

**In The Matter Of A Trade Mark Application By
Dermik Laboratories, Inc**

And

**Opposition Thereto By
Galderma S.A.**

*Before Principal Assistant Registrar Ms. P Arul Selvamalar
7 July 2005*

Trade Marks – Opposition to registration – whether the registration of the application mark would be contrary to public policy or morality, or whether it is of such a nature as to deceive the public - Section 7(4) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the application to register is made in bad faith - Section 7(6) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – Likelihood of confusion - whether the Application Mark is identical with or similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected – Section 8(1) and 8(2) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the application mark is identical with or similar to an earlier trade mark and is to be registered for goods or services which are dissimilar to those for which the earlier trade mark is protected - Section 8(3) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the Applicant’s use of the Application Mark would constitute passing off - Section 8(4)a of the Trade Marks Act 1998 [Cap. 332]

The Applicants are Dermik Laboratories, Inc, who filed an application for a trade mark on 1 August 2001, for the word BENZACLIN in class 5 for the goods, “Pharmaceutical products”. The application was accepted for registration and advertised on 28 August 2002 for opposition. Although the application is for pharmaceutical preparations, their product literature shows that their product is for the treatment of acne which is available on a prescription basis only. The approximate sales revenue for the Benzaclin product worldwide annually is US\$ 147 million and annual global advertising figure is approximately US\$ 12 million.

The Opponents’ are the registered proprietor of the mark BENZAC for the goods “pharmaceutical and sanitary preparations; medicated preparations for the skin” in class 5 since 31 October 1995. Their products, which are for the treatment of acne have been sold in Singapore since 1994. The Opponents submitted that the Applicants’ mark is identical, almost identical or similar to their mark and that there is a likelihood of confusion on the part of the public, if the mark is registered under section 8(1) and (2). They submitted that importance should be placed on the first syllable of word marks, that the suffix “lin” or “in” is common in class 5, that the prefix Benz has a direct reference to the ingredient Benzoyl peroxide and therefore it is common to the trade. They also submitted that the goods are identical or that there is a large area of overlap between the Opponents’ goods and the Applicants’ goods.

The Opponents submitted that section 8(4) may be decided simply by asking whether there is a likelihood of confusion or deception. The Opponents also submitted that the outrageous similarity between the marks should lead to the justifiable inference that the Applicants copied the Opponents’ mark under section 7(6). Under Section 7(4), the Opponents submitted that for pharmaceutical products, confusion can be potentially hazardous.

The Applicants submitted that they would be using their trade mark as BenzaClin and that therefore the average consumer would pronounce the mark as Ben-za-clin. The Applicants also submitted that the prefix Benz is derived from the ingredient Benzoyl Peroxide and that this ingredient is found in the Applicants products in class 5 bearing their other marks Benzamycin and Benzagel. They also submitted that their use of the prefix Benz, together with the Opponents’ use of the prefix, has rendered it common to the trade.

The Applicants also submitted that the trade channels for the goods are dissimilar as the Opponents product is a non-prescription medicine sold in pharmacies whereas their medicine was available only on prescription. They

also submitted that healthcare professionals are likely to pay attention to the details of a mark when prescribing the product. They also highlighted that the packaging of the Applicants' and Opponents' products were different. The Applicants submitted that section 8(4) does not apply and that if it does, the Opponents have not proven goodwill or reputation. The Applicants submitted that the application is not in bad faith as the Applicants have explained the derivation of the mark. The Applicants submitted that the Opponent mark is not well known under section 8(3).

