

UNITED AMERICAN  
PHARMACEUTICALS, INC.

Opposer,  
-versus-

AVENTISUB II, INC.  
Respondent-Applicant.

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Inter Partes Case No. 14-2009-000278

Opposition to:  
Appln. Serial No. 4-2009-00582  
Date Filed: 19 January 2009  
TM: "ALLEGRA"

Decision No. 2011- 04

## DECISION

UNITED AMERICAN PHARMACEUTICALS, INC. ("Opposer"), a corporation duly organized and existing under the law of the Philippines, with principal office located at 750 Shaw Boulevard, Mandaluyong City, filed on 01 December 2009 an opposition to Trademark Application Serial No. 4-2009-000582. The application filed by AVENTISUD II, INC. ("Respondent-Applicant"), a foreign corporation with principal office address at 3711 Kenneth Pike, Suite 200 19807, Greenville, Delaware, USA, covers the mark "ALLEGRA" under Class 5 of the International Classification of Goods, which application was published in the Intellectual Property Philippine "E-Gazette" on 01 September 2009.

The Opposer alleges the following:

- "1. The trademark 'ALLEGRA' so resembles 'ALLEGRA' trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark ALLEGRA', The 'ALLEGRA', which is owned by Respondent, will likely to cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'ALLEGRA' is applied for the same class of goods as that of trademark 'ALLEGRA' i.e. Class (5); anti-allergy/anti histamine.
- '2. The registration of the trademark 'ALLEGRA' in the name of the Respondent will violate Sec. 123 of 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:
  - (d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
    - (i) The same goods or services, or
    - (ii) Closely related goods or services; or
    - (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

Under the above-quoted provision, any mark which is similar to a registered mark shall be denied registration in respect of similar or related goods or it the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

- "3. Respondent's use and registration of the trademark 'ALLEGRA' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'ALLERTA';
- "4. Opposer, the registered owner of the trademark 'ALLERTA'; is engage in the marketing, and sale of a wide of pharmaceutical products. The Trademark Application for the trademark 'ALLERTA' was originally filed with the Intellectual Property Office on 07 December 2001 by Opposer and was approved by

registered by this Honorable Office on 06 January 2006 and valid for a period of ten (10) years. Hence, Opposer's registration of the 'ALLERTA' trademark subsists and remains valid to date.

"5. The trademark 'ALLERTA' has been extensively used in commerce in the Philippines.

5.1.1 Opposer dutifully filed Affidavits of Use pursuant to the requirement of law, to maintain the registration of 'ALLERTA' in force and effect.

5.1.2 Sample of product label bearing the trademark 'ALLERTA' actually used in commerce.

5.1.3 No less than the International Marketing Services (IMS), itself, the world's leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand 'ALLERTA' as the leading brand in the Philippines the category of Anti- Histamines Systemic (RO6A Market) in terms of market share and sales performance.

5.1.4 In order to legally market, distribute and sell these pharmaceutical preparations in Philippines, we registered the products with the Bureau of Foods and Drugs (BFAD).

"6. There is no doubt that by virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark 'ALLERTA', and the fact that they are well-known among consumers as well as to internationally known pharmaceutical information provider, the Opposer has acquired an exclusive ownership over the 'ALLERTA' marks to the exclusion of all others.

"7. 'ALLEGRA' is confusingly similar to 'ALLERTA'

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

7.1.1.1 In fact, in Societe' Des Produits Nestle' S.A. vs. Court of Appeals (356 SCRA 207,216) the Supreme Court, citing Ethepea v. Director of Patents, held in determining if colorable imitation exists, jurisprudence has developed two kinds of tests – the Dominancy Test and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitute infringement. On the other side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity.

7.1.1.2 It is worthy to note at this point that in Societe' Des Produits Nestle', S.A. vs. Court of Appeals, the Supreme Court held' the totality or holistic test only relies on visual comparison between two trademarks whereas the dominancy tests relies only on the visual but also on the aural and connotative comparisons and overall impression between the two trademarks.

7.1.1.3 Relatively thereto, the Supreme Court in McDonalds' Corporation vs. L.C. Big Mak Burger, Inc. (437 SCRA 10) held:

This Court, however, has relied on the dominance test rather than the holistic test. The dominance test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under the dominance test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets and market segments.

Thus, in the 1954 case of *Co Tiong Sa v. Director of Patents*, the Court ruled:

It has been consistently held that the question of infringement of a trademark is to be determined by the test of dominance. Similarity in size, form and color, while relevant, is not conclusive. If the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate.

x x x

- “8. Moreover, Opposer’s intellectual property right over its trademark is protected under Section 14 of Republic Act No. 8293, otherwise known as the Philippine Intellectual Property Code (IP Code), which states:

The owner of a registered mark shall have the exclusive right to prevent all parties not having the owner’s consent from using in the course of trade identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion.

