



## TRADE MARKS ACT 1955

### DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS, WITH REASONS

**Re:** Opposition by THE UPJOHN COMPANY to the registration of trade mark application number 598114 in the name of ELF SANOFI S.A.

Application no. 598114 was lodged on 15.3.93 in the name of ELF SANOFI S.A., ("the applicant"). It seeks to register the mark APROVEL in respect of "pharmaceutical products". Following examination, the mark was accepted for registration and advertised as such in the *Official Journal*.

Registration of the mark was opposed by The Upjohn Company, ("the opponent"), in accordance with the provisions of s 49 of the Act. The opposition was based on a number of grounds but only one ground was pursued by the opponent at the hearing. This was under s 33 of the *Trade Marks Act 1955*.

The opponent has served no evidence in support of the opposition, but informed the applicant that it intended to rely on the state of the register and on established case law. When the opposition came to a hearing before me, as a delegate of the Registrar of Trade Marks, the applicant was represented by Mr David Wilson, a patent attorney of the firm of Shelston Waters. The opponent was represented by Mr Gerard Skelly, solicitor, of Spruson and Ferguson.

Section 33 provides, in the relevant sub-section:

- (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.

It is common ground that the application stands or falls on comparison with trade mark registration number 553727, PROVELLE. That trade mark is registered to the opponent for precisely the goods now in question. One leg of s 33 is thus established.

### **Submissions**

Mr Skelly commenced his submissions by noting the similarities in the overall looks of the words PROVELLE and APROVEL. He argued that, while the initial letter A in the applicant's mark is obvious, the stress falls primarily on the middle and end syllables. The notable suffix "vel" in the opponent's mark illustrates this, perhaps adding a French flavour to the applicant's mark. Even if this was not so, the form of the word APROVEL was comparable to the word "caravel", in which the stress falls heavily on the end syllable. That pronunciation, he argued, was consistent with what was said in *Merck and Co Inc v Pfizer Inc*. (1986) AIPC 90-270. In other instances, the key differences would be simply lost in the overall sameness of two invented words (*McDowell's application*, 1927 44 RPC 335 at 341.)

He argued, too, that the marks were prone to confusion if the initial letter A was obscured in use, as when bottles or packages were displayed on a shelf. Equally, if the marks were used in relation to prescription goods, the "notoriously poor" handwriting of doctors could easily, he argued, render a letter A confusingly like a letter P.

Nor were the marks for use in the proverbial "studio of elocution" - *Aristoc v Rysta*. Customers could readily ask for "a PROVEL product", or hesitate - "um, ah, PROVEL, please".

Finally, there were real numbers of customers who would infer that the letter A was an indication of a form of the word PROVELLE. That mistake would perhaps come with having an inadequate knowledge of Greek structures, where, strictly speaking, the initial "a" denoted "not". Whatever the

cause of the confusion, he argued that it was a very real risk where the element "provel" remains intact within the applicant's mark.

Mr Wilson, for his part, disputed the claimed sameness of the look and sound. He relied, inter alia, on a decision given on a comparison of the opponent's PROVELLE with NUVELLE. That decision, published as *Schering v The Upjohn Co* (1994) AIPC 91-082, resulted in a win for the present opponent. The deciding officer, Ms Hardie, noted the strength in the suffix --ELLE. She concluded that, while the respective pronunciations were not established as being either the same or different, "on a visual comparison the words ending with -velle carry an idea of a French connection which is entirely absent from the -vel words". She agreed with Mr Skelly, noting that the additional eight -vel trade marks (in evidence in that case) "do not reduce the distinctiveness quantum of the word element -velle".

Nor should the ordinary possibilities of the handwriting of doctors be stretched too far, he said. Even on an unlined prescription pad, the initial letters A and P would not be rendered in any way that would allow them to look similar.

As to pronunciation, APROVEL was a three syllable mark. There was a clear stress on the first and last syllables, while the middle vowel was, he asserted, unstressed. On the other hand, PROVELLE was a two-syllable word. Given that the element PRO was common to the trade and well-known to customers in this trade and in day-to-day use, the element VELLE emerged strongly.