Held, disallowing registration

1. The only submission the Opponents made under Section 7(4) is that for pharmaceutical products, confusion can be potentially hazardous. As this ground was not substantially argued, the opposition under Section 7(4) failed.
2. The only submission that the Opponents made under this ground is that the outrageous similarity of the marks, leads to the justifiable inference that the Applicants' mark is a copy of the Opponents' mark. However, it was found that both marks are invented words and that the Applicants have explained the derivation of their mark. The ground of opposition under Section 7(6) failed.
3. The application mark and the opponents mark are not identical therefore only section 8(2) applied in this case. The Registrar found that the emphasis in two syllabic words is usually different from the emphasis in three syllabic words. The difference in the number of syllables affect the way the syllables are emphasized, and in this case distinguish the marks phonetically. In terms of visual similarity, the first part of the mark is the part that leaves a lasting impression in the minds of the consumer visually and the first part of the mark is identical to the Opponents' mark, as the first 6 letters in both marks is "Benzac". It was found that although the marks are not similar phonetically, visually they were similar.
4. The specification of goods in the application and as it exists in the registered mark are similar. The uses and the users of the goods are the same. The fact that the Applicants goods are at present available by prescription only, and the fact that the Opponents have hitherto been using their mark on products which are available off the shelf, does not distinguish the Applicants' goods from the Opponents' goods. Further, it cannot be presumed that because the Opponents have only used their mark for goods that are available off the shelf up to now, they will always only use the mark on goods which are available off the shelf for as long as they maintain their registration. Similarly, it cannot be presumed that because the Applicants use their mark on products which are available by prescription only at present, they will not use it on a type of pharmaceutical product which may be available off the shelf later, as the broad language of their specifications does allow them to later sell the product off the shelves.
5. Taking into account the aural dissimilarity and the visual similarity of the marks, the similarity of the goods and all the circumstances of the case, if the Applicants' mark is registered it is likely to cause confusion among a substantial number of members of public. The opposition under section 8(2)b therefore succeeds.
6. It was found that the Applicants' and the Opponents goods' were similar. Therefore the opposition under Section 8(3) failed.
7. The Opponents did not substantially argue this ground, and the evidence filed by the Opponents did not establish the type of goodwill or reputation needed for an action in passing off. The ground of opposition under Section 8(4a) failed.

Provisions of legislation discussed

- Trade Marks Act (Cap. 332, 1999 Rev Ed.) Sections 7(4), 7(6), 8(2b), 8(3) and 8(4a).

Cases referred to:

- Capsuloid (1906) 23 RPC 782,
- The Pianotist Company Ltd Application (1906) 23 RPC 774.
- Bale & Church v Sutton (1934) 51 RPC 129,
- Harrods (1935) 52 RPC 65
- Hacks Application (1941) 58 RPC 91.
- Harker Stagg Ltd TM [1953] RPC 205
- Electrolux (1954) 71 RPC 23,
- Accutron [1966] RPC 152,
- Buler [1966] RPC 141
- Neutrogena v Golden [1966] RPC 473.
- Rheinliebling [1966] RPC 68,

- Bali TM [1969] RPC 472
- G.E. [1973] RPC 297
- Newsweek Inc v British Broadcasting Corporation [1979] RPC 441
- Revue TM [1979] RPC 27,
- Tornado [1979] RPC 155
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873.
- Re Jaguar TM [1993] 2 SLR 466
- Wagamama Ltd v City Centre Restaurants Plc [1995] FSR 713
- Gut Springenheide & Tusky [1998] ECR 1-4657
- Sabel BV v Puma AG [1998] RPC 199,
- Canon MGM [1999] RPC 117,
- Gromax Plasticulture Ltd v Low Nonwovens Ltd [1999] RPC 367.
- Kabushiki Kaisha Hattori Seiko (Hattori Seiko Co Ltd) v Coway Investment Ltd (T90/05495) [1999] SGIPOS
- Tiffany v Fabriques de Tabac [1999] 3 SLR 147,
- Windsurfing Chiemsee v Huber & Attenberger [1999] ETMR 585
- Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd (T/a ONE.99 SHOP) [2000] 2 SLR 766
- Lloyd Shuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] FSR 77,
- Beecham Group PLC v Bayer Aktiengesellschaft (T95/08886) [2001] SGIPOS
- American Home Products Corporation v Knoll AG [2002] EWHC 282).
- Matsushita Electric Industrial Co Ltd v TKR Electronics Pte Ltd (T99/08180) [2003] SGIPOS
- The Polo/Lauren Co, LP v Shop In Department Store [2005] SGHC 175

Representation

- Mr Nathan Lau & Mr Kevin Wong (Ella Cheong Spruson & Ferguson) for the Applicants
- Mr Lim Teng Leong (Donaldson & Burkinshaw) for the Opponents