

In The Matter Of A Trade Mark Application No T02/19370F By Astrazeneca AB

and

**Opposition Thereto By
Pfizer, Inc.**

*Before Principal Assistant Registrar of Trade Marks Mr Wong Sheng Kwai
28 September 2007*

Trade Marks – Opposition to registration – Deceptive mark - whether the Application Mark is of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods or service - Section 7(4)(b) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – Likelihood of confusion - whether the Application Mark is 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]

The Applicant, AstraZeneca AB applied for registration of a mark on 26 April 2002 under the Madrid Protocol designating Singapore, which comprised the word “ZELOXZAR”, for the goods “pharmaceutical preparations and substances” in class 5.

The Opponent, Pfizer, Inc, is the proprietor in Singapore of the marks, “ZELDOX” for “a pharmaceutical preparation for the treatment of neurological conditions” and “ZELDOX IM” for pharmaceutical preparations and substances, both in class 5. The Opponent raised objections under sections 7(4) (b) and 8(2) (b) of the Trade Marks Act (1998) (hereinafter referred to as “TMA”)

The Opponent contended that the Applicant’s mark “ZELOXZAR” is similar to Opponent’s earlier marks “ZELDOX” & “ZELDOX IM” in respect of identical or similar goods which is likely to cause confusion. It should be refused registration because -

- (a) the Applicant’s mark incorporates the Opponent’s mark in that the first two syllables are very similar i.e. “ZEL” and “DOX”. The first two syllables are more dominant and are likely to be remembered.
- (b) the Applicant’s specification of goods is broad and would incorporate the Opponent’s goods under “ZELDOX” which are used for “treatment of neurological disorders” and is identical with the goods under “ZELDOX IM”.
- (c) the impression conveyed by the Applicant’s mark is that it is an extension of the Opponent’s family of marks.
- (d) the Opponent had promoted and used their marks “ZELDOX” and “ZELDOX IM” in many countries for many years. The mark “ZELOXZAR” with similar first two syllables and the intended use on similar goods will be deceptive as it may result in the belief that it is associated with the Opponent.

The Applicant contended that:

- (a) the Applicant’s mark is not similar to the Opponent’s marks. The visual and aural impact of “ZELOXZAR” is different from that of the Opponent’s marks. The marks in question are all invented words and have no conceptual meaning on which to make a comparison as to similarity.
- (b) there is a vast difference between the Opponent’s goods of “pharmaceutical preparations for the treatment of schizophrenia and other neurological conditions” and those for intended use by the Applicant, i.e. “pharmaceutical preparations and substances for the treatment and/or prevention of cancer”. Both parties’ goods are also not available to members of the public “over the counter” and are prescription drugs.
- (c) the parties’ goods are sold to highly trained and technically competent professionals such as medical doctors and pharmacists who would be well-equipped and have the expertise to differentiate pharmaceutical preparations and substances.
- (d) the mark “ZELOXZAR” is in itself not against public order or morality or of such a nature as to deceive the public in nature, quality or geographical origin of the goods and services. It, being an invented word, has no literal or dictionary meaning. The mark is therefore not inherently deceptive under section 7(4) (b).

