

**IN THE HEARINGS AND MEDIATION DIVISION OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark Application No. T0627878A
30 June 2010

IN THE MATTER OF A TRADE MARK APPLICATION BY

NOVOZYMES SWITZERLAND AG

AND

OPPOSITION THERETO BY

GENZYME CORPORATION

Hearing Officer: Ms See Tho Sok Yee
Principal Assistant Registrar of Trade Marks

Ms Lim Siau Wen (Drew & Napier LLP) for the Applicants

Ms Gooi Chi Duan (Donaldson & Burkinshaw) for the Opponents

Cur Adv Vult

GROUND OF DECISION

1 The Applicants, Novozymes Switzerland AG, applied to protect the trade mark “CEREZYME” (“the Application Mark”) in Singapore on 9 November 2006 under International Registration No. 905507 (Singapore Trade Mark No. T0627878A) in Class 1 in respect of “Enzymes for use in the brewing industry”.

2 The application was accepted and published on 22 January 2007 for opposition purposes. The Opponents, Genzyme Corporation, filed their Notice of Opposition to oppose the registration of the Application Mark on 18 May 2007. The Applicants filed their Counter-Statement on 21 August 2007.

3 The Opponents filed evidence in support of the opposition on 22 December 2008. The Applicants filed evidence in support of the application on 11 September 2009. The Pre-Hearing Review was held on 19 April 2010, after which the opposition was heard on 30 June 2010.

Grounds of Opposition

4 The Opponents rely on Sections 8(2)(a), 8(4)(i), 8(7)(a) and 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) as their grounds of opposition.

Opponents’ Evidence

5 The Opponents’ Statutory Declaration (“Opponent’s SD”) was executed by their Managing Intellectual Property Counsel, Richard D. Allison, in the United States of America on 11 December 2008.

Applicants’ Evidence

6 The Applicants’ Statutory Declaration (“Applicants’ SD”) was executed by their Global Marketing Manager, Elmar Janser, in Switzerland on 31 August 2009.

7 The Applicants’ evidence is that “CEREZYME” is a coined term. “CERE” is derived from the name of the Greek goddess of agriculture, Ceres, and the end of the mark, “zyme”, is derived from the word “enzymes”.

8 In addition, at the hearing, the Applicants tendered evidence in the nature of an Internet printout from Wikipedia under the entry “Ceres (mythology)”. This showed that Ceres was the goddess of agriculture in ancient Roman religion.

Background

9 The Opponents are one of the world’s leading biotechnology companies. They were founded in 1981 by a small group of scientists in Boston, Massachusetts, United States of America and primarily devoted to finding drugs that would treat enzyme deficiency conditions that were essential to one’s survival and which usually afflicts a very small percentage of the world’s population. The Opponents have grown from a small start-up to a diversified enterprise with annual revenue exceeding US\$3 billion and 10 000 employees worldwide.

10 The Opponents are at the forefront in developing and applying advanced technologies in the life sciences, with breakthrough treatments in several areas of

medicine. In 2007, the Opponents received the National Medal of Technology, the highest honour awarded by the President of the United States for technological innovation.

11 The Opponents focus their efforts in medical and technological areas where they can make a major positive impact on the lives of patients with serious diseases and medical conditions. For example, in the area of lysosomal storage disorders, their “CEREZYME” (imiglucerase for injection) and its predecessor “CEREDASE” (aglucerase injection) have been the only enzyme replacement treatment for Type 1 Gaucher disease for over a decade.

12 The Opponents operate in more than 70 locations in over 30 countries worldwide and their products are available in nearly 90 countries. Their trade and business activities are carried out by subsidiaries, distributors and licensees worldwide, in North and South America, Europe, Asia, Africa, Australia and New Zealand.

13 The Opponents have registered their “CEREZYME” mark in Singapore on 12 May 2003 under Trade Mark No. T0307107H in Class 5 in respect of “Injectable pharmaceutical preparation to treat an enzymatic deficiency caused by a genetic effect”.

14 The Opponents’ annual worldwide sales figures for their “CEREZYME” products are as follows:

	Worldwide (USD)
2001	589,580,000
2002	519,184,000
2003	738,881,000
2004	838,380,000
2005	833,321,000
2006	1,087,638,000

15 In Singapore, the Opponents claim that their “CEREZYME” products are sold through Diethelm Singapore Pte Ltd of 34 Boon Leat Terrace, Singapore 119866. The annual sales figures for their CEREZYME products in Singapore are as follows:

	Singapore (USD)
2005	24,000
2006	12,000

16 The Applicants use the Application Mark on enzymes for brewing beer. In actual use, “CEREZYME” is sometimes used with “SORGHUM” such that the sign reads “CEREZYME SORGHUM”. The Applicants also use another mark, “CEREMIX”, on another product, an enzyme mixture, to improve output in the brewing process. It is noted that both “CEREZYME” and “CEREMIX” have the same prefix.

17 As the Applicants' enzymes are used for brewing beer, they are used by brewing specialists and the end product is targeted at mass market beer consumers. The Applicants' major customers of their "CEREZYME" products include SABMiller, Easter African Breweries (Guinness Group), Carlsberg among others.

18 The parties have already encountered each other in a Swiss action over "CEREZYME". The Opponents here filed an opposition in Switzerland and the Federal Institute of Intellectual Property dismissed the opposition. On appeal, the Swiss Federal Administrative Court upheld the decision.

Applicable Law and Burden of Proof

19 As referred to above, the applicable law is the Trade Marks Act (Cap 332, 2005 Rev Ed).

20 The undisputed burden of proof in an opposition under the Act falls on the Opponents.

MAIN DECISION

Ground of opposition under Section 8(2)(a)

21 Section 8(2)(a) of the Act reads:

A trade mark shall not be registered if because —

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected;

...

there exists a likelihood of confusion on the part of the public.

Opponents' submissions

22 The Opponents rely on their registration under Trade Mark No. T0307107H "CEREZYME" as an "earlier trade mark" ("the Opponents' Mark"). This mark was registered on 12 May 2003, before the currently opposed application was filed on 9 November 2006.

23 The Application Mark is identical to the Opponents' Mark, as the Applicants also acknowledge in their Counter-Statement.

24 The Opponents submit that the respective goods are similar because they are both enzymes.

25 The Opponents also argue that there is a likelihood of confusion on the part of the public because the association between the Opponents' Mark and the Application Mark

causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings.

26 As such, the ground of opposition under Section 8(2)(a) is made out and the Application Mark should not be registered.

