

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE  
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

BETWEEN

**PINEWOOD LABORATORIES LIMITED**

**Applicant**

**and**

**GLAXO GROUP LIMITED**

**Opponent**

CONCERNING

**Trade Mark Application No. 2006/01968 (234832)**

**IMITAG**

**Background**

1. On 31 August, 2006, Pinewood Laboratories Limited, an Irish company of 1 M50 Business Park, Ballymount, Dublin 24, made application (No. 2006/01968) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the word IMITAG as a trade mark in respect of goods in Class 5, namely, pharmaceutical preparations and substances.
2. The application was accepted for registration and advertised accordingly under No. 234832 in Journal No. 2059 on 15 November, 2006.
3. Notice of opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 14 February, 2007 by Glaxo Group Limited of Glaxo Wellcome House, Berkeley Ave., Greenford, Middlesex UB6 ONN, England. The Applicant filed a counter-statement on 18 May, 2007 and evidence was subsequently filed

by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).

4. The opposition became the subject of a hearing before me, acting for the Controller, on 11 December, 2008. The parties were notified on 18 December, 2008 that I had decided to uphold the opposition and to refuse registration of the trade mark. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) filed on 19 January, 2009.

### **Scope of the opposition**

5. The opposition is based on the Opponent’s proprietorship and use of the trade mark IMIGRAN, which is registered under No. 137019 as of 4 January, 1990 in Class 5 in respect of pharmaceutical preparations and substances and also registered as a Community Trade Mark under No. 208801 as of 10 July, 1996 in respect of the same goods. On the basis of its registration and use of that trade mark, the Opponent says that the use of by the Applicant of the trade mark IMIGRAN would be likely to lead to confusion on the part of the public, that it would be detrimental to and take unfair advantage of the reputation of its trade mark IMIGRAN and that it would lead to passing off of the Applicant’s goods as those of the Opponent. It also claims that the application for registration was made in bad faith by the Applicant. The notice of opposition includes some other grounds of opposition but these were neither supported by relevant evidence nor pursued by argument at the hearing and I have decided, therefore, that they may be disregarded.

### **The evidence filed and facts claimed**

6. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits 1-7) dated 12 November, 2007 of Joanne Green, Vice President and Trade Mark Counsel, Corporate Intellectual Property of the GlaxoSmithKline group of companies, of which the Opponent is a member. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits TH1 and TH2) dated 31 January, 2008 of Tony Hynds, Marketing Director (Ireland) of the Applicant. Evidence in reply submitted by

the Opponent under Rule 23 consisted of a further Statutory Declaration, dated 25 April, 2008 of the aforementioned Joanne Green.

7. I would summarise the relevant facts averred to in the evidence as follows. Since February, 1996, the Opponent's trade mark IMIGRAN, which is registered in many countries throughout the world, has been used in the State in relation to a pharmaceutical preparation for the treatment of migraine, the active ingredient of which is a drug called sumatriptan. Worldwide sales of IMIGRAN have been in the hundreds of millions of euro and sales in the State in the period 1999-2006 amounted to approximately €8.25million. The product has been advertised and promoted and has appeared in the Monthly Index of Medical Specialities (MIMS) over several years. The Applicant has been selling a sumatriptan formulation under the name IMITAG since January, 2007. That product is the subject of a marketing authorisation issued by the Irish Medicines Board in September, 2006. IMITAG is a so-called "generic drug", which has been put on the market following the expiry of the Opponent's patent protecting compositions containing sumatriptan. The Opponent says that it is "*more than a coincidence*" that the Applicant has adopted the trade mark IMITAG as a name for its migraine treatment but the Applicant "*completely rejects any suggestion that its application to register the mark IMITAG was motivated by dishonesty*".

#### **The hearing and arguments presented**

8. At the hearing the Opponent was represented by Michael Kiernan, Trade Mark Agent of Tomkins & Co. and the Holder by Alison Boydell, Trade Mark Agent of Anne Ryan & Co.
9. Mr. Kiernan argued the case in support of the opposition on the basis of the close similarity between the respective trade marks, in particular, the fact that they share the distinctive prefix "IMI". In his submission, the concurrent use of two such similar words as trade marks for migraine treatments was bound to lead to confusion and it was obvious that the Applicant had adopted the name IMITAG because it did not want to "*come to the market cold*", i.e., with a name of its own invention, but sought, rather, to get the benefit of association with the Opponent's product, which had been hugely successful over many years.

10. Ms. Boydell denied that confusion was likely, pointing to the clear differences between the respective suffixes “TAG” and “GRAN” and asserting that persons exercising the kind of care that may be expected in relation to the selection of pharmaceutical products would easily distinguish between the two. The fact is that the Opponent’s and the Applicant’s products co-exist in the marketplace and no evidence of any confusion between them has been adduced by the Opponent. Nor was the Applicant’s mark deemed to be similar to the Opponent’s by the Irish Medicines Board, which was satisfied to grant a marketing authorisation for IMITAG.

