

BIOMEDIS INC.,

Petitioner,  
- versus -

CHESI FARMACEUTICA S.P.S.,  
Respondent-Applicant.

x-----x

IPC NO. 14-2010-00107

Opposition to:  
Appln. Serial No.:4-2007-0012547  
Date Filed: 12 November 2007

TM: "ATIMOS"

Decision No. 2011-83

## DECISION

Biomedis, Inc. ("Opposer") filed on 07 August 2007 an opposition to Trademark Application No. 4-2007-0012547. The application, filed by Chiesi Farmaceutica S.P.A ("Respondent-Applicant"), covers the mark "ATIMOS" for use on "pharmaceutical preparation for the treatment of respiratory diseases" under Class 05 of the International Classification of Goods.

The Opposer alleges among other things the following:

1. The Trademark 'ATIMOS' so resembles 'ATEPROS' trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark 'ATIMOS'. The trademark 'ATIMOS', which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'ATIMOS' is applied for the same class of goods as that of trademark 'ATEPROS', i.e. Class (5).

2. The registration of the trademark 'ATIMOS' in the name of the Respondent will violate Section 123 Republic Act No. 8293, otherwise known as the 'Intellectual Property Code of the Philippines', which provides, in part, that a mark cannot be registered if it:

x x x

3. Respondent's use and registration of the trademark 'ATIMOS' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "ATEPROS".

4. Opposer, the registered owner of the trademark 'ATEPROS', is engaged in the marketing and sale of wide range of pharmaceutical products. The Trademark Application for the trademark 'ATEPROS' was filed with the Intellectual Property Office on 2 October 2006 by Opposer and was approved for registration by this Honorable Office on 3 September 2007 and valid for a period of ten (10) years. Hence, Opposer's registration of the 'ATEPROS' trademark subsists and remains valid to date. x x x

5. The trademark 'ATEPROS' has been exclusively used in commerce in the Philippines. x x x

5.3 In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, Opposer registered the product with the Bureau of Food and Drugs (BFAD). x x x

6. There is no doubt that by virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark 'ATEPROS' and the fact that it is well known among consumers, the Opposer has acquired an exclusive ownership over the 'ATEPROS' mark to the exclusion of all others.

7. 'ATIMOS' is confusingly similar to 'ATEPROS'.

7.1 There are no set of rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or it is a colorable imitation of, another. Nonetheless, jurisprudence provides enough guidelines and tests to determine the same.

x x x

7.1.4 Applying the dominancy test, it can readily be concluded that the trademark 'ATIMOS', owned by Respondent, so resembles the trademark 'ATEPROS', that it will likely cause confusion, mistake and deception on the part of the purchasing public.

7.1.4.1 First, 'ATIMOS' sounds almost the same as 'ATEPROS';

7.1.4.2 Second, the first two (2) syllables of both marks are almost the same 'A-TI' and 'A-TE';

7.1.4.3 Third, the last two letters of both marks are the same 'O-S';

7.1.5 Clearly, the Respondent adopted the dominant features of the Opposer's mark 'ATEPROS';

x x x

7.2 The trademark 'ATEPROS' and Respondent's trademark 'ATIMOS' are practically identical marks in sound and appearance that they leave the same commerce impression upon the public.

7.2.1 Thus, the two marks can be easily confused for one over the other, most especially considering that the opposed trademark 'ATIMOS' is applied for the same class and goods as of that trademark 'ATEPROS', i.e. Class (5), to the Opposer's extreme damage and prejudice.

7.3 Yes, Respondent still filed a trademark application for 'ATIMOS' despite its knowledge of the existing trademark registration of 'ATEPROS' which is confusingly similar thereto in both its sound and appearance.

8. Moreover, Opposer's intellectual property right over its trademark is protected under Section 147 of Republic Act 8293, otherwise known as the Philippine Intellectual Property Code ('IP Code'), which states: x x x

9. To allow Respondent to continue to market its product bearing the 'ATIMOS' mark undermines Opposer's right to its marks. As the lawful owner of the mark 'ATEPROS', Opposer is entitled to prevent the Respondent from using a confusingly similar mark in the course of trade likelihood of confusion.

