IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS

TRADE MARKS ACT 194 OF 1993

Application no. 2006/12167

In the matter between:

CIPLA MEDPRO (PROPRIETARY) LIMITED Applicant

and

NYCOMED AUSTRIA GmbH Opponent

JUDGMENT

The Applicant is Cipla Medpro (Pty) Ltd, a South African company. The Applicant has applied for the registration of the trade mark FEXO DEVICE under trade mark application no. 2006/12167 in respect of the following goods in class 5: *"pharmaceutical and veterinary preparations, sanitary preparations for medical purposes, dietectic substances adapted for medical use, food for babies, plasters, material for dressing, material for stopping teeth, dental wax, disinfectants, preparations for destroying vermin, fungicides, herbicides".*

The Opponent is Nycomed Austria GmbH, an Australian company. The

Opponent relies on its trade mark registration for the mark XEFO under trade mark registration no. 1998/05349 in class 5 in respect of the following goods: *"Pharmaceutical preparations and substances, analgesic and/or anti-inflamatory agents for medical use".*

The opposition is directed at the same goods to which the Opponent's trade mark registration for the mark XEFO relates, all the goods in question have been listed above.

The Opponent opposes the registration of the subject trade mark application in terms of the provision of section 10(14) of Trade Marks Act 194 of 1993 ("the Act"). The section relied on provides as follows:

10. Unregistrable trade marks:- *The following trade marks shall not be registered as trade marks or, if registered, shall, subject to the provisions of section 3 and 70, be liable to be removed from the removed from the register:*

(14) subject to the provisions of section 14, a mark which is identical to a registered mark belonging to a different proprietor or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in

respect of which such trade mark is registered, would be likely to deceive or cause confusion, unless the proprietor of such mark consents to the registration of such mark.

The Applicant's contention is that there is no likelihood of confusion or deception between the use of the mark FEXO DEVICE, in view of the existence of the trade mark XEFO, which has been registered in relation to the same goods as those in respect of which the Applicant is seeking registration.

It is trite that the onus rests upon the Applicant for registration to satisfy the Registrar that there is no reasonable probability of confusion or deception, and that his trade mark otherwise qualifies for registration. If the Applicant does not satisfy the Registrar on a balance of probabilities on the issue of the likelihood of confusion or deception, it is the Registrar's duty to refuse registration (**Webster & Page par 8.41**)

Counsel for the Opponent contends that the effect of this onus is that, should the Applicant not be able to tip the scales of probabilities in its favour, or if the Registrar is of the view that the probabilities are equal, the subject trade mark must be refused. The Applicant has the onus of proving that the trade mark qualifies for registration. If there is any doubt whether the mark should be registered, the application should be refused.

What the Applicant has to establish is that there is no reasonable probability i.e. no likelihood of consumer deception or confusion (**The Upjohn Company v Merc and Another 1987 (3) SA 221 (T) at 224, Smithkline Beecham Consumer Brands (Pty) Ltd v Unilever plc 1995 (2) SA 903 (A) at 909-10**).

What has to be determined is whether there is a likelihood of confusion or deception between the use of the trade mark FEXO DEVICE, in view of the existence of the trade mark XEFO, which has been registered in relation to the same goods *(pharmaceutical preparations)* in respect of which the Applicant seeks registration.

Since the objection is based on section 10(14), the essence of the enquiry is whether the mark sought to be registered is identical or similar thereto, to the extent that the use of that trade mark in relation to the goods for which it sought to be registered, is likely to deceive or cause confusion.

The possibility of confusion or deception amongst purchasers or potential purchasers of the relevant goods or users of the relevant service must be determined. The purchaser or user, is the ordinary person, one who is neither very careful nor very careless and ignorant (**Searles Industries (Pty) Ltd v International Beer Marketing (Pty) Ltd 1984 (4) SA 123 (T) at 127 A-B**).

In **Reckitt & Colman SA (Pty) v SC Johnson & Son SA (Pty) Ltd 1993 (2) SA 307A at 315 – 316I** Harm AJA said the following:

> *"The problem in this case is, however, that it is not possible to classify the consumers of these products because they are purchased by members of all sectors of the population irrespective of race, or level of literacy or sophistication. The notional consumer is therefore as elusive as a reasonable man and it is unlikely that he will be found on any suburban bus. The fact of the matter remains that at least some members of the purchasing public are illiterate that fact cannot be ignored. But, as was pointed out by counsel for the respondent, the fact that a person is illiterate does not mean that he lacks cognitive powers. It may that a typical illiterate purchaser is a more careful purchaser because he has adapted to his disability and cannot afford to err.*

In **Pianotist Co. Ltd's (1906) 23 RPC 774, 777 line 26** the following rules were laid down as applicable to the comparison of two words:

> *"You must take the two words. You must judge them both by their look and their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must*

consider all the surrounding circumstances, and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

Regarding the comparison of the two marks Miss Joubert on behalf of the Opponent submitted that, both marks have the same number of letters and identical alphabet letters. She argued further that the Applicant has merely switched round the letters X and F as they appear in the Opponent's mark. I find this submission to be purely academic. In **Cowbell AG v ICS Holdings Ltd 2001 (3) SA 941 (SCA) at 947-948** the Court explained that the decision involves a value judgment and that the ultimate test is whether, on a comparison of the two marks, it can properly be said that there is a reasonable likelihood of confusion if both marks are to be used together in a normal and fair manner, in the ordinary course of business.

