



TRADE MARKS ACT 1955
DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS,
WITH REASONS

Re: Opposition by Johnson and Johnson to the registration of application 542273 in the name of Boehringer Ingelheim KG.

Background

On 6.2.92, the above trade mark application was advertised as accepted for registration. The application is in the name of Boehringer Ingelheim KG ("the applicant"). The trade mark the subject of the application, which was lodged on 18.9.90, is the word ALDOLES. The goods specified in the application are "pharmaceutical and sanitary preparations; plasters and all other goods in this class", or, in general terms, all medicines, veterinary preparations, disinfectants, herbicides and pesticides.

Registration of the trade mark has been opposed by Johnson and Johnson ("Johnson"). The first ground of opposition relied on by Johnson is that the mark the subject of the application is blocked by their own registration, for the trade mark HALDOL. It is also argued that the use of the trade mark ALDOLES would cause deception or confusion because of the actual market reputation of HALDOL.

Evidence

Taking together Johnson's evidence in support and in reply, the two evidence stages allowed to an opponent under the Trade Mark Regulations, certain facts emerge.

Johnson is the proprietor of trade mark registration 264789 for the mark HALDOL. The goods specified in the registration are "pharmaceutical preparations". Johnson has in fact used that trade mark, albeit narrowly, in respect of an injectable substance used to treat patients with psychoses.

The mark has been used in Australia since January 1990, although, prior to this, it was reviewed in a lecture given to pharmacists in July 1989. Similarly, the Director of Pharmacy at the Royal Park Hospital in Parkville, Victoria, has declared that he personally has known of the drug in question since 1988.

Another element of Johnson's evidence is the stated opinions of three declarants that confusion of ALDOLES and HALDOL is likely.

While it is said, in the applicant's evidence, that the marks ALDOLES and HALDOL coexist on the trade mark register of the United States, Johnson's uncontradicted reply is that the applicant's mark is unused in that country.

The applicant's evidence in answer to the opposition establishes that the trade mark ALDOLES "is not yet in use in Australia. It is intended to use the trade mark in respect of analgesics".

The applicant's evidence also goes to the state of the Trade Marks Register in Australia. A search is appended. This establishes that in class 5 there are 204 registrations for marks commencing with AL and 73 ending in DOL. It is perhaps interesting to speculate on the closeness of pairs of marks but the search gives no indication who owns the marks listed, be they similar or otherwise, so I do not think I can give it any weight at all in establishing how the Trade Marks Office might have viewed similar problems in the past.

After the evidence stages provided for in the Regulations, the matter was set down for hearing on 19.10.94. The applicant was represented by Catherine Chant, a solicitor of the attorney firm of Davies Collison Cave. Johnson was represented by Mr Leon Allen, a patent attorney of the attorney firm of Shelston Waters.

Arguments:

For reasons which follow, it will be necessary only to deal with matters under s 33(1) of the Trade Marks Act. That section provides:

33. (1) Subject to this Act, a trade mark is not capable of registration by a person in respect of goods if it is substantially identical with or deceptively similar to a trade mark which is registered, or is the subject of an application for registration, by another person in respect of the same goods, of goods of the same description as those goods or of services that are closely related to those goods, unless the date of registration of the first-mentioned trade mark is, or will be, earlier than the date of registration of the second-mentioned trade mark.

Ms Chant conceded that there is a direct overlap of goods, and Mr Allen argued that the marks were either substantially identical or deceptively similar.

He noted that there was a heavy onus on an applicant, when its mark was unused, to show that it is entitled to a registration. In his view, judged by their looks and sounds (*PIANOTIST* case 23 RPC 774, applied subsequently in many Australian cases and also relied on by Ms Chant) the marks were too close. He reminded me that I should have regard to the "effect or impression that is carried away" (*Australian Woollen Mills Ltd v FS Walton and Co Ltd* 58 CLR 641 at 658.) He argued that I should not deal with the marks as they might be pronounced in a studio of elocution and that I should have regard to reasonable possibilities of imperfect recollection.

Mr Allen commended the "expert witnesses" who, on behalf of Johnson, declared that they thought deception or confusion were likely. He noted the speech of Lord Diplock in the *GE*

case, [1973] RPC 297, that evidence of persons who are experts in specialist areas, as opposed to those in which goods are sold to the general public, is "essential".

Mr Allen noted that the words ALDOLES and HALDOL are both invented, hence more likely to be confused and that the points of difference were in fact minor: an ES on the end - this being a standard pluralisation - and an initial H which he likened to "the H in 'udson". Mr Allen also referred to the decision in *Manufacture de Bonneterie C. Mawet v Kaydale Apparel Ltd* 1984 AIPC 93-228.

