

## THE HIGH COURT

2007 4458 P

BETWEEN

ALLERGAN INC. AND ALLERGAN PHARMACEUTICALS  
(IRELAND) LTD.

PLAINTIFFS

AND  
OCEAN HEALTHCARE LTD.

DEFENDANT

**Judgment of Mr. Justice Brian J. McGovern delivered on 24th day of June, 2008**

1. In this case, the plaintiffs claim that the defendant has infringed the first named plaintiffs' registered "BOTOX" Trademarks listed in the Schedule to the Plenary Summons, and they also claim that the defendant is guilty of passing off goods as or for the goods of the plaintiffs under or by reference to their name or Mark, BOTOINA.

**The facts**

2. The plaintiffs are members of the Allergan Group of companies which produces, markets, and sells pharmaceutical products throughout the world. This case concerns one of the better known pharmaceutical products produced by the plaintiffs, namely, 'BOTOX'. This product is a preparation containing a purified form of Botulinum Toxin Type A. The product has been a great success for the plaintiffs. The first named plaintiff is a company incorporated under the laws of Delaware in the United States of America and is the owner of various registered Trademarks throughout the world in respect of BOTOX. The second named plaintiff is the holder of a licence from the first named plaintiff to use its Trademarks and to manufacture *Botox*. The second named plaintiff holds the product authorisation in this jurisdiction from the Irish Medicines Board and this allows it to manufacture the product. The court has been informed that the worldwide supply of *Botox* is manufactured in the second named plaintiff's plant in Westport, County Mayo.

**Botox**

Throughout this judgment, when I refer to BOTOX, I mean the off-label use of the product in the treatment of facial lines or wrinkles except where I state otherwise.

3. The *Botox* Trademark is a very important Intellectual Property asset of the plaintiff companies. The plaintiffs claim that it is the best known purified Botulinum Toxin product and that it has become a household consumer name. It is available for both therapeutic and cosmetic uses. The plaintiffs claim that the name '*Botox*' is not interchangeable with any other Botulinum Toxin preparation and that it is a brand which has distinguished its product from other preparations of Botulinum Toxin since its launch in Ireland and elsewhere. The plaintiffs claim that if others were entitled to freely refer to other Botulinum Toxin products under the name '*Botox*', the plaintiffs would not only lose its valuable exclusivity in the market, but that many Irish medical practitioners who use the product would no longer be certain which preparation they are using and this would have safety implications for patients. If this were to occur, there would be detrimental repercussions for the plaintiffs.

4. *Botox* is a prescription only product which has therapeutic and cosmetic applications. It must be prescribed by a registered medical practitioner and can only be provided from a pharmacy. It is administered either by doctors, dentists or other people with medical training. In its cosmetic application, it is administered by means of a micro needle and syringe. *Botox* contains, as its active ingredient, Botulinum Toxin Type A in a purified form. The defendant's product, which is complained of, namely, *Botoina*, does not contain Botulinum Toxin Type A or any other type of Botulinum.

5. Botulinum Toxin is a potent protein that acts specifically on nerve cells. It is produced by the bacterium, *Clostridium Botulinum*, which is commonly found in soil. Botulinum Toxin was first recognised and isolated in the late 1890s. When it is purified for medical use, Botulinum Toxin does not contain any bacteria but contains a tiny amount of the chemical protein secreted by the bacterium, *Clostridium Botulinum*. There are seven known stereotypes of Botulinum Toxin which are designated by the letters A, B, C, D, E, F and G. Each stereotype varies in its potency and effects. Between the 1920s and 1940s, Botulinum Toxin Type A was isolated in a purified form. In the 1950s, it was discovered that injecting Botulinum Toxin into a hyperactive muscle, blocked the release of Acetylcholine from motor nerve endings, thereby inducing a temporary relaxation of the targeted muscle. This gave rise to an interest in creating medical therapeutic products derived from Botulinum Toxin.

