

F. HOFFMAN-LA ROCHE LTD.,	}	IPC No. 14-2007-00220
Opposer,	}	Case Filed: 19 December 2007
	}	
-versus-	}	Opposition to:
	}	Appln. Serial No.: 4-2006-006408
TORRENT PHARMA PHILS., INC.	}	Date Filed: 16 June 2006
Respondent-Applicant.	}	Trademark: "TORIDON"
x-----x	}	Decision No. 2008-173

DECISION

This pertains to a Verified Opposition filed on 25 July 2007 by herein opposer, F. Hoffman-La Roche Ltd., a corporation duly organized and existing under the laws of Switzerland, with principal office located at Grenzacherstrasse 124, CH-4070 Basel, Switzerland, against the application filed on 16 June 2006 bearing Serial No. 4-2006-006408 for the registration of the trademark "TORIDON" used for goods/service in Class 05 namely, Gastrolinetic – Prolinetic Pharmaceutical Preparations, which application was published in the Intellectual Property Office Official Gazette, officially released for circulation on 30 March 2007.

The respondent-applicant in this instant opposition is Torrent Pharma Phils., Inc., with registered business address at Unit 401-C ITC Bldg., 337 Sen. Gil Puyat Avenue, Makati City.

The grounds for the opposition to the registration of the trademark are as follows:

1. Opposer is the rightful owner and originator of the registered trademark TORADOL used on goods in Classes 5. Opposer is also the prior user and registrant of the trademark TORADOL, used on analgesic pharmaceutical preparations for internal use, in the Philippines and around the world. Applicant's trademark TORIDON, as used on gastrolinetic – prolinetic pharmaceutical preparations for goods in Class 5, so resembles Opposer's trademark as to be likely, when applied to or used in connection with the identical goods of Applicant, to falsely indicate a connection between Applicant's goods and Opposer, which is widely identified and known as the source of analgesic pharmaceutical preparations for internal use bearing the trademark TORADOL. Applicant's use of the trademark TORIDON is likely to cause confusion, mistake, and/or deception on the purchasing public, and damage the Opposer's interests as owner of the registered trademarks TORADOL.
2. The registration of the trademark TORIDON in the name of the Applicant will violate Section 123.1(d) and Section 123.1(e) of the Intellectual Property Code ("IP Code"), Republic Act No. 8293, Section 6bis of the Paris Convention and Article 16 of the Agreement on Trade Related Aspects of Intellectual Property Rights.
3. The registration and use by Applicant of the trademark TORIDON will diminish the distinctiveness and dilute the goodwill of Opposer's trademark TORADOL, which is an arbitrary trademark when used in connection with analgesic pharmaceutical preparations for internal use.
4. Applicant's adoption of the confusingly similar trademark TORIDON on its goods is likely to indicate a false connection between Applicant's goods and those of Opposer, which has been identified by consumers in the Philippines as the owner of the well-known trademark TORADOL.

5. Applicant's unauthorized appropriation and use of the trademark TORIDON will infringe upon Opposer's right to the locally-registered and internationally well-known trademark TORADOL.

6. The registration of the trademark TORIDON in the name of the Applicant is contrary to other provisions of the Intellectual Property Code."

The following are the allegations of facts, to wit:

"1. Opposer is a well-known manufacturer of a wide variety of pharmaceutical products in Class 5, including analgesic pharmaceutical preparations for internal use. Opposer has adopted and has been commercially using, in the Philippines and in other countries worldwide, the trademark TORADOL for its analgesic pharmaceutical preparations for internal use, in the Philippines and around the world, long before Applicant's unauthorized appropriation of the closely and confusingly similar trademark TORIDON for use on identical goods.

2. Opposer is the registered owner of the trademark TORADOL which has been registered and/or applied for registration in the Philippines and in more than 100 countries worldwide for goods in Class 5, namely analgesic pharmaceutical preparations for internal use. Opposer has also been commercially using its trademark TORADOL long before the appropriation and use of the confusingly identical TORIDON by Applicant. Thus, the registration of the confusingly similar trademark TORIDON in the name of the Applicant will contravene Section 123.1(d) of the IP Code.

3. Opposer's registered trademark TORADOL is also a well-known trademark within the meaning of Sections 123.1(e), 147.1 of the Intellectual Property Code, Section 6bis of the Paris Convention and Article 16 of the Agreement on Trade Related Aspects of the Intellectual Property Rights and is entitled to broad legal protection against unauthorized users like the Applicant who has appropriated its for its own goods.