Held, allowing the application mark to proceed to registration

1. Comparing the marks in question as wholes, with no conceptual similarity and with differences in appearance and sound when enunciated, the marks in question are not similar for the purposes of section 8(2) (b) of the TMA.
2. The broad specifications for “ZELOXZAR” as they stand in the application are identical with those under “ZELDOX IM” and overlaps with those under “ZELDOX”. The marks in question could possibly be used on similar goods.
3. On assessing the likelihood of confusion for the marks “ZELDOX” and “ZELOXZAR”, even though the Applicant’s broad specification as it stands does overlap with the goods under “ZELDOX”, being cognizant of the Applicant’s evidence of the intention to use the application mark in a restricted and specific area and the action taken of applying for amendment, it would be artificial to ignore the fact. There is little merit in insisting that the Applicant is bound to the specification as is when there is no impediment to an amendment to the specifications being made prior to registration to reflect specific market interests. The assessment on likelihood of confusion should proceed on the basis of the Applicant’s action to restrict the goods under “ZELOXZAR” to “pharmaceutical preparations and substances for the treatment and/or prevention of cancer”. Having found that the marks in question are not similar and the goods being prescription drugs for very different fields of specialist practice i.e. mental illness and cancer, there is no real risk of confusion amongst the target group of highly trained medical professionals. Prescription drugs are handled by doctors, nurses and pharmacists, who would exercise more care and diligence in dealing with the goods and would be less likely to be confused.
4. On the likelihood of confusion between “ZELDOX IM” and “ZELOXZAR”, while the specification of goods for “ZELDOX IM” will be broad enough to cover the Applicant’s goods even after the proposed amendment is effected, for all intents and purposes, the goods under “ZELDOX IM” will still be prescription goods. The letters “IM” in “ZELDOX IM” were commonly used in the pharmaceutical industry to denote “intra-muscular”, a mode through which the drug is administered. Even if the Opponent decides in future to extend use of “ZELDOX IM” to treatments for cancer, they would have to be goods administered via “intra-muscular” modes and be available only via prescription because of the specialist area. Since the marks have been found not to be similar, there is no real risk of confusion amongst the target group of consumers being trained medical professionals.
5. It was not established on the evidence that “ZELDOX” and “ZELDOX IM” are well known in Singapore as a family of marks which would lead to confusion with the Applicant’s mark as to source among the public. There was no evidence adduced showing the promotion of the “ZELDOX IM” mark in Singapore as an associated family mark belonging to the Opponent. The letters “IM” in “ZELDOX IM” were commonly used in the pharmaceutical industry to denote “intra-muscular”, a mode through which the drug is administered. The inclusion of the descriptive letters “IM” per se did not create a second distinctive mark which will be perceived as part of a family of marks belonging to the Opponent.
6. Examining the mark “ZELOXZAR” itself, being an invented word with no literal or dictionary meaning, there is no inherently deceptive nature that would mislead the public as to the nature, quality or geographical indication of the goods.

Provisions of Legislation discussed:

- Trade Marks Act 1998 (Cap. 332, 2006 Rev. Ed.) Sections 7(4) (b) and 8(2) (b).

Cases referred to:

- The Polo/Lauren Co, LP v Shop-in Department Store Pte Ltd [2006] 2 SLR 690
- The Polo/Lauren Co, LP v Shop-in Department Store Pte Ltd [2005] 4 SLR 816
- British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281
- Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd [2006] 1 SLR 401
- Coco-Cola Company of Canada Limited v Pepsi-Cola Company of Canada Limited [1942] AER 615
- In the matter of an Application by Fox & Co to register a trade mark [1920] RPC 37
- In the Matter of Broadhead’s Application for Registration of a Trade Mark [1950] 67 RPC 209
- BENSYL Trade Mark [1992] RPC 23
- Bailey [1935] 52 RPC 136
- Bayer Aktiengesellschaft v Beecham Group P.L.C [2002] SGIPOS 2
- Gilstead Sciences Inc. v Glaxo Group Limited [2006] SGIPOS 12
- Re Jellinek’s Application (1946) 63 RPC 59
- Harker Stagg Ld’s Trade Mark [1953] RPC 205

- Bogamulia Nagadi v Glaxo Group Limited [2004] SGIPOS 6
- Novogen Research Pty Ltd v Roche Products Limited [2003] SGIPOS 16
- American Home Products v Knoll AG [2002] EWHC 282
- Pianotist Co's Application [1906] 23 RPC 777
- McDermott Laboratories Ltd v May & Baker Ltd [2006] ETMR 17
- Bayer Aktiengesellschaft v Beeham Group PLC [2002] SGIPOS 2

Representation:

- Mr Maurice Cheong (M/s Donaldson & Burkinshaw) for the Applicant.
- Mrs Murgiana Haq (M/s Haq & Selvam) for the Opponent.