TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 216722 and in the matter of an Opposition thereto.

McDERMOTT LABORATOTIES LIMITED,
t/a GERARD LABORATORIES Applicant

MAY & BAKER LIMITED Opponent

The application

1. On 2 March, 2000, McDermott Laboratories Limited, t/a Gerard Laboratories, an Irish company of Unit 35, Baldoyle Industrial Estate, Baldoyle, Dublin 13, made application (No. 2000/00717) to register the word ZIMOCLONE as a Trade Mark in Class 5 in respect pharmaceutical preparations and substances.

2. The application was accepted for registration and advertised accordingly under No. 216722 in Journal No. 1903 on 15 November, 2000.

3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 10 January, 2001 by May & Baker Limited, a British company of Dagenham, Essex RM10 7XS, England. The Applicant filed a counter-statement on 23 March, 2001 and evidence was, in due course, filed by the parties under Rules 20, 21, 22 and 23 of the Trade Marks Rules, 1996.

4. The Opposition became the subject of a Hearing before me, acting for the Controller, on 4 May, 2005. The parties were notified on 26 July, 2005 that I had decided to dismiss the opposition and to allow the application to proceed subject to the Applicant restricting the list of goods covered by it to prescription-only pharmaceuticals. I now state the grounds of my decision and the materials used in arriving thereat.

Notice of Opposition

5. In its Notice of Opposition the Opponent enumerates a number of facts and grounds of opposition, which may be summarised as follows:

(i) The Opponent is the proprietor of the trade mark ZIMOVANE, which it has used extensively in respect of pharmaceutical and veterinary preparations and substances and the Opponent has a substantial reputation in Ireland under that mark. The mark is registered under No. 115919.

(ii) The Applicant's mark ZIMOVANE is devoid of any distinctive character and registration would therefore offend against Section 8(1)(b) of the Act.

(iii) The Applicant's mark is of such a nature as to deceive the public and registration would therefore offend against Section 8(3)(b) of the Act.

(iv) Use of the Applicant's mark is prohibited in the State by an enactment or rule of law and registration would therefore offend against Section 8(4)(a) of the Act.

(v) The application for registration is made in bad faith and registration would therefore offend against Section 8(4)(b) of the Act.

(vi) The application offends against Sections 10(1) and 10(2) of the Act in that the mark ZIMOCLONE is similar to the Opponent's earlier mark ZIMOVANE and is to be registered for goods identical with or similar to the goods for which that mark is protected so that there exists a likelihood of confusion on the part of the public, including a likelihood of association with the earlier mark.

(vii) The application offends against Section 10(3) of the Act in that the use of the Applicant's mark would take unfair advantage of or be detrimental to the distinctive character or reputation of the Opponent's earlier mark.

(viii) Use of the Applicant's mark is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade or by virtue of an earlier right and registration would therefore offend against Sections 10(4)(a) and 10(4)(b) of the Act.

(ix) The Applicant's mark is not a trade mark within the definition set out in Section 6(1) of the Act.

(x) The Applicant has failed to meet the requirements of registration in that it does not use, and nor does it have a *bona fide* intention of using, the trade

mark propounded for registration and registration would therefore offend against Sections 37(2) and 42(2) of the Act.

Counter-Statement

6. In its Counter-Statement the Applicant denies each and every one of the grounds of opposition raised against the application except that it admits the Opponent's proprietorship of the trade mark ZIMOVANE.

The evidence

Rule 20

7. Evidence filed by the Opponent under Rule 20 consisted of a Declaration (and Exhibits Z1-Z3)) dated 16 October, 2001 of Christian Gelain, Director of the Group Trade Mark Department of Aventis Pharma S.A., which is in charge of the trade mark portfolios of the Aventis Group of companies of which the Opponent is a member. In his Declaration, Mr. Gelain repeats a number of the statements made in the Notice of Opposition and sets out some relevant facts, which I would summarise as follows:

   (i) The trade mark ZIMOVANE has been registered by the Opponent or a sister company in respect of goods in Class 5 in ten countries (*names provided*), including Ireland and the United Kingdom.
   (ii) The mark is in use in Ireland and turnover in products sold under it for the period 1996-2000 amounted to over €10 million. The International No-Proprietary Name (INN) of products sold under the trade mark ZIMOVANE is "zopiclone"
   (iii) Advertising expenditure for the period 1996-2000 amounted to approximately €670,000 (*sample of promotional brochure exhibited*).