### **Grounds of decision**

11. The relevant parts of Section 10 of the Act, insofar as this case is concerned, read as follows:

*10-(2) A trade mark shall not be registered if because –*

*.....*

*(b) it is similar to an earlier trade mark and would be registered for goods ... 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.*

*(3) A trade mark which is ..... similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.*

*(4) 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;*

*Section 10(2)(b)*

12. As regards Section 10(2)(b), the basic “ingredients” of an objection to registration under that Section – earlier trade mark, similar marks and identical or similar goods – are clearly present in this case. The Opponent’s Irish and Community Trade Mark Registrations both predate the present application by many years and so each is an “earlier trade mark” within the meaning of Section 11(1)(a) of the Act. The specification of goods for which the Applicant seeks protection of its trade mark is identical to that for which the Opponent’s earlier trade mark stands protected and the evidence is to the effect that each mark is used on an identical product within that specification, namely a sumatriptan-based migraine treatment. The marks are also clearly similar, having 5 letters in common, 3 of which are identically arranged and form identical opening parts in each mark. As noted by Smyth J in *Unilever PLC –v- The Controller of Patents, Designs and Trade Marks and Sunrider Corporation* [2006] IEHC 427, the first syllable of a word mark is generally the most important and the identity of the first two syllables of the three-syllable words IMIGRAN and IMITAG creates a high degree of visual and aural similarity between the trade marks. I agree with the submission made on behalf of the Opponent to the effect that the prefix “IMI” is quite distinctive as it has no meaning in the context of the relevant goods and its use in both marks enhances the overall similarity between them. Although the Opponent’s trade mark IMIGRAN might be seen as making an oblique reference to “migraine”, it is essentially a meaningless word, the overall impression given by which is determined by its visual and aural impact. A very similar overall impression is given by IMITAG.

13. The question to be addressed is, therefore, whether, in light of the similarities between the trade marks and the identity of the goods on which they are used, there is a likelihood of confusion on the part of consumers. That question is to be

determined on the basis of a global assessment of all of the relevant facts<sup>1</sup> and having regard to the principle that the average consumer must be deemed to be reasonably observant and circumspect but will rarely have the chance to make a direct comparison between the marks and must place his trust instead in the imperfect picture of them that he keeps in his mind<sup>2</sup>. The pertinent facts in this case are that both marks are used on products intended for the treatment of migraine, which is a condition that is characterised by periodic, paroxysmal headache for which specific pharmaceutical treatments such as those under consideration here are available only through pharmacies. The average consumer is the average person who suffers from migraine but the consumer pool also includes doctors and pharmacists who prescribe and dispense migraine treatments. Although the latter may be expected to exercise a high degree of professional care in the performance of their duties, nevertheless that factor must be in part balanced by the end-user's ability to make those healthcare professionals take into account his perception of the trade marks at issue and, in particular, his requirements or preferences<sup>3</sup>.

14. The question to be considered can therefore be put as follows: *What is the likelihood that the average migraine sufferer, who has used the Opponent's IMIGRAN product and who was offered IMITAG as a treatment for migraine, would assume that it was the product that he already knows or that it was connected with that product, in the sense that it emanated from the makers of IMIGRAN or from a related undertaking?* In my opinion, the answer to that question must be that there is a very real likelihood that the average person would make such an assumption. The close similarity between the marks, when considered by reference to the overall impressions given by them, is such that a person might easily mistake one for the other, particularly having regard to the fact that it may be some time since he last had need of a migraine treatment. A person who had an imperfect recollection of the name IMIGRAN would be likely

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<sup>1</sup> as per the European Court of Justice (ECJ) in Case C-251/95, *Sabel BV –v- Puma AG and Rudolf Dassler Sport*

<sup>2</sup> ECJ in Case C-342/97, *Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV*

<sup>3</sup> ECJ in Case C-412/05, *Alcon Inc. –v- Office for Harmonisation in the Internal Market (Trade Marks and Designs) and Biofarma SA*

to accept IMITAG as being the product that he previously used, if offered to him by a pharmacist as a treatment for migraine.

15. Even in the case of a migraine sufferer who had used IMIGRAN over a long period of time and was very familiar with the name such that he would immediately notice that IMITAG was a different name, it seems likely to me that he would, nevertheless, assume some connection between the two. The likelihood of two unrelated undertakings using such similar brand names for identical pharmaceutical products seems remote. To the long-time user of IMIGRAN, it would seem more likely, in my opinion, that IMITAG was simply a new form of IMIGRAN or perhaps a rebranding of the same product. If, on the basis of that perception, the consumer were to accept IMITAG as a treatment for his migraine, he would be likely to find that it was equally as effective as IMIGRAN, since they are pharmacologically the same. One can easily imagine the same consumer, on a subsequent occasion, specifically seeking out IMITAG and being prescribed or dispensed that product by a doctor or pharmacist, in preference to IMIGRAN, simply because that was the product that the consumer identified as an effective treatment on the basis of his most recent experience. Thus, while the consumer might suffer no material loss or damage arising from his confusion, the commercial damage to the Opponent which Section 10(2)(b) seeks to avoid would certainly ensue. The Opponent's customer would be lost to a competitor as a direct result of the confusion arising from the use by the latter of a similar trade mark for the identical product. For these reasons, I have decided that registration of IMITAG would be contrary to Section 10(2)(b) of the Act and that the application should be refused accordingly.

