

O-155-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2272130
BY BIOVEX LTD
TO REGISTER THE TRADE MARK:**

LEUKOVEX

IN

CLASSES 5, 10, 42

AND

**THE OPPOSITION THERETO
UNDER No 80435
BY SCHERING-PLOUGH LTD
BASED UPON THE EARLIER TRADE MARK:**

LEUCOMAX

Trade Marks Act 1994
in the matter of application no 2272130
by BioVex Ltd
to register the trade mark:
LEUKOVEX
in classes 5, 10 and 42
and
the opposition thereto
under no 80435
by Schering-Plough Ltd

BACKGROUND

1) On 8 June 2001 BioVex Ltd (referred to afterwards as BV) applied to register the trade mark **LEUKOVEX**. The application was published for opposition purposes in the Trade Marks Journal on 12 September 2001 with the following specification in respect of goods in class 5 of the International Classification of Goods and Services :

pharmaceutical preparations and substances; vaccines; diagnostic preparations; viral preparations; pharmaceutical preparations, vaccines, diagnostic preparations for treating leukaemia.

2) On 4 December 2001 Novartis AG filed a notice of opposition to this application. During the proceedings the earlier right upon which Novartis AG based its opposition was assigned to Schering-Plough Ltd (referred to afterwards as SP). Following this assignment SP was substituted as the opponent in these proceedings. Consequently, reference in this decision will be made to SP rather than Novartis AG.

3) SP is the owner of United Kingdom trade mark registration no 1385418 for the trade mark **LEUCOMAX** which was registered on 9 August 1991 for: *pharmaceutical products included in class 5*. SP states that its earlier trade mark is similar to LEUKOVEX and the goods encompassed by the respective trade marks, in class 5, are either identical or similar. Consequently, there is a likelihood of confusion and registration of BV's trade mark, as far as the goods in class 5 are concerned, would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4) SP requests that BV's application is refused for the class 5 goods and seeks an award of costs.

5) BV filed a counterstatement. In its counterstatement BV admits that the respective goods are identical or similar. However, it denies that the respective trade marks are similar and, consequently, denies that there is a likelihood of confusion. In particular BV states that LEUCO/LEUKO is common. BV requests that the opposition is dismissed and seeks an award of costs.

6) Both sides filed evidence.

7) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing, so I will make a

decision after a careful study of the papers.

8) SP filed written submissions and I take these into account in reaching my decision.

MAIN EVIDENCE OF SP

9) This consists of a witness statement by Jane Harlow. Ms Harlow is a trade mark attorney who is acting for SP. Ms Harlow exhibits packaging and literature relating to the nature and uses of LEUCOMAX. The active ingredient of LEUCOMAX is molgramostin, a white blood cell growth factor. LEUCOMAX is used in a variety of situations where white blood cell growth is of importance such as after chemotherapy, after a bone marrow transplant and for certain patients suffering from AIDS. The literature exhibited shows that the number of uses for the product has been increasing.

10) Ms Harlow exhibits an e-mail she sent to the Medicines Control Agency (MCA) in which she asked if it could carry out a search of pharmaceuticals which have regulatory approval in the United Kingdom and begin with LEUKO or LEUCO. Ms Harlow also exhibits the reply, from Mark Goddard, in which eleven products are listed. Three of these products are for SP's LEUCOMAX, three are for calcium leucovorin supplied by Cyanamid of Great Britain, three are for calcium leucovorin supplied by Faulding Pharmaceuticals and one for leucovorin calcium, also supplied by Faulding Pharmaceuticals. The other product is LeukoScan, supplied by Immunomedics BV. Mr Goddard advises in his e-mail that information is not released on marketing authorisations currently under assessment or that have not been published on the MCA website. Ms Harlow exhibits an extract from the leukoskan.com website which advises that LeukoScan is "a radio-pharmaceutical approved for use in the diagnosis of osteomyelitis in long bones and in patients with diabetic foot ulcers". Also exhibited are extracts from an on-line medical dictionary published at the Department of Medical Oncology at the University of Newcastle-upon-Tyne. These extracts advise that leucovorin is the active metabolite of folic acid and is used principally as its calcium salt is an antidote to folic acid antagonists. Leucovorin calcium is described as the calcium salt of leucovorin which is used to counteract the toxic effects of folic acid antagonists. It is used for the treatment of megaloblastic anaemias and as an adjunct to cyanocobalamin in pernicious anaemia. Ms Harlow states that MCA authorisation is normally necessary before medicines can be prescribed or sold. She exhibits an extract from the MCA's website to explain the rôle of the MCA. Ms Harlow states that it is also possible to obtain a license for medicines through the European Agency for the Evaluation of Medicinal Products (EMA). She exhibits an extract from the EMA website to show that it has not granted licenses to any products beginning with LEUCO or LEUKO. The effect of this evidence is to show that only two pharmaceutical products with a brand name beginning with LEUCO or LEUKO are licensed for use in the United Kingdom, LEUCOMAX and LeukoScan; calcium leucovorin being a generic term.