Rule 21

8. Evidence filed by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits FC1-FC3) dated 22 August, 2002 of Frank Corr, who is described as "County Manager" of the Applicant company. He says that the Applicant has been selling a zopiclone formulation under the trade mark ZIMOCLONE "for some considerable time". He exhibits an information sheet on

the product in question and a price list dated April, 2002, which contains a listing for the product. He refers to the March, 2002 edition of MIMS (Monthly Index of Medical Specialities) IRELAND, which he calls Exhibit FC3[1], and to the fact that the Opponent's trade mark ZIMOVANE and the Applicant's ZIMOCLONE appear on the same page. He says that no incidents of confusion between the two have been reported to the Applicant and that the product sold under the mark ZIMOCLONE is the subject of a marketing authorisation granted to the Applicant by the Irish Medicines Board.

Rule 22

9. Evidence filed by the Opponent under Rule 22 consisted of a Declaration dated 24 April, 2003 of Joëlle Sanit-Hugot, Head of Pharmaceutical Trade Marks Group of Aventis Pharma S.A., the company referred to at paragraph 7 above. Much of this Declaration is taken up with criticism of the Applicant's evidence under Rule 21, which the deponent says does not establish any use by the Applicant of the trade mark ZIMOCLONE in the State. Ms. Sanit-Hugot says that Exhibit FC3 to Mr. Corr's Statutory Declaration should be treated as inadmissible as it has not been *"properly executed or notarised"*. She also says that the Opponent became aware of the mark ZIMOCLONE shortly before the advertisement of the present application and that the Irish Medicines Board does not consider other trade marks in the marketplace when granting marketing authorisations. Finally, she says that the Opponent has registered the only trade mark on the Irish Register incorporating the prefix "ZIMO" and claims, therefore, that it enjoys exclusive rights in that prefix in respect of pharmaceutical products.

Rule 23 – further evidence of Applicant

10. On 19 May, 2004, the Applicant sent to the Office a Statutory Declaration (and Exhibits RC1-RC3) dated 14 May, 2004 of Ros Carney, Commercial Director of the Applicant, which it sought leave to file under Rule 23. The Office granted leave to file evidence for the purpose of replying to matters of fact that had been called into question in the Opponent's evidence under Rule 22, namely whether the Applicant had used the trade mark ZIMOCLONE in Ireland and whether a

[1] The document in question was not attached to the Statutory Declaration as filed but a copy of the relevant page from it was subsequently sent to the Office and copied to the Opponent by the Applicant's Agents.

product authorisation had been granted by the Irish Medicines Board in respect of a product bearing that name. In relation to those matters, Ms. Carney in her Declaration says that the Applicant's product sold under the mark ZIMOCLONE has been on the market in Ireland since August, 2000 and she exhibits a copy of Product Authorisation No. PA 405/44/1 dated 28 April, 2000 granted by the Irish Medicines Board to a sister company of the Applicant.

The hearing

11. At the Hearing the Opponent was represented by Jacinta Heslin, BL instructed by Tomkins & Co., Trade Mark Agents and the Applicant by Paul Coughlan, BL instructed by Anne Ryan & Co., Trade Mark Agents. While stating that the Opponent did not concede any of the grounds of opposition raised against the application in the Notice of Opposition, Ms. Heslin confined her submissions at the hearing to the grounds of opposition under Sections 8(4)(b) [*bad faith in the making of the application*], 10(2)(b) [*similarity of marks, identity/similarity of goods and consequent likelihood of confusion*] and 10(4)(a) [*right to prevent use through action for passing off*]. Mr. Coughlan's rebuttal was, as a consequence, also confined to these matters.

12. Notwithstanding the fact that the Opponent did not formally abandon the other grounds of opposition, namely those under Sections 6(1), 8(1)(b), 8(3)(b), 8(4)(a), 10(1), 10(3), 10(4)(b), 37(2) and 42(2) of the Act, I am satisfied that there is no need for me to give them any serious consideration. Because those grounds have not been supported by relevant evidence or argument, a *prima facie* case has not been made out under any of the relevant Sections of the Act and there is no onus on the Applicant to respond. Nor do I consider it necessary for me to do more than to state that I dismiss the opposition under each of those Sections as unsubstantiated.

13. There remain, therefore, only the objections that were argued at the hearing, viz., those based on Sections 8(4)(b), 10(2) and 10(4)(a) of the Act and I look at each in turn below.

