

**IN THE MATTER OF TRADE MARK APPLICATION NO. T0627878A
BY
NOVOZYMES SWITZERLAND AG**

AND

**OPPOSITION THERETO BY
GENZYME CORPORATION**

Before the Principal Assistant Registrar, Ms See Tho Sok Yee

30 June 2010

Trade Marks – *Opposition to registration - Likelihood of confusion - whether the Application Mark is identical to an earlier trade mark and is to be registered for goods similar to those for which the earlier trade mark is protected - Section 8(2)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed)*

Trade Marks – *Opposition to registration – whether the whole or an essential part of the Application Mark is identical with or similar to an earlier trade mark – whether the earlier trade mark is well known in Singapore – whether the use of the Application Mark will indicate a connection between the Applicants' goods and the proprietor of the earlier trade mark – whether the use of the Application Mark is likely to damage the interests of the proprietor of the earlier trade mark - Section 8(4)(i) of the Trade Marks Act (Cap 332, 2005 Rev Ed)*

Trade Marks – *Opposition to registration – whether the Applicants' use of the Application Mark would constitute passing off - Section 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed)*

Trade Marks – *Opposition to registration – whether the application to register is made in bad faith - Section 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed)*

The Applicants, Novozymes Switzerland AG, applied to protect the trade mark “CEREZYME” (“the Application Mark”) in Singapore on 9 November 2006 under International Registration No. 905507 (Singapore Trade Mark No. T0627878A) in Class 1 in respect of “Enzymes for use in the brewing industry”.

As the Applicants’ enzymes are used for brewing beer, they are used by brewing specialists and the end product is targeted at mass market beer consumers. The Applicants’ major customers of their “CEREZYME” products include SABMiller, Easter African Breweries (Guinness Group), Carlsberg among others.

The Opponents are one of the world’s leading biotechnology companies. They registered their “CEREZYME” mark in Singapore on 12 May 2003 under Trade Mark No. T0307107H in Class 5 in respect of “Injectable pharmaceutical preparation to treat an enzymatic deficiency caused by a genetic effect”. In the area of lysosomal

storage disorders, their “CEREZYME” (imiglucerase for injection) and its predecessor “CEREDASE” (aglucerase injection) have been the only enzyme replacement treatment for Type 1 Gaucher disease for over a decade.

There is no dispute that the respective marks are identical. Both parties use the same mark "CEREZYME" in respect of different goods.

Held, allowing the Application Mark to proceed to registration:

- 1 The Opponents submit that there is a likelihood of confusion under Section 8(2)(a) because the marks are identical and the goods, both being enzymes, are similar. The Applicants rebut that the goods are not similar because of their different uses, users, physical nature and trade channels. There is no likelihood of confusion taking into account all extraneous circumstances.
- 2 The Registrar considered that the proper comparison of goods should be between the specifications rather than the goods in actual use. Thus, the comparison is between pharmaceutical preparations (specifically “Injectable pharmaceutical preparation to treat an enzymatic deficiency caused by a genetic effect”) on the one hand, and enzymes (specifically “Enzymes for use in the brewing industry”) on the other hand.
- 3 On the above basis, the Registrar noted that the Applicants’ specified goods are a raw material used for brewing, a foodstuff additive. In contrast, the Opponents’ specified goods are finished products (pharmaceutical preparations) ready for medical use. Further, based on the Opponents’ product information on their CEREZYME drug, the Opponents’ product contains various ingredients and not solely enzymes, again bearing out the fact that it is a finished product (with various ingredients) and not just the ingredient enzymes.
- 4 Not only do the respective goods differ in physical nature, the uses, users and channels also differ. The respective goods are not substitutable and therefore not competitive. Taking into account all relevant factors, the Registrar found that the goods are not similar. Further, the Registrar found that there is no likelihood of confusion. The ground of opposition under Section 8(2)(a) therefore fails.
- 5 To succeed under Section 8(4)(i), the Opponents must first establish the existence of an “earlier trade mark”, which includes a well known trade mark. The evidence, however, is not sufficient to establish that the Opponents' mark was well known in Singapore on the application date of 9 November 2006. Further, as no reasonable likelihood of confusion was found under Section 8(2)(a), the Registrar also found that the use of the Application Mark does not indicate “a connection between those goods or services and the proprietor of the earlier trade mark” as such connection should be of the confusing kind. It follows that the use of the Application Mark is not “likely to damage the interests of the proprietor of the earlier trade mark”. The ground of opposition under Section 8(4)(i) therefore fails.
- 6 The Opponents claim that use of the Application Mark in Singapore is liable to be prevented by virtue of the law of passing off. However, the Opponents’ evidence was not sufficient to establish goodwill in Singapore. It was also not shown that

