

**In A Matter Of A Trade Mark Application No. T04/03333A By
Gilead Sciences Inc.**

And

**Opposition Thereto By
Glaxo Group Limited**

*Before Principal Assistant Registrar Ms P Arul Selvamalar
18 July 2006*

Trade Marks – Opposition to registration – Likelihood of confusion – whether the Application Mark is confusingly 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(2)b 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]

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]

The Applicants, an American company applied for registration of a trade mark EMTRIVIR in class 5 for “pharmaceuticals” on 1 March 2004. On 20 June 2006, the Applicants applied to amend their goods to, “Pharmaceutical preparations which are available by prescription only”, which was accepted. The Opponents, a British company has a registered trade mark EPIVIR in class 5, T95/11385F for the goods “Anti-viral pharmaceutical preparations and substances”. The Opponent’s pharmaceutical products under their EPIVIR mark are available in 79 countries worldwide and were first launched in Singapore in January 1997. They also have registered their trade mark in more than 100 countries, including Australia, Brunei, Hong Kong, Malaysia, New Zealand, South Africa, the United Kingdom and the United States. The Opponents’ estimated sales in Singapore in year 1997 of S\$375,000 increased to S\$600,000 in year 1998 but decreased to S\$300,000 in year 2004. The Opponent’s estimated advertising and promotional expenditure in Singapore in year 1997 was S\$50,000 but gradually decreased to S\$1,000 in year 2003.

The Applicant’s mark, EMTRIVIR was invented for use in connection with their emtricitabine product currently marketed under the EMTRIVA mark. It is a treatment for HIV-1 infection. The first 5 letters of the mark EMTRIVIR are the same as those in the generic name emtricitabine. The Applicants have registered the mark, EMTRIVIR in Japan and Taiwan. Both the Applicants and the Opponent’s drugs cater to a highly focused field of interest within the industry, namely the treatment of HIV. Their customers are highly informed and specialized, namely distributors of pharmaceutical products, doctors and pharmacists. The suffix “vir” is commonly used in generic names for HIV drugs and it is also common for pharmaceutical products.

The Opponents argued that the Applicants’ mark should not be registered as it was confusingly similar to their mark under section 8(2)b and that the registration of the application mark would be contrary to the law of passing off under section 8(4)a and that the application was in bad faith and therefore contrary to section 7(6) of the Trade Marks Act.

Held, allowing application mark to proceed to registration

1. The Applicant’s mark is EMTRIVIR, and the Opponent’s mark is EPIVIR. Both marks comprise 3 syllables which would be pronounced as Em-tri-vir and Ep-i-vir and the marks are of different lengths. Aurally and visually, the marks are dissimilar. As the suffix “vir” is an approved generic stem and common in the marketplace for anti virals, the principle that the customer will distinguish between the marks by the differing features will apply. The goods of the Applicants and the Opponents are similar and the consumers for both products are doctors and pharmacists. The average consumer would be able to distinguish between the two marks by the different beginnings, Emtri and Epi, although the suffix is common. There will be no real likelihood of confusion among substantial number of members of the public if the Applicants mark proceeds to registration. Therefore, opposition fails under Section 8(2)b.
2. The Applicants have not used the mark EMTRIVIR in Singapore and their emtricitabine product had hitherto been sold under the mark EMTRIVA. Although there is no explanation on the change of name, from EMTRIVA to EMTRIVIR, it cannot lead to a conclusion that the Applicants wanted to benefit from

the Opponent's goodwill. In addition the Opponents have not established that they have a reputation in the business of selling goods under their mark in Singapore and there is no misrepresentation. The opposition fails under Section 8(4)a.

3. The lack of explanation for the change in the Applicants product name from EMTRIVA to EMTRIVIR is insufficient on its own to establish that the Applicant acted in bad faith. Therefore, the opposition fails under Section 7(6).

Provision of legislation discussed:

- Trade Marks Act 2005 [Cap.332, Rev Ed] Sections 8(2)b, 8(4)a and 7(6).

Cases Referred to:

- Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2006] SGCA 14
- British Sugar v James Robertson [1996] RPC281
- Pianotist Company Ltd's Application (1906) 23 RPC 774
- Australian Woollen Mills Ltd v F S Walton & Co. Ltd (1973) 58 CLR 641
- Aristoc v Rysta [1945] 62 RPC 65
- Wagamama v City Centre Restaurants [1995] FSR 713
- Harker Stagg Ltd's TM [1953] 70 RPC 205
- Novogen Research Pty Ltd v Roche Products Limited [2003] SGIPOS 16
- Bayer Aktiengesellschaft v Beecham Group P.L.C. [2002] SGIPOS 2
- Night Nurse v Nit Nurse (0/085/03)
- PT Bogamulia Nagadi v Glaxo Group Limited [2004]SGIPOS 6
- Reckitt & Colman Products Ltd v Borden Inc & Ors [1990] 1 All ER 873
- Tong Guan Food Products Pte Ltd v Hoe Hng Foodstuff Pte Ltd [1991] SLR 133
- Harrods v Harrodium School Ltd (1996) RPC 697
- Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367
- McDonalds Corporation v Future Enterprises Pte Ltd [2005] 1 SLR 177
- Sanofi-Synthelabo v Bayer
- Matthias Giesen v Unilever
- Lundbeck Limited v GD Searle & Co
- Dermik Laboratories, Inc v Galderma SA [2005] SGIPOS
- Harrods (1935) 52 RPC 65
- Nation Fittings (M) Sdn Bhd v Oystertec Plc & Anor [2005] SGHC 225
- McDermott Laboratories Ltd v May & Baker Ltd (2006) E.T.M.R 17
- Fujisawa Deutschland GMBH v Wyeth (1996)
- 10 Royal Beckshire Polo Club TM [2001] RPC 32
- Harrisons TM [2005] FSR 10

Representation

- Ms Carol Goh, Ms Pearleen Loh & Ms Melanie Tan (Alban Tay Mahtani & de Silva) for the Applicants
- Ms Cecelia Girvin and Ms Ruby Tham (Drew & Napier) for the Opponent