Preliminary matter – admissibility of part of the Applicant's evidence

14. As stated at paragraph 9 above, the Opponent's evidence under Rule 22 contained a request that an exhibit accompanying the Statutory Declaration of Frank Corr filed as the Applicant's evidence under Rule 21 be regarded as inadmissible. The exhibit in question was Exhibit FC3, which Mr. Corr states is a copy of the March, 2002 edition of MIMS IRELAND. In fact, that document was not exhibited with Mr. Corr's Declaration and photocopies of the cover and the relevant page from it were subsequently sent to the Office by the Applicant's Agents. Those photocopies were not notarised in the way that the other exhibits to Mr. Corr's Declaration were, as exhibits of that nature normally are. At the hearing, Ms. Heslin confirmed the Opponent's objection to the admissibility of the photocopies for the reason stated in the Declaration of Joëlle Sanit-Hugot filed as Opponent's evidence under Rule 22. In reply, Mr. Coughlan stated that there was no provision in the Statutory Declarations Act, 1938 requiring exhibits filed with a Statutory Declaration to be notarised. He argued that the fact that the document in question was clearly identified in the Declaration and a copy of the relevant page was subsequently filed should be regarded as sufficient to warrant the admission of the relevant aspect of Mr. Corr's evidence.

15. The first observation that I would make as regards this matter is that the Opponent has challenged the admissibility of the exhibit in question but has not challenged the averment that the exhibit is intended to substantiate. The averment is to the effect that, in the March, 2002 edition of MIMS Ireland, the zopiclone formulation sold under the Opponent's trade mark ZIMOVANE and that sold under the Applicant's mark ZIMOCLONE appear on the same page. That is a simple statement of fact, which I think it is reasonable for me to accept as correct unless its veracity is called into question. The Opponent has not suggested that Mr. Corr's statement is false and its claim that the relevant exhibit should not be admitted into the proceedings because it is not notarised is, in my opinion, a form of technical objection that has no effective purpose. In any event, I agree with Mr. Coughlan's assertion that the fact that the exhibit is not notarised does not necessarily invalidate it. The document in question is clearly identified in Mr. Corr's Statutory Declaration and its omission from the exhibits accompanying the Declaration as executed and filed was obviously an oversight, which I think it

proper to overlook in exercise of the Controller's discretion as to whether or not to admit certain elements of evidence filed in proceedings before him. For these reasons, I have decided to accept as true the statement made by Mr. Corr as to the content of the March, 2002 edition of MIMS and to admit into the evidence Exhibit FC3 to Mr. Corr's Statutory Declaration, notwithstanding that it was filed subsequent to the filing of the Declaration and that it was not notarised.

The substantive matter

Section 8(4)(b) – was the application for registration made in bad faith?

16. Section 8(4)(b) of the Act provides that a trade mark shall not be registered "*if or to the extent that the application for registration is made in bad faith by the applicant*".

17. At the hearing, Ms. Heslin argued that the only reasonable inference to be drawn from the Applicant's adoption of the name ZIMOCLONE for a product that is substantially the same as the Opponent's ZIMOVANE is that the Applicant sought to create confusion by passing its product off as that of the Opponent, thereby benefiting from the efforts of the Opponent in promoting its product. She referred to the fact that a previous application by the Applicant for registration of the trade mark ZIMOGER had been withdrawn following opposition by the present Opponent based on its mark ZIMOVANE. The Applicant was, therefore, fully aware of the Opponent's earlier mark and the application to register a mark that is so similar to that mark must have been calculated to cause deception and should, therefore, be regarded as having been made in bad faith.

18. Mr. Coughlan responded to the effect that the charge of bad faith in the making of the application for registration was not made out. He argued that the adoption by an undertaking of a mark that is alleged to be similar to that of a competitor cannot, of itself, be construed as an act of bad faith. If it were, then every application that met objection on the basis of earlier rights would be open to the charge that it was made in bad faith and would be liable to be refused even if it was ultimately decided that the earlier right in question did not constitute an obstacle to the registration of the later mark. That, he said, could not be the purpose or effect of the Act and something more, in the nature of dishonesty on

the part of the Applicant, must be shown in order for the objection under Section 8(4)(b) to succeed.

