



**REPUBLIC OF KENYA
IN THE HIGH COURT OF KENYA
AT NAIROBI (MILIMANI COMMERCIAL COURTS)
Miscellaneous Application 792 of 2009**

**IN THE MATTER OF OPPOSITION TO REGISTER TMA NO. 59060
(SYNERCEF- WORD MARK)
IN THE MATTER OF APPEAL AGAINST THE RULING OF THE REGISTRAR OF TRADEMARKS**

**GLAXO GROUP LIMITED.....APPELLANT
VERSUS
SYNER-MED PHARMACEUTICALS LTD.....RESPONDENT**

JUDGMENT

Glaxo Group Ltd and Syner-med Pharmaceuticals Ltd are both pharmaceutical companies engaged in the manufacture and sale of pharmaceutical products. The appellant registered a trademark in Kenya under Trademark No.24634 in respect of class 5 in relation to Pharmaceutical and medicinal preparations. The trademark that the appellant registered is 'ZINACEF'. The trademark was registered on 9th March 1978. Since then, the appellant has been using the trademark to market an antibiotic drug under the name. The active ingredient of the antibiotic sold as 'ZINACEF' is a compound known as Cefuroxime. On 27th April 2006, the respondent applied to the Registrar of Trademarks to register the trade name 'SYNERCEF' as a trademark in the same class 5 in respect of pharmaceutical and medicinal preparations under the **Trade Marks Act**. The respondent intends to use the trademark to market its antibiotic product containing the same active ingredient as that of the appellant i.e. Cefuroxime. The appellant opposed the registration of the said trademark. The appellant was of the view that the registration of the trademark 'SYNERCEF' would cause confusion in the market as the trade name 'SYNERCEF' sounded phonetically and appeared visually as the already registered trademark of the appellant 'ZINACEF'.

The Registrar of Trademarks heard representations made by the appellant and the respondent and on 20th July 2009, made the following ruling:

“The Registrar states that taken as whole, the word “SYNERCEF” and “ZINACEF” and the respective packaging material thereof reveal the following relevant factors:

- (a) *the words have different lengths.*
- (b) *Pronunciation and semantics of the first syllable are different.*
- (c) *The goods covered by the marks are prescription drugs only and the doctors and pharmacists who handle the goods are trained professionals.*
- (d) *The issue at hand in this matter has close bearing to the above cited US case of RISPERDAL and RISEDON where the marks were found to be dissimilar.*
- (e) *No evidence has been tendered to prove that trained medical practitioners and pharmacists have a probability to confuse the prefix SYNER and ZINA.*
- (f) *There are differences in the number of colours and the design layout of the packaging materials of SYNERCEF and ZINACEF.*
- (g) *The packaging material for the Applicant and Opponent clearly and prominently indicate the origin of the product and gives the name and identify of the manufacturer of the respective pharmaceutical product.*

Based on the above-mentioned relevant factors, the Registrar makes a ruling that the applied for mark SYNERCEF is not confusingly similar to the registered mark ZINACEF. This ruling is based on the fact that the goods covered under the trademark are prescription only drugs and that the packaging materials clearly identify the origin of the product. The gist of this finding is that the applied for trademark SYNERCEF in TMA 59060 shall proceed to registration. The opposition to registration of the mark SYNERCEF is dismissed with costs”.

The appellant was aggrieved by this ruling and pursuant to the provisions of **Section 21(6) & (7)** of the **Trade Marks Act** filed an appeal to this court. The appellant raised nine (9) grounds of appeal challenging the decision of the Registrar. The appellant was aggrieved that the Registrar had totally failed to appreciate the provision of **Section 7** of the **Trade Marks Act** which gives a registered proprietor exclusive use of a registered mark. The appellant faulted the Registrar for applying the provisions of **Section 18(3)** of the **Trade Marks Act** when neither party had sought to register the suffix “CEF”. The appellant contends that the Registrar erred and contradicted himself in

proceeding to dissect the marks in an attempt to find out whether the marks are phonetically or visually similar when the correct test provides that the marks must at all times be considered as a whole. The appellant was aggrieved that the Registrar had given undue weight and consideration to the class of consumers likely to use the respective goods and totally overlooked the relevant statutory provisions under the **Trade Marks Act**. The appellant faulted the Registrar for failing to appreciate that the respondent sought to register its mark "SYNERCEF" in class 5 for pharmaceuticals whereas there was an existing trademark "ZINACEF" in class 5 for pharmaceuticals, medicinal and veterinary preparations and substances. The appellant was of the view that the Registrar had erred and contradicted himself in applying the principles of *stare decisis* and thereby arriving at an entirely wrong result. The appellant was aggrieved that the Registrar had applied legal authorities beyond the Commonwealth to reach his determination. The appellant faulted the Registrar for failing to find that the colours and design layout of the packaging materials of "SYNERCEF" and "ZINACEF" were strikingly similar and likely to confuse. Finally, the appellant was aggrieved that the Registrar had found that the respondent's mark "SYNERCEF" and that of the appellant "ZINACEF" were not confusingly similar.