4. Opposer is the first user of the registered trademark TORADOL in respect of analgesic pharmaceutical preparations for internal use in Class 5. Opposer has advertised and widely promoted its goods bearing its said trademark in the Philippines and around the world, resulting in substantial sales and goodwill over the years. Applicant has appropriated the confusingly similar trademark TORIDON in bad faith for the obvious purpose of capitalizing upon the renown of Opposer's self promoting trademark by misleading the public into believing that its goods originate from, or are licensed or sponsored by Opposer. Applicant's appropriation of the confusingly similar trademark TORIDON falsely indicates a connection between Applicant's goods and those of Opposer, which has been identified as the registered owner of the well-known trademark TORADOL and will damage Opposer's interests as registered owner of the trademarks.

5. The registration and use by Applicant of the confusingly similar trademark TORIDON will tend to deceive and/or confuse purchasers into believing that Applicant's goods emanate from or are under the sponsorship of Opposer and will damage Opposer's interests for the following reasons:

i) The trademarks are so closely similar, the only difference being the replacement of the fourth letter "A" and the last letter "L" in Opposer's registered mark by the letters "I" and "N", respectively, in Applicant's mark. The last three letters of both marks, "DON" and "DOL", are minimal pairs which, when

pronounced, have very similar sounds and the difference, if any, are undetectable by the untrained ears of the general public.

ii) Applicant's unauthorized appropriation and use of TORIDON in respect of gastroinetic – prolinetic pharmaceutical preparations will dilute the goodwill and reputation of Opposer's TORADOL marks and products among consumers.

iii) Applicant used TORIDON on identical goods as a self-promoting trademark to gain public acceptability for its goods through its association with Opposer's popular TORADOL registered trademark, which is used on analgesic pharmaceutical preparations for internal use in Class 5.

iv) The use of Applicant's trademark on its goods inevitably indicates a connection with the Opposer because the goods covered by the mark, as well as other goods of the Opposer, are identical, similar or related.

v) Applicant intends to trade upon Opposer's goodwill.

6. The registration and use of a confusingly identical trademark by Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's registered trademark."

On 19 December 2007, respondent-applicant filed its Verified Answer. It contains specific denials of paragraphs 1 to 6, inclusive of the sub-paragraphs, of the Verified Opposition; and paragraph 3, 10, 11, 13 and 15 of the affidavit executed by Dr. H.-H. Czekay. It likewise contains affirmative allegations and defenses pleaded as follows:

"3. At the outset, respondent-applicant manifests that the Verified Notice of Opposition filed by the Opposer should be dismissed because of the absence of the Secretary's Certificate duly authorizing Dr. H.-F. Czekay, Assistant Manager of F. Hoffman-La Roche Ltd., to sign the Verification of the said Opposition. It must be emphasized that the physical acts of a corporation, like the signing of documents, can be performed only by natural persons duly authorized for the purpose by a specific act of the board of directors. Thus, in the instant case, Dr. H.-F. Czekay is not duly authorized to file the said Opposition which automatically makes the said Opposition a mere scrap of paper and thereby produces no legal effect.

4. In its Verified Opposition, F. Hoffman La-Roche Ltd. ("Opposer", for brevity), alleges that: (a) the trademark "TORIDON" of TPPI resembles and is confusingly similar with Opposer's trademark "TORADOL" to falsely indicate a connection between the Applicant's goods and the Opposer' (b) that the trademark "TORIDON" of TPPI will infringe upon the locally-registered and internationally well-known trademark of Opposer; and (c) that the trademark "TORIDON" of TPPI will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "TORADOL". Opposer claims that this would likely cause confusion, mistake and deception on the part of the purchasing public. Such statements are mere assumption, suppositions and pure conjectures and have no basis in fact and in law.