From this, Mr Wilson argued that the opponent cannot have it both ways. If the element -VELLE is strong enough to render NUVELLE and PROVELLE deceptively similar, then its absence from APROVEL is significant. Equally, in the comparison of NUVELLE and PROVELLE, the hearing officer had been able to reduce the weight traditionally given to the first element in decisions deriving from *TRIPCASTROID (London Lubricants (1920) Limited's application, 1925 42 RPC 264*.

Finally, Mr Wilson noted the different visual bulks of the two marks. Normal packaging and shelf displays would not, except in unusual circumstances, obscure the full display of the trade marks.

Both parties agreed that the PROVELLE/NUVELLE decision was not the last word in comparing other sorts of marks. Both sought to use elements of it for their own purposes but for the reasons argued by both parties that case will not be overly relevant here.

**Decision:**

To a buyer who has a good recollection of either of the two marks APROVEL or PROVELLE, the other may have only a very abstract sort of similarity. To such buyers, the elements VEL and VELLE are no doubt quite distinguishable or, if they are not, then the initial AP or PRO elements will be.

The sounds of trade marks must still be considered, however. This is so despite the many changes in marketing practice, though I do not think Gummow J, in *Johnson and Johnson v Kalnin*, 26 IPR 435, was saying that the sound of a mark always has as much weight in the comparison as it has had in the past.

I do not agree with Mr Skelly that *Merck v Pfizer*, supra, necessarily lays down a definite rule for the stressing of the elements of three-syllable words. Even so, there is a reasonable likelihood of confusion from the sounds of the two marks. Mr Wilson's argument that the middle syllable of the applicant's mark will be softened or swallowed does not counter this, since in such a case the mark, while it may sound like "AP-rer-VEL" or "AP-rar-VEL", is still readily misheard for PRO-VEL

However, the real risk comes from the prospect of imperfect recollection of the mark in its printed form. There are a reasonable number of buyers who would purchase these goods with due care but with less than perfect recollection. It is this group that I must consider, as the established law shows.

The niceties of French suffixes may well be lost on many people, including those who imperfectly recall the mark they know of. To those immune to the subtleties of French, the suffix may emerge as strongly from the letters -VEL as from -VELLE, at least when the former is not part of an English word such as "marvel". In such a context, that of the ordinary and fallible buyer who does not address the last syllable in particular detail, there is a real risk that the two marks will be confused.

This finding is not difficult to reconcile with Ms Hardie's comments in PROVELLE/NUVELLE. In that case, Ms Hardie was called on to compare two -VELLE marks. Ms Hardie made some definite comments on the visual comparison of -VEL and -VELLE, but was not called on to deal with the imperfect recollection of marks incorporating those two different syllables. Thus, her disagreement with arguments based on the interchangeability of the suffixes VEL and -VELLE was tangential to her decision on the question she actually faced.

I note Mr Wilson's reference to TRIPCASTROID, supra. That case stresses the importance of the first syllable, which is a truism of the established case law. It does not go further than this. To attempt to apply it in the present case would be to put undue reliance on the first letter, rather than syllable, in two marks which are otherwise fairly close.

When the marks are looked at side by side, it may still seem unlikely that people, with ordinary levels of caution, will go wrong with both the end and the beginning of the marks. None the less, I think that this is precisely what will happen. In practice, marks are not always or often available for such side-by-side comparison. There is sufficient of both the look and the sound of the opponent's mark about the invented word adopted by the applicant. I do not believe that there is enough difference to prevent reasonable instances of confusion when one mark is encountered against a background of the imperfect recollection of the other. It follows from this, and to a lesser extent from the similarities of sound, that the two marks are deceptively similar.

It is for the applicant to establish that it is entitled to its registration. In any other case, where there is a reasonable likelihood of deception, the established law says that I must refuse to register the application. This I do.

Both representatives agreed that costs should follow the cause, and I therefore award costs in accord with the scale to the opponent.

T. Williams  
Hearing Officer  
14 November 1995