there is a misrepresentation by the Applicants to the public leading, or likely to lead, the public to believe that the “enzymes for use in the brewing industry” sold by the Applicants under the Application Mark are those of the Opponents. As goodwill and misrepresentation have not been established by the Opponents, there is no damage to be suffered by them arising from the use of the Application Mark on “enzymes for use in the brewing industry”. The ground of opposition under Section 8(7)(a) therefore fails.

- 7 The Opponents allege that the application to register the Application Mark was made in bad faith. The Opponents have used the mark “CEREZYME” well before the application date of 9 November 2006. The Opponents submit that the parties are business competitors and thus, it is no coincidence that the Applicants have chosen a mark that is identical to the Opponents’ for use on enzymes.
- 8 The Registrar found that the Applicants have given a credible derivation of the Application Mark. The beginning of “CEREZYME” is derived from the ancient Roman goddess of agriculture, Ceres, and the ending “zyme” is derived from the word “enzyme”. That such a name is used on enzymes in the brewing industry (which involves cereals, and more generically, agriculture) appears cogent in reason, rather than copycat-like in intent. The ground of opposition under Section 7(6) therefore fails.

Provisions of legislation discussed:

Trade Marks Act (Cap 332, 2005 Rev Ed) Sections 2(1), 2(7), 2(8), 2(9), 8(2)(a), 8(4)(i), 8(7)(a), 7(6)

Cases referred to:

British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281
Mohamed Mustafa & Samsudin Co Pte Ltd v Koyo Seiko Company Limited [2005] SGIPOS 11
Kabushiki Kaisha Tokyo Seimitsu (Tokyo Seimitsu Co Ltd) v Tsukishima Kikai Co Ltd [2007] SGIPOS 15
The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd [2006] 2 SLR 690
Otsuka Pharmaceutical Co. Ltd. V Farmitalia Carlo Erba SpA [1995] AIPR 86
Novogen Research Pty Ltd v Roche Products Limited [2003] SGIPOS 16
Harker Stagg case [1953] 70 RPC 205
Besavar v Nexavar (Sanofi-Synthelabo v Bayer Aktiengesellschaft UK Invalidation Application No. 12067)
Lloyd’s case (Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] FSR 77
Ashbourne Pharmaceuticals Limited v Grünenthal GmbH (UK Opposition No. 70345)
Glaxo Group Limited v Allergan Inc. (UK Opposition No. 50441)
McDonald’s Corp v Future Enterprises [2005] SLR 177
The Polo/Lauren Co., LP v Shop-In Department Store Pte Ltd [2005] 4 SLR 816
Novelty Pte Ltd v Amanresorts Ltd and another [2009] 3 SLR(R) 216
Mobil Petroleum Co, Inc v Hyundai Mobis [2010] 1 SLR 512
Reckitt & Colman Products Ltd v Borden Inc [1990] All ER 873

McDonald's Corp v Future Enterprises Pte Ltd [2005] 1 SLR 177
Royal Enfield Trade Marks [2002] RPC 24
E! Entertainment Television, Inc v Deutsche Telekom AG [2005] SGIPOS 5
Festina Lotus SA v Romanson Co Ltd [2010] SGHC 200

Representation:

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Ms Gooi Chi Duan (Donaldson & Burkinshaw) for the Opponents