In The Matter Of A Trade Mark Application No. 14723/99
By Novogen Research Pty Ltd

And

Objection Thereto By
Roche Products Limited

Before Principal Assistant Registrar P Arul Selvamalar
17 July 2003

Trade Mark Application - Opposition - likelihood of confusion - tort of passing off - section 8(2) and (4) - Trade Marks Act (Cap 332, 1999 Ed).

The Applicants are Novogen Research Pty Ltd, who applied for registration of a trade mark "RIMOSTIL" in class 5 for "pharmaceutical preparations; pharmaceuticals for the treatment of cardiovascular conditions and osteoporosis; isoflavone compositions". The Opponents are Roche Products Limited, who owned a registered trade mark "RIVOTRIL" in class 5 for "pharmaceutical, veterinary and sanitary substances; infants' and invalids' foods" since 1966. The Opponents have been using their mark on epilepsy medication available by prescription only since the 1980s in Singapore. The Applicants have been using their mark on drugs for the treatment of osteoporosis and hormone related conditions since 2001 in Singapore. The Applicants' drug is available without prescription. The Opponents relied on sections 8(2) and 8(4) in their opposition.

Held, disallowing the registration of the mark

- In terms of visual and aural similarity, both marks are word marks of the same length and start with the letters RI and end with the letters IL. Aurally, both marks have the same vowel sounds I-O-I and have three syllables. In assessing whether the average consumer would be confused, the Registrar took into account an average consumer who has probably seen or heard of Rivotril, who thereafter comes across the mark Rimostil. The average consumer may remember that the earlier mark started with R and sounded like the word before him and was of about the same length as the mark that is before him. It is unlikely that he would go beyond that and remember the earlier mark as RI-VO-TRIL exactly and therefore distinguish it from the mark that is before him RI-MO-STIL. The Registrar also took into account that these are drug names with no meaning.

- Although the Opponents had only used the mark on epilepsy medication, the Registrar found that the entire specification of the goods may be considered in the assessment of confusion. In assessing confusion, the average consumer should not be expected to distinguish the Applicant's drug from the Opponent's drug by comparing the condition that each drug is intended to treat. However, the goods on which Rivotril has been used is a relevant consideration because if the Applicants also used Rimostil for epilepsy medication, the likelihood of confusion would be greater. As the Applicant's drug is for another condition the likelihood of confusion was less but it does not mean that the likelihood of confusion does not exist. Further the fact that RIVOTRIL is only available by prescription does not mean that the likelihood of confusion does not exist.

- Taking into account the learned J Jacob's observations in the case of Harker Stagg, that if there were any reasonable ground for supposing that by reason of their similarity confusion or deception is likely to arise, the fact that the marks are used in relation to pharmaceutical preparation is, perhaps, all the more reason for seeing that the public are protected from the consequences of deception and confusion; and the degree of similarity between the marks and the goods; and the likely perception of the marks in the mind of the consumers, it was found that there was a likelihood of confusion. The opposition under section 8(2) was successful.

- Under section 8(4) it was found that the Opponents had not discharged their burden of proving the 3 elements of passing off. The Opposition under section 8(4) therefore failed.

Legislation referred to:

- Trade Marks Act (Cap 332, 1999 Ed) sections 8(2) and 8(4)

Cases referred to:

- Sabel BV v Puma AG [1998] 1 CMLR 445
- Canon Kabushiki Kaisha v Metro-Goldwin-Mayer Inc [1999] RPC 117
- Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] FSR 77
- American Home Products v Knoll AG [2002] EWHC 282
- Re Enliva
- MILKYBAR V MILKBEARS (Decision of the IPOS)
- Harker Stagg Ltd TM [1953] RPC 205
- PRURIDERM TM [1985] RPC 187
- BENSYL TM [1992] RPC 529
- Icart SA's Application [2000] ETMR 180
- Coderol v Codidol (OHIM R 622/199-3)
- Pianotist Co's Application (1906) 23 RPC 774
- Erectiko (1935) 52 RPC 135
- MIRADENT v MENTADENT (UK Patent Office)
- Jellinek's case (1946) 63 RPC 119
- British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281
- Linkworld Technology (S) Pte Ltd v Intel Singapore [1994] AIPR 197
- The Seahorse (1980) RPC 250
- J & J Colman Ltd's Application (1929) 46 RPC
- Re F Braby & Co's Applications (1882) 21 Ch D 223
- Lifeguard Milk Products Proprietary Ltd's Application [1957] RPC 79
- LIZA RICCI v NINARICCI (Decision of the IPOS)
- VUARNET v du VERNET (Decision of the IPOS)
- Polo/Lauren Co LP v US Polo Association & Anor [2002] 1 SLR 326
- Bayer [1947] RPC 125
- Lundbeck Limited v GD Searle & Co (UK Patent Office)
- Sanofi - Synthelabo v Bayer (UK Patent Office)
- Bayer v Beecham (Decision of IPOS)
- Novogen v Roche (New Zealand IP Office)
- Anheuser Busch Inc v Budweiser Budvar National Corporation (Court of Appeal, New Zealand)
- WILD CHILD TM [1998] RPC 455
- SPEEDMASTER (UK Patent Office)
- JACKPOT FLIGHT(UK Patent Office)
- Erwen Warnink BV v J Townend & Sons (Hull) Ltd [1979] AC 731
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Sterwin AG v Brocades Ltd [1979] RPC 481
- Smith Hayden & Co Ltd's Application (1946) RPC 71
- Bulmer v Bollinger [1978] RPC 79
- Jif [1990] RPC 341

Representation:

- Ms See Tho Sok Yee with Ms Gwendolene Lee (Allen & Gledhill) for the Applicants
- Mr Paul Teo (Drew & Napier) for the Opponents

There was an appeal against the decision in the High Court. The appeal was discontinued.