6. In the late 1960s, Dr. Alan Scott, a Clinical Researcher and Ophthalmologist, in San Francisco, began to investigate Botulinum Toxin Type A in pre-clinical studies for the treatment of Strabismus, which is a condition producing "crossed eye" or squint. In the course of his research and trials, Dr. Scott found that if Botulinum Toxin Type A was used in a particular formulation and was injected into certain muscles, it would correct the squint. In the 1980s, a Canadian physician observed that patients who had been treated for Blepharospasm (Involuntary Eyelid Closure), with Dr. Scott's product showed a reduction in the appearance of the Glabellar Furrows, which are the vertical lines between the eyebrows. This was attributed to the relaxation of the brow muscles. It came to be understood that when Botulinum Toxin Type A was administered as an injection into specific muscles, it attached itself to the nerve endings and was internalised into the nerve. This was followed by a blockage of the release of Acetylcholine, the neurotransmitter responsible for triggering muscle contractions. The treatment resulted in a very effective reduction or elimination of dynamic lines and wrinkles in the face. In the course of this case, Professor Mitchell Francis Brin, gave evidence that during the 1980s, he began, with other colleagues at Colombia University, to undertake a number of clinical studies on patients using injections of Dr. Scott's product, for a range of Dystonias and other disorders resulting in abnormal muscle contraction.

7. Dr. Brin became involved in discussions with Allergan Inc., in relation to the development of Dr. Scott's product for a range of therapeutic uses in the late 1980s. Around this time, Allergan acquired certain rights to Dr. Scott's product and was interested in marketing the product in the future under the name BOTOX.

8. Dr. Brin gave evidence to the court that he and his Colombia University colleagues coined the name BOTOX in or around 1986 while studying patients using injections of Dr. Scott's product for therapeutic purposes. At that time, there were two Botulinum Toxin Type A products formulated for human use available, namely, the Dr. Scott product and that being developed by Porton Down in the United Kingdom, which became known as DYSPORT. Dr. Brin and his colleagues were looking for a way of presenting the Dr. Scott's Botulinum Toxin derived product to patients. The product had been called Oculinum. Dr. Brin considered using the letters 'BTX' and this then was changed to 'BOTOX'. 'Oculinum' referred to the ophthalmic use of the Dr. Scott product but Dr. Brin was using it for a broad group of neurological disorders under a research protocol and for that purpose called it *Botox*. The plaintiffs contend that the word *Botox* specifically refers to the purified Botulinum Toxin Type A as used in Dr. Scott's product which was subsequently acquired by the plaintiffs and to distinguish it from any other type of Botulinum Toxin Type A. In the late 1980s, Dr. Scott approached Allergan Inc. to distribute his product for commercial purposes. Allergan Inc. acquired the rights to research, develop, market and sell Dr.

Scott's Botulinum Toxin product in 1988, and subsequently Allergan purchased the assets of Dr. Scott's company, Oculinum Inc., including the rights in Dr. Scott's Botulinum Toxin product.

9. The product has become a great success for the plaintiff companies and is now widely sought after by people throughout the world who wish to eliminate facial wrinkles or lines. The product comes in a vial in vacuum dried form and is diluted with sterile, non-preserved saline, for injection. The product is injected directly and very precisely into selected muscles with a micro-needle. It blocks the signals which would normally cause muscle spasms or contractions. In the cosmetic field, *Botox* can be used to treat horizontal "worry lines" on the forehead and certain other facial lines and wrinkles. Frowning, raising the eyebrows, and other habitual facial contractions cause wrinkling in this area and the repeated exercise of the forehead muscles crumple the skin on the forehead producing lines and wrinkles. If these muscles are relaxed with injections of BOTOX, the lines can be reduced dramatically or eliminated for a period of time. The beneficial effects of the injection usually last for between three and six months.

10. The use of BOTOX for cosmetic purposes is what is known as an "off-label" use. Many pharmaceutical and medical products have what are known as "on-label" and "off-label" uses. An on-label use is the use of a product for an approved application of therapeutic use. But in many cases, doctors using products become aware of further application for the product and such use is described as "off-label" use. It appears that this is quite standard and legal. Counsel for the plaintiffs offered the example of the use of certain pharmaceutical products on children. Children are not tested in clinical trials for medications but frequently use those medications because it has been established that they have a therapeutic application for adults. In such circumstances, the use of the medication on children would be "off-label" use.

