

**IN THE MATTER OF TRADE MARK APPLICATION T06/04212E
BY DABUR PHARMA LIMITED**

AND

**OPPOSITION THERETO BY
PIERRE FABRE MEDICAMENT**

*Before Principal Assistant Registrar Ms Lee Li Choon
23 October 2009*

Trade Marks – Opposition to registration – Whether the Applicants’ mark, “VINELBINE” is devoid of distinctive character and should be refused registration - Section 7(1)(b) of the Trade Marks Act (Cap 332, 2005 Revised Edition)

Trade Marks – Opposition to registration – Whether the Applicants’ mark, “VINELBINE” is devoid of distinctive character in relation to the goods which are pharmaceutical substances that contain an active ingredient or chemical substance known by its International Non-proprietary Name (“INN”) or generic name as “vinorelbine” - Section 7(1)(b) of the Trade Marks Act (Cap 332, 2005 Revised Edition)

Trade Marks – Opposition to registration – Whether the Applicants’ mark is confusingly similar to the Opponents’ earlier registered mark, “NAVELBINE” (T9109088F) in Class 5 in Singapore covering “Pharmaceutical preparations and substances; all included in Class 5” and whether the goods applied are identical or similar with the goods for which the said earlier trade mark is protected - Section 8(2) of the Trade Marks Act (Cap 332, 2005 Revised Edition)

Trade Marks – Opposition to registration – Whether as a result of the goodwill and reputation acquired by the Opponents through use of their trade mark in Singapore and worldwide and in view of the similarity between the goods covered by the Applicants’ mark and their trade mark, the use or proposed use of the Applicants’ mark in relation to which registration is sought will amount to a misrepresentation in that consumers will be led to believe that the Applicants’ goods belong to the Opponents or that the Applicants’ business is somehow connected or associated with that of the Opponents when in fact no such connection or association exists - (Section 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Revised Edition)

Trade Marks – Opposition to registration – Whether the application is made in bad faith - Section 7(6) of the Trade Marks Act (Cap 332, 2005 Revised Edition)

This is an opposition against the trade mark application T06/04212E by Dabur Pharma Limited for the word mark, “VINELBINE” in class 5 for use on “medicinal and pharmaceutical preparations”. The date of application was 1 March 2006.

The Opponents are the proprietor of the trade mark “NAVELBINE” (T9109088F) in Class 5 in Singapore covering “Pharmaceutical preparations and substances; all included in Class 5”. The pharmaceutical substances traded by the Opponents under the name, “NAVELBINE” contain an active ingredient known by its International Non-proprietary Name (“INN”) or generic name as “vinorelbine”. The Opponents were the first and sole company in the world, to use and market the product that carry the active ingredient, “vinorelbine” which was developed under patent licence from the Centre National de la Recherche Scientifique (CNRS) in most countries until 2005. The Opponents’ products were first put onto the market in France from 1989 and then worldwide from 1991, under the Opponents’ mark, “NAVELBINE”.

Held, refusing registration:

1. There are only minor differences between the mark, “VINELBINE” and “VINORELBINE” which is the INN or generic name for the active ingredient in the goods as the differences lie in the middle of the words and such differences are usually glossed over or slurred in pronunciation. Both visually and aurally, the two words, “VINELBINE” and “VINORELBINE” look and sound very similar. Thus, “VINELBINE” is a trivial variation of “VINORELBINE” and on the whole, this renders “VINELBINE” devoid of distinctive character in relation to the goods which contain the active ingredient known as “VINORELBINE”. Registration of the Applicants’ application for “VINELBINE” in relation to

- “medicinal and pharmaceutical preparations” is therefore refused under Section 7(1)(b) of the Trade Marks Act (Cap 332) 2005 Revised Edition.
2. The Registrar also considered the policy rationale for protecting INNs since “VINORELBINE” is an INN. The Registrar noted that INNs belong to an international system in the pharmaceutical world to allow medical professionals, scientists and pharmacists to easily identify chemical substances/active ingredients by their generic names/INN. The Registrar also noted that INNs are meant to be non-proprietary so that they are universally available and can be used without restriction in pharmacopoeias, labelling, product information, advertising and other promotional material, drug regulation and scientific literature, and as a basis for product names, e.g. for generics. As registration of a word that resembles closely to an INN could potentially curtail such freedom of usage, registration would go against such public policy.
 3. The Registrar found the words, “NAVELBINE” and “VINELBINE” to be different, both visually and aurally. In the circumstances, the marks are not confusingly similar such that there exists a real likelihood of confusion on the part of the public. In the circumstances, the Opponents failed on the ground in Section 8(2)(b) of the Trade Marks Act (Cap 332) 2005 Revised Edition.
 4. As the words, “NAVELBINE” and “VINELBINE” are not confusingly similar, the Opponents failed to prove that there had been a misrepresentation by the Applicants in their use of “VINELBINE” and therefore, there is no basis to refuse registration under Section 8(7)(a) of the Trade Marks Act (Cap 332) 2005 Revised Edition.
 5. The Opponents failed to make out their case under Section 7(6) of the Trade Marks Act, (Cap 332) 2005 Revised Edition that the application was made in bad faith.

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332) 2005 Rev. Ed. Sections 7(1)(b), 7(6), 8(2), 8(7)(a).

Cases referred to:

- Love Co. Pte Ltd v The Carat Club Pte Ltd [2008] SGHC 158 (High Court)
- MediaCorp News Ptd Ltd v Astro All Asia Networks PLC [2009] SGHC 176 (High Court)
- Novogen Research Pty Ltd v Roche Products Limited [2003] SGIPOS 16
- Johnson & Johnson v Uni-Charm Kabushiki Kaisha [2006] SGHC 241) (High Court)
- SA Societe LTJ Diffusion v Sadas Vertbaudet SA [2003] FSR 34
- The Polo/Lauren Co., LP v Shop In Department Store Pte Ltd [2006] SGCA 14 (Court of Appeal)
- Gilead Sciences Inc. v Glaxo Group Limited [2006] SGIPOS 12
- Astrazeneca AB v Pfizer Inc. [2007] SGIPOS 16
- Nation Fittings (M) Sdn Bhd v Oystertect Plc and another suit [2005] SGHC 225 (High Court)

Representation:

- Ms Farah Namazie and Faith Kuah (Namazie & Co) for the Applicants
- Ms Ruby Tham (Drew & Napier) for the Opponents