19. The Act does not define what is meant by "bad faith" in the making of an application for registration but it must, in my opinion, be understood as involving some form of dishonest or otherwise reprehensible conduct on the part of an applicant[2]. In order for bad faith to be proven, that specific misconduct on the part of an applicant must either be shown by evidence adduced by an opponent or it must be the inescapable inference to be drawn from the circumstances of the application. In the present case, the Opponent has not adduced evidence of any conduct on the part of the Applicant that would tend to suggest that the application for registration has been made in bad faith. It has, rather, relied on the circumstances of the application and asserted that the Applicant *must* have had a dishonest intention in adopting a name for its product that is similar to its (the Opponent's) existing trade mark.

20. That raises the question of whether an application by an undertaking for registration of a mark that is similar to that of a competitor should be regarded, *prima facie*, as an act of bad faith. In the case of Application No. 213120 (1999/01340), *AFFEX* in Class 5 by Fujisawa Deutschland GmbH and opposition thereto by Wyeth, I considered that question and decided, for the reasons set out in my decision dated 21 February, 2005, that such an application should not be so regarded. Of course, every case turns on its own facts and I have to look at the particular facts of this case to decide whether it is reasonable to infer that the application for registration was made in bad faith by the Applicant. Those facts are that the Opponent's ZIMOVANE product was on the market and enjoying significant sales when the Applicant brought out an identical product under the name ZIMOCLONE. I am also satisfied that the adoption by the Applicant of a name that was similar to one already in use by the Opponent was not simply a coincidence but that the Applicant was fully aware of the Opponent's product when it chose the name for its competing product.

[2] In the ***Gromax*** case in the High Court of England and Wales [1999] RPC 367, Lindsay J referred to dishonesty and "*dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined*".

21. So, is the only reasonable inference to be drawn from the Applicant's adoption of the name ZIMOCLONE that it was motivated by a dishonest intention or one that falls short of normal standards of acceptable commercial behaviour? I think not. Perhaps the Applicant chose the name to convey the message to potential customers that the product so marked was similar in nature to the Opponent's product ZIMOVANE and was, in effect, an alternative to that product. While the Opponent might not be pleased about the emergence of a competing product, the name of which calls attention to the fact that it is an alternative to that of the Opponent, it is, in reality, no more than a normal and legitimate act of commercial competition. Of course, if the name chosen by the Applicant is of such a nature as to create a likelihood of confusion in the minds of the relevant consumers, including a likelihood of association with the Opponent's trade mark, then the application for registration will be refused under Section 10 of the Act. As regards the objection to registration under Section 8(4)(b) however, more than the mere adoption by the Applicant of a similar mark to that of the Opponent needs to be shown in order for the allegation of bad faith to be substantiated. In the absence of any evidence of misconduct on the part of the Applicant and in light of the fact that the adoption by it of the name ZIMOCLONE is not necessarily dishonestly motivated, I conclude that the allegation of bad faith in the making of the application has not been proven and I dismiss the opposition under Section 8(4)(b) accordingly.

Section 10(2)(b) – is there a likelihood of confusion on the part of the public?

22. Section 10(2)(b) of the Act reads as follows:

> *"A trade mark shall not be registered if because –*
>
> > *(b) it is similar to an earlier trade mark and would be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, ….*
>
> *there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the later trade mark with the earlier trade mark."*

23. It is clear from the wording of that Section that, in order for the prohibition on registration to apply, there must be a real likelihood of confusion between products marked with the respective trade marks. A likelihood of association between the marks in the minds of consumers is not, in itself, a sufficient ground for concluding that there is a likelihood of confusion; the concept of the likelihood of association is not an alternative to that of likelihood of confusion but serves, rather, to define its scope[3]. In order to determine whether such a likelihood of confusion would exist in practice, it is necessary to conduct an assessment of all of the relevant factors, including the degree of similarity of the respective marks and the respective goods, the degree of distinctiveness of the earlier mark, the overall impression created by the marks, the circumstances of the trade in the relevant goods and the likely perception of the average consumer of those goods.

