to a treatment of migraines and headaches, it was launched in the United Kingdom in 1991 and has been used continuously from that date. Sales figures are provided at exhibit LSE3 for the years 1995-1999. The figures for the years 1996-1999 are all in excess of £41 million. Examples of packaging, patient information and advertising information are provided at exhibits LSE5 & 7. Most of this is undated, but there are various © dates showing 1997, 1998 and 1999. Invoices are provided at exhibit LSE6 and these show sales within the relevant period, that is, before 11 September 1998.

6. The applicants' evidence consists of a single statutory declaration dated 4 October 2000 by Martin A Voet, Assistant Secretary of Allergan. Mr Voet's evidence makes comments in reply to the submissions made in the opponents' evidence, I need not summarise these here. No evidence that the applicants' trade mark is in use was submitted by the applicants. However, Mr Voet explains the origin of the trade mark MIRAGAN. He states that it is derived from the Spanish word MIRAR meaning to see and the suffix GAN which is a family suffix of his company. He provides at exhibit MAV1 a list of his company's trade marks.

Decision

7. The grounds of opposition as set out in the statement of grounds refer to sections 5(2)(b), and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

“5.- (1)

(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

(3)

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

8. The term ‘earlier trade mark’ is defined in section 6 of the Act as follows:

- “6.- (1) In this Act an “earlier trade mark” means -
- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

9. I will consider first the opponents’ ground of objection under section 5(2)(b). In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) 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 BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;
- (f) 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 BV v. Puma AG* page 8, paragraph 24;

- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

10. Both of the opponents' trade marks, United Kingdom registration 1400920 and Community Trade Mark (CTM) 208801 are earlier trade marks within the definition of section 6 of the Act. Both registrations cover the same specification. For ease of reference I will use the UK registration. The applicants' and opponents' trade marks are reproduced below:

Applicants' trade mark	Opponents' trade mark
MIRAGAN	IMIGRAN
Class 5	Class 5
"Pharmaceutical preparations for the treatment of glaucoma"	"Pharmaceutical preparations and substances; all included in class 5".

11. The likelihood of confusion must be appreciated globally taking into account the various factors listed above. The opponents argued that the goods for which the applicants seek protection are covered by their earlier trade mark and I did not understand Mr Campbell to argue otherwise. Thus the goods here are identical. One of the factors that I must take into account is the distinctive character of the earlier trade mark and any reputation that it may enjoy. The mark is in any event, an invented word and for many pharmaceutical products it would possess a distinctive character in its own right but I agree with Mr Campbell that when used on a treatment for migraine, it does not possess such an overwhelmingly strong distinctive character. The opponents filed evidence in support of the opposition and this evidence was directed to establishing a reputation in their trade mark. This evidence was criticised by the applicants' representative as being insufficient to support a claim to a reputation. In particular, the applicants noted that no advertising expenditure and market share information had been provided. I agree, with these criticisms but given the high level of turnover across a number of years, together with the examples of packaging and patient information showing use of the trade mark, the evidence is in my view sufficient to establish a reputation in the trade mark IMIGRAN at the relevant date.

12. However, the fact that I have found such a reputation does not in my view entitle the

opponents to claim a reputation for IMIGRAN in relation to all the goods covered by their registration. The use that is shown in my view covers pharmaceutical preparations for the treatment of migraine and headaches. No use has been shown on other pharmaceutical preparations and I find that the reputation of IMIGRAN extends only to these goods and not pharmaceutical preparations and substances per se.

13. That said, the opponents' registration covers these goods and I must of course take into account notional and fair use of the opponents' trade mark in relation to the goods for which it is registered. The applicants' trade mark has not been used but I must also assume notional and fair use of the applicants' mark; *Reactor* [2000] R.P.C. at page 288. Thus, even taking into account the opponents' reputation for the treatment of migraine and headaches I do not think that they can be in any better position than considering notional and fair use across the full range of goods for which their trade mark is registered. The case law also tells us that I must take into account the fact that members of the public are unlikely to see the two trade marks side by side but instead must carry around an imperfect picture of them kept in their minds.

14. During the course of the hearing, submissions were made as to the approach I should adopt when considering opposition proceedings to trade marks covering pharmaceuticals. In summary, Mr Wilkinson argued that when considering such cases and assessing the likelihood of confusion between the trade mark the subject of the application and other trade marks, the registrar should adopt a cautious approach, taking into account the danger to the health of consumers in the event that two trade marks are confused. On the other hand, Mr Campbell suggested that the average consumer is more careful when purchasing pharmaceuticals and so trade marks that might otherwise be similar and lead to confusion could exist side by side when applied to pharmaceuticals.

15. This is not a new debate to trade mark law and Mr Wilkinson referred me to an article written by Jane Mutimear "OHIM's Approach to Pharmaceutical Oppositions" [2001] 134 Trademark World at page 26. As the title suggests, this article analyses the approach taken by the Office for Harmonisation in the Internal Market in several oppositions to Community Trade Marks which cover pharmaceutical products. The article suggests that at present OHIM adopts a higher threshold before confusion can be found. The article is critical of that approach pointing to the potential consequences to public health when two pharmaceuticals are confused. At the hearing reference was also made to a recent decision of OHIM's Third Board of Appeal *Alimirall Prodesfarma S A v. Mudipharma A.G.* (Case R 622/199-3). This case concerned the trade marks CODIDOL and CODEROL for pharmaceutical goods in class 5. The Third Board of Appeal upheld the decision of the opposition division and found that there was a likelihood of confusion. The parties in that case advanced similar arguments to those before me. The Board did not express a view as to the correct approach but concluded:

"Furthermore, even if, as the applicant argues, the Board were to apply a higher threshold for a finding of a likelihood of confusion, that would not be sufficient to counter the Board's finding in the present case."

