

**IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS  
TRADE MARKS ACT 194 OF 1993**

In the matter between:

**TORRENT PHARMACEUTICAL LTD**

Applicant

And

**THE WELLCOME FOUNDATION LTD**

Opponent

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**JUDGMENT**

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The Applicant for registration is Torrent Pharmaceuticals Ltd (hereinafter referred to as “the Applicant”). The Applicant had applied for the trade mark number 2005/03550 **LAMITOR** in class 5 in respect of:

*“Pharmaceutical substances and preparations for human use”.*

The Opponent is The Wellcome Foundation Ltd (hereinafter referred to as “the Opponent”), a wholly owned subsidiary of the multinational corporation,

GlaxoSmithkline, one of the largest research-based pharmaceutical companies. The Opponent is the registered proprietor of trade mark number 1987/05474 **LAMICTIN** in class 5 in respect of:

*“Pharmaceutical and medicinal preparations and substances”.*

At the hearing of this matter Counsel for the Opponent made an application for substitution of the Opponent to Glaxo Group Limited and Glaxo Group was introduced as the Opponent in respect of aspects of the opposition Application was further made that the matter would continue as if Glaxo Group (hereinafter referred to as “the Opponent”) had been a party to the proceedings from the commencement thereof. This application was not opposed, and it was therefore granted by the Tribunal.

The Opponent initially opposed the trade mark application of the Applicant in terms of Sections 10(12) and 10(14) of the Trade Marks Act, Act 193 of 1994 (“the Act”).

Counsel for the Opponent however stated in his heads of argument that he would limit his argument to the provisions of Section 10(14).

At the start of the hearing Counsel for the Applicant proposed a limitation to the specification of the application under opposition, to read as follows:

*“Pharmaceutical substances and preparations for the treatment of disorders of the central nervous system available on prescription”.*

Counsel for the Opponent did not object to the proposed amendment of the specification. He responded that we were now faced with the situation where the opposed application had been reduced to certain pharmaceuticals available only on prescription. He referred to the *Adcock Ingram Intellectual Property (Pty) Ltd and Adcock Healthcare (Pty) Ltd v Cipla Medpro (Pty) and the Registrar of Trade Marks (265/2011) ZACSA 39* judgment submitting that the Supreme Court of Appeal departed from the previous 1983 Adcock Ingram case, and that subsequent hereto the patient was now made part of the decision making process in respect of the choice of medication even on prescription.

It was his submission that from a practical point of view and as far as confusing similarity of the trade marks were concerned, the limitation of the LAMITOR trade mark, to the narrow specification of goods, did little to change the likelihood of deception or confusion in the market place. All it did according to Counsel for the Opponent was in fact strengthening the position of the Opponent. He further submitted that what the Applicant had now succeeded in doing by proposing to limit its specification of goods so narrowly, was to exclude those other trade marks which incorporated or commenced with the prefix "LAMI". It thereby defused the argument that "LAMI" as a prefix was common to the trade in relation to the goods applied for. He submitted that it certainly did not appear to be common to the trade in respect of the specification of goods of which the Applicant had now proposed to limit its goods to "*Pharmaceutical substances and preparations for treatment of disorders of the central nervous system available on prescription*".



Counsel for the Opponent submitted that what remained was the comparison of the marks LAMITOR and LAMICTIN, without reference to other marks upon which reliance was placed as a defence or justification for the opposition. He stated that the late move by the Applicant in an attempt to strengthen their prospects of obtaining registration for obvious reasons did exactly the opposite.

In referring to paragraph 7 and 8 of his heads of argument Counsel for the Opponent submitted that the onus to prove registration in this matter rested on the Applicant, and not on the Opponent. What the Applicant had to show was that it was entitled to registration. He further referred to the Applicant's heads of argument in paragraph 2.6, where it was stated that despite the LAMITOR and LAMICTIN trade marks having co-existed in the market place since 2005, thus for almost seven years, there was no evidence of any actual confusion produced by the Opponent.

The submission was attacked by the Opponent stating that it was not entirely true in that sense, as the Replying Affidavit was filed in February 2009, which was some three years ago. No one knew what had happened since the filing of the Replying Evidence since none of the papers were updated subsequent to the filing thereof. The Opponent further contended that it was known that proof of actual confusion was not a necessity. It was also known how difficult it was to in fact prove instances of actual confusion. People would not even know if they had been confused and would not know who to lodge a complaint with if they had been confused.

Counsel for the Opponent further addressed me on comments which were made in the Answering Affidavit, and also with specific reference to paragraph 4.2 of the Applicant's heads of argument, where it was said that both trade marks commenced with "LAM" and the common active ingredient in both was "LAMOTRIGINE". Counsel for the Opponent questioned why then did the Applicant not choose the trade mark to be L-A-M-O-T-O-R, if that was the commencement of the active ingredient. What the Applicant instead did was to choose the exact prefix of the innovative drug the one that had been a patent for twenty years and the one that was in use by the Opponent. He opined that the Applicant tried to get its mark as close as possible to that of the Opponent.