9.1 Being the lawful owner of 'ATEPROS', Opposer has the exclusive right to use and/or appropriate the said marks and prevent all third parties not having its own consent from using in the course of trade identical or similar marks, where such would result in a likelihood of confusion.

9.2 By virtue of Opposer's ownership of trademark 'ATEPROS', it also has the right to prevent third parties, such as Respondent, from claiming ownership over Opposer's marks or any depiction similar thereto, without its authority or consent.

9.3 Moreover, following the illustrative list of confusingly similar sounds in trademarks which the Supreme Court cited in *McDonald's Corporation, McGeorge Food Industries, Inc. vs. Big Mak Burger, Inc.* 437 SCRA 268 (2004), it is evident that the mark 'ATIMOS' is aurally confusingly similar to Opposer's mark 'ATEPROS'.

9.4 To allow Respondent to sue its 'ATIMOS' mark on its product would likely cause confusion or mistake in the mind of the public or deceived purchasers into believing that the 'ATEPROS' product of the Respondent originate from or is being manufactured by Opposer, or at the very least, is connected or associated with the 'ATEPROS' product of the Opposer, when such connection does not exist.

9.5 In any event, as between the newcomer, Respondent, which by confusion loses nothing and gains patronage unjustly by the association of its products bearing the 'ATIMOS' mark with the well-known 'ATEPROS' mark, and the first user and actual owner of the well-known mark, Opposer, which by substantial investment of time and resources and by honest dealing has already achieved favor with the public and already possesses goodwill any doubt should be resolved against the newcomer, Respondent, considering that Respondent, as the latter entrant in the market had a vast range of marks to choose from which sufficiently distinguish its products from those existing in the market.

10. By virtue of Opposer's prior and continued use of the trademark 'ATEPROS', the same have become well-known and established valuable goodwill to the consumers and the general public as well. The registration and use of Respondent's confusingly similar trademark on its goods will enable the latter to obtain benefit from Opposer's reputation, goodwill and advertising and will tend to deceive and/or confuse the public into believing that Respondent is in any way connected with Opposer.

11. Likewise, the fact that Respondent seeks to have its mark 'ATIMOS' registered in the same class (Nice Classification 5) as the trademark 'ATEPROS' of Opposer will undoubtedly add to the likelihood of confusion among the purchasers of these goods.

12. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent of the trademark 'ATIMOS'. In support of the foregoing, the instant Opposition is herein verified Mr. Dante Sibug which likewise serves as his affidavit (*Nasser v. Court of Appeals*, 191 SCAR 783 [1990]).

The Respondent-Applicant filed its Answer on 13 January 2009, alleging among other things, the following:

4. Chiesi Farmaceutica S.P.A. is a juridical entity and existing under the laws of Italy, with business address at Via Palermo 26/A 43100 Parma, Italy. It is a pharmaceutical company founded in 1935, now with global operations consisting of 22 direct affiliates, 3 manufacturing sites, and 3 research centers. It has over 3,000 employees worldwide.

5. Its production plants are located in three different sites: Officine Farmaceutiche di Parma (Italy), with 400 staff members, split into the San Leonardo and

the via Palermo sites, the Blois-La Chausee plant in Saint Victor (France), with more than 50 employees, and the Santana de Parnaiba plant (Brazil), with 100 workers.

6. Chiesi Farmaceutica SPA manufactures pharmaceutical products designed to treat respiratory, cardiovascular, neonatology, and musculo-skeletal diseases. Its main products are marketed and sold under the brands FOSTER, CLENIL, ATIMOS, BRAMITOB, CLIPPER, CUROSURE, BREXIN, and IPERTEN.

7. ATIMOS is pMDI formulations of formoterol fumarate based on Modulite technology, indicated for the long-term treatment of both asthma and chronic obstructive Pulmonary Disease (COPD). Considered the best overall LABA on the market, due to its remarkably fast onset of action associated with long-term duration (up to 12 hours), ATIMOS guarantees optimal lung deposition even in the peripheral airways with its unusually extra fine particle size, thus enabling the disease to be uniformly treated. As a result, ATIMOS has a superior bronchodilating effect and is as effective as other formoterols in DPI formulation. Moreover, it is also safe and well-tolerated compared to other pMDI and DPI formoterol formulations. The product is currently marketed in all the major European countries, where it performed positively in 2007 on a Chiesi group basis.