Applicants' submissions

27 The Applicants do not dispute the identity between the Application Mark and the Opponents' Mark.

28 However, the Applicants submit that the goods under the Opponents' Mark are in no way similar to the goods under the Application Mark, taking into account the respective uses, users, physical nature and trade channels of the goods.

29 Further, the Applicants contend that there is no likelihood of confusion taking into account all extraneous circumstances.

30 As such, the Opponents' claim under Section 8(2)(a) must fail.

Decision on Section 8(2)(a)

31 At the outset, it bears saying that the outstanding issues under this ground of opposition have to do with the similarity of goods and the likelihood of confusion. There is no dispute that the marks in question are identical.

Similarity of Goods

32 In ***British Sugar Plc v James Robertson & Sons Ltd*** [1996] RPC 281 ("***British Sugar***"), 296, Jacob J set out the following factors in assessing whether there is similarity of goods:

- (a) The respective uses of the respective goods
- (b) The respective users of the respective goods
- (c) The physical nature of the goods
- (d) The respective trade channels through which the goods reach the market;
- (e) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether there are, or likely to be found on the same or different shelves
- (f) The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

33 The Opponents submit that the above represents guiding principles and there is no fixed weightage for each factor. In the present case, it is the Opponents' contention that at least two or three criteria are met to support a finding of similarity of goods.

34 On the uses of the respective goods, both sides are in agreement that the uses differ. According to the specification of the Opponents' Mark, the goods are used "to treat an enzymatic deficiency caused by a genetic disease". On the other hand, the Application Mark is used on goods in the brewing industry.

35 As for the respective users of the goods, the users of the Applicants' goods are brewing specialists in the industrial sector and their major customers include Carlsberg and SABMiller. In contrast, the users of the Opponents' goods are medical and pharmaceutical specialists, while the end-users are patients with Gaucher disease.

36 The Opponents however submit that the physical nature of the respective goods are the same. Both goods are enzymes. The fact that the respective goods are under different classes (1 and 5) in the International Classification of Goods and Services does not defeat their submission that the goods are the same. By way of example, the Opponents cite the product milk. Milk for babies is classified under Class 5 while milk in general is classified under Class 29.

37 The Applicants' interpretation and application of this factor differs. Regarding the physical nature of the Applicants' goods, they are granulated and used with brewing equipment. In contrast, the Opponents' goods are administered through intravenous infusion to the human body.

38 Turning to the *British Sugar* decision at page 297, the UK court applied this factor as such:

Their physical nature is somewhat different, the Robertson product being hardly pourable and really needing spooning out of the jar whereas the British Sugar product is meant to be poured out of the small hole in the plastic top.

39 It would appear that the Applicants' interpretation and application of this factor are more persuasive. However, the Opponents' submissions on this point are not irrelevant. It makes a fundamental assertion that the respective goods are of the same nature at a higher level of abstraction than the Applicants submit. Even if this assertion does not fall neatly under the "physical nature" factor, I am entitled to take into account the assertion as I should all relevant considerations.

40 On this particular factor, still, I would like to make an observation on the issue of class numbers, seeing as both parties have mentioned it in their submissions. Class numbers – in this case, class numbers under the Nice Classification (International Classification of Goods and Services) – facilitate the classification of goods and services in respect of which trade marks may be registered. The Applicants point out that the respective goods are proper to different classes – 1 and 5 in this case. The Opponents

submit that despite different class numbers, the respective goods are similar, citing the example of the product “milk” above.

41 The Nice Classification is a tool and a useful one at that. It provides an internationally recognised system for the classification of goods and services in the context of trade mark applications. Usually, goods and services of the same or similar nature are categorised in the same class when there is a common thread running through them. Sometimes, unrelated goods are also found in the same class e.g. fire-extinguishing apparatus and computer programmes are both found in Class 9. By and large, it provides guidance during examination of trade mark applications as to the appropriate classes to search for prior, conflicting marks.

42 However, the Nice Classification is only a starting point and does not purport to be authoritative in determining whether goods are similar. The fact that goods are categorised in the same class may indicate that they are similar in nature, but the actual inquiry has to deal with the specific goods at hand and look beyond the class number. Likewise, the fact that goods are not in the same class does not necessarily mean that they are not similar goods. That is also the point of cross-searching other potentially related classes in examination practice.

43 Hence, I cannot stop the line of inquiry at this point and dismiss the Opponents’ case merely because the respective goods are in different classes. The actual goods in issue must be weighed in the balance and it is to this exercise that we return.

44 With regard to the physical nature of the respective goods, apart from counsel’s submissions, I have considered the reasoning of the Swiss Federal Administrative Court’s decision upholding the Federal Institute of Intellectual Property’s decision on appeal. This judgment was marked as Exhibit “EJ-7” of the Applicants’ SD and dated 23 January 2009.

45 The court of three judges delivering the Swiss decision found that:

Furthermore, the opposing trademark is not registered for enzymes as such, but for drugs for the treatment of enzyme deficiencies. The homepage for those affected www.gaucher.de also shows that, apart from enzyme replacement therapy, other pharmacological therapeutic forms also exist... It also emerges from the product information stated on the homepage www.cerezyme.com that the appellant’s drug also contains, apart from enzymes, other ingredients, such as the osmotic diuretic Mannitol and sodium citrate against blood clotting.

It can therefore be said that both the presence of alternative treatment options for Gaucher’s disease and the fact that enzyme replacement preparations do not only contain enzymes speak against a similarity of goods.

46 The Swiss decision has touched on a point that was not submitted on substantively by both parties. However, it is imperative that I deal with it, as it is a fundamental

consideration. It involves going back to the actual specification of goods covered by the Opponents' Mark, namely "Injectable pharmaceutical preparation to treat an enzymatic deficiency caused by a genetic effect".

47 While the Opponents have submitted that their goods are essentially enzymes, their specification above is wider in scope than enzymes. The specification is wide enough to cover any other injectable pharmaceutical preparation, not necessarily enzymatic in nature, used to treat an enzymatic deficiency caused by a genetic effect, not necessarily Gaucher's disease only. While it is usually helpful to compare actual goods using the trade marks, the scope of rights is ultimately determined by the scope of the specification of goods when dealing with trade marks in the registration system. Here, the proper comparison should be between pharmaceutical preparations (specifically "Injectable pharmaceutical preparation to treat an enzymatic deficiency caused by a genetic effect") on the one hand, and enzymes (specifically "Enzymes for use in the brewing industry") on the other hand.