Ms Chant argued, for her part, that the differences between the marks were significant. In her view the total impacts of the two marks were more readily distinguishable than Mr Allen would have me believe. Overall the two marks could, she said, easily be distinguished by sight. She relied on *London Lubricants appn* (1925) 42 RPC 264 at 279 to remind me of the importance of the first syllable in the sound and memorability of marks, and on a British decision, *WB Pharmaceuticals v Wellcome Foundation*, published in brief form at 1985 IPD 8024. That case illustrates what she argued to be the obvious point that, in writing in general and in doctors' prescriptions in particular, it is likely to be the ends of words which will be unclearly written, not their beginnings. This countered, she argued, Mr Allen's claim that a handwritten capital H could, in some handwritings, look like a capital A.

She relied on *Otsuka Pharmaceutical Co Ltd v Rousel-Uclaf* 1992 AIPC 90-911, where the marks GLACOLAN and CLAFORAN were at issue, for the principle that, with prescription goods, sound is less important than look. She relied on the skill and attention paid to dispensing such goods and noted in *Aktiebolaget Astra v Schering Corp* 22 IPR 485, where the trade marks UNI-DUR and IMDUR were considered.

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Even allowing for non-prescription goods, and allowing for imperfect recollection, either visual or aural use would not give rise to deception. With that in mind she noted the comments in

Johnson and Johnson v Kalnin 26 IPR 435. In that case, Justice Gummow first of all noted the English view in a decision of Mr Justice Whitford in *Mars GB v Cadbury Ltd* [1987] RPC 387:

I have, of course, referred to those words of Parker J. (in the *PIANOTIST* case, *supra*) which deal with the need to consider not only the look of the marks but their sound. However, in present day conditions, when all items of confectionery of this size - as is apparent from the evidence before me in this case - are sold packaged with the brand appearing clearly on the packaging, and when the goods are, for the most part, picked up by the customers, and on the goods as picked up the marks will be clearly visible, the question of sound is perhaps becoming of diminishing importance."

I think it is a well-known fact, and one of which I can take note, that retail outlets of the type referred to here operate on the principle that the customers select their purchases from display shelves with little or no intervention from sales staff, as one of the means whereby operational costs are reduced and product prices are kept as competitive as possible.

Justice Gummow said:

There is, I think, some force in this observation, but nevertheless, it must be kept in mind that, for example, both aural and visual presentation are combined in television advertising.

Ms Chant formulated an argument that, where there were some aural differences between the marks and obvious visual differences, I could safely put weight on the latter.

All in all, her view was that the applicant had met the onus placed on it, both before the examiner of trade marks and subsequently.

Decision:

Conflicting marks.

In the light of the obvious differences between the marks when compared side by side, I do not think they can be held to be substantially identical. At the end of the day, this matter is to be decided on the likelihood of ordinary buyers mistaking HALDOL for ALDOLES when those marks are used in the ordinary way for class 5 goods which may be sold on supermarket or pharmacy shelves or elsewhere. The care and attention paid to the reading or

deciphering of prescriptions is not of great weight where the applicant seeks to register a trade mark to be used for non-prescription goods, while what it faces is a possible conflict with a registration for just such self-serve medicines. While people buying medicines no doubt pay more attention to the trade marks of such goods than they might to the proverbial bag of sweets, the standard which applies will impose a greater burden on the applicant than would apply for prescription lines, where a written order is required in order to reduce the scope for errors.

At first sight, there is not apparently a great deal in common in the two marks - the differences Ms Chant relied on are obvious. It is perhaps for this reason that the registration of HALDOL was not considered prior to the acceptance of the application; it was not found in a search of the register. However, lying beneath those differences is an overall sameness, a similarity in the total impressions left by the two marks. This impression is perhaps the "Gestalt" of reading and recognition relied on by the opponent in *Astra v Schering*, supra.

In that case I found that it was not appropriate to rely on such broad-brush comparisons for prescription goods; nor do I agree that it is entirely appropriate here, except as a rough formulation of the tests that apply in the comparison of invented words of some length. The matters to be considered are finely balanced and the decision now to be made is, to my mind, at least as close as any in those relied on by the representatives of the parties. The balance must be approached as in *Australian Woollen Mills*, supra:

In deciding this question, the marks ought not, of course, to be compared side by side. An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark or device for which the protection of an injunction is sought. The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark or device is the same.

This is not a simple case of HUDSON vs UDSON, since the marks at issue here are both invented words, neither of which is likely to particularly rivet an effect or impression into the

minds of purchasers. It is when the matter is put in such terms, of the effect or impression that will be carried away, and in the absence of the original for purposes of comparison, that the potential for deception is most clearly seen.

