

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2172950  
BY LUNDBECK LIMITED TO REGISTER A TRADE MARK  
IN CLASSES 16 AND 35**

**AND**

**IN THE MATTER OF OPPOSITION No 49345 THERETO  
BY G D SEARLE & CO**

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in Classes 16 and 35**

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**IN THE MATTER OF Opposition No 49345 thereto  
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### **BACKGROUND**

1. On 24 July 1998 Lundbeck Limited applied under the Trade Marks Act 1994 to register the trade mark CELEXA for a specification of goods which reads:

Class 16:

"Printed publications; advertising and promotional materials; paper, cardboard and goods made of these materials; books, booklets, magazines, journals, letterheaded paper, compliment slips; stationery; parts and fittings for all the aforesaid goods; all relating to pharmaceuticals and the promotion and marketing of pharmaceuticals."

Class 35:

"Advertising, promotion and marketing of pharmaceutical products; business advice and information in relation to pharmaceutical products."

2. The application numbered 2172950 was published for opposition purposes on 7 October 1998.

3. On 7 January 1999 G D Searle & Co filed notice of opposition to this application. The grounds of opposition, in summary, are:

1. The opponents are the proprietors of registration No. 2158599 for the mark SOLEXA in respect of "Pharmaceuticals in the nature of anti-inflammatory analgesics."
2. The applicants' mark is so similar to the opponents' mark as to cause confusion on the part of the public and that registration by the applicant would be contrary to the provisions of Section 5(2) of the Act.
3. The applicants' mark is similar to the opponents' mark which has a reputation in the UK and the use of the applicants' mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponents' mark

and that registration would be contrary to the provisions of Section 5(3) of the Act.

4. The opponents' mark is distinctive by reason of its use in the UK and that registration of the applicants' mark would be contrary to the provisions of Section 5(4) of the Act in that the opponents are proprietors of an earlier right in relation to the mark applied for.
5. Registration of the applicants' mark would be contrary to the provisions of Section 3(3)(b) of the Act as it is of such a nature to deceive the public and will associate the mark with the opponents.
6. Registration of the applicants' mark should be refused under the provisions of Section 3(6) of the Act in that it has been applied for in bad faith.

4. The applicants filed a counterstatement denying all grounds.

5. Both sides seek an award of costs.

6. Both sides have filed evidence and agreed that the matter can be decided from the papers. However, both sides took the opportunity to file written submissions. In doing so, the opponents withdrew all grounds except those in relation to Section 5(2). Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

#### **OPPONENTS' EVIDENCE**

7. This consists of a statutory declaration dated 31 January 2000 by Roger A Williams, who says he is Assistant Secretary and Assistant General Counsel of the opponents' company.

8. Mr Williams says that the opponents have filed an application for the mark SOLEXA in Class 5 under application No. 2158599 in respect of "Pharmaceuticals in the nature of anti-inflammatory analgesics." Details are provided as Exhibit RAW1. (The application has subsequently proceeded to registration).

9. Mr Williams then says that the applicants' mark is filed in respect of goods in Class 16 and services in Class 35 which relate to pharmaceutical products. He goes on to say that printed materials and advertising relating to pharmaceuticals "will be directed towards and come to the attention of the purchasing public who wish to purchase pharmaceuticals sold by reference to my company's mark SOLEXA. This must be a potential cause for confusion amongst that purchasing public."

#### **APPLICANTS' EVIDENCE**

10. This consists of a statutory declaration dated 3 October 2000 by Jarne Elleholm who says he is Managing Director of the applicants' company.

11. Mr Elleholm refers to use of the mark CELEXA in the United Kingdom since October 1998 (ie after the filing date). Mr Elleholm goes on to say that the mark is used as the name of one of three sales teams, using the mark as a reference to the division in which they work when they present themselves to customers, namely General Practitioners and other medical professionals. Mr Elleholm further states that the mark is mainly used verbally and on stationery business cards. Exhibit JE1 provides an example of a business card using the applicants' mark. The mark is not used, Mr Elleholm says, on packaging or on advertisements for pharmaceutical products.

12. That concludes my review of the evidence. However, as mentioned earlier, both parties provided written submissions.

### **OPPONENTS' WRITTEN SUBMISSIONS**

13. These submissions are provided in a letter dated 20 July 2001 from Mr G Farrington of Ladas & Parry, the opponents' trade mark agents.

14. Mr Farrington, as mentioned earlier, withdraws all grounds of opposition other than that remaining under Section 5(2). He says that "The opposition is founded on the basis that the opponent has an earlier trade mark which covers goods which are similar to the goods and services of the mark applied for and which is a similar mark to the opposed mark." Mr Farrington's submissions then confirm that for the purpose of Section 5(2)(b) the opponents' mark is clearly an earlier mark and that it is now a registered trade mark.

15. Mr Farrington argues that the applicants' mark is aurally "almost identical" to the opponents' mark and that there are also visual similarities given the final letters in both marks are LEXA.