48 On the above basis, it is noted that the Applicants' goods are a raw material used for brewing, a foodstuff additive. In contrast, the Opponents' goods are finished products ready for medical use. The specification of the Opponents' Mark itself bears this out on the face of the record; the goods covered are pharmaceutical preparations. Further, based on the Opponents' product information on their CEREZYME drug, the Opponents' product contains various ingredients and not solely enzymes (imiglucerase in this case), again bearing out the fact that it is a finished product (with various ingredients) and not just the ingredient enzymes.

49 Thus, overall, I would be slow to find that the respective goods have the same physical nature.

50 Moving on to the factor "trade channels", the Opponents' case is that the respective trade channels and contact points overlap. This is because the market players in the enzyme industry (e.g. pharmaceutical companies, researchers, investors) have regular dealings with one another. Enzymes have identical production origins and similar distribution channels and research areas.

51 On the other hand, the Applicants submit that due to the different uses of the respective goods, the trade channels also differ. The Applicants' goods are industrial enzymes used in the brewing industry. They are sold on a business-to-business basis. In contrast, the Opponents' goods reach the market through a medical trade channel. End-user patients come into contact with the goods in hospitals, clinics, and sometimes at home.

52 Again, the basis of inquiry along these lines is predicated on the respective specifications of the parties. One should consider enzymes ("Enzymes for use in the brewing industry") as against pharmaceutical preparations ("Injectable pharmaceutical preparation to treat an enzymatic deficiency caused by a genetic effect"), and ask whether the two go through the same trade channels to reach the market. Framed as such, the

answer is clear. Even if at the initial stage, enzyme manufacturers in general have contact with pharmaceutical companies, this does not detract from the fact that specification for specification, the trade channels by which “Enzymes for use in the brewing industry” and “Injectable pharmaceutical preparation to treat an enzymatic deficiency caused by a genetic effect” reach their respective markets are markedly different.

53 The goods in issue are not self serve consumer items and thus, the next factor considered in *British Sugar* is not applicable here.

54 We move on to consider the extent to which the respective goods are competitive. *British Sugar* elaborates that one may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

55 Accordingly, the Opponents cite in support the Freedonia report “Enzymes – Market Research, Market Share, Market Size, Sales, Demand Forecast, Market Leaders, Company Profiles, Industry Trends” published in August 2006. The Opponents submit that enzyme producers are treated as being within one similar market, because such a report as Freedonia exists. The Opponents point out that the report identifies both parties as major players in the enzyme industry.

56 In the Freedonia report, the subject matter of which is the US enzyme industry, there are separate categories for “Pharmaceuticals” and “Food & Beverage Processing”. On page 1 of the report, it is written:

This study analyzes the \$1.6 billion US enzyme industry. It presents historical demand data and forecasts for 1995, 2000 and 2005 and forecasts to 2010 and 2015 by product (e.g. carbohydrases, proteases, polymerases, nucleases, lipases) and *by market* (e.g., pharmaceuticals, starch processing, food and beverage processing, research and biotechnology, cleaning products, diagnostics).
(emphasis added)

This demonstrates that the enzyme industry is a large and varied one, as the subsequent contents of the Freedonia report also indicate.

57 Furthermore, as noted earlier on, the Applicants’ goods are a raw material used for brewing while the Opponents’ goods are finished products. Hence, I am inclined to believe that the respective goods are not substitutable and therefore not competitive.

58 The Opponents also rely on the Intellectual Property Office of Singapore (“IPOS”) decision *Mohamed Mustafa & Samsudin Co Pte Ltd v Koyo Seiko Company Limited* [2005] SGIPOS 11 (“*Mustafa*”). There, likewise, the respective marks of the parties were identical and the issue of similarity of goods was in contention. The Applicants’ goods were lighting apparatus in Class 11 while the Opponents’ goods included electrical

apparatus and instruments, and sound and picture transmitting and receiving apparatus in Class 9. Principal Assistant Registrar Anne Loo opined at [45] and [47] that:

Electrical apparatus and instruments, sound and picture transmitting and receiving apparatus are goods that are sold in the same stores as goods such as torches, cookers, electric lamps, electric cooking utensils and fittings for lights. Electrical goods emanating from different manufacturers are plentiful in the market and are usually competing for shelf space in stores which sell electrical appliances. It is not uncommon to find these goods sold in stores in Singapore such as Best Denki, Courts, and Harvey Norman or even on the shelves of the Applicants' own premises. Given that the trade channels overlap therefore, there will clearly be an overlap in the nature of the customers of the Opponents' and the Applicants' goods.

...

Hence, considering the uses, the users, the physical nature of the goods or acts of services, the trade channels through which the goods or services reach the market, the extent to which the goods and services are in competition with each other, I find that the goods applied for by the Applicants in their application are similar to goods of the Opponents' mark registrations.

59 The Opponents' submission is that even though lighting apparatus in Class 11 and electrical apparatus and instruments, and sound and picture transmitting and receiving apparatus in Class 9 seemed different, the trade channels through which these goods reach the market overlap. Just as these goods occupy the same shelf space, in the present case, enzymes are also sold in the same, single marketplace and should be considered similar goods.

60 On the other hand, the Applicants cite another IPOS decision, *Kabushiki Kaisha Tokyo Seimitsu (Tokyo Seimitsu Co Ltd) v Tsukishima Kikai Co Ltd* [2007] SGIPOS 15 ("*Seimitsu*"). Principal Assistant Registrar Anne Loo held at [38] that:

I find from the evidence filed that the Opponents and the Applicants do not appear to be engaged in a common field of activity. The products that the Opponents and the Applicants deal in do not move in the same trade channels and the parties are involved in different but specialised areas of technology. Therefore, although the goods that are in question relate generally to machinery used for measurement and semiconductor manufacturing, they are not goods which in their respective specialised areas can be said to be similar goods.

61 Relying on *Seimitsu*, the Applicants' rebuttal is that while the Opponents attempt to associate the respective goods by claiming that the industry of production and research of enzymes are ruled by technology, this does not necessarily result in a conclusion that the goods are similar or related. After all, many different industries are also driven by

technology and know-how, e.g. telecommunications, construction, space and transportation.

62 It would appear that finding of fact in *Mustafa* is not directly applicable here. The principles to be applied based on *British Sugar* are the same. However, the facts differ. In *Mustafa*, the respective goods are self-serve consumer items “usually competing for shelf space in stores which sell electrical appliances”. The trade channels and end-users overlap in the case of electrical appliances. The same can hardly be said of enzymes for brewing as compared with pharmaceutical preparations for Gaucher disease. This is also consistent with the principle applied in *Seimitsu*, where the respective trade channels are examined. In *Seimitsu*, “the parties are involved in different but specialised areas of technology”. In the present case, the parties’ goods are likewise relevant in “different but specialised areas of technology”, in food and beverage processing technology and in pharmaceutical technology.