Mr Searle argued on behalf of the Applicant that there is no likelihood of confusion or deception between the two marks when one considers the sense, sound and appearance of the two marks. He further submitted that the two marks, if used concurrently, would not confuse nor deceive the ordinary consumer. The likelihood of confusion or deception must *"be appreciated globally."* Our have adopted the approach of the European

Court of Justice in **Sabel BVV Puma AG, Rudolf Dassler Sport** where it was stated that the global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant component(**Webster & Page at par 7.3**).

In **National Brand Ltd v Blue Lion Manufacturing (Pty) Ltd 2001 (3) SA 563 (SCA)** the two competing marks were ROMANY CREAMS and ROMANTIC DREAMS. The issue was whether the respondent's use of the mark ROMANTIC DREAMS infringed the trade mark ROMANY CREAMS. The dispute was confined to whether the respondent's mark so nearly resemble the registered trade mark as to be likely to cause confusion. It was held that there was no infringement as regards the visual similarity of the two marks.

Nugent AJA stated the following:

> *"It is important to bear in mind, particularly in a case like the present one that the likelihood or otherwise of deception or confusion must be attributable to the resemblance of the marks themselves and not extraneous matter. Similarities in the goods themselves or in the form in which they are presented might form the basis of action for passing of, but that is not before us, and as for present purposes they must be disregarded.*

In my view, the marks are not likely to deceive or confuse by their sound. As for the sense of the two phrases, in my view they bear no resemblance at all. It was upon their visual appearance, however, that counsel for the appellant placed the greatest store, pointing out that the first and last five letters of both marks were not identical. When those letters are highlighted, as they were in the heads of argument, the resemblance might seem impressive, but it must be born in mind that the appellant is not likely in fair and normal use to highlight those letters at the expense of the remainder, and nor is there any suggestion that the respondent has used or will its mark in that way. On the contrary, they are likely to be seen in the form in which the words are ordinarily written, and should be visually compared in that form.

A word mark, particularly one that makes use of language, is not merely a combination of abstract symbols, but is usually recognisable as a whole. In that respect, in my view, its visual appearance cannot be separated altogether from its sense. Where the sense of one word mark differs markedly from that of another, in particular where the registered mark is well-known, it seems to me that the scope for deception or confusion is reduced, though these are always matters of degree. In my view the visual distinction in the

words that are in issue in this case, bearing in mind too that each immediately conjures up a different picture, are such that there is not likely to be deception or confusion."

In this matter we cannot in view of the analysis above safely say FEXO DEVICE and XEFO are visually similar. It is incorrect to say the two marks are visually similar merely because they have the same number of letters of the same alphabetical letters. I consider the two marks visually different. It should further be noted that the Applicant's mark incorporates a device which defeats the argument that the marks have identical letters. Mr Searle on behalf of the Applicant is quite right that ordinary words with the same number of letters in different sequence are common. He gave a good example of the following sample: BORE and ROBE, TAKE and KATE, MADE and DAME, TARE and RATE and also MATE and TAME.

Regarding the sound of the two marks it is clear they differ completely and are pronounced differently. Even conceptually it cannot be safely said that they are the same. The criteria of likelihood of confusion which includes the likelihood of association with the earlier mark, means that the mere association, which the public might make between the two trade marks as a result of their analogous semantic content, is not itself sufficient ground for concluding that there is a likelihood of confusion

within the meaning of that provision (**Sabel BV supra**).

The Applicant's application to strike out paragraph 18 of the affidavit of Mr Simons does not warrant detailed consideration. The paragraph states that: *"The typical consumer of products over the counter will not, in a normal retail outlet, note that the prefix "FEX" in the Applicant's trade mark, if read back to the front would read as XEF, being a prefix of the Opponent's trade mark. Instead, the consumer will note that the mark create the same visual impression impact and will be confused".*

It is quite obvious that when consumers read they always read from the beginning and not from the end backward.

It has been held in a number of decisions that it should be remembered that the likelihood of confusion or deception is a matter for the Court and that the judgment of the Court must not be surrendered to any witness.

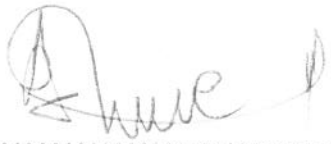
Having considered all the documents and all the arguments submitted to me in relation to this opposition, the following judgment is made:

(i) the application to strike out is dismissed with costs

(ii) the opposition is dismissed with costs

(iii) trade mark application no. 2006/12167 FEXO DEVICE to proceed to registration.

(iv) The Opponent shall pay the Applicant's costs.



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DEPUTY REGISTRAR OF TRADE MARKS

07 SEPTEMBER 2009