16. The goods and services at issue are then referred to by Mr Farrington who says -

"In normal circumstances goods in Class 16 and services in Class 35 would not be considered to conflict with goods in Class 5. However, the limitation placed on the specification of the mark applied for brings the goods and services within the scope of the opponents' registration."

17. Mr Farrington then expands on the reasons for coming to this conclusion and says "We believe that the likelihood of confusion would arise both for the purchasing public but also in relation to medical professionals given the similarity of the marks." However, Mr Farrington explains that no evidence of actual confusion has been filed because the opponents' mark is not in use.

18. Mr Farrington concludes by saying:

"Here we have very similar marks and goods and services which may not be considered particularly similar but they are obviously related. It seems to us highly likely that the association that would arise between these marks would cause the public to wrongly believe that the respective goods and services come from the same or

economically linked undertakings and that is what would prove that there is a likelihood of confusion."

## **APPLICANTS' WRITTEN SUBMISSIONS**

19. These submissions are provided under cover of a letter dated 2 August 2001 from Urquhart-Dykes & Lord (Milton Keynes), the applicants' trade mark agents. Much of the submissions relate to grounds which have now been withdrawn by the opponents. Those relating to Section 5(2) are set out below.

20. The submissions explain that the applicants' mark is used in connection with a pharmaceutical sales team who present themselves to General Practitioners and other medical professionals with literature relating to the pharmaceutical products they are promoting. Their mark is used in relation to printed matter and promotional services relating to pharmaceuticals, but not in relation to a particular pharmaceutical product or on packaging of any pharmaceutical products. They also say that the marks CELEXA and SOLEXA are visually very different.

21. That concludes my summary of the written submissions.

## **DECISION**

22. The only remaining ground is under Section 5(2) of the Act which reads as follows:

"5.-(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."

23. The term "earlier trade mark" is itself defined in Section 6 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;"

24. I take into account the guidance provided by the European Court of Justice (ECJ) in

*Sabel BV v Puma AG* [1998] E.T.M.R. 1, *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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* 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*, paragraph 23;
- (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*, paragraph 23;
- (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*, 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*, 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*, paragraph 26;
- (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*, 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*, paragraph 29."

25. It is clear that identical marks are not involved and so it is Section 5(2)(b) of the Act

which applies. Furthermore, the applicants' goods and services and the goods of the opponents, as set out earlier in this decision are clearly not the same and is not a matter of dispute between the parties. Therefore, the first matter I need to consider is whether similar goods/services apply in this case. If they do not then the opposition must fall as Section 5(2)(b), the opponents' only grounds, cannot apply. I must also apply the test to the specification filed, as a notional test, and not to the more limited range of goods and services referred to in the applicants' evidence and submissions.

26. The CANON case, *Canon KK v Metro-Goldwyn-Meyer Inc* (1999 RPC 117) refers to factors which determine the similarity of goods as set out in the TREAT case by Jacob J. (paragraph 23 of the judgement) which are:

- (a) The uses of the respective goods or services;
- (b) The users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets, and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are in competition with each other; that enquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or the services in the same or different sectors.

27. Taking each of these points in turn I now go on to consider whether the goods/services are similar.

28. Uses (Point a). The opponents' goods are pharmaceuticals in Class 5 used to provide anti-inflammatory analgesic treatments of ailments. The applicants' goods in Class 16 are "all relating to pharmaceuticals and the promotion and marketing of pharmaceuticals" and are not used for the treatment of ailments. The applicants' services are for advertising, promotion and marketing of pharmaceutical products and business advise and information relating to pharmaceuticals. They are not used for the treatment of ailments. I find the uses are, therefore, different.

29. The users (Point b). The opponents' goods are used by the general public. The applicants' goods, as listed, may also be used by the general public, by the medical profession or by the pharmaceutical industry. However, in my view, this is too broad a test. I am not aware that e.g. pharmaceutical manufacturers or the medical profession trade in the goods covered by the applicants in Class 16. Furthermore, the type of goods likely to be traded in

Class 16 are not of the type which would use pharmaceutical names for such trading and I have no evidence that this would be so. Therefore I consider the users of the goods are unlikely to be the same.

30. In relation to the services in Class 35, the applicants' users will be the pharmaceutical industry and also the medical profession requiring information about pharmaceuticals. The users of the service will not be those requiring treatment of ailments, but rather the providers of such treatments such as GPs, or the providers of the means by which the public can treat themselves eg. chemists or supermarkets. I find, therefore, that the users of the applicants' services and the opponents' goods are not the same.

31. Physical nature (Point c). The opponents' goods are pharmaceuticals while the applicants' goods are made of paper and cardboard or are items of stationery. The goods are clearly different in nature and the services are self-evidently unrelated, in nature, to pharmaceuticals. I find the nature is, therefore, different.

