

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2238157
IN THE NAME OF BIO VEX LTD**

AND

**IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF
INVALIDITY (UNDER NO. 80810)
BY SMITHKLINE BEECHAM PLC**

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**IN THE MATTER OF registration No. 2238157
in the name of Bio Vex Ltd**

and

**IN THE MATTER OF an application for a declaration of
invalidity (under No. 80810)
by SmithKline Beecham Plc**

BACKGROUND

1. The details of trade mark registration 2238157 are as follows:

Mark:	VEXELL
Goods/services:	<u>Class 5</u> – Pharmaceutical preparations and substances; vaccines; diagnostic preparations, viral preparations. <u>Class 10</u> – Diagnostic apparatus; medical testing apparatus; medical apparatus and instruments. <u>Class 42</u> – Medical and scientific research; discovery and design of pharmaceutical and therapeutic preparations; diagnostic services.
Filing date:	4 th July 2000
Registration date:	18 th December 2000
Registered proprietor:	Bio Vex Ltd

2. On 2nd May 2002 an application for a declaration of invalidity in respect of the above registration was filed by SmithKline Beecham Plc. A statement of grounds accompanied the application, in summary the grounds upon which the application is made are:

Section 47(2)(a)	That the registration should be declared invalid pursuant to Section 47(2)(a) of the Act on the following grounds:
Section 5(2)(a)	That the trade mark is visually and phonetically similar to the earlier trade marks of the applicant. Furthermore, the goods for which registration is sought are identical with or similar to the goods for which the trade marks of the applicant are protected, so that there exists a likelihood of

confusion on the part of the public. The applicant claims to be the proprietor of the following earlier marks:

Trade Mark	Number/filing date	Goods
Vixsel	UK trade mark 2221045 filed on 1/2/2000	Class 5 – Pharmaceutical and medicinal preparations for human use.
Vixsel	CTM trade mark 1531862 filed on 29/02/2000	Class 5 – Pharmaceutical and medicinal preparations and substances to treat diseases and disorders of the cardiovascular system.

3. The registered proprietor did not file a counterstatement in response to the application for invalidity, the application is therefore uncontested. However, it does not follow that the uncontested nature of this action will automatically mean success for the applicant and failure for the registered proprietor. A registered trade mark has a statutory presumption of validity, this is provided by Section 72 of the Act. If that presumption of validity is to be displaced then any application for a registered trade mark to be declared invalid must have merit. I find support for this line of thinking in the decision in the *Firetrace Case* (BL 0/278/01) where the Hearing Officer states:

“It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

4. The applicant was given an opportunity to file evidence, written submissions or oral submissions (at a hearing) in order to support their application. Neither evidence nor written submissions were received; no request for a hearing was made.

5. The onus in these proceedings is on the applicant to show that their application has merit, but no evidence has been filed to support their application. However, given that the sole ground of invalidation is that raised under Section 5(2)(b), and that this is ground that does not necessarily require evidence, I now turn to give a decision based upon a careful study of the statement of grounds.

DECISION

6. The applicant claims that the registration should be declared invalid in accordance with Section 47 of the Act on the basis of the provisions of Section 5(2)(b). The relevant parts of the legislation are as follows:

“47.(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in Section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

.....
(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.”

“5(2) A trade mark shall not be registered if because-

(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.”

7. An earlier right is defined in Section 6, the relevant parts of which state:

“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”

8. 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] R.P.C. 117, *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 132, 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 224;
- (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 133 paragraph 29.

Distinctiveness of the earlier marks

9. When considering a claim under Section 5(2)(b), an assessment of the distinctive character of the earlier mark is normally conducted in order to ascertain whether it is entitled to enhanced protection (see point (f) above). The distinctive character of the earlier marks may reside in the inherent qualities of the marks and/or through the use made of them.

10. As no evidence has been filed I can only consider the inherent qualities of the marks. Both earlier marks are for the word VIXSEL. This is not an ordinary English dictionary word, nor does it allude to one. There does not appear to be anything in the mark that is in anyway descriptive of the goods in question (or of any other goods or services). From the information I have before me, it is an invented word. Taking this into account I

consider the applicant's earlier marks to have a high degree of distinctive character and consequently will enjoy a high penumbra of protection as part of my assessment of the likelihood of confusion.

Similarity of marks

11. When considering the question of similarity, I do so with reference to any visual, aural and conceptual similarities. For ease of reference, I reproduce the marks below:

Registered Proprietor's mark

Applicant's mark

VEXELL

VIXSEL

12. Visually, the marks are of similar length and begin with the same letter (V). They also share the same third letter (X), and both contain the letters EL towards the end of the marks. These similarities, particularly standing in what I consider to be a relatively short mark, bring me to the conclusion that there is a high degree of visually similarity.

