

Success at last

Pharma Trade Mark Update

Pharmaceutical brand owners have enjoyed limited success in opposition proceedings before the Registrar since the introduction of the Trade Marks Act 1995 on 1 January 1996. However, two recent decisions give some scope for optimism.

VALIUM

In November 2007, Roche Products Limited (Roche) successfully opposed registration of an application by Hylebut Pty Ltd (Hylebut) to register a composite trade mark containing the word Valium with an image of a person in a sitting position in respect of "clothing, hats" in Class 25.



Roche prevailed on the Section 60 ground, namely that because of the reputation of its VALIUM pharmaceutical brand, use of Hylebut's mark would be likely to deceive or cause confusion.

The Registrar's delegate found the respective trade marks were deceptively similar and acknowledged the considerable reputation enjoyed by Roche arising from its use of the VALIUM trade mark for pharmaceuticals for the treatment of anxiety and tension since 1963. However, evidence from an advertising and marketing expert, directed to brand extension, was disregarded.

Hylebut contended that its trade mark was merely a parody of Roche's VALIUM mark. The delegate gave this argument due consideration, but took the view that a

sizeable proportion of the purchasing public would be caused to wonder whether or not Roche is the source of clothing and hats. The delegate indicated that, in most cases, this would be brought about by a failure to recognise the parody in the situation. This is primarily because the word part of Hylebut's mark was identical to Roche's VALIUM mark. The delegate considered that the differences in the respective goods would not prevent an unacceptable level of confusion. Clothing items are notorious for their use as a medium to give greater exposure to well known trade marks and hats are sold in pharmacies.

RETROVIR

In February 2008, Glaxo Wellcome Australia Ltd (Glaxo) successfully opposed registration of applications by Bukwang Pharm Co., Ltd to register the trade marks Rebovir and Revovir for "antiviral agents; preparations for treating hepatitis; therapeutic preparations for hepatic disease" in Class 5.

The oppositions were based on Glaxo's RETROVIR trade mark registration and use of this mark for pharmaceuticals for use in the treatment of HIV. Glaxo prevailed on the Section 44 ground, namely that the Rebovir and Revovir trade marks were deceptively similar to the registered RETROVIR mark and covered the same or similar goods.

Significantly, the Registrar's delegate was quite critical of evidence from the Registrar of the Pharmacy Board of Victoria directed to the possibility of medical misadventure through the mistake of one prescription for another. This type of evidence had been criticised in earlier cases as involving general health policy considerations into the comparison of trade marks, rather than providing concrete evidence about the marketplace in which the pharmaceuticals are sold.

The marketplace for prescription pharmaceuticals is tightly regulated and involves the intervention of trained and educated healthcare professionals.



Nonetheless, the delegate still took the view that the respective trade marks were deceptively similar. The trade marks in issue were relatively short and invented words, of similar length and construction, have the same number of syllables and also have similar beginnings and endings. The delegate observed that people tend to recognise words from the pattern or outline that they form. The prospect of the respective trade marks being mistakenly recognised for each other was relatively high and there was an associative force between them. The delegate observed that healthcare professionals are human and the weight given to their professional training should not be undue.



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