Comparison of the marks

24. The marks in question are ZIMOVANE and ZIMOCLONE and it is immediately apparent that there are significant similarities between them. The inclusion in each of the element "ZIMO" is the most significant. Coming, as it does, at the start of each word, that element is significant in determining both the look and the sound of the words and its occurrence and positioning in each mark is an important point of similarity between them. That similarity is strengthened by the fact that both words are roughly the same length, both end in "NE" and both have a long, soft second syllable ("*ain*" and "*own*", respectively). There are, of course, some differences between the marks, notably the differences in appearance, sound and meaning of the suffixes, which consist of words in their own right, but these differences are not, in my opinion, particularly significant in terms of the marks as a whole. As regards the conceptual or connotative significance of the respective words, it must be observed that each is an invented word having no ordinary or dictionary meaning and, to that extent, they cannot be seen as particularly similar or dissimilar from a conceptual aspect. On an overall assessment, I find that there is a high degree of similarity between the respective marks and I treat them accordingly for the purpose of determining the likelihood of confusion.

[3] ECJ in Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445 – paragraph 18

Comparison of the goods

25. The Opponent's earlier trade mark is registered in Class 5 in respect of "*pharmaceutical and veterinary preparations and substances*". The goods of the present application are as set out at paragraph 1 above, viz., "*pharmaceutical preparations and substances"* in Class 5. The goods of the application are, therefore, identical with those in respect of which the Opponent's earlier trade mark is protected. Furthermore, the evidence has shown that, in fact, both marks are used in relation to identical products within the general category of pharmaceutical preparations and substances, namely pharmaceuticals for use in the short-term management of insomnia.

Distinctiveness of the earlier mark

26. It is established that the more distinctive a mark is, whether inherently or because of the use made of it, the more likely it is that there will be confusion if a similar mark is subsequently used in relation to similar goods. The Opponent's mark ZIMOVANE is an invented word, which does not allude to or otherwise describe the relevant goods and, as such, must be regarded as an inherently distinctive trade mark for those goods. According to the Opponent's evidence, there were very substantial sales of products under its mark prior to the date of the present application (the relevant date) and I think it right to assume, therefore, that, in addition to its inherent distinctiveness, the mark had become known as the name of the Opponent's product.

The circumstances of the trade and the average consumer

27. If considered in relation to the goods of the application as filed, namely pharmaceutical preparations and substances, the circumstances of the trade could include everything from direct retailing of mild analgesics via supermarkets and convenience stores to the sale of over-the-counter medicines in pharmacies and the prescribing and dispensing of prescription-only drugs by doctors and pharmacists. Similarly, the average consumer would have to be regarded as the average person as the chain of supply would involve direct sales to consumers generally as well as the dispensing of medicines by healthcare professionals. In light, however, of the fact that the mark propounded for registration is actually used in relation to a prescription-only product, I regard it as appropriate for me to

consider the likelihood of confusion arising from the use of the Applicant's mark on those specific goods and, if necessary, to require that the specification of goods be amended accordingly before allowing the application to proceed.

28. The circumstances of the trade in prescription-only pharmaceuticals are such that the persons to whom such products are primarily addressed are medical doctors and pharmacists. I have previously taken the view[4] that such persons may be expected to exercise great care in the selection and dispensing of medicines. They are under a duty of care to their clients to ensure that the correct medicine is prescribed and dispensed and the consequences of errors in that regard may be extremely grave. The circumstances in which medicines are prescribed and dispensed may usually be expected to reduce the likelihood of confusion between different products as, in addition to brand names, the relevant healthcare professionals would have regard to such matters as active ingredients, dosage amounts and dosage frequency and they would give advice and information to the ultimate consumers of the products in relation to those matters. In this instance, that factor is not relevant as it appears from the evidence that the respective products of the parties are identical in many respects, each being a cyclopyrrolone (I.N.N. zopiclone) sold in packs of 28 x 7.5mg white tablets and each having the same recommended dosage rates and contra-indications and very similar side effects.

Likelihood of confusion

29. Having regard to all of the foregoing factors, I am required to make a global assessment of the likelihood of confusion arising if the Applicant's mark is used in a normal and fair manner as a trade mark for the relevant goods. In practical terms, that requires consideration of the following question: What is the likelihood that a doctor or pharmacist will, because of the high degree of similarity between the respective marks and the identity of the respective products, instead of prescribing or dispensing the Opponent's product ZIMOVANE, mistakenly prescribe or dispense the Applicant's product ZIMOCLONE? In considering that question, it is right to think of instances such as those suggested at the hearing by Ms. Heslin, for the Opponent, namely,

[4] in Application No. 213120, *AFFEX* referred to in paragraph 20

- that ZIMOVANE might be recommended to a doctor by a colleague and that, through imperfect recollection, he might subsequently prescribe ZIMOCLONE thinking that it was the product recommended to him,

- that a pharmacist might misread a prescription for ZIMOVANE as ZIMOCLONE and dispense the Applicant's product in place of the Opponent's, there being no real difference between the respective products, or

- that either person might associate the respective products one with the other because of the similarities of their names and wrongly conclude that ZIMOCLONE was a related product to ZIMOVANE.