13. When assessing the aural similarities between the marks, I firstly note that both marks contain two syllables. Whilst not being identical in pronunciation, both syllables in each of the marks will be pronounced in a similar way. I am also conscious that the letters "XELL" (as contained in the registered proprietor's mark) will be pronounced with an S sound after the letter "X"; this brings it even closer to the comparable element (XSELL) in the applicant's mark. Thus, in my view, the two words would be pronounced "VEXSELL" and "VIXSEL". I therefore consider there to be a high degree of aural similarity.

14. There is no evidence before me to suggest that both marks are anything other than invented words. As the words are different, conceptual similarity is not particularly high.

Similarity of goods/services

15. In order to assess the similarity of the goods, I note the test set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at page 296; one must consider:

- (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 services;
- (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 on the same or different shelves; and

(f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. The above factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgment, the ECJ stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.’

17. I have received no evidence or submissions on the question of the similarity between the goods and services covered by the registered proprietor’s mark and the goods covered by the applicant’s earlier right. I am therefore left to take the best view of matters myself whilst taking into account the above case law.

The Class 5 goods

18. The registered proprietor’s class 5 specification covers a broad range of goods in Class 5 including pharmaceutical products at large and also diagnostic preparations. The applicant’s earlier rights cover pharmaceutical and medicinal products either limited to human use or to use in respect of the treatment of diseases of the cardiovascular system. Taking this into account, the registered proprietor’s specification must cover some goods identical to those covered by the applicant’s earlier rights. Where the goods are not identical (e.g. pharmaceutical products other than for human use, and pharmaceutical products other than for treating diseases of the cardiovascular system, and diagnostic preparations), I consider them to be of a similar nature having taken due regard to their nature and users etc.

The Class 10 goods

19. The registered proprietor’s specification in Class 10 reads:

“Diagnostic apparatus; medical testing apparatus; medical apparatus and instruments.”

20. The applicant’s earlier right does not extend to Class 10, I must therefore assess whether their goods in Class 5 are similar to the registered proprietor’s goods in Class 10.

21. The physical nature of the goods does differ, one being pharmaceutical products and other preparations, the other being various forms of apparatus. The users of both will

include medical professionals but may also include members of the public. The uses have similarities, both pharmaceuticals & medical apparatus and instruments are used for the treatment of disease whilst diagnostic preparations & medical testing and diagnostic apparatus would be used for testing and diagnostic purposes. I have no evidence before me to suggest who the respective users of the products are or through what trade channels the goods are sold. Taking all the relevant factors into account, I consider there to be some albeit a low degree of similarity.

The Class 42 services

22. The registered proprietor's specification in Class 42 reads:

“Medical and scientific research; discovery and design of pharmaceutical and therapeutic preparations; diagnostic services.”

23. The applicant's earlier right does not extend to Class 42, I must therefore assess whether their goods in Class 5 are similar to the registered proprietor's services in Class 42.

24. The physical nature of the goods/services differs given the inherent differences between any product compared to the provision of a service. Whilst I do not consider the goods/services to be in any way competitive, I am mindful that a link could be formed in the mind of the consumer between a pharmaceutical product and the type of services covered by the registered proprietor's specification. The users will again include medical professions. The uses are not identical, but both are in a similar field. Taking all the relevant factors into account, I again consider there to be some albeit a low degree of similarity.

Likelihood of confusion

25. I have already found that there is a high degree of visual and aural similarity between the registered proprietor's and applicant's marks. Given the nature of the goods and services, visual and aural will be the primary points of reference as they will be chosen by the eye and ear with little consideration of conceptual issues. I have also found some of the respective goods to be identical and some to be similar. Even though I have only found a small degree of similarity between the registered proprietor's Class 10 & 42 specifications and the earlier right's specifications, I consider that this, when taken with the high degree of similarity between the marks themselves and also the earlier right's high penumbra of protection, will lead to a likelihood of confusion. The application for a declaration of invalidity consequently succeeds.

Conclusion

26. Taking the above findings into account I declare the registered proprietor's registration to be invalid. I direct that it be removed from the register and in accordance with Section 47(6) of the Act the registration is deemed never to have been made.

Costs

27. Although the applicant requested costs in their initial statement of grounds, no submissions were received on this matter prior to writing this decision. Taking into account that the registered proprietor did not contest the application, nor did the applicant provide me with any submissions to persuade me that costs should be awarded to them, I decline to make an award to either party.

Dated this 09 day of May 2003

**Oliver J Morris
For the registrar
The Comptroller General**