*Section 10(3)*

16. The Opponent's objection under Section 10(3) of the Act depends on its claim that the trade mark IMIGRAN had established a reputation in the State<sup>4</sup> as of the relevant date, i.e., the date of filing of the opposed application, 31 August, 2006. In support of that claim, the Opponent has given evidence of use of the trade mark in the State, including the value of sales and promotion, and has stated that

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<sup>4</sup> there was no specific evidence as to the extent that the Community Trade Mark might have a reputation in the Community and nor was that point pursued on behalf of the Opponent at the hearing

IMIGRAN “*is the market leader in its product category*”<sup>5</sup>. While I accept that evidence as showing, on the balance of probabilities, that a substantial number of migraine sufferers have been exposed to the use of IMIGRAN as a trade mark for a migraine treatment, I do not consider it sufficient to demonstrate that, at the relevant date, IMIGRAN had the kind of reputation that Section 10(3) seeks to protect. Evidence of use is not the same as evidence of reputation and there is insufficient factual information in the Opponent’s evidence on which to infer that its trade mark had acquired a particular reputation as of the relevant date. For that reason, I have decided that the objection under Section 10(3) is not available to the Opponent and that the opposition grounded on that section should be dismissed.

*Section 10(4)(a)*

17. In assessing the merits of the opposition under Section 10(2)(b), I have already considered certain of the factors relevant to the objection under Section 10(4)(a), namely, the similarity of the marks and the likelihood of confusion (deception) leading to damage. The only additional question in the context of the objection under Section 10(4)(a) is whether, at the relevant date, the Opponent had a protectable goodwill attached to pharmaceutical products that it supplied by association in the minds of the relevant public with the name IMIGRAN. I am satisfied on the evidence that it did and so I would also refuse registration of the Applicant’s mark under section 10(4)(a) of the Act.

*Section 8(4)(b)*

18. The notice of opposition filed by the Opponent contains, at paragraph 5, an allegation that the application for registration was filed in bad faith by the Applicant and that registration of the mark would offend against Section 8(4)(b) of the Act. No particulars of that allegation are given so that the Applicant could not have known, when it filed its counter-statement, the basis on which the charge of bad faith was made against it. The counter-statement contains a flat denial of the allegation. The particulars of the allegation of bad faith are to be found in the Opponent’s evidence under Rule 20, in which Ms. Green asserts that the

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<sup>5</sup> para. 7 of Joanne Green’s Statutory Declaration dated 25 April, 2008 filed under Rule 22

Applicant adopted the trade mark IMITAG to trade on the Opponent's reputation in the trade mark IMIGRAN. The point is elaborated on in the Opponent's Rule 22 evidence, in which Ms. Green states that the Applicant's choice of IMITAG as a trade mark for its migraine treatment constitutes an attempt to mislead or deceive consumers. That was also the basis of the argument made on behalf of the Opponent at the hearing, during which Mr. Kiernan suggested that the Applicant had sought to "ride on the coattails" of the Opponent's success.

19. In my opinion, the Opponent is not entitled to succeed on this ground of opposition for two reasons. Firstly, the allegation of bad faith is not properly made and particularised in the notice of opposition. That seems to me to be a fundamental requirement in the context of an allegation as serious as that of bad faith and I consider that the Opponent's failure to state, in the notice of opposition, precisely why it alleges that the application for registration was filed in bad faith by the Applicant invalidates the allegation *ab initio*.

20. If I am wrong in this and if it can be said that the charge of bad faith was fully and fairly laid by the Opponent, nevertheless, I would dismiss it on the basis that it has not been substantiated by relevant evidence nor supported by compelling argument. The Opponent has given no evidence of anything that the Applicant has done that tends to support the Opponent's claim that the Applicant has sought to deceive or confuse the public or to profit from the Opponent's claimed reputation under the trade mark IMIGRAN. Nor is that the inescapable inference to be drawn from the Applicant's adoption of the trade mark IMITAG for use in relation an identical pharmaceutical product to IMIGRAN. It is equally arguable that the Applicant sought to do no more than use the name IMITAG to indicate to consumers that its product, being a generic drug, was an alternative to IMIGRAN and similarly suitable for use as a migraine treatment. While the Opponent may be understandably unhappy about the emergence of IMITAG, the Applicant's adoption of that name does not, of itself and without more evidence of wrongdoing, constitute an act of bad faith. Of course, if the likely result of the use of IMITAG is that there will be confusion among consumers, then the application is open to refusal under Section 10, as I have already decided. However, that

likelihood of confusion is not a basis on which to hold also that the mark was adopted, and the application for registration filed, in bad faith.

Tim Cleary

Acting for the Controller

4 February, 2009