

PLATINUM PHARMACEUTICAL
PVT. LTD.

Opposer,
-versus-

FOURNIER INDUSTRIE ET SANTE
S.A.S.,

Respondent-Applicant.

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IPC NO. 14-2009-00178

Opposition to:
Reg. No. 4-2008-015053
(Filing Date: 15 December 2008)

TM: TRILIPIX

Decision No. 2011-68

DECISION

PLATINUM PHARMACEUTICAL PVT. Ltd., (“Opposer”), filed on 21 July 2009 on opposition to Trademark Application Serial No. 4-2008-015053. The application, filed by FOURNIER INDUSTRIE ET SANTE S.A.S. (Societe Par Actions Simpliffee) (“Respondent-Applicant”), covers the mark “TRILIPIX” for use on “pharmaceutical preparations for treatment of cardiovascular disease” under Class 05. The Opposer alleges among other things, the following:

2. Opposer’s country of origin is a signatory of and has ratified the provisions of the Paris Convention for the protection of the Industrial Property x x x having acceded to the same on April 22, 2004. The Paris Convention entered into force with aspect to the Islamic Republic of Pakistan on July 22, 2004. As such and pursuant to Section 1 of IP Code in relation to Rule 201 of the Rules and Regulations of Trademarks, Service Marks, Tradenames, and marked or Stamped Containers x x . Opposer is entitled to the benefits granted to foreign nationals to the extent necessary to protect its rights in its Intellectual Property in the Philippines.

3. On July 03, 2008, the Opposer lodged an application before the Bureau of Trademarks of the Intellectual Property Office for registration of the mark LIPIX for goods falling under Class S, specifically for ‘pharmaceutical preparation in the form of tablet, capsule, injection, suspension, syrup, spray, cream, gel and lotion’. The application was duly received and denominated as Application No. 4-2008-007890. A certified true copy of said application is attached as Annex ‘B’.

4. Thereafter or on November 14, 2008 and without any action from the Bureau of Trademarks, Opposer's mark was immediately allowed publication. Accordingly, the Opposer paid the necessary fees and Opposer’s mark was duly published in the E-Gazette which was officially released for opposition on November 21, 2008.

5. On the other hand, Respondent—Applicant’s mark TRILIPIX was applied for registration only on December 15, 2008 or long after Opposer's mark was already duly filed, examined and allowed for publication. Considering the uncanny and suspicious resemblance of Respondent-Applicant’s mark TRILIPIX with Opposer's mark LIPIX which resemblance will more than certainly cause confusion, mistake and deception to the consuming public, and considering further that the Opposer is the prior user, adopter and owner of the mark LIPIX as well as the prior applicant for registration of the said mark in the Philippines, it is clear that the registration of the mark TRILIPIX will cause extreme injury to Opposer who hereby cites the following grounds in support of this Opposition;

The grounds for opposition are as follows;

6. The mark TRILIPIX cannot be registered as its registration will violate Section 123, paragraph (d) of the IP Code which provides, in part, that a mark cannot be registered if it: x x x

7. Opposer has openly and continuously used the mark LIPIX in the Philippines for goods falling under Class 5 long before Respondent-Applicant's trademark application for TRILIPX was filed on December 15, 2008. Moreover, the Opposer continues to use the mark LIPIX in the Philippines. In fact, the goods upon which the mark LIPIX is used are being imported and locally distributed by Medisys Pharma, Incorporated, a domestic trader and importer of generic and branded pharmaceutical products. Print-outs of relevant portions of Medisys Pharma, Incorporated's website featuring the mark LIPIX are attached as Annexes 'C', 'C-1' to 'C-5'. Copies of Purchase Orders from Medisys Pharma, Incorporated are likewise attached as Annexes 'D' to 'D-2'. In contrast, Respondent-Applicant's mark TRILIPX has neither presence nor goodwill in the Philippines.

8. Opposer has likewise extensively promoted and marketed the mark LIPIX in the Philippines and as such, the Opposer has earned substantial goodwill for the mark LIPIX in the Philippines. Attached as Annex 'E' is a joint Sworn Statement, executed by the Opposer's Chief Executive Officer, Naushad Muhammad and Director, Amin Muhammad, attesting to the humble beginnings of the Opposer and its valiant efforts to firmly establish positive consumer reputation of its mark LIPIX.

9. The Respondent-Applicant's mark TRILIPX is confusingly similar to Opposer's mark LIPIX and is applied for the same class of goods which similarity would be likely to deceive or cause confusion as to the origin of the goods. For Respondent-Applicant to adopt an almost identical mark TRILIPX for the same class of goods clearly belies its intention to unfairly trade on the carefully honed goodwill and reputation of Opposer's mark LIPIX.

9.1 In determining whether confusing similarity exists between two marks, it is sufficient that one is a colorable imitation of the other. Colorable imitation has been defined as such a close or ingenious imitation as to be calculated to deceive ordinary purchasers. Colorable imitation does not mean such similitude as amounts to identity. Nor does it require that all the details be literally copied. In finding a confusing similarity between two marks, it will be sufficient to prove that essential characteristics of one mark have been imitated or copied into another mark. Confusing similarity means such similarity in form, content, words, sound, meaning, special arrangement, or general appearance of the trademark with that of another trademark in their overall presentation or in their essential, substantive, and distinctive parts as would likely to mislead or confuse the purchaser in the ordinary course of purchasing the genuine article.