It was submitted on behalf of the Opponent that there was a general tendency of people to slur words, the earlier portion or prefixes of words generally being the most important and the most dominant and where people would place the emphasis. A patient having received LAMICTIN would be forgiven for thinking with some imperfect recollection that he was being prescribed LAMITOR, or for wondering if there was not perhaps some connection between the two products, or whether the one was not perhaps rather associated with the other. In closing, the submission was made that the Applicant had not discharged the onus of showing that it was entitled to registration and that the opposition should therefore be upheld with costs.

Counsel for the Applicant submitted in relation to the limitation of goods, that it had already been suggested to the Opponent's Attorneys on 11 July 2007, thus before the

proceedings were brought. She said the reason for the proposed limitation was due to the change of the applicable law, as was evident in the Adcock Ingram case (*supra*). It was submitted that the difference was now that the relevant test had changed.

Counsel for the Applicant stated that the medicines covered by both the Applicant's and the Opponent's marks and both classified as Schedule 3 medicines were anti-epileptic drugs. She stated that in this instance the consumer of the medication was a very specific one, namely a person suffering from epilepsy. In addition, Schedule 3 medication could only be obtained by way of medical prescription.

It was submitted on behalf of the Applicant that in terms of Section 22(f) of the Medicines and Related Substances Act, Act No. 101 of 1965, a doctor was obliged to explain to a patient that there were other alternatives as a substitution to prescribed medicines, in other words as a generic for the branded medicine. She stated in terms of this the pharmacist would explain to the patient which was the branded medicine that had been prescribed, but that there was the option of using the generic medication and because of that there could be no possible confusion as to the fact that one was the other. The patient would accordingly be informed that the Applicant's product was not the medicine which had been prescribed, but the generic alternative.

She submitted secondly, in terms of this Section that the pharmacist was obliged to prescribe the generic medication, unless the patient expressly refused it. It was argued that it was common cause that LAMITOR was a generic for LAMICTIN and that the



products had already co-existed for three years at the time the papers were filed, and at that point in time there was no evidence of actual confusion. Confusion was less likely to occur as the pharmacist had to explain to the patient that the generic product was a substitute for the product prescribed.

In as far as the actual marks themselves were concerned Counsel for the Applicant submitted that with reference to the prefix "LAM", there could be no dispute that as it was reference to the common substance Lamotrigine. It was further submitted it must be borne in mind that the consumer would be advised that this was a generic product and therefore there was less likelihood of confusion. A person with epilepsy would certainly be very careful about the medication that he or she took for the condition, and it would thus be an informed decision. Counsel for the Applicant submitted that, that was the reason for proposing the limitation to the specification otherwise one would have taken into account that the trade mark would have been used on any product which could be bought over the counter and this was not the case in this particular instance.

Regarding the comparison of the words, the Applicant submitted that they were not confusingly similar. LAMITOR and LAMICTIN sounded differently and this could not be said to be confusingly similar. It was further contended that they were also not conceptually similar as there was no picture or concept that would come into the consumers mind when reading the two marks.

Counsel for the Applicant submitted that it was very important that there shouldn't be a monopoly with regard to the letters "L-A-M" because of the fact that it did not describe the common ingredient. Counsel for the Applicant further submitted that other marks incorporating "LAMI" still played a significant role having regard to the specifications for which those marks were registered for they were very broad and were not limited to epileptic drugs. Even the Opponent's specification was said to be broad. The point the Applicant made was that the Opponent seemed to be of the opinion that it could claim exclusive rights to marks beginning with the word "LAMI".

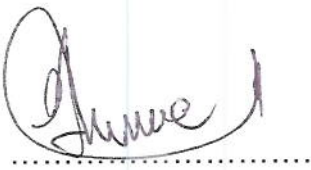
Counsel for the Opponent submitted in his closing remarks that the Applicant's Counsel did not understand the latest *Adcock Ingram* judgment (*supra*). He stated in addition that Section 22(f) of the Medicines and Related Substances Act, 101 of 1965 in fact increased the likelihood of deception or confusion, not decreased it. He conceded that it was true that the marks were not conceptually confusingly similar, but according the *Adcock Ingram* decision, when faced with invented words the scope of deception or confusion increased. The possibility of deception didn't decrease because there was no particular connotation to the words with which the public could associate it. He said this was for example why *ROMANTIC DREAMS* and *ROMANY CREAMS* were held not to be confusingly similar, because conceptually they were so different.

It was my finding after having read the papers filed of record and having listened to the parties submissions that, the two trade marks were not confusingly similar nor were they conceptually similar.



In view of the aforesaid it was ordered that:

1. The Opposition was dismissed;
2. Trade Mark Application No. 2005/03550 LAMITOR in class 5 in the name of Torrent Pharmaceutical Ltd should proceed to registration; and
3. Costs were awarded to the Applicant.



Abey Tuwe (Mr)

Deputy Registrar: Trade Marks

07 December 2012