5. It is well-settled rule in our jurisprudence that "the danger of confusion involving trademarks is remote in the case of medicines which are dispensed only upon prescription or sold with the intervention of a pharmacist." (See Etepha, A.G. v. Director of Patents [1996] 16 SCRA 495, 501-502; x x x)

6. In the case of Etepha vs. Director of Patents, et. al. 16 SCRA 495, the Supreme Court said that in cases involving competing trademarks of

pharmaceutical products, the margin of error or the likelihood of confusion of one from the other is remote, if not inexistent, because such products are dispensed only upon medical prescription. x x x

7. Following the controlling jurisprudence cited above, the subject marks in the case at bar will not cause any confusion on the minds of the general public because these products involve medicines which are dispensed only upon prescription or sold with the intervention of a pharmacist. To be sure, a close scrutiny of the sample packages of the competing marks will show that these products cannot be dispensed without prescription. x x x

9. The Bristol doctrine is squarely in point with the factual antecedents of instant case. The Product of the Opposer, TORADOL (Ketorolac trometamol) expressly states that it is dispensable only upon a doctor's prescription. On the other hand, Respondent-Applicant's product, TORIDON (Domperidone) may be bought either over the counter (for 10mg Dispersible Tablet) or through a doctor's prescription (for 1mg/mL Suspension Gastro-Kinetic/Prokinetic in 30mL Bottle).

10. Thus, following the Bristol doctrine, the subject marks (Opposer's TORADOL Ketorolac trometamol 30 mg/mL i.m./i.v. Injection vis-à-vis Respondent-Applicant's TORIDON Domperidone 10 mg Dispersible Tablet (Gastro-Kinetic/Prokinetic) which are brought with a doctor's prescription (for TORADOL) or over the counter (TORIDON in tablet form) will not cause any confusion on the minds of the general public because these products are bought through different means. Therefore, the chances of being confused into purchasing one for the other are rendered more negligible.

11. Furthermore, using the holistic test, a comparison of the entirety of the competing marks show that the differences between the two trademarks outweigh their similarities, thereby confusing similarity is unlikely. Applying this test to the subject trademarks, although the words "TORIDON" and "TORADOL" have the same prefix and similar-sounding suffixed, they appear in their respective labels with strikingly different backgrounds and surroundings, as to color, size and design. x x x

12. It cannot be gainsaid, therefore, the general public will be misled in buying prescription medicines (Opposer's TORADOL Ketorolac trometamol 30 mg/mL i.m./i.v. Injection vis-à-vis Respondent-Applicant's for 1 mg/mL Suspension Gastro-Kinetic/Prokinetic in 30mL Bottle because 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; and he knows what he is to buy. He examines the product sold him and he checks to find out whether it conforms to the medical prescription. With this tedious procedure, one will wonder how an intending buyer may be confused on what he is to buy if the pharmaceutical product is already written in the medical prescription. It is of common knowledge that an intending buyer of pharmaceutical products always follows the medical prescription of his doctor to the letter.

13. Moreover, the purported likelihood of confusion is unlikely since it is a common practice on 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 and suffixes.

14. The most compelling arguments against Opposer's confusing similarity argument is Republic Act No. 6675 (An Act to Promote and Ensure the Production of an Adequate Supply, Distribution, use and Acceptance of Drugs

and Medicines Identified by their Generic Names) or otherwise known as the “Generics Act of 1998”. x x x

16. Under the Generics Act of 1998, it is mandatory that generic terminologies of medicines are indicated in medical prescriptions. The use of the word “shall” in Section 6(b) of the Generics Act of 1988 attests to its mandatory character requiring the use of generic terminology in the prescription and dispensing of drugs. It is noteworthy to mention that the final provision of the Generics Act allows brand names of the generic products to be written in the doctor’s prescription but in smaller print compared to its generic name and must be in parenthesis. Simply put, the generic name of the medicine is mandated to be bigger in print than the brand name. This means that doctors should write their prescriptions in generic names and if they would want to write the brand names, the latter should be deemphasized and in parenthesis. x x x

17. In the case of opposer’s TORADOL Ketorolac trometamol 30 mg/mL i.m./i.v. Injection vis-à-vis Respondent-Applicant’s for 1 mg/mL Suspension Gastro-Kinetic/Prokinetic in 30 ml Bottle (prescription medicines), there will definitely be no confusion nor any likelihood of confusion as the generic names of the two competing products are different. For the mark “TORIDON” its generic name is “DOMPERIDONE” while for the mark “TORADOL” its generic name is “KETOROLAC TROMETAMOL”. Therefore following the Generics Act of 1988, if a doctor prescribes the product “TORIDON”, the prescription should be: DOMPERIDONE (toridon). If on the other hand, the doctor prescribes the product “TORADOL”, the prescription should be: KETOROLAC TROMETAMOL (toradol). If a doctor fails to write his prescription in this manner, he will be penalized for violation of the Generics Act of 1988.