32. Trade Channels (Point d). The opponents' pharmaceuticals and the goods and services provided by the applicants are likely to come together, if considered at a general level. Medical practitioners and GPs are likely to prescribe drugs such as those provided by the opponents and will also receive the goods and services provided by the applicants. Members of the public may also receive information about pharmaceuticals (printed matter e.g. advertising material) and have pharmaceuticals prescribed by their GP. The pharmaceuticals may also be bought in a supermarket or over a prescription counter. Therefore, both the pharmaceuticals and the printed matter are likely to be brought to the attention of both the general public and medical practitioners. However, as in (b) above, I consider this too broad a test. The applicants' goods are unlikely to be traded in the same area as the opponents' pharmaceuticals.

33. In my view the services provided by the applicants are unlikely to share trade channels with the opponents' goods since the applicants' customers are not the general public or medical practitioners but the pharmaceutical industry or businesses. Therefore, the trade channels for the applicants' services are not the same as those for the opponents' goods.

34. Supermarket shelves (Point e). The opponents' goods are likely to be found on supermarket shelves or, possibly over the counter at supermarkets' pharmacy departments. The applicants' goods are unlikely to be sold in supermarkets. However, if they are, they are bound to be in a separate area and on different shelves, being printed matter or stationery. The applicants' services clearly do not fall in this area. Therefore, I find no similarity in this area between the opponents' goods and the applicants' goods and services.

35. In Competition (Point f). It is clear that the respective goods and services are not in competition with each other and are not in the same sectors, notwithstanding the fact that the subject matter of the applicants goods and services relates to pharmaceuticals, the opponents' products.

36. Taking the best view I can of the matter I consider that similar goods are not involved. On all counts other than "users" and "trade channels", I find that no similarity exists. With



regard to the two points referred to above the similarity seems, at best, to be tenuous and does not stand up to scrutiny when actual trading is taken into account. Therefore, I find there is no similarity in goods/services.

37. Following on from the previously mentioned CANON case, the Court of Justice returned to the question of likelihood of confusion for the purposes of Article 4(1)(b) of First Council Directive 89/104 of December 21, 1988, - equivalent to Section 5(2)(b) of the UK's Trade Marks Act 1994 - in a further reference from Germany. The Court amplified upon the reasoning in the SABEL case, *Sabel BV v Puma AG* (1998 RPC 199) in the following passage:

"17. A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods and services."

and at paragraph 22:

"22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar."

(See paragraph 20 of the VIAGRA case, *Pfizer Ltd and Pfizer Incorporated v Eurofood Link (United Kingdom) Ltd*, 2000 ETMR 896).

38. As I find that the applicants' goods and services are not similar to the opponents' goods I consider the opposition fails under the only remaining ground, Section 5(2)(b) of the Act.

39. In case I am wrong in finding that the goods and services at issue are not similar I now go on to consider whether there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier mark.

40. It is clear from the above that, if I consider the goods and services at issue are not similar, the degree of similarity in the event that I am wrong must be considered very slight indeed, given the analysis provided above.

41. Turning to a comparison of the marks, as noted in *Sabel v Puma* visual, aural and conceptual similarities must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. Visually I consider there are significant differences. While noting the common ending "LEXA", it is well established in case law that it is the beginnings of words which have the greatest impact. Clearly CEL and SOL are quite different and, in my view, help to distinguish the marks visually, when taken as a whole.

42. Aural comparison, as stressed by the opponents, suggests that there is little or no difference in the pronunciation of the marks. I find, that the marks must be considered aurally similar or the same.

43. Conceptual similarity is, in my view, not strong. Clearly both words are invented and have common endings. However, "SOL" suggests to me a reference to the sun while "CEL" suggests an abbreviation of e.g. celluloid (See dictionary reference). Overall, however, I would expect visual and aural considerations to be the major factors in determining confusion between the marks.

44. I must, of course, consider the matter globally taking account of the weak (if any) similarity in goods and services and some degree of similarity in the marks.

45. In relation to aural similarity, which appears to represent the opponents' strongest case, it seems to me that the applicants' goods and services are unlikely to be referred to or traded in verbally by the general public. Furthermore, the public in general and the medical profession in particular are likely to take extra care when dealing with pharmaceuticals or goods and services related to pharmaceuticals. It is clear from the evidence that the applicants' mark will be used aurally in relation to GPs and the medical profession (See paragraph 11 of this decision). However, while I have found that the marks are aurally very similar or the same, I do not find that this is sufficient to demonstrate confusion given the differences in the respective goods and services and that their likely users are sophisticated.

46. The visual and conceptual differences between the marks and, again, the nature of the goods and services make confusion by "a reasonably well informed and reasonably circumspect and observant" consumer even less likely, in my view. All the more so in the absence of any use of the opponents' mark which therefore has no enhanced reputation.

47. The Act requires me to consider the likelihood of confusion, as opposed to the mere possibility of confusion. For the reasons given above, I consider that confusion is highly unlikely. Therefore, the opposition fails under the only remaining ground, Section 5(2)(b).

48. The opposition having failed, the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £435 . This sum is to be paid within seven days of the end 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 06 day of March 2002**

**R A JONES  
For the Registrar  
the Comptroller-General**