

Republic of the Philippines
SUPREME COURT
Manila

EN BANC

G.R. No. L-20635 March 31, 1966

ETEPHA, A.G., petitioner,

vs.

DIRECTOR OF PATENTS and WESTMONT PHARMACEUTICALS, INC., respondents.

McClure, Salas and Gonzalez, for petitioner.

Sycip, Salazar, Manalo, Luna and Associates, for respondent.

SANCHEZ, J.:

To the question: May trademark ATUSSIN be registered, given the fact that PERTUSSIN, another trademark, had been previously registered in the Patent Office? The Director of Patents answered affirmatively. Hence, this appeal.

On April 23, 1959, respondent Westmont Pharmaceuticals, Inc., a New York corporation, sought registration of trademark "Atussin" placed on its "medicinal preparation of expectorant antihistaminic, bronchodilator sedative, ascorbic acid (Vitamin C) used in the treatment of cough". The trademark is used exclusively in the Philippines since January 21, 1959.¹

Petitioner, Etepha, A. G., a Liechtenstin (principality) corporation, objected. Petitioner claims that it will be damaged because Atussin is so confusedly similar to its Pertussin (Registration No. 6089, issued on September 25, 1957) used on a preparation for the treatment of coughs, that the buying public will be misled into believing that Westmont's product is that of petitioner's which allegedly enjoys goodwill.

1. The objects of a trademark are "to point out distinctly the origin or ownership of the articles to which it is affixed, to secure to him who has been instrumental in bringing into market a superior article or merchandise the fruit of his industry and skill, and to prevent fraud and imposition."² Our over-all task then is to ascertain whether or not Atussin so resembles Pertussin "as to be likely, when applied to or used in connection with the goods ... of the applicant, to cause confusion or mistake or to deceive purchasers".³ And, we are to be guided by the rule that the validity of a cause for infringement is predicated upon colorable imitation. The phrase "colorable imitation" denotes such a "close or ingenious imitation as to be calculated to deceive ordinary persons, or such a resemblance to the original as to deceive an ordinary purchaser, giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other."⁴

2. That the word "tussin" figure as a component of both trademarks is nothing to wonder at. The Director of Patents aptly observes that it is "the common practice in the drug and pharmaceutical industries to 'fabricate' marks by using syllables or words suggestive of the ailments for which they are intended and adding thereto distinctive prefixes or suffixes".⁵ And appropriately to be considered now is the fact that, concededly, the "tussin" (in Pertussin and Atussin) was derived from the Latin root-word "tussis" meaning cough.⁶

"Tussin" is merely descriptive; it is generic; it furnishes to the buyer no indication of the origin of the goods; it is open for appropriation by anyone. It is accordingly barred from

registration as trademark. With jurisprudence holding the line, we feel safe in making the statement that any other conclusion would result in "appellant having practically a monopoly"⁷ of the word "tussin" in a trademark.⁸

While "tussin" by itself cannot thus be used exclusively to identify one's goods, it may properly become the subject of a trademark "by combination with another word or phrase".⁹ And this union of words is reflected in petitioner's *Pertussin* and respondent's *Atussin*, the first with prefix "Per" and the second with Prefix "A".

3. 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 a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed.¹⁰ Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.¹¹ For, indeed, trademark infringement is a form of unfair competition.¹²

We take a casual look at the two labels — without spelling out the details — bearing in mind the easy-to-remember earmarks thereof. Respondent's label underscores the trademark *Atussin* in bold, block letters horizontally written. In petitioner's, on the other hand, *Pertussin* is printed diagonally upwards and across in semiscript style with flourishes and with only the first letter "P" capitalized. Each label plainly shows the source of the medicine: petitioner's at the foot bears "Etepha Ltd. Schaan Fl", and on top, "Apothecary E. Taeschner's"; respondent's projects "Westmont Pharmaceuticals, Inc. New York, USA" at the bottoms, and on the lower left side the word "Westmont" upon a white diamond shaped enclosure and in red ink — a color different from that of the words above and below it. Printed prominently along the left, bottom and right edges of petitioner's label are indications of the use: "for bronchial catarrh — whopping-cough — coughs and asthma". Respondent's for its part briefly represents what its produce actually is - a "cough syrup". The two labels are entirely different in colors, contents, arrangement of words thereon, sizes, shapes and general appearance. The contrast in pictorial effects and appeals to the eye is so pronounced that the label of one cannot be mistaken for that of the other, not even by persons unfamiliar with the two trademarks.¹³

On this point the following culled from a recent decision of the United States Court of Customs and Patent Appeals (June 15, 1956) is persuasive:¹⁴

Confusion is likely between trademarks, however, only if their *overall* presentations in any of the particulars of sound, *appearance*, or meaning are such as would lead the purchasing public into believing that the products to which the marks are applied emanated from the same source. In testing this issue, fixed legal rules exist — if not in harmony, certainly in abundance — but, in the final analysis, the application of these rules in any given situation necessarily reflects a matter of individual judgment largely predicated on opinion. There is, however, and can be no disagreement with the rule that the purchaser is confused, if at all, by the marks as a *whole*.

4. We now consider exclusively the two words — *Pertussin* and *Atussin* — as they appear on the respective labels. As previously adverted to, these words are presented to the public in different styles of writing and methods of design. The horizontal plain, block letters of *Atussin* and the diagonally and artistically upward writing of *Pertussin* leave distinct visual impressions. One look is enough to denude the mind of that illuminating similarity so essential for a trademark infringement case to prosper.

