

IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS

TRADE MARKS ACT, ACT 194 OF 1993

Trade Mark Application No. 2005/12493 RANTRAL in class 5

RANBAXY LABORATORIES LIMITED

Applicant

And

SANOFI-AVENTIS

Opponent

JUDGMENT

The Applicant for registration is Ranbaxy Laboratories Limited, an Indian company of 19 Nehru Place, New Delhi 110 019, India. The Applicant develops and distributes generic pharmaceuticals and medicinal products. The Applicant has applied to register trade mark no. 2005/12493 RANTRAL in class 5 in respect of:

“Pharmaceutical and medicinal preparations for human and veterinary use.”

The Opponent is SANOFI-AVENTIS, a French company, at 174 de France, 75013, Paris, France. The Opponent is the registered proprietor of trade mark registration number 1985/08517 XATRAL registered in class 5 in respect of:

“Pharmaceutical products.”

The Opponent’s grounds of opposition were based on the provisions of Sections 10(12) and 10(14) of the Trade Marks Act, Act 194 of 1993 (“the Act”).

Section 10(12) of the Act provides that a mark shall not be registered if is:

“a mark which is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be contra bonos mores, or be likely to give offence to any class of persons”

Section 10(14) of the Act provides that a mark shall not be registered which is:

“identical to a registered trade 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 the trade mark consents to the registration of such mark.”

A. Notice of Application to strike out

The Applicant lodged a notice of application to strike out paragraph 3(g) of the founding affidavit of Sophie Bodet together with annexures “C”, “D” and “E”, on the grounds that the deponent Bodet was not qualified to express the opinions that she did in the said

paragraph and that the articles referred to in annexure “C”, “D” and “E” were inadmissible text book material, which did not constitute evidence.

In paragraph 6 on page 3 of his heads of argument, Counsel for the Applicant stated that Ms Bodet was not a person entitled to give expert evidence in this matter and it was submitted that she had not qualified herself to do so. The deponent had not taken the Tribunal into its confidence as to her education qualifications. She had not qualified herself in the pharmaceutical field nor had she qualified herself as a pharmacist or pharmacology field. No particulars whatsoever of her work experience was given nor had she given any particulars of her so-called acquaintance with the pharmaceutical industry. The deponent had provided no facts to support an assertion that she was an expert in *“all aspects of the pharmaceutical industry worldwide and in South Africa”*.

It was submitted that the witness failed the trite and elementary requirement to show that she acquired by study or experience, sufficient knowledge of the subject to render her opinion of value in resolving the issues before the Tribunal.

Annexures “C”, “D” and “E” which constituted website extracts in which facts or opinions were sought to be advanced were, as argued by Applicant’s Counsel, also not admissible. They were liable to be struck out. It was submitted that the Opponent’s attempt to introduce those articles or extracts failed at the first hurdle. Counsel for the Applicant cited **Menday v Protea Assurance Co. Ltd 1976 (1) SA 565 E at 569**, where the Court stated:

“However eminent an expert may be in a general field, he does not constitute an expert in a particular sphere unless by special study or experience he is qualified to express an opinion on that topic. The dangers of the holding otherwise – of being overawed by a recycle of degrees and diplomas are obvious, the court then has no way of being satisfied that it is not being blinded by pure theory untested by knowledge or practice. The expert must either himself have knowledge or experience in the special field on which he testifies or he must rely on the knowledge or experience of others.

Where, therefore, an expert relies on passages in a text book, it must be shown, firstly, that he can, by reason of his own training affirm the correctness of the statement in that book, and secondly, that the work to which he refers is reliable in the sense that it has been written by a person of established repute or proved experience in that field. In other words, an expert with purely theoretical knowledge cannot in my view support his opinion in a special field (of which he has no personal experience or knowledge) by referring to passages in a work which has itself not been shown to be authoritative.”

Text books, and thus articles in the nature of annexures “C”, “D” and “E” were not evidence *per se*, submitted Counsel for the Applicant.