9.2 Thus, in determining whether confusing similarity exists between two marks, the Supreme Court has developed and applied either one of two tests, to wit: (1) the dominancy test; and (2) the holistic test. As its title implies, the test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception. On the other end of the spectrum is the holistic test which focuses on the entirety of the marks in question in determining the existence of confusing similarity.

9.2 Pitted against either the dominancy or holistic test, Respondent-Applicant's mark TRILIPX is confusingly similar with Opposer's LIPIX in terms of spelling, pronunciation and overall appearance: x x x

9.3 Specifically, the following factors evidencing the resemblance between the two marks must not have escaped this Honorable Bureau's attention:

(a) Both LIPIX and TRILIPX are word marks and in appearance as a whole are confusingly similar with each other.

(b) The dominant element of the two marks is undoubtedly the word 'LIPIX' with only three letters, i.e. 'TRI', separating Respondent-Applicant's mark from Opposer's mark making Respondent-Applicant's mark confusingly similar with Opposer's mark.

(c) Both LIPIX and TRILIPX are pharmaceutical products under the same class of goods.

10. The foregoing factors more than clearly show Respondent—Applicant's attempt to get a 'free ride' on the positive brand reputation of the mark LIPIX which Opposer had painstakingly established and spent substantial amounts of money on to develop. Why out of all the combinations of letters to use in its goods, Respondent-Applicant had to choose one that is almost identical to a mark that is known and associated with quality goods and products? It is therefore clear that the registration of Respondent-Applicant's TRILIPDC mark will create confusion in the minds of purchasers and consumers, who will be deceived into believing that Opposer and Respondent-Applicant are affiliated entities, or that Respondent-Applicant has the Opposer's sponsorship, all to the latter's great prejudice. All told, it is now incumbent upon this Honorable Bureau to disallow the registration of Respondent-Applicant's mark as such registration is a clear violation of Section 123.1, paragraph (d) of the IP Code and will cause grave damage to the Opposer.

11. Finally, this Honorable Bureau may also take notice of the admissions made by the Respondent-Applicant in its Opposition filed against the herein Opposer in Inter Partes Case.

No. 14-2009-00087 where Respondent-Applicant openly and repeatedly admitted the existence of confusing similarity between the herein Opposer's mark LIPIX and herein Respondent—Applicant's mark TRILIPDC. Excerpts of Respondent-Applicant's admissions in said Inter Partes Case NO. 14-2009-00087 are quoted hereunder for easy reference: x x x

12. In view of all the foregoing, Respondent-Applicant's trademark application for TRILIPDC under Application Serial No. +2008-015053 filed on December 15, 2008 covering various goods in Class 05 in the name of Fournier Industrie Et. S.A.S. should be denied, in accordance with Section 123.1 (d) of the IP Code.

13. Opposer reserves its right to present such other evidence in support of its claims and allegations as well as in rebuttal to the evidence to be presented by Respondent-Applicant in support of its Answer to this Notice of Opposition. Opposer also reserves its right to present such other facts as may be necessary in the course of these proceedings."

The Respondent—Applicant filed on 04 January 2010 its Verified Answer, alleging, among other things, the following:

6. At the onset, it should be pointed out that the issue of confusing similarity between the marks 'LIPIX' and 'TRILIPDC' is not disputed. The only issue to be resolved therefore is who between the Respondent and Opposer is the owner and prior applicant of the marks LIPIX/TRILIPDC.

7. It should be noted that Respondent applied for registration of the mark 'TRILIPDC' with Benelux on June 25, 2008 goods under Class 05, and the same was issued Registration No. 0846287 on September 05, 2008.

8. In addition to the above-mentioned Benelux registration, Respondent also filed trademark applications in various countries and jurisdictions all over the world, such as Argentina, Brazil, Canada, Colombia, European Union, France, Hongkong, India, Indonesia, Australia, China, Iran, Japan, Republic of Korea, Russian Federation, Singapore, Ukraine, Vietnam, Jordan, Kazakhstan, Lebanon, Malaysia, Mexico, Pakistan, the Philippines, Saudi Arabia, South Africa, Taiwan, Thailand, United Arab Emirates, United States of America and Venezuela clearly and undeniably demonstrating Respondent's ownership of said mark.

9. It should also be noted that Rules 201 and 202 of the Rules and Regulations on Trademarks, Trade Names, and Marked or Stamped containers provides that a mark Filed in the Philippines with a claim of priority in accordance with said Rules 201 and 202 shall have the same filing date as that earlier application filed in the foreign country—in this case the Benelux registration.

10. Considering that the Benelux Trademark Registration was filed on June 25, 2008, the aforementioned Philippine trademark application, pursuant to the aforementioned Rule 201 and 202, also bears a filing date of June 25, 2008 — which is clearly earlier than Opposer's `LIP1X` application which was only filed on July 03, 2008.