63 Having considered the non-exhaustive factors in *British Sugar*, case authorities cited and all relevant circumstances of the case, I find that “Enzymes for use in the brewing industry” and “Injectable pharmaceutical preparation to treat an enzymatic deficiency caused by a genetic effect” are not similar goods for the purposes of Section 8(2)(a).

Likelihood of Confusion

64 If I am wrong in my finding that the respective goods are not similar, I go on to consider whether, in view of the identity of marks and similarity of goods, there is a likelihood of confusion on the part of the public.

65 The Opponents submit that in view of all the factors, including the following:

- (i) The Application Mark is identical to the Opponents’ Mark
- (ii) “CEREZYME” is a 3-syllabic invented word that is highly distinctive
- (iii) Both parties are considered by the market to be in the same industry
- (iv) A global assessment of likelihood of damage is the approach to adopt

it is highly likely that the public will be confused into thinking that enzymes for use in the brewing industry sold under “CEREZYME” come from the Opponents or from a company with economic links to the Opponents and/or that the Opponents have found a new use (to aid brewing), for their imiglucrase product sold under “CEREZYME”.

66 The Applicants submit that there is no reasonable likelihood of confusion because of the following reasons which take into account relevant extraneous circumstances:

- (i) The respective goods are different and highly specialised in nature, in their respective fields.
- (ii) On the evidence, the Application Mark is used with the word “SORGHUM”, which is a type of cereal crop. The target audience looking at such use will

- immediately associate the goods bearing the Application Mark with sorghum or related cereal products.
- (iii) The respective marks co-exist on the trade mark registers in many countries such as Austria, Belarus, Bosnia and Herzegovina, Bulgaria, Croatia, Japan, Kazakhstan, Korea, Moldova, Romania, Russia Federation, Serbia, Tajikistan, Turkey, Ukraine and Vietnam.
 - (iv) The Swiss Federal Administrative Court upheld the Federal Institute of Intellectual Property's decision on appeal, and found in the Applicants' favour.

67 On the issue of likelihood of confusion, the Singapore Court of Appeal in *The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* [2006] 2 SLR 690 ("*Polo/Lauren*") at [28] makes clear the correct approach:

"the question of likelihood of confusion has to be looked at globally taking into account all the circumstances including the closeness of the goods, the impression given by the marks, the possibility of imperfect recollection and the risk that the public might believe that the goods come from the same source or economically-linked sources... Steps taken by the defendant to differentiate his goods from those of the registered proprietor are also pertinent... So also is the kind of customer who would be likely to buy the goods".

68 In taking into account all relevant circumstances, one issue in contention between the parties stands out in this case. It poses the question: To what extent is the fact that a pharmaceutical product is involved relevant in the standard of finding likelihood of confusion?

69 The Opponents submit that since their mark is used on pharmaceutical goods, the Registrar should exercise more caution in ensuring that there will be no confusion amongst the public as to the origin and uses of pharmaceutical goods, because the consequences of such confusion is potentially disastrous. In this regard, the Opponents cite the IPOS decisions *Otsuka Pharmaceutical Co. Ltd. V Farmitalia Carlo Erba Spa* [1995] AIPR 86 and *Novogen Research Pty Ltd v Roche Products Limited* [2003] SGIPOS 16 ("*Novogen*"). In the latter case, the Principal Assistant Registrar found a likelihood of confusion and said that:

One factor that has influenced me in the present case is the fact that we are dealing with goods in the pharmaceutical industry where confusion could lead to dangerous consequences. I have taken into account the views of the learned J Jacob in the *Harker Stagg case* [1953] 70 RPC 205 in arriving at my conclusion. In that case, the proprietors of a registered mark Aludrox for pharmaceutical preparations in class 5 applied to cancel a later registration of Algelox for chemical substances for use in medicine and pharmacy in class 3. The Court upheld the decision of the Hearing Officer not to cancel the registration. However the learned Justice Jacob said that if there were ... any reasonable ground for

supposing that by reason of their similarity confusion or deception is likely to arise, the fact that they (the marks) are used in relation to pharmaceutical preparation is, perhaps, all the more reason for seeing that the public are protected from the consequences of deception and confusion. This case was decided in 1953.

I have also considered the more recent decision of the Hearing Officer of the UK Patent Office in *Besavar v Nexavar (Sanofi-Synthelabo v Bayer Aktiengesellschaft* Invalidation Application No. 12067), where he applied the test of the average consumer as set out in the *Lloyd's case (Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR 77). He also said that he was not aware of any authority under the current law (i.e. since the amendment to the Trade Marks Act in the United Kingdom) which suggested that in the pharmaceutical industry a different standard is to be followed. His attention had been drawn to the *Harker Stagg case* when he came to this conclusion. However I am of the view that the warning of Justice Jacob that caution should be exercised when it comes to the pharmaceutical industry is still applicable even though the Singapore Trade Marks Act has also been amended.

(citations added)

70 The Opponents submit that although the above cases relate to similar marks both being used on pharmaceutical goods, the same practice of caution and care should extend to cases where the application mark, though not used on pharmaceutical goods, is identical to a trade mark used on such goods. The public may think that the respective goods both sold under the identical mark “CEREZYME” may be used interchangeably. If the Applicants’ “CEREZYME” were used on a Gaucher disease patient as a substitute for the Opponents’ “CEREZYME”, the consequences will be disastrous.

71 I do not think that the mere fact that a pharmaceutical product is involved (whether on the part of one or both parties) means that the standard of likelihood of confusion is necessarily lowered to protect the public, in particular patients. The fact could, however, be taken into account as part of the surrounding circumstances that may be considered and be given the appropriate weightage in the balancing exercise in each case.

72 After all, the potential factual matrices are myriad. There could be varying combinations of prescription drugs, over-the-counter drugs and non-pharmaceuticals (e.g. “Enzymes for use in the brewing industry” in this case) under comparison, not to mention other factors that come into play. Hence, in terms of the threshold for likelihood of confusion, it would be foolhardy to attempt to calibrate a unique, fixed, lower (as the Opponents propound) standard that applies when a pharmaceutical mark is involved. Besides, the debate on whether pharmaceutical trade marks should be judged differently from non-pharmaceutical trade marks is far from settled. Even if they should be judged differently, there is no universal consensus whether a lower or higher standard should be applied. Proponents for a lower standard say that healthcare professionals are often overworked and may write prescriptions in illegible handwriting, and there is potential danger to the health of consumers if confusion occurs. On the other hand, a higher

threshold for confusion may be justified because the average consumer is reasonably expected to be more careful when purchasing pharmaceuticals; in the case of prescription drugs, the consumer is protected by the intervention of the doctor or pharmacist before a pharmaceutical is made available to him.