The Opponent’s Counsel only addressed me on the application to strike out at the hearing of this matter, as she did not deal with it in her heads of arguments. She

submitted that in order to achieve the striking out there must be prejudice. Reference was made to Rule 6(15) in that in terms of the rule two requirements should be satisfied before an application to strike any matter from any affidavit could succeed. Firstly, the matter sought to be struck out must indeed be scandalous, vexatious or irrelevant, and secondly, the court must be satisfied that if such a matter was not struck out the parties seeking such relief would be prejudiced.

Counsel for the Opponent submitted that nothing was placed before the Tribunal that the Applicant would be prejudiced, and on this basis alone the application to strike out should fail. She argued that Mrs Bodet was not presenting any expert opinion, she was giving her own opinion.

Regarding the extracts from the internet the Opponent's Counsel submitted at the hearing that the fact that Mrs Bodet found those articles on the internet and that they referred to doctors bad handwriting, was not hearsay. She did not say they were correct or that the findings were correct. She made those statements with reference to the fact that prescriptions were made by way of handwriting. Handwriting could be bad and that might lead to deception or confusion. She did not need to be an expert as those articles were submitted for purpose of showing that doctors bad hand writing could lead to deception or confusion and that was the extent to which it was there. Therefore it did not constitute hearsay evidence, she found it was there and it should not be struck out.

It was on this basis that the Opponent's Counsel submitted that the application to strike out should be dismissed with costs. In summary, she said there was no prejudice, no allegation of prejudice, it was not expert evidence nor hearsay evidence.

The three annexures interestingly referred to conditions that prevailed in foreign jurisdictions such as Greece, Australia and Florida. Nothing was placed before the Tribunal to corroborate their contents nor was reference made to a single incident in South Africa where confusion existed or a wrong drug was prescribed due to doctor's bad handwriting.

In view of the above, the application to strike out was granted.

B. MAIN OPPOSITION MATTER

The Opponent based its opposition on the existence of its registered trade mark XATRAL. The Opponent's contention was that the subject trade mark was confusingly and deceptively similar to XATRAL, both visually and phonetically.

It was common cause that the Opponent opposed the subject trade mark application on the grounds of sections 10(12) and 10(14).

In her heads of argument, Counsel for the Opponent submitted that the Opponent had made extensive use of the trade mark XATRAL in South Africa. The use was in relation

to pharmaceutical products and had acquired a substantial goodwill and reputation in the trade mark.

The onus rests upon the Applicant to satisfy the Tribunal that there was no reasonable probability of confusion or deception, and that its trade mark otherwise qualified for registration. If the Applicant was not able to discharge this onus, the subject trade mark application should be refused (***Webster & Page South African Law of Trade Marks para 8.41***).

On behalf of the Opponent it was submitted that the effect of the onus was that, should the Applicant not be able to tip the scales of probabilities in its favour, or if the Registrar was of the view that the probabilities were equal, the subject trade mark should be refused. Cited in support of this submission was the case ***Accurate Watch Co v Accurist Watches Ltd 2004 BIP 115 (RTM) at 117 B-C:***

“The Applicant has the onus of proving that a trade mark qualifies for registration. If there is any doubt whether the mark should be registered, the application should be refused

It was common cause that one of the issues to be decided by the Tribunal was whether there was a likelihood of confusion between the use of the trade mark RANTRAL, in view of the existence of the trade mark XANTRAL, which had been registered in relation to the same goods as those in respect of which the Applicant sought registration.

The Opponents, in their heads of arguments, addressed the Tribunal more on the section 10(14) ground of opposition. The enquiry under Section 10(14) was, in essence, whether the mark sought to be registered was identical or similar to a registered trade mark belonging to a different proprietor, or so similar thereto, that the use of the trade mark in relation to the goods or services for which it was sought to be registered, was likely to deceive or cause confusion.

It was further submitted on behalf of the Opponent that the Section 10(14) ground of opposition required an almost clinical comparison on two legs. The first was a comparison of the Opponent's and Applicant's marks, and secondly, a comparison of the goods of the respective marks as they appeared on the register. It was not necessary to consider how and if the goods were used in the market place. The goods in respect of which the Applicant sought to register its trade mark RANTRAL were said to wholly include those goods in respect of which the Opponent's trade mark was registered.