EVIDENCE OF BV

11) This consists of a witness statement by Robert Coffin. Mr Coffin is chief scientific officer of BV. Mr Coffin states that BV chose the trade mark LEUKOVEX because LEUKO alludes to the white blood cells or leukocytes. He exhibits an extract from "Websters Third New International Dictionary" with a definition of leukocyte. Mr Coffin states that the VEX part of the trade mark is intended to allude to vectors. He states that LEUKOVEX will be used for vaccines for infectious diseases and cancers. The products are vectors in that they are vehicles

that contain genetic information and are used in the delivery of that information to a cell.

12) Mr Coffin states that he is aware of several registered trade marks having the prefix LEUCO or LEUKO for pharmaceutical products. He exhibits a list showing the details of four trade marks beginning LEUCO. The comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 have been quoted time and time again by the registrar:

In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.@

The state of the register evidence tells me nothing. In this case the comments of Jacob J are all the more pertinent as the evidence of SP shows that none of the trade marks have licenses for use in the United Kingdom from either the MCA or the EMEA. I will, therefore, say nothing further in this decision about the state of the register of evidence as it has no bearing upon my deliberations.

13) Mr Coffin states that LEUCOMAX is essentially a GM-CSF growth factor preparation for stimulating the growth of white blood cells. The LEUKOVEX product is a therapeutic vaccine. The rest of Mr Coffin's statement represents submissions rather than evidence of fact and I will say no more about it here. However, I bear his comments in mind in reaching my decision.

EVIDENCE IN REPLY OF SP

14) This consists of a further witness statement by Ms Harlow. Ms Harlow exhibits a copy of Mr Coffin's extract from "Websters Third New International Dictionary". She comments that this extract shows that there are various medical terms which start with LEUKO and LEUCO and that it cannot be inferred that the relevant public would assume that LEUCO or LEUKO refer to leukocytes. Ms Harlow exhibits printouts arising from "pharma in-use" searches carried out on the Saegis database. These relate to the trade mark registrations which are referred to in paragraph 12. The database does not identify any of the trade marks as being in use in the United Kingdom, or elsewhere. Ms Harlow goes on to make various submissions that do not represent evidence of fact. She exhibits a copy of Mr Coffin's statement highlighting that on two occasions LEUCOMAX is misspelt as LEUKOMAX.

DECISION

Likelihood of confusion - section 5(2)(b) of the Act

15) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

"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."

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

16) United Kingdom registration no 1385418 is an earlier trade mark as defined by section 6(1)(a) of the Act.

17) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

Comparison of goods

18) The counterstatement of BV admits that the respective goods are identical or similar. It is somewhat surprising, therefore, to find Mr Coffin appearing to argue that the respective goods are not so. Mr Coffin looks at the goods upon which SP currently uses its trade mark and those upon which BV intends to use its trade mark. I have to consider the specifications in their entirety. SP's specification is for pharmaceutical products at large, it covers anything that can be described by this term. “The Concise Oxford Dictionary” defines pharmaceutical as “adj. of or relating to medicinal drugs, or their preparation, use, or sale”. All of the goods of the application are for treating incapacities and will be taken into the body. The respective goods are, therefore, identical or so close that it makes no effective difference. (It is also to be noted that BV have admitted that the goods are identical or similar.)

Comparison of trade marks

19) The trade marks to be compared are:

SP's trade mark:

LEUCOMAX

BV's trade mark:

LEUKOVEX

20) I take into account the matter must be judged through the eyes of the average consumer of the goods in question (*Sabel BV v Puma AG* page 224) who is deemed to be reasonably well informed and reasonably circumspect and observant.

21) In its counterstatement BV claims that the prefix LEUCO/LEUKO is common. Part of the evidence is directed to this point. SP put up evidence, which is not contradicted, that only two products beginning with LEUCO or LEUKO as part of a brand name are licensed for use in the United Kingdom: SP's LEUCOMAX and LeukoScan. Although LeukoScan is licensed in the United Kingdom there is no evidence of actual use here. SP's evidence, in my view, clearly shows that LEUCO/LEUKO are not commonly used for trade marks for pharmaceuticals. It is quite difficult to prove a negative but owing to the licensing of pharmaceuticals I consider that SP has done a good job in doing this difficult task. LEUCO may give an allusion to some people of leucocyte. However, that is likely to depend on the specific goods upon which it is used. SP's specification encompasses all pharmaceutical

products and so must be considered in relation to products which have no relationship to leucocytes. Also 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). 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). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The trade marks could be divided into two, if the relevant public indulged in trade mark dissection as a pastime, however I see no reason why in normal use they should be. I am of the view that each of the trade marks “hang together” quite naturally.