18. The Opposer erroneously alleges in its Verified Opposition that the trademark “TORIDON” is similar in sound to Opposer’s mark “TORADOL”.

19. In this case of Amigo Manufacturing vs. Cluett Peabody Co., Inc., G.R. No. 139300, March 14, 2001, the Supreme Court held that the trademarks “GOLD TOP” and “GOLD TOE” are not confusingly similar in sound. x x x

20. In the Amigo case, the Bureau of Patents did not rely on the idem sonans test (similarity in sound) alone in arriving at its conclusion. In that case, the competing trademarks are “GOLD TOP” versus “GOLD TOE”. All letters are the same except for the letters “P” for “GOLD TOP” and “E” for “GOLD TOE”. Moreover, in the case of Doctors Pharmaceuticals, Inc. v. Director of Patents, 19 CAR (7s) 1147, 1155 (1974), it was held that the marks “TRANSPULMIN” and “PULMIN” for cough syrup are dissimilar marks. Furthermore, in the case of American Cyanamid Company v. Pediatrica, Inc. [1987] 96 O.g. 9494, 9496-9497, it was held that the marks “PEDIAMOX” and “DIAMOX” for medicines are dissimilar. In the instant case, the completing marks are “TORIDON” versus “TORADOL”. In the case of “TORIDON”, only the first syllable is the same with “TORADOL”. Moreover, in the case of “TORIDON”, between its first and last syllables is the letter “I” which makes the mark distinct from the Opposer’s mark “TORADOL”. Therefore, there can be no confusing similarity in sound of the subject marks.

21. Moreover, confusion and deception is unlikely in the instant case because the subject marks are marks for prescription medicines which are valuable item (Respondent-Applicant’s 1 mg/mL Suspension Gastro-Kinetic/Prokinetic in 30 mL Bottle vis-à-vis Opposer’s TORADOL Ketorolac trometamol 30 mg/mL i.m./i.v. Injection I ampoules). These prescription medicines do not belong to the category of products for immediate consumption. More importantly, in the case of

Respondent-Applicant's TORIDON Domperidone 10 mg Dispersible Tablet Gastor-Kinteic/Prokinetic vis-à-vis Opposer's TORADOL Ketorolac trometamol 30 mg/mL i.m./i.v. Injection, the former's product in tablet form may be bought without prescription but the latter's product in ampoules may never be bought without prescription. Again, the chances of being confused into purchasing one for the other are therefore all the more rendered negligible. Therefore, confusion and deception is less likely.

22. Furthermore, in the case of Del Monte Corporation vs. Court of Appeals, G.R. No. 78325, January 25, 1990, the Supreme Court held, to wit:

"The question is not whether the two articles are distinguishable by their label when set aside by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. x x x

23. In the case of Emerald Garment Manufacturing Corp. vs. Court of Appeals, G.R. No. 100098, December 29, 1995, the Supreme Court held that since the competing marks are for "jeans", which are not inexpensive, the casual buyer is more cautious and discriminating and thus, confusion and deception is less likely. In another case, Lim Hoa vs. Director of Patents, 100 Phil. 214, the Supreme Court held, to wit:

"The danger of confusion in trademarks and brands which are similar may not be so great in the case of commodities or articles of relatively great value such as radio, TV, etc., for the prospective buyer before making the purchase, reads the pamphlets and all literature available and even make comparisons with similar articles in the market. He is not likely to be deceived by similarity in the trademarks because he makes a more or less thorough study of the same."
(Emphasis supplied)

The doctrines of the above mentioned cases strongly support TPPI's contention that confusion or likelihood of confusion is remote in the instant case as the subject marks involved are marks for products that can only be bought through a medical prescription (Respondent-Applicant's 1 mg/mL Suspension Gastro-Kintetic/Prokinetic in 30ml Bottle vis-à-vis Opposer's TORADOL Ketorolac Trometamol 30 mg/mL i.m./i.v. Injection in ampoules).

24. Finally, jurisprudence states that the idem sonans rule is important only where the goods are advertised over the radio. In the case of Marvex Commercial, Co., Inc. vs Petra Hawpia, 18 SCRA 1178, the Supreme Court ruled, to wit:

"where the goods are advertised over the radio, similarity in sound is of especial (sic) significance. The importance of this rule is emphasized by the increase of radio advertisements in which we are deprived of help of our eyes and must depend entirely on the ear."