In **Khan's Chemical Industry CC v Unilever plc 2004 BIP 107 (RTM) at 109C – F** it was held that:

“The dispute between the parties is whether the applicant's mark is so similar to the opponent's mark, that the use thereof in relation to the goods in respect of which it is sought to be registered and which are the same as or similar to the goods in respect of which such trade mark is registered, would be likely to deceive or cause confusion.

The wording of the section does not require any party to prove extensive use. The manner or extent of use of marks by the respective parties would only be relevant should it have a bearing on a finding as to whether or not there, is likelihood of deception or confusion as to the origin of the goods. In one case it may carry much weight but may be wholly irrelevant, or of very slight significance in another. The premise is that each party uses its mark in a normal and fair manner. Whether or not contesting marks could likely deceive or cause confusion is a matter of fact to be decided on the facts of each particular case. It is common cause that the applicant bears the onus of proof to satisfy this tribunal that there is no reasonable probability of deception or confusion and that the mark is therefore registrable”.

It was further held that:

“The approach to be adopted to an enquiry of this nature is formulated as follows in Plascon-Evans Paints v Van Riebeeck Paints (Pty) Ltd 1984 (3) SA 623 (A) at 640-641:

‘The determination of these questions involves essentially a comparison between the mark used by the defendant and the registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the defendant’s mark would make upon the average type of consumer who would likely purchase the kind of goods to which the marks applied. This notional user must be conceived of as a person of average intelligence, having proper eyesight and buying with caution. The comparison must be made with reference to the sense,

sound and appearance of the marks. The marks must be viewed as they would be encountered in the market place and against the background of relevant surrounding circumstances. The marks must not only be considered side by side, but also separately. It must be borne in mind that the ordinary purchaser may encounter goods, bearing the defendant's mark, with an imperfect recollection of the registered mark and due allowance must be made for this. If each of the marks contains the main or dominant feature or idea the likely impact made by this on the mind of the customer must be taken into account. As it has been put, marks are remembered rather by general impressions or by some significant or striking features than by photographic recollection of the whole. And finally consideration must be given to the manner in which the marks are likely to be employed as, for example, the use of name marks in conjunction with generic description of the goods'."

In paragraph 10.9 of the Opponent's heads of argument it was stated that the test for opposition under this section could be equated to the test for opposition in terms of section 17(1) of the 1963 Act. In this regard the Opponent cited **Cowbell Holdings AG v ICS Holdings Limited 2001 (3) SA 941 SCA at 947H-948D** where the test was set out as follows:

" Section 17(1) creates an absolute bar to registration provided the jurisdictional fact is present, namely that the use of both marks in relation to goods or services in respect of which they are sought to be registered, and registered, would be likely to deceive or cause confusion. The decision involves a value judgement and the

ultimate test is, after all, as I have indicated, 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”.

On the comparison of marks, it was submitted on behalf of the Opponent, that the possibility of confusion or deception amongst purchasers of the relevant goods, or users of relevant service must be determined. The purchaser, or user, was the ordinary person, one who was neither very careful nor very careless and ignorant **(Searles Industries (Pty) Ltd v International Power Marketing (Pty) Ltd 1984 (4) SA 123 (T) at 127 A-B).**

Both parties in the matter referred to **Pianotist Co Ltd’s APPN (1906) 23 RPC 774-779** stating the following rules 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 take the goods to which they are to be applied. You must consider the nature and kind of customer who would like 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.”

In comparing the marks visually, the Opponent Counsel submitted that both marks mainly consisted of the mark “TRAL”. The only difference between the marks was the

first syllables, being “XA” and “RAN”. Both the syllables contained a short, sharp “A” sound. The first syllables of each mark were, according to the Opponent, confusingly similar in themselves and did not serve to distinguish the two marks from each other.