In response to the appeal, the respondent's general manager Tiruvalanchuzi S. Viswanathan swore a replying affidavit in opposition to the appeal. He deponed that the trademark represented in TMA 59060 "SYNERCEF" is individual and distinct in style, ambience all character and other aspects and bears no resemblance to the appellant's mark or any one else's. He insisted that the mark "SYNERCEF" was incapable of being confused with "ZINACEF" or causing deception in the market. He stated that the packaging and contents of "SYNERCEF" are entirely and distinctively different from that of "ZINACEF" and is therefore properly registered under the **Trade Marks Act**. The respondent produced original packagings of both trademarks for the purpose of scrutiny and assessment by the court to determine whether indeed the two trademarks were similar as alleged by the appellant. He deponed that the market targeted by the respondent's trademark is sophisticated and well informed and is able to distinguish the two trademarks. He further stated that the goods covered by the respondent's trademark are sold by professional pharmacists and only on prescription, and therefore it was unlikely that there would occur confusion in the minds of the buying public. He reiterated that the packaging adopted by the respondent is distinct from the one that has been adopted by the appellant. He urged the court to apply the test of whether the two trademarks are sufficiently close visually and phonetically to likely cause the public to be confused or deceived. Applying this test, the respondent is of the view that the trademarks "SYNERCEF" and "ZINACEF" are unlikely to cause any confusion or deception in the market. He urged the court to take into consideration that the prefix "SYNER" was part of the respondent's corporate name "SYNER-MED" while "CEF" is the short name for the antibiotic molecule "CEFUROXIME". He urged the court to dismiss the appeal.

Prior to the hearing of the appeal, counsel for the appellant Mr. Kinoti and counsel for the respondent Mr. Sharad Rao agreed by consent to file skeleton submissions. They duly complied and filed the said submissions. The appellant's counsel further filed list of authorities which he sought to rely on in support of his submission. At the hearing of the appeal, counsel notified the court that they would be relying entirely on the written submission. The issue for determination by this court is whether the Registrar reached the correct decision in disallowing the opposition by the appellant for the registration of the trademark "SYNERCEF" submitted for registration by the respondent. Certain facts are not in dispute in this appeal. It is not disputed that the appellant is the registered owner of the trademark "ZINACEF". The appellant was so registered on 9th March 1978 under Trade Mark No. 24634. The trademark will expire in 2013. The Trade Mark was registered under class 5 of Trademarks that relates to pharmaceutical, medicinal and veterinary preparations. It is further not disputed that the appellant offers for sale an antibiotic whose active ingredient is the antibiotic molecule "CEFUROXIME". It was common ground that the respondent also offers to the pharmaceutical market an antibiotic whose active ingredient is the same antibiotic molecule "CEFUROXIME". The respondent applied to the Registrar of Trade Marks to register the trade mark "SYNERCEF". The appellant objected to the registration of the respondent's trade mark on essentially the ground that the name that the respondent intended to have registered as a trade mark bore a similarity to the trade mark already registered by the appellant i.e "ZINACEF". The appellant was of the view that since the appellant and the respondent sold pharmaceutical products to the same market, the registration of the trade mark "SYNERCEF" would cause confusion and deception in the market taking into consideration that the appellant was already the registered owner of a trade mark which phonetically sounded and visually looked the same as the said trade mark proposed to be registered by the respondent. Of course, the respondent is of a contrary view. It is the respondent's case that the Registrar of Trade Marks made the correct decision when he ruled that the trade mark of the respondent was dissimilar to that of the appellant.

In determining an appeal such as the present one, it is my considered view that the court will deal with the appeal like any other appeal subject only to the specific requirements of the **Trade Marks Act**. In that regard, this court has re-evaluated and re-considered the evidence and the arguments presented before the Registrar of Trade Marks with a view to arriving at an independent determination whether or not to allow the appeal. Of course, the court will take into consideration the submissions made by the parties in this appeal. Under **Section 14** of the **Trade Marks Act**,

“No person shall register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

Section 15(1) of the **Act** provides that,

“Subject to the provisions of sub-section (2) no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or in respect of services, is identical with or nearly resembles a mark belonging to a different proprietor and already in the register in respect of the same services or description of services.”