73 The IPOS decision in *Novogen* is not inconsistent with the foregoing. The Principal Assistant Registrar did not depart from the established principles of assessing likelihood of confusion and took into account relevant considerations in her finding of fact:

In finding that there exists a likelihood of confusion, I have taken into account the test of the average consumer set out in the *Lloyds case*. An average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The Applicants' pharmaceutical preparation is not an eye drop or a cream for external application which a reasonably well informed, observant and circumspect consumer may distinguish from the Opponents tablets for consumption. The Applicants' drug is sold in a tablet form for consumption just like the Opponents. I think that an average consumer, who is reasonably well informed, circumspect and observant, may confuse the marks RIVOTRIL and RIMOSTIL.

74 The Applicants helpfully referred to two decisions of the UK Trade Marks Registry. In *Ashbourne Pharmaceuticals Limited v Grünenthal GmbH* (Opposition No. 70345), the hearing officer opined at [38]:

The opponent has stated that a different threshold applies in assessing the likelihood of confusion in relation to pharmaceutical products. He gives no basis for this assertion. It is something that has been argued often but not, as far as I am aware, upheld. *It confuses the issue of likelihood of confusion with the effects of confusion* – what could happen if an incorrect drug was taken. In relation to the issue of likelihood of confusion I must apply the precepts and concepts of trade mark law. There are agencies – such as the Medicines Control Agency – who have statutory powers to deal with what can be described as the non-trade mark law issues of trade marks used in relation to drugs. The matter is dealt with in the decision of Mr James in case BL 0-532-01 in relation to both prescription and over the counter drugs.

(emphasis added)

75 Further, in *Glaxo Group Limited v Allergan Inc.* (Opposition No. 50441), Professor Ruth Annand, the Appointed Person hearing the appeal, expressed at [18] the view that:

I have arrived at this view without engaging in the debate whether a higher or lower threshold needs to be reached before confusion can be established in conflicts between pharmaceutical trade marks. For my own part, I do not believe that different standards exist or are necessary to exist. *The test of likelihood of*

confusion is flexible enough to allow each case to be judged according to its own peculiar facts. Relevant considerations may include those mentioned by the First Board of Appeal in *TEMPOVATE/EMOVATE, EUMOVATE*, supra., namely that some medicinal products are administered over the counter without prescriptions, some consumers resort to self-prescription and professionals are often overworked and may write prescriptions in hardly legible handwriting (although drugs may be prescription only, professionals may be on hand to assist choice with OTC products and pharmacists usually check illegible prescriptions).

(emphasis added)

76 The above reasoning resonates with wisdom and common sense. As I have expressed above, circumstances vary from case to case even within the specialised pharmaceutical field. The multiplicity of relevant factors that inform every finding of likelihood of confusion is matched by the flexibility of the test that we already benefit from.

77 Moving on to applying the principles in the *Polo/Lauren* decision, the factors to consider here include the closeness of the goods, the impression given by the marks, the risk that the public might believe that the goods come from the same source or economically-linked sources, the steps taken by the Applicants to differentiate their goods from those of the Opponents and the kind of customer who would be likely to buy the goods.

Closeness of the Goods

78 I have found earlier that the goods are not similar. They are each specialised in their technical field with different uses and users. The Opponents' goods are a finished pharmaceutical product unlike the Applicants' goods which are a raw material used for brewing. Even if, however, I am wrong and the respective goods should have been found similar, I find here that the goods are not close to a sufficient degree as to lead to a reasonable likelihood of confusion, for the same reasons why I had not found them similar as iterated earlier in this paragraph.

Impression Given by the Marks

79 The Opponents emphasize that "CEREZYME" is a distinctive, invented word. As such, it would create a deeper impression than non-invented words which have a direct meaning in the English language. It is therefore more susceptible to confusion than a non-invented word mark.

80 I appreciate that "CEREZYME" is an invented word and agree with the Opponents' line of reasoning to some extent. However, with specific regard to "CEREZYME", the invented word is allusive. The suffix "-ZYME" suggests that the goods are enzymes of some sort. The register record has also corroboratively shown that it is common for trade marks ending with "-ZYME" to relate to enzymes.

81 Hence, when one apprehends a mark as “CEREZYME”, the depth of impression could plausibly be greater as compared to a non-invented word mark. However, there is an element of genericism as well, due to the suffix “-ZYME” which alludes to enzymes. In this case, the respective marks are identical and thus, this factor taken in a vacuum can be construed in the Opponents’ favour. I am mindful that the distinctiveness of “CEREZYME” marginally increases the likelihood of confusion in the public. However, the inquiry is a balancing act and we move on to consider other relevant circumstances.

Risk that the Public Might Believe Goods Come from the Same Source or Economically-linked Sources

82 The Opponents point out that the Applicants’ website at www.novozymes.com states that “Novozymes produce pharmaceutical proteins for other companies.” This demonstrates that the parties operate in the same market and industry. The Applicants rebut that their enzymes and biopharma businesses are operated separately as seen in their organisational structure. The website www.novozymes.com showcases the whole Novozyme Group. The Applicants are only one corporate entity under the umbrella of the parent company, Novozymes A/S. There are separate subpages at www.novozymes.com that show different sales offices for enzymes and biopharmas. The Applicants’ SD states that there are no customers in the pharmaceutical field that also buy the Applicants’ range of brewing enzymes as the enzymes and biopharmas businesses are not related in any way.

83 At the hearing, I asked the Opponents’ counsel whether any part of their evidence demonstrates that in the trade, enzyme manufacturers sell the same kind of enzyme to both the brewing and pharmaceutical industries. Or, are there at least other examples of the same enzymes being sold by enzyme manufacturers to disparate industries? The Opponents’ counsel answered in the negative but emphasized that the Applicants themselves sold pharmaceutical proteins as their website indicates. The latter point was explained and rebutted by the Applicants, as detailed at [82].

84 I do not discount the possibility that the public might indeed have cause to wonder whether “CEREZYME” enzymes for brewing and “CEREZYMES” the pharmaceutical preparation may emanate from the same or related source, based on the Opponents’ submissions on the website at www.novozymes.com. After all, the purchasing public will tend to be more interested in the goods themselves than in the detailed corporate structure and organisation within a group. Thus, while the doctrine of separate legal entities will be appreciated by the legally-minded, it is the shoes of the purchasing public that one must step into here.

85 However, the inquiry does not stop there. The foremost question is how real is the risk that the public, and even the specific end-users, would believe the respective goods come from the same source or economically-linked sources. To answer this question, the trade channels, nature, uses and users of the respective goods are all relevant. For instance, the users of both parties’ “CEREZYME” goods are in different specialised

fields and are reasonably expected to exercise a higher degree of care and attention in the selection and purchase of goods. We have explored this line of inquiry when considering whether the goods were similar under Section 8(2)(a) above. For the same reasons, I believe that the risk is not so great as to cross the threshold of a likelihood of confusion arising from the identity of marks and similarity of goods.

Steps taken by Applicants to Differentiate

86 The Applicants sometimes use the Application Mark with the word “SORGHUM”, a cereal crop whereas the Opponents use their “CEREZYME” mark as it is.

87 While this practice may mitigate against any risk of confusion at present, I will not attribute too much weight to it in the balancing exercise as “SORGHUM” is not part of the Application Mark and the Applicants are at liberty to use “CEREZYME” on its own without “SORGHUM” at any time.

Kind of Customer Likely to Buy Goods

88 This factor has been examined closely in the earlier consideration of the respective goods. The users of the Applicants’ goods are brewing specialists in the industrial sector such as Carlsberg and SABMiller. In contrast, the users of the Opponents’ goods are medical and pharmaceutical specialists, while the end-users are patients with Gaucher disease.

89 In dealing with beverages which are ingested by the human body as well as with medicines to treat a disease, both kinds of customers would necessarily be careful and circumspect. These customers would also buy their respective goods from reliable sources who can be trusted to provide the correct goods needed. Having regard to the kind of customers likely to buy the respective goods of the parties, the likelihood of confusion is not high.

Conclusion

90 In arriving at a conclusion on the likelihood of confusion, I have cautioned myself that a mere reminder of or association with the earlier trade mark is not tantamount to likelihood of confusion: see *McDonald’s Corp v Future Enterprises* [2005] SLR 177 at [66] and *The Polo/Lauren Co., LP v Shop-In Department Store Pte Ltd* [2005] 4 SLR 816 at [35].

91 Next, I ask, whether having weighed the relevant factors and considerations in the balance, the Opponents have discharged their burden of proof in establishing a likelihood of confusion that arises from the identity of marks and similarity of goods.

92 Overall, in a global assessment of the relevant circumstances, I find that the Opponents have not established a likelihood of confusion on a balance of probabilities.

93 As such, the ground of opposition under Section 8(2)(a) must fail.

Ground of opposition under Section 8(4)(i)

94 Section 8(4) of the Act reads:

Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

- (a) the earlier trade mark is well known in Singapore; and
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
 - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or
 - (ii) if the earlier trade mark is well known to the public at large in Singapore—
 - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
 - (B) would take unfair advantage of the distinctive character of the earlier trade mark.

Section 2(1) defines “earlier trade mark” as:

- (a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or
- (b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark, and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered

Section 2(1) defines “well known trade mark” as:

- (a) any registered trade mark that is well known in Singapore; or
- (b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —
 - (i) is a national of a Convention country; or
 - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,whether or not that person carries on business, or has any goodwill, in Singapore

Sections 2(7) to (9) are pertinent to a consideration of whether a trade mark is well known in Singapore. They are set out below:

(7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of —
 - (i) any use of the trade mark; or
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.

(8) Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

(9) In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;
- (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;
- (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

Opponents’ submissions

95 The Opponents submit that the Opponents’ Mark is well known in the pharmaceutical and enzymes industry as well as to persons who know about Gaucher disease. At the hearing, the Opponents’ counsel particularized the relevant consumers as people who dispense their “CEREZYME” product, who use it (since it is the only thing they have to survive) and the family of Gaucher disease patients. In fact, the Opponents’ SD at Paragraph 9(a)(i) states that for the past decade, the Opponents’ “CEREZYME” product was the only drug available for Gaucher disease.

96 Even if the respective goods are not similar (which the Opponents deny), use of the Application Mark in relation to “enzymes for use in the brewing industry” would indicate a connection between those goods and the Opponents, and is likely to damage the interests of the Opponents.

Applicants’ submissions

97 The Applicants’ case is that the Opponents’ Mark is not well known in Singapore, that the use of the Application Mark on “enzymes for use in the brewing industry” would not indicate a connection between those goods and the Opponents, and is not likely to damage the Opponents’ interests.

Decision on Section 8(4)(i)

98 To succeed under this ground, the Opponents must first establish under Section 8(4)(a) that “CEREZYME” is well known in Singapore on the application date of 9 November 2006.

99 The deeming and definition provisions in Sections 2(8) and (9) are relevant here, as they make clear that the Opponents’ “CEREZYME” does not have to be well known to every person in Singapore, in order to be found well known. The Singapore Court of Appeal decision in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Amanresorts*”) at [154] makes clear that the Section 2(9)(a) phrase “all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied” is correctly interpreted as the actual and/or potential consumers of the goods and services of the proprietor of the earlier well known mark.

100 The Opponents have particularized their relevant consumers as people who *dispense* the “CEREZYME” product, who *use* it and the *family* of Gaucher disease patients. As a starting point, we may establish this as the “relevant sector of the public in Singapore” for the purposes of Section 2(8).

101 The next issue then is whether the evidence demonstrates that “CEREZYME” is well known in Singapore. If “CEREZYME” is well known to the “relevant sector of the public” defined above, then it is indeed well known in Singapore.

102 In the *Amanresorts* decision at [149], the Court of Appeal states that:

Third, the deeming provision in s 2(8) still requires the trade mark in question to be “*well known*” [emphasis added] to the relevant sector of the public in Singapore. In this regard, it is interesting that Singapore did not implement Art 2(2)(c) of the Joint Recommendation, which provides that a mark which is merely “known” to the relevant sector of the public “may” be considered to be *well known*. All this suggests that there are different degrees of public knowledge of a trade mark, and the requisite level of knowledge required under Singapore’s

legislation tends towards the higher end of the scale: *ie*, to qualify for protection under s 55 of the current TMA, the trade mark concerned must be more than merely "known" to the relevant sector of the public in Singapore.

103 I have considered all the Opponents' evidence, including the annual sales figures, set out at [14]-[15] and evidence on the use and promotion of the Opponents' "CEREZYME". The Opponents themselves are one of the world's leading biotechnology companies, being a diversified enterprise with annual revenue exceeding US\$3 billion and 10 000 employees worldwide. They are the recipients of noteworthy accolades, such as the National Medal of Technology, the highest honour awarded by the President of the United States for technological innovation.

104 However, I am hard pressed to find that "CEREZYME" is well known to the relevant sector of the public on the face of the evidence. That the Opponents are a very major and visible player in the global biotechnology industry is recognised, but it cannot save the day when the spotlight is on the mark, and not the mark's proprietor. There is insufficient evidence relating to the public perception of the mark "CEREZYME" in Singapore. It may even be that the same mark has "well known" status in other parts of the world, for example in the United States of America, but the same cannot be said for Singapore based on the available evidence.

105 The two invoices in the Opponents' SD are both addressed to Pacific Biosciences Pty. Ltd. with the same delivery address to Summit Company (M) Sdn Bhd in Malaysia. The Applicants argue that if the "CEREZYME" drug was sold through Diethelm Singapore Pte Ltd as the Opponents' SD states, it is curious that there is no documentary support for this, as such should be readily available. Nevertheless, I draw no adverse inference from this and instead consider closely the evidence tendered.

106 It is interesting to note that the Opponents' annual sales figures for their "CEREZYME" products in Singapore are USD24,000 for 2005, and their invoice no. PT172220 dated 3 November 2005 despatched 15 vials of Cerezyme at USD12,000. This is already half the value of their annual sales for 2005. It is not clear whether the other USD12,000 worth of sales in 2005 were delivered to Singapore, Malaysia or elsewhere.

107 At the hearing, the Opponents' counsel pointed out that the Opponents sometimes provide their "CEREZYME" drug free of charge on compassionate grounds. Looking at the two invoices dated 3 November 2005 and 2 March 2006, I observe that indeed, both instances involved the provision of the Opponents' "CEREZYME" based on compassionate grounds. The invoices contained remarks such as "A portion of this shipment (15 vials) is compassionate use product being provided free of charge", "This products is being provided by Genzyme's Charitable Foundation. Compassionate Use on behalf of patient Melanie Chin" and "Humanitarian aid donation shipment". The main idea I believe the Opponents' counsel conveyed is that even if the evidence does not show that "CEREZYME" is sold, the product in fact reaches patients who need the medicine, hence making the mark well known.

108 However, attributing the paucity of documentary support for the use and promotion of the mark in Singapore to compassionate donations to Malaysia does not advance the Opponents' cause, as the mark's actual reach in Singapore is not clearly made out. There is little or no other Singapore-specific evidence. This is not to say that a mark must be used in Singapore before it can be well known here – this is not the case, see definition of “well known trade mark” at Section 2(1). The relevant factors for finding that a mark is well known include those set out at Section 2(7). It is unknown whether the information and promotional material adduced in evidence is circulated in Singapore and if so, to what extent. Website material may have a global reach potentially, but there is no evidence, for example in the form of web analytics reports, to demonstrate that Singapore users have been exposed to the information and promotion of the “CEREZYME” mark and to what extent.

109 I am mindful that “*The trade mark concerned must be more than merely ‘known’ to the relevant sector of the public in Singapore*”: *Amanresorts* at [149]. On the evidence, it is questionable whether the Opponents' “CEREZYME” mark has left a footprint in Singapore. However, even giving the evidence the best possible spin and heaviest weight, I am only prepared to conclude that “CEREZYME” may be “known” to the “relevant sector of the public” defined above. The mark has not been proven to be “*more than merely ‘known’ to the relevant sector of the public in Singapore*”, and in fact well known.

110 Even if I am wrong to find that the Opponents have not made out their case that “CEREZYME” is well known in Singapore, the remaining two elements of Section 8(4)(i) are still not established by the Opponents.

111 The second and third elements of Section 8(4)(i) require that the use of the Application Mark indicates “a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark”.

112 In respect of “indicate a connection”, the Singapore Court of Appeal decisions in *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 at [94] to [95] and in *Amanresorts* at [226] to [227] made clear that “connection” must be a confusing sort of connection.

113 The issue of confusion has been considered in detail under Section 8(2)(a) and the same considerations apply here. As I have found no reasonable likelihood of confusion under Section 8(2)(a), I also find that the use of the Application Mark does not indicate “a connection between those goods or services and the proprietor of the earlier trade mark” under Section 8(4)(i).

114 It follows that the use of the Application Mark is not “likely to damage the interests of the proprietor of the earlier trade mark”.

115 As such, the ground of opposition under Section 8(4)(i) must fail.

Ground of opposition under Section 8(7)(a)

116 Section 8(7)(a) of the Act reads:

A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —
(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade

Opponents' submissions

117 The Opponents submit that the three elements of passing off are satisfied here. The Opponents' "CEREZYME" mark is the first effective treatment for Gaucher disease. By virtue of long and extensive use worldwide and in Singapore, goodwill subsists in the Opponents' mark.

118 There would be a misrepresentation if the Application Mark were used on "enzymes for use in the brewing industry" as a reasonable person would be confused that such goods originated from the Opponents or an enterprise economically-linked to the Opponents.

119 It follows that once goodwill and misrepresentation are made out, damage is readily inferred.

Applicants' submissions

120 The Applicants deny that the Opponents enjoy any goodwill in "CEREZYME" in Singapore. The sales figures provided are paltry and only four copy invoices, all to the same company, were furnished in support. It is noted that the delivery address was a Malaysian address.

121 The Opponents have also been silent whether the sample advertisements and brochures in the Opponents' SD were distributed in Singapore or elsewhere. There were no advertising figures for Singapore.

122 The weakness of the Opponents' evidence on the use of their mark has been pointed out in the Applicants' SD. However, despite the opportunity, the Opponent did not file any evidence in reply to address the issues.

123 There is no misrepresentation because the Applicants' use of the Application Mark is not calculated to deceive. In any case, the parties are not engaged in a common field of activity; the respective goods are not competitive. Use of the Application Mark will not result in a misrepresentation that causes confusion to the public and trade.

124 As the elements of goodwill and misrepresentation are not made out, it is not necessary to consider the third element of damage.

Decision on Section 8(7)(a)

125 The test for passing off is well established and not in dispute between the parties. The Singapore Court of Appeal in *Amanresorts* reiterated at [36] the uncontroversial elements of this ground. It cited *Reckitt & Colman Products Ltd v Borden Inc* [1990] All ER 873 at page 880 for the “classical trinity” of passing off as follows:

- (a) goodwill attached to the goods or services which the plaintiff supplies, in the mind of the purchasing public by association with the identifying get-up under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services
- (b) misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are those of the plaintiff
- (c) damage that the plaintiff is likely to suffer by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.

126 The first issue, then, is whether the Opponent has established goodwill in the “CEREZYME” mark in Singapore as on the application date of 9 November 2006.

127 The annual sales figures in Singapore for 2005 and 2006 are set out above at [15]. As observed at [108] in the consideration whether “CEREZYME” is well known, it is not clear if the information and promotional material adduced in evidence is circulated in Singapore and if so, to what extent. It is also unclear whether the Opponents’ goods have been dispensed to patients in Singapore, as the available documentary evidence shows that the goods were delivered to a Malaysia address. Unlike under Section 8(4), to succeed under Section 8(7)(a), it is necessary to use and/or promote the mark in Singapore to establish goodwill. While it is commendable that the Opponents sometimes provide “CEREZYME” free of charge on compassionate grounds, it is at the same time regrettable that they have not given better evidence to make out their claim to goodwill in their “CEREZYME” drug in Singapore.

128 Regarding the second element of misrepresentation, the considerations in respect of “likelihood of confusion” under Section 8(2)(a) above are also relevant here under passing off. On the facts of the case, for the same reasons elaborated above under Section 8(2)(a), the Opponents have not satisfied me that there is a misrepresentation by the Applicants to the public leading, or likely to lead, the public to believe that the

“enzymes for use in the brewing industry” sold by the Applicants are those of the Opponents.

129 As goodwill and misrepresentation have not been established by the Opponents, there is no damage to be suffered by them arising from the use of the Application Mark on “enzymes for use in the brewing industry”.

130 In view of the foregoing, the ground of opposition under Section 8(7)(a) must fail.

Ground of opposition under Section 7(6)

131 Section 7(6) of the Act reads:

A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Opponents’ submissions

132 The Opponents submit that they have used the mark “CEREZYME” well before the application date of 9 November 2006. The Applicants would, being in the same industry as the Opponents, surely be aware of the Opponents’ mark.

133 The parties are business competitors and thus, it is no coincidence that the Applicants have chosen a mark that is identical to the Opponents’ for use on enzymes.

Applicants’ submissions

134 The Applicants submit that the Application Mark was selected in good faith. In particular, the Application Mark is a coined term. The beginning of “CEREZYME” is derived from the ancient Greek goddess of agriculture, Ceres, and the ending “zyme” is derived from the word “enzyme”. The ending also follows the end of the Applicants’ name “Novozymes”.

135 In rebuttal to the Opponents’ claim, the Applicants submit that bad faith cannot be made out simply on account of the alleged goodwill and reputation enjoyed by the Opponents.

136 Further, there is no reason for the Applicants, a reputable and established company with many offices worldwide, to want to use an identical mark to the Opponents’ on enzymes for brewing. This is particularly the case having regard to the fact that the Opponents’ “CEREZYME” is used to treat a medical illness. Even with such knowledge, it is highly inconceivable that the Applicants would want to misappropriate the Opponents’ mark and use it on products used in beer, a drink for enjoyment.

Decision on Section 7(6)

137 The Singapore Court of Appeal in *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR 177 at [78] referred to *Royal Enfield Trade Marks* [2002] RPC 24 with approval. There, the English court held that:

Any allegation that a trade mark has been applied for in bad faith is a serious allegation ... A plea of fraud should not lightly be made ... and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the fact ... In my judgment precisely the same considerations apply to an allegation of ... bad faith made under Section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference.

138 The IPOS decision of *E! Entertainment Television, Inc v Deutsche Telekom AG* [2005] SGIPOS 5 is also instructive in this case. Under Section 7(6), Principal Assistant Registrar Arul Selvamalar opined that:

In almost all trade mark opposition proceedings this ground is pleaded and argued. The evidence that opponents rely on generally to establish this serious allegation is the fact that they have an extensive reputation in their mark. They urge the Registrars hearing the oppositions to find that because of their extensive reputation the applicants must have known about the opponents mark and the applicants must have copied the opponents mark.

The opponents urge the Registrars to make these findings as irresistible inferences that must be drawn from the fact that the opponents have an extensive reputation in their mark. Time and again Registrars have stated that more evidence is needed to establish such a serious allegation and that the mere fact that the opponent's mark has been extensively used and the applicant must have known about it, does not mean that the applicant must have copied the opponent's mark in bad faith.

139 The above is especially germane here, as the Opponents' submissions in this case also run along those lines, which, without more evidence, cannot suffice.

140 The Opponents' mark "CEREZYME" may be invented, but, as considered under [80] to [81] above, the invented word is allusive. The suffix "-ZYME" suggests that the goods are enzymes of some sort. Hence, there is an element of genericism as well. This is in contrast to a fully invented mark such as "KODAK". One cannot make the logical leap that because another trader lays claim to the same mark "CEREZYME", it is necessarily copied. One should further consider the latter's explanation on how the mark was derived at their end and, after weighing all the evidence, determine whether it has been proven on a balance of probabilities that there was bad faith. This is consistent with the approach taken in the recent High Court decision of *Festina Lotus SA v Romanson Co Ltd* [2010] SGHC 200 ("*Festina*").

141 The Applicants have given a credible derivation of the Application Mark. The Applicants' SD declares that "CEREZYME" is derived from "CERES", the name of the Greek goddess of agriculture. (More accurately, "Ceres" is the name of the Roman goddess of agriculture and "Demeter" is her Greek counterpart.) That such a name is used on enzymes in the brewing industry (which involves cereals, and more generically, agriculture) appears cogent in reason, rather than copycat-like in intent.

142 The Applicants also use another mark, "CEREMIX", on another product, an enzyme mixture, to improve output in the brewing process. This suggests that they have a legitimate interest in using the prefix "CERE-" and such use is consistent with the derivation furnished above.

143 The Applicants' account is entirely reasonable, and not contrived. This is in contrast to *Festina* at [122] to [123] where, on the facts, "the Respondent's brand story on the name 'J.ESTINA' appears extremely contrived" and "The graphs which supposedly illustrate the process of ultimately choosing the name 'J.ESTINA' also do not explain in any way how the word 'ESTINA' came into being."

144 Taking into account all the relevant circumstances, the Opponents have not established, on a balance of probabilities, that the application to register the Application Mark was filed in bad faith

145 Accordingly, the ground of opposition under Section 7(6) fails.

Conclusion

146 Having considered the pleadings, evidence and submissions of the parties, I find that the opposition fails under all grounds. Protection in Singapore is conferred on International Registration No. 905507 (Singapore Trade Mark No. T0627878A). The Applicants are entitled to costs to be taxed if not agreed.

Dated this 30th day of September 2010

See Tho Sok Yee

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Division

Intellectual Property Office of Singapore