11. In or around the year 1990, Allergan decided to adopt the Trademark, BOTOX for their Botulinum Toxin Type A product and Allergan began marketing and selling the *Botox* under the *Botox* brand name, in or around January 1991. On 31st December, 1990, an application was filed by Allergan in the United States for the word mark BOTOX in relation to the following goods in Class 3: "Pharmaceutical preparations; namely, ophthalmic muscle relaxants". This Mark was registered on 9th June, 1992, under Registration No. 1692384. A second application for the word Mark 'BOTOX' followed on 6th February, 1991, and was registered on 18th August, 1992, in relation to "Pharmaceutical preparations for the treatment of neurological disorders", in Class 5 (under Registration No. 1709160). The first named plaintiff owns in excess of 400 word and logo Trademark registrations for the *Botox* brand in 110 countries or regions around the world. In Ireland, the first named plaintiff owns Trademark Registration No. 149845 in Class 5 in respect of "Pharmaceuticals for the therapeutic treatment of neurological disorders and muscle dystonias". Of particular relevance to this action is the fact that the first named plaintiff is the registered proprietor of the following community Trademarks:-

(a) Community Trademark No. 2015832 'BOTOX ®' device which is registered in Class 5 for "Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, Cerebral Palsy, spasms, tremors and pain";

(b) Community Trademark No. 2575371, "It's not magic, its BOTOX®", device which is registered in Class 5 for "Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, sports injuries, Cerebral Palsy, spasms, tremors and pain."

(c) Community Trademark No.1923986 "BOTOX® as Botulinum Toxin Type A Purified Neurotoxin Complex" device which is registered in Class 5 for "Pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhidrosis, Cerebral Palsy, spasms, tremors and pain", and in Class 16 for "printed educational materials"; and

(d) Community Trademark No. 3700317 'BOTOX®' which is registered in Class 3 for "Cosmetics; face creams and lotions; skin creams and lotions".

## **BOTOINA**

12. BOTOINA is a cosmetic product manufactured by Labo Europa SRL., and is distributed in the State by the defendant. Under the 'BOTOINA' brand, a line of wrinkle treatment cosmetics is sold. The product is sold on the basis that the user first applies cream which is contained in a glass bottle or vial, with a precision applicator, and then applies a day cream, a night cream and an eye contour cream from tubes. These cosmetics are marketed in different concentrations, depending on the depth of the wrinkles or facial lines. The bottle, or vial, of cream is packaged in a box which contains three patented cosmetic precision applicators. These are made up of a graduated pipet and a metal elbow-shaped cannula with a rounded edge. The defendant and Labo Europa SRL ("Labo") contends that the patented precision applicator is to enable the user to accurately and completely distribute the cream contained in the bottle onto the wrinkles. It has to be left on the wrinkles for ten minutes before massaging into the skin.

13. BOTOINA is advertised in the print media and also in selected pharmacies. Samples of newspaper advertisements and magazine advertisements were furnished to the court. The newspaper ads for the product consist of a black and white photograph of a syringe-like object under the heading:

"BOTOINA:

no more wrinkles".

The advertisement is contained within the boundaries of a thin black line and is clinical in appearance. It is not at all the type of glossy advertisement one would normally associate with a cosmetic product. The template used for magazine advertising also contains a large picture of the syringe-type applicator together with four small photographs indicating how the applicator would be used to apply the product to wrinkles on the face. The court was also furnished with copies of larger advertisements which would be placed in pharmacies where BOTOINA was on sale. The dominant feature of almost all the advertisements was the syringe-like applicator. A display stand (Exhibit P) containing a vial and three syringe-like applicators together with a shelf or drawer containing booklets on the product was also produced.