Sub-section (2) provides that,

“In case of honest concurrent use, or other special circumstances which in the opinion of the court or the Registrar may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the court or Registrar may think it right to impose.”

In respect of use of word or words in a trade mark, **Section 18(1)** of the **Act** provides that,

“The registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance or some activity...”

The authors of the leading treatise on the law of Trade Marks, **Kerly’s Law of Trade Marks and Trade Names**, Tenth Edition (1972) stated that the principles to be considered in determining whether or not a trade mark sought to be subsequently registered is similar to the trade mark that is already registered, is whether the two trade marks are so similar as to cause deception and confusion in the market (see page 450 – 456). In Kenya, there are several decided cases which address this point. In **Beirsdorf Ag v Emirchem Products Limited [2002] 1KLR 876** Mbaluto J allowed an application for injunction where the plaintiff had sought to restrain the defendant from using the trade name “NIVELIN” in the sale of a petroleum jelly product which the court found to be similar to the registered trade mark of the plaintiff “NIVEA” by which a similar product was sold. The court held that the two names were such that if allowed to be used in the market would cause confusion in the market. Similarly, in **Pharmaceutical Manufacturing Co v Novelty Manufacturing Ltd [2001] KLR 392** Ringera J (as he was then) held that the defendant’s use of the trade name “TRI-HISTINA” infringed the registered trade mark of the plaintiff “TRIHISTAMIN”. He held that the two names were substantially similar as to likely deceive and cause confusion in the course of trade in relation to pharmaceutical and medical preparations and substances in respect of which it is registered. In **London Overseas Trading Co. Ltd v The Raleigh Cycle Company Ltd [1959] EA 1012**, the court upheld the decision of the Registrar of Trade Names to refuse to register the trade name “LALE” which in his view was phonetically identical to the word “RALEIGH” which had been registered as a trade mark.

In the present appeal, it was evident that the Registrar of Trade Marks fell in error when he truncated the name “SYNERCEF” and “ZINACEF” by excluding the suffix “CEF” and thereby reaching the wrong conclusion that the prefix “SYNER” and “ZINA” had no meaning and therefore the subsequent registration did not constitute an infringement of the appellant’s trade name. I think the correct position of the law is that in cases such as the present one, the words that are the subject of the dispute relating to a trade name should be considered as a whole and not in the manner that the Registrar did. If the Registrar had considered the words as a whole he would undoubtedly have arrived at a different decision. Having considered the applicable law, it is clear that the words “SYNERCEF” and “ZINACEF” are phonetically similar in pronunciation that it is likely to cause confusion and deception in the market. In the **Raleigh Cycle Company** case, the court took judicial notice of the fact that among Ugandans, it was common for the letter “R” to be pronounced as “L”, hence its decision that the word “LALE” was phonetically identical to the word “RALEIGH”. This court takes Judicial notice of the fact that many people in Kenya would likely pronounce the letter “SY” as “ZI” and therefore the two names would be pronounced in a phonetically identical manner and not distinctly as claimed by the respondent. I did not buy the argument by the respondent that the market to which the pharmaceutical products are sold is sophisticated and therefore medical professionals who will be dealing with the two products will unlikely be confused or deceived by the two trade names. The fact that the two products sold by the appellant and the respondent are prescription only drugs does not preclude the fact that confusion would be caused when an order is made orally or by telephone to such professions such as pharmacists or doctors.

I therefore hold that the appeal filed by the appellant has merit and is hereby allowed. The decision of the Registrar of Trade Marks made on 20th July 2009 is hereby set aside and substituted by the decision of this court upholding the opposition by the appellant. I hold that the name “SYNERCEF” is so similar, phonetically and visually to the registered trade mark of the appellant “ZINACEF” to an extent that it will cause confusion and deception in the minds of the public. Pursuant to **Section 52** of the **Trade Marks Act**, I hereby direct that the registration of “SYNERCEF” as a trade mark under TM No.59060 be cancelled as the same is similar to the registered trade mark No. 24634 “ZINACEF” registered by the appellant. The appellant shall have the costs of this appeal and that of the opposition before the Registrar of Trade Marks. It is so ordered.

DATED AT NAIROBI THIS 4TH DAY OF FEBRUARY 2010.

L. KIMARU
JUDGE