In such a context, I must allow for the various and subtle ways in which different people may recall the competing marks. Some, no doubt, will place full emphasis on the initial letter H, and perhaps they will be in the majority. But I am not convinced that all buyers of analgesics, cough lozenges or other more or less mundane medical products will recall the marks in this accurate and particular way, and it is probable that a reasonable number of buyers will regard the sound of either of these invented words as part of its essence. Therefore, I must reduce the weight I can give to the differing initial letter, and I agree with Mr Allen that the endings, OL or OLES, are of very little weight. My conclusion is, therefore, that when I allow for an appropriate degree of imperfect recollection, there will be a small but still reasonable chance of deception or confusion.

The authorities show that the application should be refused in such a case. I therefore conclude that the application should be refused for non-prescription pharmaceuticals.

The application presently stands in respect of all goods in class 5, and there are prescription goods within its current scope. I have concluded that the marks will be able to coexist, in terms of s 33, for prescription goods, where normal standards of professionalism will prevail.

In doing so, I do not dispute the seriously declared opinions of the experts on whom Johnson has relied. However, those declarants were not cross-examined and their opinions must be assessed out of context. That, of course, was not the situation which Lord Diplock had in mind in the *GE* case, *supra*, where his speech refers to "witnesses called in at the trial", while what was actually at issue in *GE* was the relevance of survey evidence to the situation in the market for ordinary consumer goods. To the extent that the declarants in the present matter hold some concern about the possibility of confusion, in some apprehended but unidentified

context, I note their views but I give them minimum weight. Even had it been clear just how and why the declarants were apprehensive about such confusion, I would still not be able to give their views full weight without some means of knowing if their concerns were in fact reasonable. Such might come, for instance, from a question which asked if the marks now in suit were unusually close by the standards of the profession, or how they compared in closeness to similarities against which the declarants are no doubt routinely on guard. Such a weighting factor is lacking in the present case and this brings me back to a point which Mr Allen conceded, that at the final word the decision is one for the tribunal, not for a body of declarants.

On the other hand I note and accept Ms Chant's argument about the clarity of the first parts of handwritten words, which seems to be consistent with established standards in these matters. This will reasonably preclude confusion among professionals even in the event that the marks are rendered as HALDOLS and ALDOLES. It is stretching credibility too far to assume that the handwriting of doctors is so poor that an initial letter H in such a context, the worst case scenario, would be written in a way that can be confused with an A.

I do not find there to be any conflict for goods which are not pharmaceuticals. They are outside the scope of Johnson's registration, and the registration of ALDOLES for dissimilar goods will not give rise to problems.

For the record, I make no finding as to the second ground relied on by Johnson, that use of the applicant's mark would cause deception or confusion in the light of the established reputation of the mark HALDOL. The action of s 28 in of the present Act is still subject to considerable controversy. I share Mr Allen's frustration with the situation but my finding under s 33 should preclude any problems which might otherwise have been seen to arise under s 28. It is only in respect of a narrow and very specialised range of medicines that HALDOL has any reputation, and that area of conflict is no more than a subset of the prescription goods I have addressed in relation to s 33.

Intention to use.

Mr Allen did not press the argument that the applicant's stated intention to use the mark was narrower than that originally affirmed when the application was examined. None the less it is clear that the applicant has narrowed its focus since the application was made. Ms Chant conceded that the applicant has, for whatever reason, clarified its intention to use. She argued, however, that the clarification was subsequent to the making of the application, which was properly accepted on the basis of the originally intended, broader use.

I must agree with this. The original decision to accept the application, on the basis of a statement of intention to use, was correct. It is no more than arguable, from the declarations on file, that the applicant has abandoned its original broader intention.

The applicant has recently declared that the mark: "is not yet in use in Australia. It is intended to use the trade mark in respect of analgesics". Such a specific statement would not, now and on its own, be enough to found a claim for proprietorship for any goods other than analgesics. None the less, a broader intended use was originally positively stated, in writing as per the terms of regulation 8. There would need to be some clear-cut evidence before I found that the applicant had actually abandoned its title, gained in lodging the application, in respect of the broader goods.

Having heard the representatives of the parties, I am satisfied that the former broad intention to use is in fact now considerably reduced. That, however, is a matter which may best be left to some future application under s 23, which deals with unused registered trade marks.

Conclusion

In resolving the matter under s 33, I will refuse the application unless, within one month of the date of this letter, it is restricted to "prescription pharmaceuticals; all other goods in class 5 except pharmaceuticals", or such narrower statement as the applicant may propose.

Subject to any appeal from this decision, I direct that each side should bear its own costs.

T.E Williams
Hearing Officer

21 February 1995