In the case at bar, the competing marks are not advertised over the radio nor on television. The competing marks, especially the product of the Opposer, are marks for products that are dispensed only upon medical prescription. Thus, the idem sonans test cannot be arbitrarily applied in the instant case.

In opposer's Reply dated and filed 02 January 2008, the following allegations as contained in respondent-applicant's answer was denied: paragraphs 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 20, 21, 22, 23, 24, 25. Opposer further alleged facts in denial of new

matters by way of defense, particular in reference to Republic Act (R.A.) No. 6675, or the Generics Act of 1988 and R.A. 8293, or the Intellectual Property Code of the Philippines, to wit:

“a. x x x This argument, however, is bereft of merit particularly since the Generics Act of 1988 does not require that only the generic name should be written on prescription forms, but that the medical professional prescribing the drug may write out brand name as well. The fact that respondent-applicant argues that the brand name should be de-emphasized and written out in small letters bolsters the likelihood of confusion on the part of the pharmacist dispensing the drug, or the consumer buying the product, since the reader might actually miss out the differences in the spelling of the brand name.

b. x x x This claim, however is erroneous, simply because it fails to consider that (i) the supply chain for prescription drugs, from its manufacturing, distribution, and final dispensation to patients, does not solely involve medical professionals, and (ii) medical professionals are susceptible to imperfect recollection of the product dispensed.

b.1 While the cases cited by the Applicant were decided based on the old Trademark Law, new developments have arisen which led to the enactment of the IP Code. In the field of prescription drugs, for example, the likelihood of confusion is evaluated based on the confusion arising from the relevant public, which may include even non-consumers but also those who are in direct contact with the marks, such as distributors and medical professionals.

Since no case law is available on the interpretation of the Intellectual Property Code with respect to prescription drugs, resort may be made to jurisprudence in other jurisdictions whose trademark laws have similar provisions as that of the Intellectual Property Code. x x x

b.2 If allowance is made for the normal and fair use of the marks – where it cannot be assumed that the marks would be seen together, and which would include use of the words in other forms, such as handwritten form on a doctor’s prescription – the difference between the marks may not be nearly so apparent. In these circumstances, there is potential for visual confusion. Some medicinal products are administered over the counter without prescriptions, some consumers resort to self-prescription and medical professionals, who have an imperfect recollection of the products and their origins, are often overworked and may write prescriptions in hardly legible handwriting.”

In respondent-applicant’s Rejoinder dated and filed 11 January 2008, it was re-emphasized that in the absence of a board resolution authorizing Dr. Czekay to file, sign and verify the instant case, then any pleading on behalf of opposer should be considered as a mere scrap of paper, thus, has no legal effect. The following are further pleaded, to wit:

“4. In its Reply, Opposer asserts that there is likelihood of confusion on the part of the pharmacist dispensing the drug or the consumer buying the drug since the reader of the prescription might actually miss out the differences in spelling of the brand name. Moreover, Opposer asserts that there is likelihood of confusion because the supply chain for prescription drugs from its manufacturing, distribution and final dispensation to patients, does not solely involve medical professionals and that medical professionals are susceptible to imperfect recollection of the product dispenses. These are sham assertions and have no factual or legal basis.

5. Pharmacist and medical professionals are obligated by law, specifically by the Generics Act of 1988, to be highly familiar with the prescription and

dispensing of drugs and medicines. They are mandated by law to write (for doctors) and dispense (for pharmacists) the generic terminology rather than the brand name. x x x

10. In its Reply, Opposer asserts that: (1) there could be potential visual confusion because the prescription of drugs is usually in a doctor's handwritten form, (2) that medicinal products are administered over the counter without prescriptions, (3) that consumers resort to self-prescription, and (4) that medical professionals, who have an imperfect recollection of the products and their origins, are often overworked and may write prescriptions in hardly legible handwriting. Such assertions have definitely no legal and factual basis.