14. The plaintiffs claim that the defendant's product infringes their Trademark and also that the get-up of the product is calculated to cause confusion in the minds of people who would be using the product.

## **The law**

15. Article 9 (1) of Council Regulation (EC) No. 44/94 provides:

"A Community Trademark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(a) Any sign which is identical with the Community Trademark in relation to goods or services which are identical with those for which the Community Trademark is registered;

(b) Any sign where, because of its identity with or similarity to the Community Trademark and the identity or similarity of the goods or services covered by the Community Trademark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the Trademark . . ."

16. It is accepted by the plaintiffs that 'BOTOINA' is not identical to 'BOTOX' and that Article 9 (1) (a) does not apply. Decisions of the European Court of Justice have established certain clear principles regarding how an allegation of infringement should be assessed (see *Sabel B.V. v. Puma A.G* C-251/95, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* C-39/97, and *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijnsen Handel B.v.* C-342/97).

17. The principles set out in these decisions were endorsed by Finlay Geoghegan J. in the case of *Confresco Frischalterprodukte GmbH & Co. KG v. Controller of Patents* [2007] 2 I.L.R.M. 430 at 433. In that case, the learned trial judge was considering s.10 (2) (b) of the Trademarks Act 1966, which provides:

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

The section is similar to Article 9 (1) (b) of Community Regulation (EC) No. 40/94. At p. 433 of her judgment, she endorsed the written submissions filed on behalf of *Confresco* which summarised the decisions of the European Court of Justice as follows:

"1 In determining and assessing the likelihood of confusion for the purpose of section 10(2) (b), account must be taken of all the circumstances of the case, including the degree of similarity between the two marks and between the goods or services, the likelihood that the public will make an association between the earlier mark and the mark in respect of which registration is sought, and the distinctiveness of the earlier mark. [Case C-251/95 *Sabel BV v. Puma AG* [1997] 1 E.C.R. I-06191 (paragraph 22)].

2 In assessing the degree of similarity between two marks, the decision maker must determine the degree of visual, aural and conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed. [Case C-342/97 *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijnsen Handel BV* [1999] E.C.R. I-03819 (paragraph 27)] For this purpose the average consumer is deemed to be reasonably well informed, reasonably observant and circumspect. [*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijnsen Handel BV* (paragraph 26)]

3 The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components,. Each mark must be viewed as a whole and should not be dissected for the purposes of a comparison. This is because the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. [*Sabel BV v. Puma AG* (paragraph 23)]

4 The higher the degree of distinctiveness of the earlier trade mark the greater the protection granted to it and vice versa. [*Sabel BV v. Puma AG* (paragraph 24); Case C-39/97 *Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc* [1998] E.C.R. I-05507 (paragraph 18)] Distinctiveness may be inherent or enhanced by a reputation which the mark enjoys on the market. [*Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc.* (paragraph 18)]."

18. Finlay Geoghegan J. accepted that a judge is entitled to bring to bear his/her own experience as a consumer or potential buyer of a product in assessing the likelihood of deception, thereby following the principles set out by Lord Diplock in the case of in *Re. GE Trademark* [1973] R.B.C. 297 at 321. It seems to me that this is the correct approach. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* Case C-39/97, the European Court of Justice held that there is a likelihood of confusion where the public have been mistaken as to the origin of the goods and services in question. In *Alcon Inc. v. OHIM* Case C-412/05, the European Court of Justice held that:

"55. . . the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8 (1) (b) of Regulation Number 44/94 (see to that effect *Canon*, paragraph 29, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] E.C.R. I-3819, paragraph 17)."