8. Chiesi Farmaceutica SPA has been using the mark ATIMOS since March 2004. For the years 2006 and 2007, sales of ATIMOS products in the European Union countries (including Italy) amount to Euro 5,732,000 and Euro 6,351,000 respectively.

9. The mark ATIMOS was first filed in Italy on 30 July 2003 and granted under an Italian Trademark Registration Certificate No. 00917798 dated 5 November 2003.

10. The mark is also protected by an International Trademark Registration issued by the World Intellectual Property Organization under International Registration No. 816749 dated 5 November 2003. This registration covers the following designated countries: Austria, Bulgaria, China, Croatia, Czech Republic, Egypt, France, Hungary, Latvia, Morocco, Poland, Portugal, Romania, Russian Federation, Serbia and Montenegro, Slovakia, Slovenia, Spain, Ukraine, Estonia, Greece, Lithuania, Turkey, United Kingdom, Albania, Australia, Benelux, Denmark, Algeria, Iran, Sudan, Syrian Arab Republic, Vietnam, Belarus, Georgia, and Republic of Korea.

11. In addition, Chiesi Farmaceutica SPA has applied and/or secured registration for ATIMOS in the following countries: Argentina, Canada, Chile, Colombia, Venezuela, South Africa, Tunisia, Taiwan, Hong Kong, Israel, Jordan, Kuwait, Lebanon, Saudi Arabia, Singapore, Sri Lanka, Thailand, United Arab Emirates, Yemen, Malaysia, and New Zealand.

12. Chiesi Farmaceutica SPA repleads all the foregoing allegations by reference and in further support pleads as defenses the following:

*Chiesi's trademark ATIMOS is not  
Confusingly similar to Biomedis'  
Trademark ATEPROS*

-----  
12.1 The trademark ATIMOS is not confusingly similar to the mark ATEPROS as to be likely to cause confusion, mistake, and deception on the part of the purchasing public.

12.2 In the case of Mead Johnson & Company vs. N.V.J. Van Drop, Ltd., et al., the Supreme Court held that 'in determining whether two trademarks are confusingly similar, the two marks in their entirety as they appear in the respective labels must be considered in relation to the goods on which they are

attached. The discerning eye of the observer, must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other.

12.3 In this case, N.V.J. van Dorp applied to register its trademark ALASKA, which was opposed by Mead Johnson on the basis of its trademark ALACTA. The Supreme Court held that there were no confusing similarity between ALASKA and ALACTA, explaining that while 'there are similarities in spelling, appearance and sound for both are composed of six letters of three syllables each and each syllable has the same vowel, but in determining if they are confusingly similar a comparison of said words is not the only determining factor. The two marks in their entirety as they appear in the respective labels must also be considered in relation to the goods to which they are attached.

12.4 In resolving the issue of confusing similarity between the two marks, the class of persons and the nature of the goods should be considered. Thus, in Etepha A.G. vs. Director of Patents and Westmont Pharmaceuticals, Inc. the Supreme Court ruled that: x x x

12.5 Applying Supreme Court ruling here, there is no probability of confusion that can exist between the marks ATIMOS and ATEPROS for the reason stated below, viz..

12.5.1 First, ATIMOS is to be used on "pharmaceutical preparations for the treatment of respiratory diseases under Nice Classification 5; ATEPROS, on the other hand, issued 'for treatment of respiratory diseases under Nice Classification 5; ATEPROS, on the other hand, is used 'for treatment of symptomatic benign prostatic hyperplasia in men with enlarged prostate.

12.5.2 Second both marks contain different generic active ingredients. ATIMOS contains 'FORMOTEROL FUMARATE'; while ATEPROS contains 'FINASTERIDE'.

12.5.3 Third, both marks are used on pharmaceutical products that are dispensed under a medical prescription only.

12.5.4 Fourth, ATEPROS printed label (see Annex 'C') shows its formulation, indications, dosage and administration, treatment, side effects, precautions, warning, storage, presentation, name and address of manufacturer and importer, and generic counterpart. These matters are important points that will distinguish ATEPROS from ATIMOS.