22) I do not believe that either side has argued that phonetically LEUKO and LEUCO are other than identical. The x sound at the end of each is also the same. Taking into account the dieing away at the ends of the words I consider that the final vowels will not be greatly emphasised and there will be little phonetic difference between them. V and M have different sounds. Overall I consider that the respective trade marks enjoy a good deal of phonetic similarity.

23) As SP pointed out Mr Coffin misspelt LEUCOMAX as LEUKOMAX, showing how easily the letters K and C can be interchanged owing to the phonetic identity in certain contexts. When recalling the earlier trade mark the consumer might well substitute a K for a C in his/her mind. In this case this is all the more likely for those who would see an allusion to leukocytes, as leucocyte is an alternative spelling of leukocyte. I assume, also, that a great deal of care was made in drafting Mr Coffin’s witness statement, yet this error occurred on two occasions. The average consumer 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 BV* page 84, paragraph 27). Mr Coffin is not the average consumer and had the trade marks in front of him and still made a mistake in the spelling of SP’s trade mark on two occasions. The two trade marks are the same length. They begin with the same three letters and the letters O and X appear in the same position relative to the other letters. Considering the trade marks in their entirety and taking into account the principle of imperfect recollection I consider that the respective trade marks are visually similar.

24) As I have stated above for certain of the goods LEUCO/LEUKO might give an allusion to leukocytes. If this is the case that element of the trade marks will have a similar conceptual similarity. MAX is a common shortening for maximum. There is no evidence to suggest that the average consumer will see VEX as alluding to vectors. If one indulged in trade mark dissection there is a potential element of conceptual similarity. However, I think that considering the trade marks in their entirety that they are more likely to be seen as invented words rather than having clear conceptual associations. Consequently, I do not consider that the respective trade marks are conceptually similar. However, the nature of the trade marks also means that I do not consider that they are conceptually dissimilar and so no extra distance is put between them by a conceptual dissonance.

25) Overall, I consider that the respective trade marks enjoy a good deal of similarity.

Conclusion

26) In deciding if there is a likelihood of confusion I have to take into account various factors. The distinctiveness or otherwise of the earlier trade mark is of importance as there is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). The natural corollary to this is that there is a lesser likelihood of confusion where the earlier trade mark is lacking in distinctiveness. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

27) In this case no claim has been made by SP as to its trade mark enjoying a reputation. The LEUCO element of SP's trade mark is potentially allusive for goods relating to white blood cells. MAX has its own meaning. However, I need to consider the trade mark as a whole and am of the view that the two elements form a unified whole that will be seen as an invented word and a trade mark. I cannot see any reason why SP's trade mark does not have a good capacity to identify the goods for which it is registered from those of other undertakings. I am of the view that LEUCOMAX has a reasonable degree of inherent distinctiveness.

28) The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case I consider that there is a good deal of similarity between the two trade marks and the trade marks encompass identical or highly similar goods.

29) In coming to a global appreciation as to whether there is a likelihood of confusion I must consider the relevant public. BV comments on the specialist nature of its goods and those of SP. These comments ignore the specifications as they exist. Both specifications encompass pharmaceutical products at large. Consequently, part of the public could be making very careful and educated decisions owing to its specialist knowledge, eg consultants, but part of the public will be the man or woman on the street. The man or woman on the street is unlikely to purchase the goods in the same way as a box of matches or a pair of shoe laces. The nature of the goods is such that some care is likely to be taken. However, a good deal of that care is likely to be directed to the purpose, effects and possible side effects of the product rather than the trade mark.

30) Taking all the above factors into account I consider that there is a likelihood of confusion. Owing to the proximity of the trade marks and the breadth of the specification of SP's trade mark the outcome would have been no different if BV had limited its goods to those Mr Coffin indicated were of particular interest to it. **The class 5 goods of the application are to be refused in their entirety.**

31) SP targeted its opposition to just the goods in class 5. It made no wild claims. It constructed its case in an extremely focused and effective fashion, not attempting to drag in extraneous grounds or making wild claims. Some of its evidence fell into submission but for the most part its evidence was evidence of fact and was directed to the basis of the argument in the counterstatement of BV and the evidence of Mr Coffin. The opposition was filed and conducted in a thoroughly realistic and sensible fashion. This is a case where the kitchen sink was not thrown in and it benefited from it.

COSTS

32) Schering-Plough Ltd having been successful, it is entitled towards a contribution towards its costs. I order BioVex Ltd to pay Schering-Plough Ltd the sum of £1400. 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 11th day of June 2003

**David Landau
For the Registrar
the Comptroller-General**