5. As we take up *Pertussin* and *Atussin* once again, we cannot escape notice of the fact that the two words do not sound alike — when pronounced. There is not much phonetic

similarity between the two. The Solicitor General well-observed that in Pertussin the pronunciation of the prefix "Per", whether correct or incorrect, includes a combination of three letters P, e and r, whereas, in Atussin the whole starts with the single letter A added to suffix "tussin". Appeals to the ear are dissimilar. And this, because in a word combination, the part that comes first is the *most pronounced*. An expositor of the applicable rule here is the decision in the Syrocol-Cheracol controversy.¹⁵ There, the ruling is that trademark Syrocol (a cough medicine preparation) is not confusedly similar to trademark *Cheracol* (also a cough medicine preparation). Reason: the two words "do not look or sound enough alike to justify a holding of trademark infringement", and the "only similarity is in the last syllable, and that is not uncommon in names given drug compounds".

6. In the solution of a trademark infringement problem, regard too should be given to the *class* of persons who buy the particular product and the circumstances ordinarily attendant to its acquisition.¹⁶ The medicinal preparation clothed with the trademarks in question, are unlike articles of everyday use such as candies, ice cream, milk, soft drinks and the like which may be freely obtained by anyone, anytime, anywhere. Petitioner's and respondent's products are to be dispensed upon medical prescription. The respective labels say so. An intending buyer must have to go first to a licensed doctor of medicine; he receives instructions as to what to purchase; he reads the doctor's prescription; he knows what he is to buy. He is not of the incautious, unwary, unobservant or unsuspecting type; he examines the product sold to him; he checks to find out whether it conforms to the medical prescription. The common trade channel is the pharmacy or the drugstore. Similarly, the pharmacist or druggist verifies the medicine sold. The margin of error in the acquisition of one for the other is quite remote.

We concede the possibility that buyers might be able to obtain Pertussin or Attusin without prescription. When this happens, then the buyer must be one thoroughly familiar with what he intends to get, else he would not have the temerity to ask for a medicine — specifically needed to cure a given ailment. In which case, the more improbable it will be to palm off one for the other. For a person who purchases with open eyes is hardly the man to be deceived.

For the reasons given, the appealed decision of the respondent Director of Patents — giving due course to the application for the registration of trademark ATTUSIN is hereby affirmed. Costa against petitioner. So ordered.

Bengzon, C.J., Bautista Angelo, Concepcion, Reyes, J.B.L., Barrera, Regala, Makalintal, Bengzon, J. P., and Zaldivar, J.J., concur.
Dizon, J., took no part.

FOOTNOTES:

¹Section 2 of the Trademark Law requires actual use in the Philippines of not less than two months before application may be filed.

²52 Am. Jur., p. 508, citing cases.

³Section 4(d), Trade Mark Law.

⁴87 Corpuz Juris Secundum, p. 287.

⁵The Director of Patents cites the following: "NUMOTOZINE" (Reg. No. 1990-S, renewed under Reg. No. 7461-R) for treatment of pneumonia, bronchitis, pleurisy, etc.; "ASCARICIDOL" (Reg. No. 6090) and "ASCAROL" (Reg. No. 4114), both for expelling intestinal worms such as ascaris; "DIARROL" (Reg. No. 5864) for treatment of diarrhea, dysentery and intestinal disorders; "ASMAKOL" (Reg. No. SR-104), "ASMADREN" (Reg. No. 4353), "ASMOL" (Reg. No. 5379), all for treatment of asthma.

⁶Webster's Third International Dictionary, 1964 ed., p. 2470.

⁷Miles Laboratories, Inc. vs. Pepsodent Co., 104 F(2d), 205, 207. Here the marks pepso-seltzer and alka-seltzer were involved. The U.S. Court of Customs and Patent Appeals held that "seltzer" was descriptive, and could not be appropriated.

⁸In Dixi-Cola Laboratories, Inc., et al. vs. Coca-Cola Co., 117 F (2d), 352, 360, the Circuit Court of Appeals in refusing to enjoin use of Dixi-Cola, held that "Cola" is descriptive and generic. See also Coca-Cola Co. vs. Carlisle Bottling Works, 43 F (2d) 101, 103, where "Cola" was held to be descriptive, so that "Roxa Kola" is not an infringement of "Coca-Cola".

⁹Annotations, Lawyers' Reports, Annotated, 1918 A, p. 966.

¹⁰87 Corpus Juris Secundum, pp. 288-291.

¹¹87 Corpus Juris Secundum, pp. 291-292.

¹²Clarke vs. Manila Candy Co., 36 Phil. 100, 106; Co Tiong Sa vs. Director of Patents, 95 Phil. 1, 4.

¹³Mead Johnson & Co. vs. N.V.J. Van Dorp, Ltd., et al., G.R. No. L-17501. April 27, 1963. In this case, this Court held that the trademark ALASKA does not infringe the registered trademark ALACTA. This court, after comparing the sizes of the containers and the color pattern, was impressed more by the dissimilarities (in the labels attached to the containers) than by the similarities appearing thereon. The present case, we believe, is within the coverage of Mead Johnson decision.

¹⁴Lekas & Drivas, Inc. vs. Tenth Avenue Trading Corp., 223 F (2d), pp. 294, 296; emphasis supplied.

¹⁵The Upjohn Co. vs. Schwartz, etc., 246 F(2d), pp. 254, 262.

¹⁶87 Corpus Juris Secundum, p. 295.