In my opinion I really found this submission to be stretching as what had to be compared were the marks as a whole and not syllables within the marks. This purely amounted to an artificial dissection of the marks, which could not be allowed. This is supported by the fact that even Opponent’s Counsel contradicted herself as she stated in paragraph 12.3 on page 20 of her heads of argument that the comparison, for purposes of this opposition, remained between the Opponent’s trade mark XATRAL and the Applicant’s subject trade mark RANTRAL.

Regarding the presence of other marks starting with RAN I found it unnecessary to belabour the issue around this, as there was nothing indicating these marks would be regarded as a series. There was no indication that the marks were associated, as rightly submitted by the Opponent. The same approach would also apply to marks such as SYSTRAL, SPASNENTRAL, SECTRAL and SUBTRAL, which are sufficiently removed from the Opponent’s mark.

The Opponent argued that in view of the above submissions, the subject trade mark application remained confusingly similar to the Opponent’s mark XATRAL.

At the hearing Applicant’s Counsel submitted that the essence of the dispute was the marks RANTRAL and XATRAL. He further conceded that there was an overlap in the

respective goods, but it should also be borne in mind as a relevant fact that the Opponent's mark was registered for a specific pharmaceutical product in terms of the Medicines and Related Substances Control Act 101 of 1965. It was a product that may only be sold to the public by way of prescription. As such the Opponent could not make any other use of its registered XATRAL.

Counsel for the Applicant submitted that when the mark RANTRAL was considered it did not look similar to XATRAL to the extent that deception or confusion could arise, it was not pronounced similarly and there was no ideological similarity between the respective marks.

The first syllable of a word mark was generally the most important, having regard to the tendency of people to slur the endings of words (*Budweiser Budvar National Corporation v Anheuser Bush Corporation* 2002 BIP 126 (RTM) 129).

It was submitted that the Tribunal was required to postulate normal and fair use of the respective marks and have regard to the fact that the Opponent's pharmaceutical product could only be obtained on prescription. In this regard the Applicant cited a passage from *Triomed (Pty) Ltd v Beecham Group PLC and Others* 2001 (2) SA 522 (T) 550E-551F arguing that it was instructive and that the Registrar would take cognisance of the principles set forth therein, which were contrary to the case that the Opponent was seeking to make out. It was stated that:

"In my view it is of particular relevance in this case that the goods fall under the category of ethical pharmaceutical products, i.e. products obtained on prescription only. It is not the ultimate patient who decides what to purchase. The pharmaceutical is prescribed for him by a medical practitioner and dispensed by a pharmacist and administered by a nurse on the ward".

It was submitted that in view of the above principle, a patient who had been using XATRAL and intended to purchase this product, even with an imperfect recollection, could request RANTRAL. There was no way that a patient would wonder whether there was an association between XATRAL and RANTRAL, or whether RANTRAL emanated from the same source as XATRAL. The patient would not find RANTRAL as an over-the-counter medication for his condition.

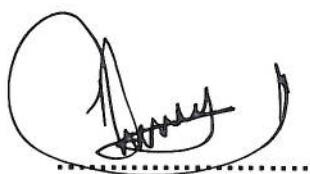
Regarding the languages I fully agreed with the Applicant's Counsel in his heads of argument that, it was irrelevant that South Africa had eleven official languages, particularly as the marks concerned had no ideological content.

I also agreed with the Applicant's submission that it was further irrelevant that the Opponent had no control over the Applicant's products bearing the mark RANTRAL. Surely the Opponent was not in the business of policing other people's product. It was submitted in conclusion that the two marks were not deceptively or confusingly similar.

Even though the Applicant conceded at the hearing that there was an overlap of the goods, I found that there was no reasonable degree of visual or aural similarity between the trade marks XANTRAL and RANTRAL. Even on a consideration of the doctrine imperfect recollection, the average consumer would in my opinion not mistake one mark for the other and be confused as to the origin of the goods sold under the respective marks.

I therefore, after having heard submissions by both parties, and having read all the papers filed of record, ordered as follows:

- (a) that trade mark application no. 2005/12493 RANTRAL in class 5 should proceed to registration; and
- (b) that the opposition was dismissed with costs, including the costs of senior Counsel.



Abey Tuwe (Mr)

Deputy Registrar: Trade Marks

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.....March 2012