In the same case, the court held that the fact that intermediaries such as healthcare professionals are liable to influence, or even to determine, the choice made by the end-users is not, in itself, capable of excluding all likelihood of confusion on the part of those consumers as regards the origin of the goods at issue (see para. 57 of judgment). In the present case, it is clear from the evidence that BOTOX is administered by registered medical practitioners or dentists or others with medical training. But the end-users of the product (when used for cosmetic purposes) are those members of the public who wish to remove wrinkles from their face or ameliorate their effect. It is the same group who are the end-users of the BOTOINA product which is specifically advertised for the reduction of wrinkles. Indeed, more often than not, on advertising posters the words "BOTOINA - Wrinkles" appear together. The way in which a Trademark is perceived in the mind of the average consumer of the category of goods or services in question is important in assessing the likelihood of confusion. In general, the average consumer rarely has a chance to make a direct comparison between the different signs but must rely on an imperfect recollection of them. It can be assumed that persons using a product such as BOTOX or BOTOINA would be reasonably well informed because one does not agree to the injection of a substance into the muscles of the face or the application of creams or lotions to the face without having given some thought to the consequences. Furthermore both products are expensive and one would expect the consumers to exercise some discernment in choosing them. The end-users of BOTOX (where used for cosmetic purposes) and BOTOINA are, broadly speaking, the same.

19. The defendant relies on the provision of s.15 (1) of the Trademark Act 1966, which provides:

"A registered Trademark shall not be infringed by the use of another registered Trademark in relation to goods or services

for which the latter is registered, but subject to section 52 (6)."

20. The defendant relies on the fact that the sign 'BOTOINA' has been registered as a Trademark in this jurisdiction in Class 3 or "Cosmetics; face creams and lotions; skin creams and lotions" and that the defendant is a licensee of that Trademark in this jurisdiction. Section 7 (1) of the 1996 Act provides:

"A registered Trademark is the property right obtained by the registration of the Trademark under this Act and the proprietor of a registered Trademark shall have the rights and remedies provided by this Act."

21. In circumstances where the plaintiffs are the holder of a Community Trademark giving them exclusive rights therein, the court will have to determine what is the effect of the registration of a Trademark under national law where the owner of the national Trademark justifies the use of same by virtue of its national registration.

#### Passing Off

22. In *B&S Ltd. v. Irish Auto Trader Ltd.* [1995] 2 I.R. 142 at 144, McCracken J. adopted the speech of Lord Diplock in *Erven Warnink Bv. v J. Townend & Sons (Hull)* [1979] A.C. 731 at p.742, as identifying the characteristics of passing off as:-

"(i) A misrepresentation,

(ii) made by a trader in the course of trade

(iii) to prospective customers of his or ultimate consumers of goods or services supplied by him

(iv) which is calculated to injure the business or goodwill of another trader (in the sense that it is a reasonably foreseeable consequence) and

(v) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a *quaintmet* action) will probably do so."

23. I would adopt this as a proper definition of passing off. I would also adopt the definition of Budd J. in *Polycell Products Ltd. v. O'Carroll* [1959] Ir. Jur. Rep. 34 at 36 where he said:

"To establish merchandise in such a manner as to mislead the public into believing it is the merchandise or product of another is actionable. It injures the complaining party's right of property in his business and injures the goodwill in his business. The person who passes off the goods of another acquires, to some extent, the benefit of the business reputation of the rival trader and gets the advantage of his advertising."

24. It has long been accepted that the courts, in an action for passing off, should look at the "get-up" of the product and the manner in which it is presented to the public or to consumers of the product. In such an action, it is not necessary for the plaintiff to prove that the defendant consciously or deliberately set out to cause confusion. The defendant's state of mind is irrelevant to the existence of the cause of action of passing off (see Laffoy J. in *Guinness Ireland Group v. Kilkenny Brewing Co. Ltd.* [1999] 1 I.L.R.M. 531 at 537). At the end of the day, each Mark must be viewed as a whole and should not be dissected for the purposes of a comparison. Equally, a global view should be taken of the manner in which the product is presented to the public. If the plaintiffs establish that the product, BOTOINA, is being sold and marketed in such a manner as to mislead the public into believing that it is the product of the plaintiffs, or is connected with the plaintiffs' business, and this is done in a way which is calculated to injure the business or goodwill of the plaintiffs or cause them actual damage, then the plaintiffs' claim for passing off will be established.