11. Therefore, considering that the competing marks are undisputedly confusingly similar, the sole issue at hand is who between the Respondent and Opposer has superior rights over the mark/s LIPIX/TRILIPIX.

12. Considering that Respondent has a filing priority date of June 25, 2008, whereas Opposer only filed its application on July 03, 2008, Respondent has superior rights over the mark/s LIPIX/TRILIPIX.

13. As correctly pointed out by Opposer, as between competing Applicants, the Applicant with the earliest priority date has superior rights over the applied mark, as provided for by Section 123 par. D of the RA 8293 otherwise known as the Intellectual Property Code of the Philippines (IP Code). Said provision of the IP Code provides that: x x x

14. Further, as aptly pointed out by Opposer and is undisputed, the marks `1.IPIX` and `TRILIPIX` are confusingly similar.

15. Consequently, and following the above cited provision of the IP Code, Respondent has superior rights over the mark LIPIX/TRILIPIX and Opposer has no right whatsoever to prohibit the registration of the above captioned application.

16. As a matter of fact, Respondent has already lodged an Opposition to Platinum Pharmaceuticals application for the mark `LIP1X` and said Opposition is currently pending with the IP Office."

The preliminary conference was terminated on 16 February 2010. Thereafter, the parties filed their respective position papers on 08 March 2010.

Should the opposition to Trademark Application Serial No. 4—2006—005376 be sustained?

It is undisputed that the competing marks are confusingly similar and used on similar goods. The facts also show that both parties filed trademark applications in the Philippines. The contentious issues boil down to ownership and to which application was filed first — is it the Opposer's or the Respondent—Applicant's?

The Opposer filed its trademark application for "LIPIX" on 03 July 2008. The Respondent-Applicant on the other hand filed the opposed application on 15 December 2008 but with a claim of priority date of 25 June 2008, the date it filed a trademark application with the "Benelux" countries.

Under Sec. 131 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), it is provided, among other things, that an application for registration of a mark filed in the Philippines by a person referred to in Sec. 3 of the IP Code, and who previously duly filed an application for registration of the same mark in one of those countries, shall be considered as filed as of the day the application was First Filed in the foreign country. Thus, pursuant to Sec. 131 of the IP Code and Rules 201 and 202 of the Trademarks Rules and Regulations, the Respondent-Applicant in effect has a filing date that was earlier than the Opposer's. Hence, Sec. 123.1 (d) of the IP Code cannot be applied in favor of the Opposer.

The Opposer though, contests the Respondent—Applicant's claim of priority, arguing that the latter should prove that the Benelux application was the earliest foreign application for the mark TRILIPIX. In this regard, the Respondent—Applicant has asserted that the Benelux

application is its earliest foreign trademark application for the mark TRILIPIX. The Bureau of Trademarks considered the Respondent—Applicant's claim of priority. Because the Opposer now disputes the Respondent—Applicant's positive assertion, it has the burden of substantiating its allegation that the latter's claim or priority is not valid.

This Bureau noticed that the Opposer attached to its position paper a print—out of a webpage of the United States Patent and Trademark Office which supposedly shows the filing of an application for the registration of the trademark TRILIPIX in the United States on 27 February 2007. On this, the Respondent-Applicant is correct in arguing in its position paper that the Opposer's submission of such "evidence" is no longer allowed at that point. This Bureau cannot even take cognizance *motu proprio* of the information contained therein via judicial notice, the same being acts of a foreign government.

But even assuming in *arguendo* that the Benelux application is not the First or earliest foreign application for the trademark TRILIPIX, the Respondent-Applicant should be allowed to register the mark in the Philippines. It is emphasized that 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 to 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. Thus, the right to register trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration. The Supreme Court held:

"By itself, registration is not a mode of acquiring ownership. When the applicant is not the owner of the trademark being applied for, he has no right to apply for registration of the same.

x x x

"Registration, without more, does not confer upon the registrant an absolute right to the registered mark. The certificate of registration is merely a *prima facie* proof that the registrant is the owner of the registered mark or trade name. Evidence of prior and continuous use of the mark or trade name by another can overcome the presumptive ownership of the registrant and may very well entitle the former to be declared the owner in an appropriate case."

In this instance, the Respondent—Applicant is without a doubt the owner of the mark TRILIPIX, having appropriated and used it prior to the filing by the Opposer of its trademark application for LIPIX. As the owner of the mark, the Respondent-Applicant therefore has the right to register it.

The Opposer asserts that the marks TRILIPIX and LIPIX are confusingly similar. But, the Opposer itself also contends that an application for the registration of the mark TRILIPIX was filed by the Respondent—Applicant as early as 2007. Thus, in effect the Opposer has acknowledged the fact that prior to its appropriation of the mark LIPIX, a confusingly similar mark is already being used and owned by another. Corollary, the Opposer would have no right to register the mark LIPIX and obtain exclusive use thereof and to prevent the Respondent-Applicant from registering the mark TRILIPIX.

WHEREFORE, premises considered, the instant opposition is hereby DENIED. Let the file wrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 August 2011