30. To my mind, these hypothetical examples are not at all fanciful and nor should they be dismissed lightly; they are very real possibilities that must result from the marketing of identical products under names that are highly similar. However, registration is not to be refused if it is ***possible*** that there will be confusion among the relevant class of consumers but only if such confusion is ***likely*** and a ***likelihood*** of confusion cannot be inferred from a hypothetical possibility of confusion. While these marks are very similar, they are not identical and, for confusion between them to be likely, there must, I think, be a certain lack of attention on the part of the persons to whom the respective products are addressed. However, as I have indicated, it is not correct to assume that persons charged with the very important task of prescribing and dispensing prescription-only pharmaceuticals will act carelessly.

31. I note from the copy extract of MIMS Ireland, March, 2002 edition (the controversial exhibit to Mr. Corr's Statutory Declaration filed as Applicant's evidence under Rule 21) that, in addition to the products of the Opponent and the Applicant, zopiclone formulations are available under the names ZILEZE, ZOPITAN and ZORCLONE. Of course, those names do not display nearly as much similarity to the Opponent's ZIMOVANE as does the mark propounded for registration, but their existence must be taken as evidence that there is a certain

commonality of approach to the naming of the relevant products. In the absence of evidence to the contrary, I must assume that doctors and pharmacists are able to cope with that phenomenon without falling into confusion as between the various products. The existence of a number of products of this type, the names of all of which begin with the letter Z and some of which also have other features in common ("ZI", "ZO", "CLONE") also reduces the likelihood of an association being created in the minds of the relevant consumers between the specific products of the Applicant and the Opponent, such that those persons might perceive a link between the undertakings putting those products on the market (confusion by association). Notwithstanding the fact that the prefix ZIMO is common to both the Applicant's and the Opponent's marks and does not appear to be used by any other manufacturer, I am not convinced that this alone would be enough to make consumers believe that the Applicant's product is one of a "ZIMO" line of products owned by the Opponent or that it is manufactured under licence from the Opponent.

32. I cannot say for certain whether confusion between ZIMOVANE and ZIMOCLONE is likely but I must attempt to make the best assessment I can having regard to all of the relevant circumstances. The involvement of trained professionals in the supply chain of the relevant products is, in my opinion, a very significant factor in that assessment and one that sways the balance of probabilities in favour of allowing the application to proceed in respect only of prescription-only pharmaceuticals. While not, therefore, discounting the possibility of confusion, I think I must find that there is not an appreciable likelihood of confusion such as to warrant refusal of the application under Section 10(2)(b) of the Act, provided that the list of goods covered by it is restricted to prescription-only pharmaceuticals.

Section 10(4) – is the use of the mark by the Applicant liable to be prevented by virtue of the law of passing off?

33. Section 10(4)(a) of the Act reads as follows:

> *"A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented –*

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,"

34. The determination of the objection to registration raised by the Opponent under this Section requires consideration of the following three questions:

(i) Did the Opponent have a reputation under the name ZIMOVANE as of the relevant date?

(ii) Would the use by the Applicant of the name ZIMOCLONE on a competing product constitute a misrepresentation as to the origin of that product?

(iii) If so, would it result in damage to the Opponent?

35. I have, in fact, considered these questions already in addressing the opposition under Sections 8(4)b) and 10(2)(b). As regards the first question, I have found that the Opponent's product under the name ZIMOVANE was on the market and enjoying significant sales as of the relevant date. However, I have also decided that the adoption by the Applicant of the name ZIMOCLONE was not in bad faith and that its use of that name as a trade mark for the relevant goods is not likely to cause confusion among the relevant public. It follows that I cannot regard the Applicant's use of the mark ZIMOCLONE as a misrepresentation as to the origin of the goods and nor can I regard it as likely to cause any damage to the Opponent. For these reasons, I find that the use by the Applicant of the trade mark ZIMOCLONE is not liable to be prevented by virtue of the law of passing off and I dismiss the opposition under Section 10(4)(a) of the Act accordingly.

Tim Cleary
acting for the Controller
29 August, 2005