#### The evidence

25. I have already set out at the beginning of this judgment the history of BOTOX and how it is a highly purified form of Botulinum Toxin Type A used in a particular concentration, specific to the product, and administered by a micro needle and syringe. I have also set out, in broad terms, the manner in which BOTOINA anti-wrinkle cream is sold and used by purchasers. I am satisfied on the evidence that BOTOX and BOTOINA are marketed to the same consumers and will be sought by persons who are seeking to eliminate or ameliorate the effect of wrinkles or lines on the face. Although BOTOX is a pharmaceutical product and can only be administered by someone with medical training, it is, in fact, used for cosmetic purposes. The fact that it has to be administered by a medically competent person is relevant only to the extent that it may dispel any confusion that might arise between it and other products used for the same cosmetic purpose and, in particular, BOTOINA. The defendant contends that BOTOX is a weak Mark and has acquired a generic quality. I accept the evidence of Professor Brin that he invented the name BOTOX for Dr. Alan Scott's original formulation of Botulinum Toxin Type A in a purified form. Professor Brin denies that BOTOX is an acronym for Botulinum Toxin. I have my doubts about that, but I am satisfied that he coined the word to describe a particular formulation of Botulinum Toxin Type A which was the formulation prepared by Dr. Scott. I reject the contention of the defendant that it is a weak Mark or that is generic. Mr. Edward Sauerman, who is employed by Allergan Ltd. as Vice President and General Counsel for the Eurasia region, gave evidence that the first named plaintiff is required by the regulatory authorities of a number of countries to market the BOTOX product for licensed cosmetic use under a name that distinguishes it significantly from the name used in relation to therapeutic treatments. The name VISTABEL was adopted for a number of EU countries and his evidence is to the effect that when the plaintiffs receive a licence from the Irish Medicines Board to allow them to market the product for cosmetic purposes, it will not be marketed under the name of BOTOX, but rather the name VISTABEL, because they could not lawfully market BOTOX using the mark that was registered in Ireland in August 2006. Furthermore, BOTOX is a medicinal product which has many uses as outlined earlier in this judgment and is used in an "off-label" context for cosmetic purposes. The plaintiffs argue that they have, in any event, registered the Trademark BOTOX in its various forms for pharmaceutical use and that it has established a reputation in many countries for its cosmetic use. The evidence establishes that this is clearly so. It therefore does not seem to me to be a matter of great importance that BOTOX is not marketed as a Class 3 product since the question still remains as to whether or not the defendant's mark is likely to cause confusion, or that the "get-up" of the defendant's product is such as to cause confusion and enable the defendants to derive a commercial benefit from the goodwill which has been established in the plaintiffs' product, BOTOX.

26. Evidence given to the court establishes that the plaintiffs have made very substantial profits out of the sale of BOTOX. In 1997, the worldwide net sales for the product were US\$90.1 million. By 2005, this figure was US\$830.9. In 2005, 43% of the consolidated BOTOX net sales were used for cosmetic purposes. In Ireland, the approximate annual sales for BOTOX in 1999 were €117,832 and by 2005 this figure had risen to €495,482. In 2004, the number of vials of BOTOX sold in Ireland for cosmetic use was approximately 1,300. This had risen to 2,760 by 2007.

27. Conflicting evidence was given by witnesses for the plaintiffs and the defendant on the efficacy of the product, BOTOINA and the

effectiveness of the application of the serum or cream by a precision applicator. It is not necessary for me to reach a conclusion on this evidence in order to determine the issues between the parties. Since the issue I have to decide is whether or not that the use of the name BOTOINA amounts to a Trademark infringement, or that the defendant is guilty of passing off, the issue as to the efficacy of the product is not relevant save as to the effect it might have on the Plaintiff's reputation if people used BOTOINA, thinking that it was a product connected with the plaintiffs, and were dissatisfied with it.

### **Visual, aural, and conceptual similarity.**

28. I turn now to the assessment of the degree of visual, aural and conceptual similarity between the products in issue in this case, following the principles set out in the case of *Confresco Frischalterprodukte GmbH & Co. KG v. Controller of Patents* [2007] 2 I.L.R.M. 430.

