

A Skirmish of the Suds

By Azlina A Khalid

On 06 July 2006, a trade mark application was filed for the mark OILUM by Galenium Pharmasia Laboratories, an Indonesian pharmaceutical company and the application was accorded Trade Mark Number 06011831. Subsequent to a smooth search and examination process by the Malaysian IP office, the subject mark was advertised for opposition purposes.

OILATUM is a brand owned by Stiefel Laboratories (now a GSK company). The mark has been registered around the world including Malaysia. Stiefel Laboratories thereafter filed an Opposition proceeding based on the following grounds:

- a. Registration of the Applicant's mark offends against Section 14 Trade Marks Act ("TMA");
- b. Registration of the Applicant's mark is contrary to Article 6bis of the Paris Convention, and as such is also contrary to the same Section 14 TMA;
- c. Registration of the Applicant's mark is contrary to Section 10 TMA;
- d. Registration of the Applicant's mark offends against Section 19 TMA;
- e. The Applicant cannot claim to be the bona fide proprietor of the mark and registration of the same is contrary to Section 25 TMA; and
- f. The Applicant's mark when used in relation to the goods applied for may give rise to passing off.

The Applicant resisted the trade mark opposition on the grounds that the mark OILUM was independently created by the founder of the Applicant, Dr. Eddy Joesoef. He was a qualified dermatologist from a family with medical/pharmaceutical background. The mark was coined from a derivation of the words OIL (the generic substance) and OLEUM OLIVARUM (the Latin word for olive oil). In addition, the marks concerned were not identical to one another and that the Applicant had already been selling products bearing the mark in Malaysia for quite some time without any objections from the Opponent.

After both parties had provided Written Submissions to the Opposition Officer, a decision was issued where it was held allowing the registration of the mark OILUM. The basis of the Registrar's pronouncement was premised on the factors below:

1. The marks were held to be neither identical nor were they closely similar to one another. Visually the marks are different as each was represented in a stylized form. Phonetically, the marks were also held to be different as the Applicant's mark had 2 syllables whilst the Opponent's mark had three.
2. The Opposition Officer did find that the goods of both marks were goods of the same description. Nevertheless, it was noted that the goods concerned i.e. personal care products were not the kind of goods which customers would simply pick from the shelves and pay without giving it any thought or reasonable care. As such, the goods though similar in nature would not likely be taken to confuse the public and

consumers as they would normally read the label and know which product they are buying.

3. The mark OILUM had been shown to be distinctive at the search and examination stage and it was further shown by evidence that there had been use of the mark in the market without any objections from the Opponent.

It is heartening to note that the Registrar's decision was not appealed by the Opponent to the High Court. This means that they have accepted the Registrar's rationale in good faith. Further, the Applicant is now free to protect their valuable trade mark and continue to build their reputation and goodwill arising from the use of their trade mark in respect of their products of interest.