16. It seems to me that the role of the registrar is to apply the Trade Marks Act 1994 and its subordinate legislation to the proceedings brought before her. Other provisions and

authorities exist for the licensing of pharmaceuticals and in my view, it is not the role of the Trade Marks Registry to stray into these areas. Under the provisions of the Act and acting on behalf of the registrar I must consider whether there exists a likelihood of confusion if the applicants' and opponents' trade marks are used in respect of the goods for which they are respectively applied for and registered. I must find a likelihood of confusion not merely a possibility of confusion; *Reactor* at page 290.

17. Of course, in assessing the likelihood of confusion I must consider this matter through the eyes of the average consumer of the goods in question. Consequently, I have to take into account the way or ways in which the products in question reach the end consumer. In a case such as this a pharmaceutical may be available only on a doctor's prescription or through a pharmacist, these are professionals who are accustomed to dealing with the various products that are available and one might expect them to be more observant and circumspect than others. Other pharmaceuticals are available over the counter and are available to the general public without the intervention of a pharmacist or doctor when different considerations may apply. Each case must be determined on its own facts and on the evidence that is presented to the registry. In this case I have no evidence as to how these two pharmaceutical preparations covered by the respective specifications will be sold. The specifications are not limited in any way and so I must assume that they are or may be made available directly to the general public over the counter.

18. With these considerations in mind I go on to consider whether the trade marks are similar, taking into account the visual, aural and conceptual similarities between the two trade marks.

19. Visually, although the two trade marks are each seven letters in length and, as Mr Wilkinson pointed out, the letters M I G A appear in the same order in both, viewed as a whole there are in my view clear visual differences between the two marks. If one proceeds to analyse the marks in more detail one can see that the applicants' trade mark MIRAGAN starts with a consonant, the opponents' IMIGRAN with a vowel. The first four letters of the applicants' mark are MIRA and the opponents' IMIG. There is however, some similarity in the ending of the trade marks GAN and GRAN. As the differences between the two trade mark occur in the first part of the marks they will in my view have a greater impact on the eye than if they occurred at the end of the mark. This would also mitigate against the danger of imperfect recollection.

20. Aurally there is some similarity between the marks arising from the phonetic similarity in the ending of the two marks; GRAN and GAN. If the two trade marks are spoken one after the other they are difficult to announce. However, they will not be spoken in that way. I must consider whether in oral use there is a likelihood of confusion between IMIGRAN and MIRAGAN. Whilst I accept Mr Wilkinson's submission that the I in IMIGRAN will be soft, it is still present in the word. Both words are made up of three syllables. The applicants' would in my view be pronounced by the average English speaker as MI RA GAN, the opponents' as I MI GRAN. The first two syllables of each word are very different. In my view, as the differences between the two trade marks occur at the beginning of the two trade marks they are sufficient to differentiate between them. It was accepted under the Trade Marks Act 1938 that the beginning of words is more important with the ending of words tending to become slurred; *London Lubricants Limited's Application (TRIPCASTROID)* 42

1925 R.P.C. 264 at page 279 and I see no reason why this should not apply under the Trade Marks Act 1994.

21. Conceptually, the applicants' mark appears to have no meaning and is an invented word. Mr Voet states that it is derived from the Spanish word MIRAR (to see) and so alludes to the therapeutic effects of the product, together with the "family" suffix GAN. However, I doubt that the meaning of MIRAR would be apparent to the majority of the relevant public. Equally, the opponents' mark is an invented word but alludes to its purpose when used on products for the relief of migraine. If it was used on other pharmaceutical products it would be meaningless. As such, there is no conceptual similarity between the two trade marks.

22. Mr Hobbs Q.C., sitting as the Appointed Person in *Balmoral Trade Mark* [1998] R.P.C. 297 at page 301, found that section 5(2) raised a single composite question. Adapted to this case it can be stated as follows: are there similarities (in terms of marks and goods) which would combine to create a likelihood of confusion if the applicants' trade mark MIRAGAN and the opponents' trade mark IMIGRAN were used concurrently in relation to the goods for which they are respectively registered and proposed to be registered?

23. Taking all the factors into account and in particular, taking account of the distinctiveness of the opponents' trade mark, the identity of the goods for which registration is sought and imperfect recollection, I am of the view that the question posed above must be answered in the negative.

24. Finally I consider the opponents' ground of objection under section 5(4)(a). The requirements for passing off have been restated many times and can be found in the decision of Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

25. As part of my decision under section 5(2)(b) I found that the opponents had established a reputation in the United Kingdom in the trade mark IMIGRAN in respect of pharmaceuticals for the treatment of migraine and headaches. As the opponents have a registration for the mark IMIGRAN for pharmaceutical preparations, I questioned Mr Wilkinson as to how he could be in any better position under section 5(4)(a) than under section 5(2)(b). He could not answer that question but still asked me to consider the question under section 5(4)(a). Having

found that the opponents have the necessary reputation I must consider whether there is a misrepresentation by the applicants. Under section 5(2)(b) when considering use of the opponents' trade mark on identical goods I found that there was no likelihood of confusion. Here, under section 5(4)(a), where I can only consider the use that has been made of the opponents' trade mark, that is a pharmaceutical for the treatment of migraine and headaches, it follows from what I have said above that use of the applicants' trade mark on pharmaceutical preparations for the treatment of glaucoma could not result in any misrepresentation by the applicants. The opponents' ground under section 5(4)(a) therefore falls to be dismissed.

26. The applicants have been successful and are entitled to a contribution towards their costs. I order that the opponents pay the applicants the sum of £835-00 as a contribution towards their costs. This sum is to be paid within seven days of 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 25 day of September 2001

**S P Rowan
For the Registrar
the Comptroller General**