11. Opposer's arguments are self-defeating. First, Respondent-Applicant cannot imagine trained medical personnel of any kind substituting one for the other, especially when it is the fact that Administrative Order No. 62, Series of 1989, defines violative prescriptions as those: (a) where the generic name is not written, (2) where the generic name is not legible and a brand names which is legible is written; and (3) where the brand names is indicated and instructions added, such as the phrase 'No Substitution' which tend to obstruct, hinder or prevent proper generic dispensing. The same Order provides that "Violative prescriptions shall not be filled and they shall be kept and reported by the pharmacist of the drug outlet or any interested party to the nearest DOH Officer for appropriate action and the pharmacist shall advise the prescriber of the problem and/or instruct the customer to get the proper prescription. Second, Opposer's assertion that medical professionals are often overworked is speculative and no evidence or proof has been presented to substantiate such allegation. Finally, it is highly improbable that a person would have access to both of these prescription drugs for self-administration."

Subsequently, during the Preliminary Conference set for this instant case, parties failed to reach into amicable terms. The conference was terminated and parties were directed to file their respective position papers and, if desired, draft decisions within a non-extendible period of ten (10) days from receipt of the order directing them to do so.

In compliance to Office Order No. 79, series of 2005, the following pieces of documentary evidence are admitted: (1) for the opposer, Annexes "A" and "B", Exhibits "A", "B", "C", "D-1", "E", to "Z" (inclusive of sub-markings) of the Verified Opposition; Annexes "A" and "B" of the Reply; and for the respondent-applicant, Exhibits "1" to "8" of the Answer; Annexes "1" and "2" of the Rejoinder.

The issues –

I – Whether or not the Opposition is dismissible on the ground of defective Verification.

II – Whether or not there is confusing similarity between opposer's registered mark "TORADOL" and respondent-applicant's "TORIDON".

On the first issue posed by respondent-applicant, a perusal of the records will show that the Verification, which includes the Certification of Non-Forum Shopping, as attached in the Verified Opposition dated 16 July 2007, was signed and sworn to by Dr. H.-F. Czekay, allegedly the Assistant Manager of F. Hoffman-La Roche Ltd., herein opposer. Further examination reveals the absence of any documentary proof that Dr. H.-F. Czekay was in fact granted the authority from the Board of Directors of the opposer corporation to institute this instant case, more particularly, to execute the required verification and certification of non-forum shopping.

As a rule, the exercise of corporate powers including the power and capacity to sue and be sued in its corporate name (Section 36, Corporation Code of the Philippines), shall be controlled and held by a majority of the number of directors or trustees as provided for in the articles of incorporation (Section 25, supra.). Thus, the power of a corporation to sue in any court is generally lodged with the Board of Directors through a board resolution. In the instant case, there was no authority from the Board of Directors of F. Hoffman-La Roche Ltd., through a board resolution, for Dr. H.-F Czekay to act for and in behalf of the corporation in the institution of this particular case. Hence, he has no personality to execute, sign and swear to the preparation of the opposition which is intended to secure an assurance that the allegations in the pleading are true and correct and the pleading is filed in good faith, and to prohibit and penalize the evils of forum shopping.

In the case of *Jorge Gonzales and Panel of Arbitrators v. Climax Mining Ltd., Climax-Arimco Mining Corp., and Australasian Philippines Mining Inc.*, GR No. 161957, February 28, 2005, it was declared, to wit:

“Under Section 3, Rule 46 of the Rules of Court, a petitioner is required to submit, together with the petition, as sworn certificate of non-forum shopping, and failure to comply with this requirement is sufficient ground for dismissal of the petition. The requirement that petitioner should sign the certificate of non-forum shopping applies even to corporation, the Rules of Court making no distinction between natural and juridical persons. The signatory in the case of the corporation should be “a duly authorized director or officer of the corporation” who has knowledge of the matter being certified. If, as in this case, the petitioner is a corporation, a board resolution authorizing a corporate officer to execute the certification against forum-shopping is necessary. A certification not signed by a duly authorized person renders the petition subject to dismissal.”

Indeed, verification is merely a formal requirement of the law. It is not jurisdictional in nature however, it does not make it less a rule, for “what is at stake is the matter of verity attested by the sanctity of an oath to secure an assurance that the allegations in the pleading have been made in good faith, or are true and correct and not merely speculative.” (*Hun Hyung Park v. Eung Won Choi*, G.R. No. 165496, February 12, 2007) On the other hand, a certification of non-forum shopping is a jurisdictional requirement in the filing of a complaint or any initiatory pleading. “Section 5, Rule 45 of the 1997 Rules of Civil Procedure provides that the failure of the petitioner to submit the required documents that should accompany the petition, including the certification against forum shopping, shall be sufficient ground for the dismissal thereof. the same rule applies to certifications against forum shopping signed by a person on behalf of a corporation which are unaccompanied by proof that said signatory is authorized to file a petition on behalf of the corporation.” (*Shipside Incorporated v. The Hon. Court of Appeals & The Republic of the Philippines*, G.R. No. 143377, February 20, 2001)

