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Jamaica Intellectual Property Office

IN THE MATTER OF APPLICATION NO. 44 756
BY EGIS GYÓGYSZERGYÁR RT
TO REGISTER A TRADE MARK IN CLASS 5

JAMAICA INTELLECTUAL
PROPERTY OFFICE
(An Agency of the Ministry of
Industry, Investment & Commerce)

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DECISION AND GROUNDS OF DECISION

1. On the 9th of January 2004, Egis Gyógyszergyár RT, through its agents, Myers, Fletcher and Gordon, Attorneys-at-Law, (hereinafter referred to as “the Applicant”) applied under the Trade Marks Act 1999 (hereinafter referred to as “the Act”) for registration of the trade mark **PARLAZIN** in Class 5 in respect of:

“Pharmaceutical preparations for human use”

2. The mark was accepted for publication by the Trade Marks Registry on March 30, 2004 and publication effected in the Jamaica Gazette thereafter.
3. A Form TM 4 - Notice of Opposition accompanied by the Statement of Grounds was filed on November 18, 2004 by Livingston, Alexander and Levy, Attorneys-at-Law, on behalf of Aventis Pharma Deutschland GMBH (hereinafter referred to as “the Opponent”). The Opponent is a pharmaceutical manufacturer and is the registered proprietor in Jamaica of Trade Mark number 10 137 - BARALGIN – which is also registered in Class 5 in respect of “pharmaceutical, veterinary and hygienic preparations and substances”.
4. The Opponent asserts that the registration of the trade mark PARLAZIN contravenes Section 13 (2) (b) of the Trade Marks Act, 1999 in that the proposed mark is greatly similar to its trade mark and is in respect of identical goods such that there exists a likelihood of confusion including the likelihood of association on the part of the public of the Applicant’s mark with the Opponent’s earlier trade mark.

5. The Opponent further states inter alia, that :
- (1) *The proposed mark is an infringement of the Opponent's rights as under Section 9 (3) (b) of the Trade Marks Act 1999.*
 - (2) *The proposed mark is not distinctive of the pharmaceutical products of the Applicant and is derived from the Opponent's trade mark and as such the application has been made in bad faith and should therefore be refused registration by virtue of Section 11 (4) (e) of the Trade Marks Act 1999.*
6. Form TM 5 and Grounds of Counterstatement were filed on behalf of the Applicant on January 20, 2005.
7. The Applicant denied all the allegations set out in the Opponent's Grounds of Opposition. In particular, the Applicant stated the following:
- (i) *It denies the Opponent's allegation that the proposed PARLAZIN is similar to the Opponent's Trade Mark BARLAGIN and that there are sufficient visual and phonetic differences between the marks which would avoid confusion or the likelihood of confusion on the part of the public between the two marks.*
 - (ii) *The Applicant's and Opponent's marks stand side by side on the trade mark registers of several countries throughout the world without any confusion on the part of the public.*
 - (iii) *The product bearing the Applicant's mark is intended and marketed as an atiallergic whilst the product bearing the Opponent's mark is used as an analgesic.*

(iv) The Applicant's mark is made in good faith and is a genuine and ingenious trade mark.

8. On the 31st October, 2005 the Opponent filed a joint Statutory Declaration of Joëlle Sanit-Hugot and Jean-Pierre Pousset, Trade mark Counsels of the Opponent company.
9. On the 31st January, 2006 the Applicant filed a Joint Statutory Declaration of Dr. György Ujfalussy and Dr. Attila Mándi, Deputy Director for Pharmaceutical Development and head of the Intellectual Property Department of the Applicant company.
10. Opposition Hearing was held on the 11th October, 2006. Ms. Sanya Young and Ms. Andrea Scarlett, Attorneys-at-Law of the Firm Myers, Fletcher and Gordon, appeared for the Applicant and Ms. Kathryn Cousins, Attorney-at-Law of the Firm Livingston, Alexander & Levy, appeared for the Opponent.
11. At the hearing Counsel for the Opponent indicated that the Opponent would not be pursuing the opposition under Section 9 (3) (b) of the Act.
12. This Opposition is brought in respect of Section 13 (2) (b) of the Act which states as follows:

13 (2)

A trade mark shall not be registered if-

(b) it is similar to an earlier trade mark and the goods or services in relation to which application for registration is made are identical with or similar to those for which the earlier trade mark is protected;

and there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark.

13. The term “earlier trade mark:” is defined in Section 14 of the Act as follows:

14(1) In this Act an “earlier trade mark” means-

- (a) a registered trade mark; 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 entitled to protection under the Paris Convention as a well known trade mark; or
- (c) 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 (b), subject to it being so registered.

14. The trade mark on which the Opponent seeks to rely is, BARALGIN registration number 10 137 is an earlier trade mark as defined in Section 14.

15. Although several other cases were referred to by the parties I found the following cases the most helpful in providing guidance in this matter:

16. *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R.1 and in *Lloyd Schuhfabrik Meyer & Co. GmbH v. Adidas AG* (2000) E.T.M.R. 723.

17. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 8, paragraph 22;

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 8, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 8, paragraph;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 8, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 9, paragraph 26;
- (h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section;

Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc page 9,
paragraph 29.

18. The two trade marks to be considered are:

Opponent's Trade Mark

BARALGIN

Class5

Pharmaceutical, veterinary
and hygienic preparations and
substances.

Applicant's Trade Mark

PARLAZIN

Class 5

Pharmaceutical preparations
for human use.

19. Let me first consider whether the goods herein are similar or identical. The goods or the application have not been limited in any way. The comparison that has to be made is between the goods as applied for and the goods as registered. Thus evidence as to how the Applicant intends to use the proposed mark cannot and ought not to be taken into account.
20. The goods of the application which are under attack are: *pharmaceutical preparations for human use*. The goods of the earlier registration are: *pharmaceutical, veterinary and hygienic preparations and substances*.
21. The Applicant denies in its Counterstatement that the respective goods are neither identical nor similar. I do not agree with this position. I find that whilst the goods or the respective trade marks are not identical they are in fact similar.
22. The goods cannot be considered identical because the specification relating to veterinary preparations would not be included in goods specified as pharmaceutical preparations for human use. However, it is my view that the goods are similar as pharmaceutical preparations for human use must encompass pharmaceutical and hygienic preparations and substances.

23. I therefore find that goods of the respective trade marks are similar.
24. The Opponent's Counsel in her submissions at the hearing urged the tribunal to treat marks relating to pharmaceutical goods with special care
25. To that submission I would cite the following statement in the case of *Glaxo Group Plc v Allergan Inc* (BL O/414/01 and BL O 293/02):

“It seems to me that the role of the Registrar is to apply the Trade Marks Act 1994 and its subordinate legislation to the proceedings brought before her. Other provisions and authorities exist for the licensing of pharmaceuticals and in my view, it is not the role of the Trade Marks Registry to stray into these areas. Under the provisions of the Act and acting on behalf of the Registrar I must consider whether there exists a likelihood of confusion if the applicants' and opponents' trade marks are used in respect of the goods for which they are respectively applied for and registered. I must find a likelihood of confusion not merely a possibility of confusion”

26. I therefore place no special importance on whether a higher or lower threshold needs to be reached before confusion can be established in conflicts between pharmaceutical trade marks.
27. That being said I do accept that the as it relates to pharmaceutical products that one may need to consider:
- (1) whether the goods maybe available over the counter or by prescription;
 - (2) That the average consumer may be medical professionals and/or the public at large;
 - (3) That where the good will be available by prescription that some of those prescriptions may be handwritten;
 - (4) That the public may be purchasing goods in the environment of a busy chemists shop; and

- (5) That the average person is unlikely to be so careless in health issues that he or she will act in other than a reasonably circumspect and observant fashion.
28. It should be noted no evidence was filed as to whether two marks are available as over the counter or prescription..
29. Notwithstanding I think it is fair to say that visual appreciation of a pharmaceutical mark is of great importance. This is so since generally pharmacists will be working from (type or handwritten) prescription. In over the counter medication these will often be selected by the consumer from the displays of the goods in the pharmacy, supermarket or other places of purchase. Oral usage should not be discontinued as they are instances where doctors will telephone prescriptions to pharmacists.
30. I now turn to the actual comparison of the marks.
31. Each trade mark is of three syllables. Although the first syllables of each mark -PAR" and "BAR" are not identical visually I am of the view that they are phonetically similar. As well I am of the view that the last syllable of each mark - "ZIN" and "GIN" are also phonetically similar. It is of course likely that in oral use that the final syllable will be less clearly pronounced than the first two syllables. I therefore consider that the marks do share a good deal of phonetic similarity.
32. The marks are invented words. Despite this the Applicant has argued that its mark PARLAZIN has a conceptual meaning which it has set out at Paragraph 7 of its filed Counter-Statement whereby it states that the first part of the mark - PARLA - is derived from the Hungarian word "PARLAGFU" the name of the plant causing certain allergies that the Applicant's product, an anti-allergic, seeks to treat. The second part of the mark it argues is derived from the active ingredient "CETIRIZINE".

33. I agree however, with the submissions of the Opponent that it is very unlikely that the conceptual meaning that the Applicant ascribes to its mark will be readily recognizable and appreciated by the Jamaican consumer who is not familiar with Hungarian or the plant cited so as to make the Applicant mark conceptually distinctive. I therefore find that the words "BARALGIN" and "PARLAZIN" have no significance for the Jamaican consumer.
34. Visually the trade marks obviously share various letters. It is important to bear in mind that the public rarely has the opportunity to compare trade marks directly and since in this case there are no conceptual aids which the public can use to distinguish the marks there is more likelihood for imperfect recollection to be brought into play. I think there is some visual similarity between the marks because of the common presence of the letters "a" and "r".
35. I therefore am of the view that the Applicant's mark is similar to that of the Opponent's mark.
36. All that is therefore left is to determine whether there is a likelihood of confusion.
37. The relevant consumer for the goods in question can be anyone. I do agree with the Applicant's submission that customers will take some care and are in fact expected to, when dealing with pharmaceutical products whether they be for allergies or are analgesics. However, in this case the customer would be faced with identical goods, similar trade marks which have no conceptual association to aid memory and an earlier trade mark that is distinctive.
38. Taking all those factors into account I consider that there is a likelihood of confusion in respect of the Applicant's trade mark.

39. In their submission Counsel for the Applicant brought my attention to an extract taken from the treatise "TRADE MARK LAW: A PRACTICAL ANATOMY" by Jeremy Philips. The extract pro-offered the position that "Evidence of co-existence without actual confusion is good evidence that there is no likelihood of confusion". They then stated that since the marks BARALGIN and PARLZALIN were co-existing on the trade mark Register of twenty-six (26) and since the Applicant had not provided any evidence of confusion in those twenty-six countries it therefore means that there is no likelihood of confusion.
40. I cannot accept this argument as it is difficult to conflate a trade mark application with use in the market place. There are several factors that have to be considered:
- (i) Has the trade mark been used with other indicia?
 - (ii) Has it been used for the full range of goods in the specification?
 - (iii) Has it been sold through the same retail channel?
41. I refer to and rely on the case of Compass Publishing BV v Compass Logistics Limited [2004] RPC 41 in which Laddie J held:

"It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of

the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

42. I also adopt the dicta of Millet LJ in the case of *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 where he said:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

43. Thus the Applicant's assertion that the evidence of likelihood of confusion must be present by the Opponent to the tribunal is rejected.
44. In the circumstances the Opposition is upheld.
45. There is no Order as to costs.

Edward G. Brightly

Acting Registrar of Industrial Property