

**In The Matter Of A Trade Mark Application By  
PT Bogamulia Nagadi**

**And**

**Opposition Thereto By  
Glaxo Group Limited**

*Before Principal Assistant Registrar Ms. Anne Loo  
18 February 2004*

**Trade Marks** – Opposition to registration – whether the opponents had a reputation – whether registration of the application mark would cause confusion or deception - section 15 of the Trade Marks Act [Cap. 332, 1992 Ed]

**Trade Marks** – Opposition to registration - whether the Application Mark is similar to an earlier registered trade mark - Section 23 of the Trade Marks Act [Cap. 332, 1992 Ed]

The Applicants, PT BOGAMULIA NAGADI, applied on 4th February 1998 for the registration of the word “TEMPOVATE” in Class 5 of the International Classification of Goods in respect of “pharmaceutical preparations”. The Opponents, Glaxo Group Limited, lodged a Notice of Opposition against the trade mark application on 4th October 2000. The Opponents are the registered proprietors of the trademarks BETNOVATE, DERMOVATE, EUMOVATE and OTOVATE in class 5, and have promoted and used the mark extensively in Singapore and in many other countries for many years.

The Opponents contended that the registration of the TEMPOVATE mark would be contrary to sections 10, 12(1), 15 and 23 of the Act. The Opponents argued that the use of the Applicants’ mark TEMPOVATE which nearly resembles Opponents’ registered marks on goods identical or of the same description as the goods of the registrations is likely to deceive or cause confusion in the minds of consumers or lead to the belief that there is some connection and/or association between the Applicants’ and the Opponents’ goods when no such connection and/or association exists.

The Opponents also contended that by reason of the use of their registered marks, the Applicants’ mark is not distinctive or capable of distinguishing the goods of the Applicants and by reason of the use and reputation established by the Opponents in the suffix “OVATE”, the Applicants cannot claim bona fide to be the proprietor of the mark TEMPOVATE.

**Held, disallowing registration**

1. The fundamental question relating to the suffix “OVATE” is whether the Opponents’ claim that the suffix “OVATE” is so well-known to the trade and public in Singapore and has become distinctive of the Opponents in respect of pharmaceutical preparations. Aside from just the similarity of the suffix “OVATE”, the wider issue is whether the marks TEMPOVATE, BETNOVATE, DERMOVATE and EUMOVATE compared as wholes are similar visually, phonetically and conceptually such that there will be a likelihood of deception or confusion amongst a substantial number of consumers.
2. On visual and aural comparisons of the Applicants’ mark TEMPOVATE and the Opponents’ marks BETNOVATE, DERMOVATE and EUMOVATE, the marks are dissimilar. However, determination of the likelihood of confusion or deception is a more complex exercise and the visual and aural comparison of marks are never done in vacuo without considering all the circumstances.
3. The Opponents’ marks have been in use since 1987, i.e. 11 years as at the date of the Applicants’ mark and have goodwill by virtue of long use. The suffix “OVATE” or “VATE” which appears in their marks BETNOVATE, DERMOVATE and EUMOVATE do not have any association with a particular drug or is not part of the generic name of a drug. The suffixes “OVATE” or “VATE” are clearly invented for they do not link the products with any particular drug or chemical. The products with names ending with “OVATE” also do not have any association with a particular egg-shape to which the meaning of “OVATE” refers. By the Opponents’ long use in the market, consumers will be aware of the Opponents’ marks and will associate the use of marks ending with “OVATE” or “VATE” with the Opponents.

4. There is therefore a real and tangible risk of deception or confusion among a substantial number of persons if the Applicants' mark is allowed to proceed to registration. The Opponents therefore succeed under sections 15 and 23.

#### **Provisions of legislation discussed**

- Trade Marks Act (Cap. 332, 1992 Rev. Ed.) Sections 15 and 23.

#### **Cases referred to:**

- Aristoc Ltd v Rysta Ltd [1943] 60 RPC 87
- Bailey (1935) 52 RPC 136
- Bali Trade Mark 1969 RPC 47
- Beck, Koller & Co. Ltd's Application (1947) 64 RPC 76
- Broadhead's Application [1950] 67 RPC 209
- Coca-Cola Company of Canada Limited v Pepsi-Cola Company of Canada Limited [1942] 1 All ER 615
- Fox and Company's Application [1920] 37 RPC 37
- Glaxo Group Ltd v Medrel GmbH (OHIM) R1178/2000-1
- Hans Emanuel Newmann Enoch's Application [1945] 2 All ER 637
- Harker Stagg Ltd.'s Trade Mark [1953] RPC 205
- Societe Des produits Nestle S A v Newmans Chocolates Ltd (TM/99/13086) [2003] IPOS 2
- In the Matter of an Application by Laslidas Jellinek for the Registration of a Trade Mark [1946] 63 RPC 59
- In the Matter of Application No. 2061715 in the name of Takeda Chemical Industries Ltd.
- Jellinek's Application (1946) 63 RPC 59
- Kellogg Co. v Pacific Food Products Sdn Bhd (1998) 3 SLR 28 [High Court]
- Kellogg Co. v Pacific Food Products Sdn Bhd (1999) 2 SLR 651 [Court of Appeal]
- Pianotist Co's Application (1906) 23 RPC 774
- Polo/Lauren LP v United States Polo Association & Anor [2002] 1 SLR 326
- SEMIGRES Trade Mark [1979] RPC 300
- Smith Hayden & Co's Application (1945) 63 RPC 97
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- UNIMAX Trade Mark [1979] RPC 469

#### **Representation:**

- Ms. Moi Sok Ling (Messrs Khattar Wong & Partners) for the Applicants
- Mr. Paul Teo (Messrs Drew & Napier) for the Opponents