### **Visual similarity**

29. It seems to me that there is significant visual similarity between the words BOTOX and BOTOINA. The first four letters of each product are the same. I believe the correct approach in assessing the visual simplicity is to adopt the method employed by Smyth J. in *Unilever plc. v. Controller of Patents* [2007] 2 I.L.R.M. 389, where he stated at p. 397:

"Whether two words are used or a compound word is used, if the emphasis is clearly on the first word or prefix in the compound word, then it seems to me that that is the predominant sound and the visual impact of the Mark."

### **Aural similarity**

30. The first part of the words BOTOX and BOTOINA sound quite similar insofar as the first three letters of each word are pronounced the same way as the word 'boat'. In each word the accent is on the first syllable and I hold that there is an aural or phonetic similarity between the words.

### **Conceptual similarity**

31. 'BOTOX' and 'BOTOINA', being invented words without any ordinary everyday meaning, do not seem to be capable of conceptual similarity other than by assessing them by reference to the overall impressions created by the Mark, bearing in mind their distinctive and dominant components. They cannot be considered in the same way that the Marks "RESPICUR" and "RESPICORT" were considered in the case of *Mundipharma AG OHIM Case T-256/04*. In that case, the court said:

"Next, the court notes that, in the present case, the conceptual perception of the opposing Marks will be different for the two groups making up the relevant public. The professional public, because of its knowledge and experience, will generally be able to understand the conceptual meaning of the term referred to by the different components of the opposing Marks, namely, 'respiratory' for 'respi', 'cure' or 'heal' for 'cur' and 'corticoids' for 'cort'. Thus, by breaking down the two Marks into their respective components, they will interpret the Mark applied where it is corresponding to a 'cure for respiratory problems' and the earlier Mark as designating 'corticoids intended for respiratory illnesses'."

In my view, no similar conceptual analysis could take place between the words 'BOTOX' and 'BOTOINA'. Dr. Montanari has given evidence that the word BOTOINA was chosen because it was believed that it gave a feeling of wellbeing, promoting the idea of beauty. She said that the first syllable containing the letters "Bo" is identical to the pronunciation of the French word "beau" meaning beautiful. I found that evidence to be unconvincing. In any case, it seems to me that the consumers or users of BOTOINA in Ireland are unlikely to make that connection.

### **Identity and/or similarity of the goods**

32. On one level it could be said that BOTOX and BOTOINA are quite different insofar as BOTOX consists of a very small amount of powder contained in a glass vial, whereas BOTOINA is a serum or cream in a glass vial. But there are many similarities in the way the products are presented. BOTOX is contained in powder form in a minute quantity in a glass vial which is then diluted with solution, before being drawn off by syringe and injected. BOTOINA is a serum or cream in a vial which is drawn off into a syringe-like applicator and applied to the wrinkles or lines on the face which are to be treated. Both products are used for the reduction or amelioration of wrinkles or lines on the face. In the mind of persons seeking such treatment, BOTOX has a well established reputation and there can be no doubt that BOTOINA seeks to capture the same market since it is presented as a cosmetic for the treatment of wrinkles. There is, therefore, an obvious link between the two products. If the marketing and sale of BOTOINA by the defendant is likely to cause confusion with the plaintiffs' product so as to suggest that the goods or services in question come from the same undertaking or from economically linked undertakings, then a Trademark infringement will be established.

33. Although motive is irrelevant, I cannot ignore some of the material that was made available to the Court through the defendant's discovery. Extensive communication by email took place between the defendant and Labo Europa concerning the Press Release to be issued in the marketing of BOTOINA in Ireland. The earlier drafts of the Press Release made references to BOTOINA being "a home-care alternative to BOTOX" and contained references to Botulinum Toxin. Admittedly, the references to Botulinum Toxin were in the context of BOTOINA being a cosmetic product which does not contain Botulinum Toxin. The defendant received advice that it would have to be very careful in using the word BOTOX of Botulinum Toxin. The actual Press Release omitted all references to Botulinum Toxin.

34. The manual produced for pharmacies, which was discovered by the defendant, showed in one document "the development stages behind BOTOINA" and indicated that the research contained three stages. These are stated to be as follows:

"1st Stage Botulinum toxin Surgical operations

2nd Stage Botulinum toxin

For aesthetic use Aesthetic micro-injections

3rd Stage BOTOINA Cutaneous

applications".

The same document goes on to deal with Botulinum Toxin and its use in the cosmetic environment and then goes on to describe BOTOINA, where the document states:

"Leading cosmetic research establishments have undertaken many studies in an attempt to achieve results similar to

those obtained by injecting Botulinum Toxin by using non-invasive application of cosmetic preparation.”

35. It is quite clear from these extracts that the defendants perceived that a connection might be made between Botulinum Toxin and the product BOTOINA. All of this suggests that the manufacturers of the product, and the defendant, were trying to create an interface between BOTOX and BOTOINA which would be somewhat blurred. This is a factor which I am entitled to take into account in deciding whether or not the use of the word BOTOINA and the marketing of that product were likely to cause confusion, notwithstanding the fact that the defendant's intentions are irrelevant in deciding whether or not there was an infringement or passing off.

### **Conclusion**

36. I am satisfied that, since the plaintiffs are the holder of a Community Trademark, giving them exclusive rights therein, that the defendants' defence under s. 15 (1) of the Trademark Act 1986, cannot succeed. The "Registered Trademark" referred to in s. 15 is a Trademark registered under the 1996 Act and not a Community Trademark.

37. Having regard to the legal principles applicable to this case, and having regard to the evidence, I am of the view that the use of the mark BOTOINA creates a likelihood of confusion with the plaintiffs' mark where the relevant members of the public could be mistaken as to the origin of the goods. I have reached this conclusion by considering the visual, aural and conceptual similarities of the Marks in viewing each Mark as a whole and having regard to the purpose for which each is intended and the end-users who are targeted by the parties to the action. I therefore hold that the plaintiffs have infringed the Plaintiffs' Community Trade Mark number 2015832 "BOTOX" and Community Trade Mark number 3700317 "BOTOX", being the class 5 and class 3 marks respectively.

38. I am also satisfied that, having regard to the overall "get-up" of the BOTOINA product and the marketing of it with particular emphasis on a syringe-like applicator, that it is likely to cause confusion and that its sale and/or marketing is done in such a manner as is likely to cause confusion and to mislead the public into believing that the product sold by the defendant has some connection with the plaintiffs and their product, BOTOX. I have no doubt that the effect of this is to enable the defendant to "piggy back" on the goodwill which has been established in the product BOTOX. I do not have to consider whether the "get-up" of BOTOINA was deliberately designed to cause confusion in the minds of the public or to mislead them because, as I have stated earlier in this judgment, it is well settled that the defendant's state of mind is wholly irrelevant to the existence of a cause of action of passing off. Whether or not the choice of name of the product, BOTOINA, and the use of a precision applicator which looks like a syringe and the storage of the serum in a glass vial with some similarity to the plaintiffs' product, BOTOX, were intended to cause confusion, is irrelevant. What I have to decide is whether or not the get-up of the product, BOTOINA, as sold and marketed, is likely to lead those members of the public, seeking such a product, to the belief that the goods are those of the plaintiff, or connected with the plaintiffs' business. It seems to me that the entire way in which BOTOINA is marketed – as an anti wrinkle product, in a glass vial, to be applied using a syringe-like applicator, and with a name that has aural and visual similarities – is calculated to cause confusion, and presents the product in a way which is likely to mislead the public into believing it is connected in some way with BOTOX. I hold that on the facts of this case, the plaintiffs have established that the defendant is guilty of passing off. The plaintiffs, therefore, succeed on both grounds of their claim, namely, the Trademark infringement and the passing off.

39. The parties have left over the issue of damages and the nature of the relief to be granted until my determination of the issues on infringement and passing off. I will hear the parties on the form that the order should take.