12.5.5 In like of these differences, possibility of confusion among the intended buyers is remote if not nil.

12.4 (sic) Relevantly, Generics Act of 1988 requires that medicines and pharmaceutical and preparation be dispensed to the consuming public only under medical prescription. Also, entities selling these medicines and pharmaceutical preparations are mandated to inform the consumer public of the generic counterpart. Thus, these requirements will eliminate possibility of confusion among the consuming public involving ATIMOS and ATEPROS medicines and pharmaceutical preparations.

12.5 (sic) Section 6, paragraphs (b), (c) and (d) of the Generics Act of 1988, as amended by Republic Act 9502, read as follows: x x x

12.6 (sic) The present case mirrors that of *Bristol Myers Company vs. The Director of Patents and United American Pharmaceuticals, Inc.* x x x

12.7 (sic) Again, the Supreme Court ruled in *American Cyanamid Co. vs. Director of Patents and Tiu Chian* that the trademark SULMETINE was not confusingly similar to SULMET, both marks were used on veterinary products. x x x

12.8 (sic) Additional safeguard to avoid possibility of trademark confusion has been added in the Pharmacy Law (Republic Act 59211) by Republic Act 9502 (An Act Providing for Cheaper and Quality Medicines). The recent amendment prohibits the sale of prescriptive pharmaceutical products and medicines outside a prescription drugstore or hospital pharmacy. A drugstore or pharmacy will, therefore, guide the consuming public of the correct medicine to purchase. This effectively erases any possibility of confusion between two pharmaceutical products. Consequently, one buying an ATEPROS medicine to treat an enlarged prostate will not be confused with ATIMOS that is issued to treat respiratory disease.

Should the Respondent-Applicant be allowed to register the mark ATIMOS?

Sec. 123.1(d) of the Intellectual Property Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or of it nearly resembles such a mark as to be likely to deceive or cause confusion.

In this regard, record shows that at the time the Respondent-Applicant filed the contested application on 12 November 2007, the Opposer has an existing trademark registration for the mark ATEPROS. However, this Bureau finds that the mark ATIMOS is not confusingly similar to ATEPROS.

The competing marks are used on different pharmaceutical products. The registration of ATEPROS covers drugs for the *“treatment and control of benign prostatic hyperplasia and for the prevention of urologic events to reduce the risk of acute urinary retention and reduce the risk of the need of surgery including transurethral resection of the prostate and prostatectomy”*, while the Respondent-Applicant’s application covers *“pharmaceutical preparation for the treatment of respiratory disease”*.

Even if we consider the parties’ respective goods related because these are pharmaceutical products, confusingly similarity is still unlikely. The competing marks can easily be distinguished from one another. Both marks start with the letters “A” and “T” and ends with “O” and “S”. However, the similarity in looks and sounds end there. The combination of the letters “I”, “M”, “O” and “S” to form syllables “IMOS” has given the Respondent-Applicant’s mark a visual representation and aural properties that are so different from the combination of the letters “E”, “P”, “R”, “O” and “S” in the Opposer’s mark. The fact that the pharmaceutical products on which the competing marks are used are dispensed through prescription further renders confusion as to sound improbable.

If the marks are placed side-by-side, the eyes are drawn to the middle letters, with the letters “A” and “O” and “S” at the extremities glossed over. This can be attributed to the stark contrast between the appearances of the letters “I” and “M” in the Respondent-Applicant’s mark, and the letters “E”, “P” and “R” in the Opposer’s, and thus making it unlikely for a sales clerk to commit mistake in reading the physician’s prescription.

The essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are

procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.

In this instance, the Respondent-Applicant's mark point out distinctly the origin or ownership of the goods on which the mark is used. There is no evidence that the Respondent-Applicant is choosing or in coming of the mark ATIMOS could have been inspired by, or motivated by intention to copy or imitate, the Opposer's mark. The Respondent-Applicant has been using the mark and caused its registration in other countries as early as 2003.

Accordingly, this Bureau finds no cogent reason to deny the Respondent-Applicant the registration of its mark ATIMOS.

WHEREFORE, premises considered, the instant opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2007-0012547 be returned, together with the copy of this Decision, to the Bureau of Trademarks, for information and appropriate action.

SO ORDERED.

Taguig City, 27 October 2011.

ATTY. NATHANIEL S. AREVALO  
Director, Bureau of Legal Affairs  
Intellectual Property Office