- “9. To allow Respondent to continue to market its products bearing the ‘ALLEGRA’ mark undermines Opposer’s right to its marks. As the lawful owner of the marks ‘ALLERTA’, Opposer is entitled to prevent the Respondent from using a confusingly similar mark in the course of trade where such would likely mislead the public.

x x x

- “10. By virtue of Opposer’s prior and continued use of the trademark ‘ALLERTA’, the same have become well-known and established valuable goodwill to the consumers and the general public as well. In fact, the brand ‘ALLERTA’ is being aggressively advertised in TV, Radio and Prints. 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 the Opposer.

- “11. Likewise, the fact Respondent seeks to have its mark ‘ALLERTA’ registered in the same class (Nice Classification 5) as the trademark ‘ALLERTA’ of Opposer plus the fact that both are anti-allergy will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

- “12. Thus, Opposer’s interests are likely to be damage by the registration and use of the Respondent of the trademark ‘ALLERTA’. In support of the foregoing, the

instant Opposition is herein verified by Mr. Eliezer J. Salazar which likewise serves as this affidavit (Nasser v. Court of Appeals, 191 SCRA 783 1990)".

This Bureau issued a Notice to answer a copy of which was served upon the Respondent-Applicant on 10 March 2010. The Respondent-Applicant, however, did not file an answer. Hence, Rule 2, Sec. 11 of the Regulations on Inter Parties Proceedings as amended, provides:

Section 11. Effect of failure to file an answer,-In case the Respondent-Applicant fails to file an Answer, or if the Answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

This Bureau noticed that the verification and certification on non-forum shopping attached to the opposition was signed by one Eliezer J. Salazar, purportedly, the "General Manager" and "Authorized Representative" of the Opposer. However, there is nothing in the records, including the documents submitted by the Opposer. To show that the said party had authorized Eliezer R. Salazar to file the opposition and sign the required verification and certification of non-forum shopping. What was submitted by the Opposer is a "SECRETARY'S CERTIFICATE" issued by one Luis R. Ladera, supposedly the "Assistant Corporate Secretary" of BIOMEDIS, INC. The document states, among other things, that BIOMEDIS INC's Board of Directors adopted and approved a resolution:

1. authorizing said corporate entity to oppose the registration of the trademark "APPETON & DEVICE" for being confusingly similar to its trademark "APPEBON 500;
2. designating the law firm Ochave & Escalona and its lawyers as legal counsels for the opposition to the registration of "APPETON & DEVICE", and
3. authorizing one Dante M. Sibug as BIOMEDIS, INC., authorized representative to sign the opposition to the registration of "APPETON & DEVICE", and the required certification of non-forum shopping and the verifications.

The SECRETARY'S CERTIFICATE submitted by the Opposer, therefore, is obviously not a proof of Eliezer J. Salazar's authority to file the instant opposition case and sign the required verification and certification of non-forum shopping.

Accordingly, there being no proof that the Opposer had authorized Eliezer J. Salazar to file the opposition and to sign the verification and certification on non-forum shopping, it is deemed that the opposition is unverified and that no certification on non-forum shopping was submitted. Consequently, the opposition should be dismissed for failure to comply with the requirements in filing an opposition case.

The instant opposition must also be dismissed for lack of merit.

It is emphasized that the fundamental principle and legal bases of trademark registration is that the owner of the trademark has the right to register it. The essence of trademark registration is to give protection to the owners of trademarks. The function of 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 or 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, Sec. 123.1 (d) of the Intellectual Property Code provides that a mark shall not 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 if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its trademark application, the Opposer already has an existing trademark registration for the mark ALLERTA. Also, the Respondent-Applicant's mark will be used on pharmaceutical products that are similar and/or closely related to the Opposer's particularly, anti-allergy/anti-histamine.

But are the competing marks identical or resemble each other that confusion or deception is likely to occur?

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some factors such as sound; appearance, form, style shape, size or format, color, idea connoted by the mark; the meaning, spelling and pronunciation of the words used; and the setting in which the words appear may be considered, for indeed, trademark infringement is a form of unfair competition.

Thus, confusion is likely between marks only if their over-all presentations, as to sound, appearance or meaning, would make it possible for consumers to believe that the goods or products, to which the marks are attached, emanated from the same source or are connected or associated with one another.

In this regard, the competing marks are reproduced for comparison and scrutiny:

**ALLERTA**

**ALLEGRA**

Opposer's mark

Respondent-Applicant's mark

The competing trademarks consist of three (3) syllables. The first four (4) letters of the competing marks are the same. However, the fourth and fifth letters of the Respondent-Applicant's mark ("G", "R", and "A") are different from the Opposer's ("R", "T", and "A"). Such difference confers on the Respondent-Applicant's mark a character that makes it distinguishable from the Opposer's, as to composition, visual presentation and sound. The distinction already manifests in the second syllables of the competing marks.

Thus, the likelihood of the consumers being deceived or confused is remote, much less the chances of physicians, pharmacists, sales clerks and those dispensing drugs and medicines committing mistakes.

WHEREFORE, premises considered, the instant opposition to Trademark-Application Serial No. 4-2009-00582 is hereby DENIED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

14 January 2011, Makati City.