It is so much as observed that opposer’s Reply failed to put up a jurisdiction worthy of rebuttal of the issue n lack of authority to institute this instant case. This therefore leads to conclusion that opposer simply failed to comply with the aforecited law, in which the Amended Rules on Inter Partes Proceeding, as amended (Office Order No. 79, series of 2005), Section 7.3 in substance, provides that the filing of the opposition or petition has to be in the require form in compliance with the requirements including the certification of non-forum shopping, otherwise the case shall be dismissed outright without prejudice.

Clearly, the present opposition lacks the proper verification and certification of non-forum shopping as required by the applicable law, rules and jurisprudence, warranting dismissal of this instant case.

Be that as it may, this Bureau after in depth study of the substantive issue of confusing similarities of the contending marks, find no merit in the instant opposition for the registration of respondent-applicant’s applied mark “Toridon”.

Section 123.1 (d) of Republic Act (R.A.) No. 8293, or the Intellectual Property Code, provides, to wit:

“Sec. 123. *Registrability.* – 123.1. A mark cannot be registered if it:

x x x

(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;

x x x”

The foregoing provision deduced that the determining factor in the registration of marks is whether the use of the competing marks in connection with the goods or business will *likely cause confusion*.

In the instant case, the contending marks are opposer’s registered trademark “TORADOL” and respondent-applicant’s applied mark “TORIDON”.

TORIDON

TORADOL

Respondent’s Mark

Opposer’s Mark

The examination of the marks “TORADOL” and “TORIDON” reveals similarity such that the first syllables of both marks consist of letters “TO” and the next letter “R” or “TOR”. A further scrutiny would show that the only difference between the marks being the replacement of the fourth letter “A” and the last letter “L” in the Opposer’s registered mark by the letters “I” and “N”, respectively, in Respondent-Applicant’s mark. Obviously, both marks consist of three syllables which, when pronounced, produced similar sounds that you cannot distinguish one from the other, thus is confusingly similar.

In so far as the goods covered by the contending marks, it is apparent that both trademarks cover pharmaceutical preparations falling under Class 5 of the Notice Classification of Goods. As such, both products flow through the same channels of trade, therefore, confusion between the two trademarks would likely result to prospective buyers. In the case of *Continental Connector Corp. vs. Continental Specialties Corp.*, 207 USPQ 60, the rule applied was that, the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term. By analogy, confusion cannot also be avoided by merely dropping or changing one of the letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to

purchase the one supposing it to be the other. (Societe Des Produits Nestle, S.A. vs. Court of Appeals, G.R. No. 112012, April 4, 2001) An unfair competitor need not copy the entire mark to accomplish its fraudulent purposes. It is enough if he takes the one feature which the average buyer is likely to remember. (Nims, The Law of Unfair Competition and Trademarks, 4th ed., Vol. 2, pp. 678-679) Indeed, measured against the dominant-feature standard, Respondent-Applicant's mark must be disallowed. For, undeniably, the dominant and essential feature of the article is the trademark itself.

It is also worthy to note that the determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two marks is such that there is possibility of the older brand mistaking the newer brand for it.

Finally, it must be emphasized that Opposer's mark "TORADOL" (to which Respondent-Applicant's mark "TORIDON" is confusingly similar) is a registered mark since August 11, 2005 by virtue of the issuance of Certificate of Registration No. 4-2000-005564 by this Office. As owner of the said registered mark, Opposer is entitled to protection pursuant to Section 138 of Republic Act No. 8293 which states that "the certificate of registration is a prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto."

Following the cited laws and jurisprudence, this Bureau hereby resolved that the Opposer was able to prove sufficiently the grounds to oppose the applied subject mark "TORIDON"

IN VIEW of all the foregoing, the instant Verified Opposition is, as it is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 4-2006-006408 for the mark "TORIDON" filed on June 16, 2006 covering Class 05 goods for pharmaceutical preparations namely, gastroinetic/proinetic is hereby REJECTED.

Let the file wrapper of "TORIDON", subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 24 September 2008.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs