L.R. IMPERIAL, INC.
Opposer,

- versus -

TORRENT PHARMA PHILS., INC.
Respondent-Applicant,
x----------x

IPC No. 14-2008-00021
Case Filed: January 28, 2008

Opposition to:

Appl'n Serial No.: 4-2007-007687
Date Filed: 19 June 2007
Trademark: "CO-NORMOTEN"

Decision No. 2009-103

DECISION

This is a VERIFIED OPPOSITION filed by opposer L.R. Imperial, Inc. to the application for registration of the trademark "CO-NORMOTEN" bearing Application Serial No. 4-2007-007687 filed on June 19, 2007 by Respondent-Applicant Torrent Pharma Phils. Inc. covering goods under Class 05, namely, "Pharmaceutical Preparation- Angiotensin II Antagonists", and published for opposition on page three (3) of the IP Philippines electronic gazette which was officially released on November 29, 2007.

Opposer is a corporation organized and existing under and by virtue of the laws of the Philippines with principal office located at 2nd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan, Metro Manila. Respondent-applicant is likewise a corporation organized and existing under the laws of the Philippines with principal address at Unit 401-C ITC Bldg., 337 Sen. Gil Puyat Ave., Makati City.

The grounds for this opposition are as follows:

1. The trademark "CO-NORMOTEN" so resembles the trademark "NORTEN", owned by Opposer, which was registered by this Honorable Office on 08 July 2004. The trademark "CO-NORMOTEN", 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 "CO-NORMOTEN" is applied for the same class and good as that of trademark "NORTEN", i.e. Class (5); for treatment of hypertension.

2. The registration of the trademark "CO-NORMOTEN" 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; (Emphasis supplied)

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 if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

Respondent's use and registration of the trademark "CO-NORMOTEN" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "NORTEN".

The facts to be relied upon and proven by oppose are as follows:

4. Opposer LRI, the registered owner of the trademark "NORTEN", is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark "NORTEN" was filed with the Intellectual Property Office on 13 July 1999 by LRI and was approved for registration by this Honorable Office on 08 July 2004 and valid for a period of ten (10) years or until 08 July 2014. The Opposer's registration of the "NORTEN" trademark subsists and remains valid to date.

5. The trademark "NORTEN" has been extensively used by the Opposer in commerce in the Philippines since July 15, 1998. Opposer, as registrant dutifully filed its Affidavits of Use pursuant to the requirement of law, to maintain the registration of "NORTEN" in force and effect.

6. There is no doubt that by virtue of the above-mentioned Certificate of Registration No. 4-1999-004989, Opposer has acquired an exclusive ownership over the mark "NORTEN" to the exclusion of all others.

7. "CO-NORMOTEN" is confusingly similar to "NORTEN"

7.1 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.

7.1.2 In fact, in Societe Des Produits Nestle, S.A. vs. Court of Appeals [356 SCRA 207, 216,] the Supreme Court, citing Etepha v. Director of Patents, held "[i]n determining if colorable imitation exists, jurisprudence has developed two kind 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."

7.1.2 It is worthy to note at this point that in Societe' Des Produits Nestle', S.A. vs. Court of Appeals [Supra, p. 221,] the Supreme Court held "[T]he totality or holistic test only relies on visual comparison between two trademarks whereas the dominancy test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks."

7.1.3 Relative 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 dominancy test rather than the holistic test. The dominancy test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under the dominancy 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 dominancy. 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. (G. Heilman Brewing Co. vs. Independent Brewing Co., 191 F., 489, 495, citing Eagle White Lead Co. vs. Pflugh (CC) 180 Fed. 579). The question at issue in cases of infringement of trademarks is whether the use of the marks involved would be likely to cause confusion or mistakes in the mind of the public or deceive purchasers. (Auburn Rubber Corporation vs. Honover Rubber Co., 107 F. 2d 588; .. .) (Emphasis supplied.)

7.1.4 Applying the dominancy test, it can be readily concluded that the trademark "CO-NORMOTEN", owned by Respondent, so resembles the trademark "NORTEN", that it will likely cause confusion, mistake and deception on the part of the purchasing public.

7.1.4.1 Both marks have the same letter "N". O.R."

7.1.4.2 Both marks end with the same three letters "T-E-N"

7.1.4.3 Although they do not have the same number of syllables, the second and the last syllables of both marks have exactly the same sound and appearance.

7.1.5 Clearly, the Respondent adopted the dominant features of the Opposer's mark "NORTEN"

7.1.6 As further ruled by the High Court in McDonalds' case (p.33)

In short, aurally the two marks are the same, with the first word of both marks phonetically the same, and the second word of both marks also phonetically the same. Visually, the two marks have both two words and six letters, with the first word of both marks having the same letters and the second word having the same first two letters. In spelling, considering the Filipino language, even the last letters of both marks are the same.

"The Court has taken into account the aural effects of the words and letters contained in the marks in determining the issue of confusing similarity."

7.2. The trademark "NORTEN" and Respondent's trademark "CO-NORMOTEN" are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

7.2.1 Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed trademark "CO-NORMOTEN" is applied for the same class and goods as that of trademarks "NORTEN", i.e. Class (5); for treatment of hypertension, to the Opposer's extreme damage and prejudice.

7.3 Yet, Respondent still filed a trademark application for "CO-NORMOTEN" despite its knowledge of the existing trademark registration of "NORTEN" 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 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" [Emphasis supplied]

9. To allow Respondent to continue to market its products bearing the "CO-NORMOTEN" mark undermines Opposer's right to its marks. As the lawful owner of the mark "NORTEN", 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.

9.1 Being the lawful owner of "NORTEN", Opposer has the exclusive right to use and/or appropriate the said marks and prevent all third parties not having its 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 the trademark "NORTEN", 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. L.C. Big Mak Burger, Inc.*, 437 SCRA 268 (2004), it is evident that the mark "CO-NORMOTEN" is aurally confusingly similar to Opposer's mark "NORTEN".

9.4 To allow Respondent to use its "CO-NORMOTEN" mark on its products would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the "CO-NORMOTEN" products of Respondent originate from or is being manufactured by Opposer, or at the very least, is connected or associated with the "NORTEN" products of Opposer, when such connection does not exist.

9.5 In any event, as between the newcomer, Respondent, which by the confusion loses nothing and gains patronage unjustly by the association of its products bearing the "CONORMOTEN" mark with the well-known "NORTEN" 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 would sufficiently distinguish its products from those existing in the market.

10. By virtue of Opposer's prior and continued use of the trademark "NORTEN", 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 any way connected with the Opposer.

11. Likewise, the fact that Respondent seeks to have its mark "CO-NORMOTEN registered in the same class (Nice Classification 5) as the trademark "NORTEN" of Opposer plus the fact that both are for treatment of hypertension will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

12. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent of the trademark "CO-NORMOTEN.

On June 19, 2008, respondent-applicant filed its VERIFIED ANSWER making the following specific denials:

1. For the reasons stated here and its affirmative allegations and defenses below, TPPI specifically denies the following paragraphs of the Verified Opposition:

1.1 Paragraph 1[1], for lack of knowledge and or information sufficient to form a belief as to the truth of all the allegations stated therein, and for being highly speculative and erroneous in fact and in law.

1.2 Paragraph 2, for being erroneous in fact and in law, and, self-serving.

1.3 Paragraph 3, for being highly speculative and erroneous in fact and in law.

1.4 Paragraphs 4, 5, and 6 for lack of knowledge and or information sufficient to form a belief as to the truth of all the allegations stated therein, and for being self-serving.

1.5 Paragraphs 7,7.1,7.1.1,7.1.2,7.1.3,7.1.4,7.1.4.1, 7.1.4.2, 7.1.4.3, 7.1.5, 7.1.6, 7.2, 7.2.1, 7.3 for being an erroneous interpretation and application of the law, untrue, speculative, self-serving and erroneous in fact and in law.

1.6 Paragraph 8, for applying the wrong interpretation of the quoted provision.

1.7 Paragraph 9, for being untrue and highly speculative.

1.8 Paragraphs 9.1 and 9.2 for being erroneous in fact and in law, and for being speculative.

1.9 Paragraph 9.3, for being untrue, speculative and for erroneously applying the Supreme Court doctrine stated in the said paragraph.

2.0 Paragraphs 9.4 and 9.5, for being untrue, speculative and erroneous in fact and in law.

2.1 Paragraphs 10, 11 and 12, for lack of knowledge and or information sufficient to form a belief as to the truth of all the allegations stated therein, for being untrue, speculative, self-serving and erroneous in fact and in law.

Respondent-applicant then makes special and affirmative allegations and defenses:

2. In its Verified Opposition, L.R. Imperial, Inc. (“Opposer”, for brevity), alleges that: (a) the TPPI’s trademark “CO-NORMOTEN” resembles Opposer’s trademark “NORTEN”; (b) that the trademark “CONORMOTEN” is confusingly similar to the trademark “NORTEN”; and (c) that the trademark “CO-NORMOTEN” is aurally confusingly similar to the trademark “NORTEN”. Thus, Opposer claims that these reasons would likely cause confusion, mistake and deception on the part of the purchasing public.

3. As will be discussed and demonstrated below, Opposer’s claim of infringement of its trademark “NORTEN” is speculative and has no basis in fact and in law. This Honorable Office should dismiss the Verified Opposition pursuant to existing law and controlling jurisprudence.

Opposer’s claim of infringement
of its trademark is unfounded
since the likelihood of confusion
is remote if not inexistent with
respect to prescription drugs.

4. Under existing law and controlling jurisprudence, the requisites of trademark infringement are: (1) the validity of plaintiff’s mark; (2) Plaintiff’s ownership of such valid mark and (3) the use of the mark or its colorable imitation by the alleged infringer which

1 All references to paragraph numbers refer to paragraphs of the Verified Opposition, unless otherwise indicated.

results in likelihood of confusion.[2] The third requisite is the most critical. Thus, it has been held that the gravamen of trademark infringement is the likelihood of confusion[3] Infringement cases do not require actual imitation; only a colorable one, likely to confuse the public. The crux of this case then is whether the use of the two contending marks would likely cause confusion or mistake in the mind of the public or likely deceive purchasers.[4]

5. Jurisprudence tells us that the determination of likelihood of confusion takes into consideration the purchasers, the nature of the goods, and whether or not the goods are related to each other[5] Jurisprudence likewise tells us that there are two kinds of purchasers; the casual purchaser[6] and the careful purchaser.[7] Thus, the Supreme Court in the case of Emerald Garment Manufacturing Corp. VS. Court of Appeals, 356 SCRA 207 (2001), held that the "test is not found in the deception, or of the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The simulation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."[8] In other words, the purchaser likely to be deceived is not the person who knows nothing about the trademark which has been counterfeited but the person who is in some measure acquainted with an established design.[9]

6. In the case before this Honorable Hearing Officer, it is emphasized that the instant case involves trademarks of prescription drugs. Thus, it is a 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 [1966]16 SCRA 495 501-502; Bristol Meyers Company v. Director of Patents [1966] 17 SCRA 128, 132; Yu Hun & Company v. Palting [1955] 51 a.G. 5730, 5735; Eli Lilly & Company v. United Drug Company, Inc., CA-G.R. No. 33079-R, February 5, 1969; Doctors Pharmaceuticals, Inc. v. Director of Patents [1974] 19 CAR (2S) 1147,1156; Roche International, Ltd. V. Medichem Pharmaceuticals, Inc., [1975] 73 a.G. 1717; Roche International, Ltd. V. International Pharmaceuticals, Inc., CA-G.R. SP No. 13975, July 28, 1976.

7. In the case of Etepha vs. Director of Patents, et aI., [1966] 16 SCRA 495, the Supreme Court emphasized that, the margin of error or the likelihood of confusion of one medicinal product from the other is remote, if not inexistent, if the products are dispensed only upon medical prescription. The Supreme Court held:

"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 application. 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 label says so. An intending buyer must have to go first to a licensed doctor of

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2 McDonald's Corporation v. L.C. Big Mak Burger, Inc., 437 SCRA 10, 24 (2004)
3 These elements adopted by the Supreme Court in deciding the McDonalds controversy are also the elements required by the Lanham Trade-Mark Act of 1946 [Lanham Act], § 32 (1), 15 U.S. CA § 1114(1), in establishing infringement, cited in A & H Sportswear Co., Inc. v. Victoria's Secret Stores, Inc. 167 F.Supp2d 770 (2001) thus, "The gravamen of an action for trademark infringement where the parties are not competitors is that the defendant's use of a mark similar to plaintiff's is likely to cause confusion or mistake, or deception of purchasers as to the source or origin of defendant's goods or services." The Court adopted the ruling in Shaley's Inc. v. Covalt, 704 F.2d 426 (1983), and in VMG Enterprises Inc. v. F. Quesada and Franco, Inc. 78 F.Supp. 648 (1992), which referred to the element if likelihood of confusion as the touchstone of trademark infringement. See supra note 2.
4 Co Tiong Sa v. Director of Patents, 95 Phil. 4 (1954).
5 Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft, 27 SCRA 1214 (1969)
6 See Lim Hoa v. Director of Patents, 100 Phil 214 (1956).
7 See American Cynamid Co. v. Director of Patents, 76 SCRA 568 (1977).
8 Emerald Garment Manufacturing Corp. v. Court of Appeals, 356 SCRA 207 (2001).
9 See RUBEN E. AGPALO, THE LAW ON TRADEMARK, INFRINGEMENT AND COMPETITION 48 (2000)

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." (Emphasis supplied)

8. Likewise in Bristol Meyers Company v. Director of Patents [1966] 17 SCRA 128, 132, the Supreme Court also held:

"Accordingly, taken as they will appear to a prospective customer, the trademark in question is not opting to confuse. Furthermore, the product of the applicant is expressly stated as dispensable only upon doctor's prescription, while that of oppositor does not require the same. The chances of being confused into purchasing one for the other are therefore all the more rendered negligible. Although oppositor avers that some drugstores sell "BIOFERIN" without asking for a doctor's prescription, the same if true would be an irregularity not attributable to the applicant, who has already clearly stated the requirement of a doctor's prescription upon the face of the label of its product." (Emphasis supplied)

9. Following the controlling jurisprudence cited above, the subject marks in the instant case 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. In the case of "CO-NORMOTEN", its sample package states, to wit:

> "CAUTION"
> Foods, Drugs, Devices and Cosmetics Act
> prohibits dispensing without prescription."
> (Emphasis supplied)

The same warning appears in the sample package of "NORTEN"

10. It cannot be gainsaid, therefore, that the general public will be misled in buying medicines 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. Essentially, the initial purchase decision is made by the physician, who writes out a prescription. As will be discussed further below, the physician under the Generics Act of 1998 is mandated to write the generic or scientific nomenclature of the medicine prominently and is also allowed to include the brand name in which case it must be in small caps and enclosed by a parenthesis. After which, the consumer then visits a pharmacy, where the patient is attended by a licensed professional pharmacist. Upon receipt of the prescription slip, the pharmacist may on his own initiative or upon customer inquiry, advise the consumer that there is a generic alternative that is cheaper, but equally effective. After the consumer chooses, the pharmacist proceeds to select the required drug from the storage shelves, which are out of reach of the customer. The pharmacist then physically delivers the medicine to the consumer who typically uses it at a later time. Unlike the typical off-the-shelf or over-the-counter consumer product, which is not the case here, the decision to purchase the prescription drugs, and the implementation thereof, are in the capable hands of specially licensed and trained professionals who are not likely to be confused.

11. The Opposer erroneously claims that the "two marks can be easily confused for one over the other, most especially since the oppose trademark "CO-NORMOTEN" is applied

for the same class and goods as that of trademarks (sic) 'NORTEN", that is "for the treatment of hypertension."

12. Such specious argument deserves scant consideration from this Honorable Office. It bears stressing that the true dispensers of prescription medicaments, such as medical professionals and pharmacists, are so sophisticated and skilled at distinguishing between products that they are, as a matter of law, incapable of confusion. In the case of Pharmacia Corp. v. Alcon Laboratories, Inc., 201 F. Supp. 2d 335 (May 14, 2002), the United States District Court of New Jersey held that the relevant consumers for prescription drugs are physicians who are capable of fine distinctions between marks, making confusion even less likely, thus:

17. The relevant market for the products is a significant factor, particularly when the market consists of sophisticated professionals. Victoria's Secret II, 237 237 F.3d at 215, 225; Ford Motor Co. 930 F. 2d at 293; Restatement (Third) of Unfair Competition, § 25, at 271 (1995) (hereinafter "Restatement") ("Discerning purchasers are more likely to recognize elements that distinguish two similar marks and are thus more likely to retain separate mental associations for each of the designations.")

18. In trademark cases involving competing prescription drugs, the relevant consumers are physicians because patients do not choose their own prescription drugs. Smithkline Beckman Corp. v. Pennex Prods. Co., 605 F. Supp. 746, 752-53 (E.D. Pa. 1985) ("Prescription drugs are a unique commodity. It is the physician, not the consumer, who selects the prescription.") Pennwalt Corp. v. Zenith Labs., Inc., 472 F.Supp. 413,422 (E.D. Michigan 1979) ("[T]he dispensing physician is in fact the individual who truly exercises the consumer-patient's freedom of choice in the marketplace when issuing the prescription.") Physicians are capable of fine distinctions between marks, making confusion even less likely. Doral Pharmamedics v. Pharmaceutical Generic Developers, Inc., 148 F. Supp. 20 127, 138-139 (D.P.R. 2001) (confusion between prescription drugs "Exotic-HC" and "Genexotic-HC" unlikely); Pfizer Inc. v. Astra Pharm. Prods., 858 F.Supp. at 1328 (identical XL suffix unlikely to confuse physicians, "as sophisticated a group as one imagine"); Barre-National, 773 F.Supp. At 742, 745 (sophistication made confusion between "Barre" and "Barr" unlikely; Schering Corp. vs. Thompson Med. Co., 209 U.S.P.Q. 72,74 (S.D.N.Y.) (same: confusion between "Polaramine" and "Prolamine" unlikely.) (Emphasis supplied)

13. Likewise, in the case of Doral Pharmamedics, Inc. v. Pharmaceutical Generic Developers, Inc., 148 F.Supp. 2d 127 (June 19, 2001), it was held that in the absence of proof that pharmacists and physicians were actually confused between the two products (GENEXOTIC vs. EXOTIC), likelihood of confusion cannot be assumed (Attached as Exhibit "4" is a copy of the Decision in Doral Pharmamedics, Inc. v. Pharmaceutical Generic Developers, Inc.,). The United States District Court of Puerto Rico ruled, to wit:

> "The First Circuit has tackled in a prior decision the issue of whether there is likelihood of confusion amongst medical professionals from the use of similar or identical trademarks. In Astra Pharmaceutical v. Beckman Instruments, 718 F. 2d 1201 (1st Cir. 1983), the First Circuit stated that:
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> "Perhaps the most critical factor that weighs against [plaintiff] in our consideration of this issue is the sophistication of the class of prospective purchasers of the subject products. If likelihood of confusion exists, it must be based on the confusion of some relevant person; i.e. a customer or purchaser. And there is always less likelihood of confusion where goods are expensive and purchased after careful consideration. [cites omitted] ... Astra's salespersons are also highly trained in order to be able to communicate with the pharmacists and anesthesiologists who will be deciding whether or not to buy their products. These sales people make it crystal clear who manufactures the drugs, as the

hospital will always make a careful determination of the source of the drug before it will be listed on the hospital formulary. After all, these drugs may be used in life and death situations, and the hospital, being in a position of trust, must be extremely cautious about what medicines it administers to its patients, as well as their source.

"In short, it is simply inconceivable the purchasers of the parties' respective products could be confused as to the source of these products" Astra, 718 F.2d at 1206-7.

Doral submitted no evidence in support of its contention that pharmacists are *139 likely to be confused. Furthermore, Doral failed to present this Court with evidence as to actual confusion among "droguerias" or physicians regarding the two prescription drugs. Typically, physicians are the first to find themselves in the position of making a choice between the two medicaments. Therefore, Doral had to produce evidence as to actual or likely confusion among physicians when prescribing Genexotic or Exotic, as well as among pharmacies. Doral failed to produce such evidence. Accordingly, Doral has not established a likelihood of success in proving the likelihood of confusion, an essential element of its claim. (Emphasis supplied)

14. Furthermore, in the absence of proof that medical professionals and pharmacists were and will be confused between the subject marks of the competing products, likelihood of confusion must be ruled out. The case of Pharmacia Corp. v. Alcon Laboratories, Inc., 201 F. Supp. 2d 335 (May 14, 2002), wherein the United States District Court of New Jersey ruled that in the absence of evidence of actual confusion or likelihood of confusion between the marks "XALATAN" and "TRAVATAN", likelihood of confusion cannot be easily assumed is instructive. The Court ruled, to wit:

"114. There is no evidence of actual confusion in the market place. Alcon began shipping Travatan on March 16, 2001, the day it received FDA approval. Through the end of October, 2001, more than 115,000 prescriptions for Travatan had been filed. Def. Ex. TT (DX03877-82), and more than 200,000 units of Travatan had been shipped to pharmacies. Def. Ex. E (DX00331) (Krueger Decl., ¶ 11). There have been no reported instances of confusion, nor is there any evidence of medication errors involving the two drugs. Pharmacia has acknowledged that it knows of no instances of actual confusion. Def. Ex. I (DX01236) (1st Int. Ans. No 10); Gurreri Tr., at 78-80; Obstbaum Tr., at 61-65; Eisenberg Tr., at 80-81; 12/17 Tr., at 113 (Harfstrand); Harfstrand Tr., at 159-60; Garanzini Tr., at 38-41.

"116. The United States Pharmacopeia (USP") collects and reports instances (both "actual" and "potential") of misprescription and medication error. It has not reported any actual instances of misprescription or error between Travatan and Xalatan. Def. Ex. G (X00605-08) (McCabe Decl., Ex. 7) (USP Quality Review, May 1999); Def. Ex. K (DX01438-43) (Di Domizio Decl., Ex. 3) (USP Quality Review, March 2001); Def. Ex. C (DX00229) (DeSantis Decl., Ex. 6) (USP Medication Errors Reporting Program form); 12/17 Tr., at 210-13 (Di Domizio); 12/18 Tr. 168-71 (Lambert); Di Domizio Tr. 182-83.

"117. By FDA regulation, 21 C.F.R. § 314.80 (i), Pharmacia is required to maintain a database of all adverse events involving Xalatan. Gurreri Tr., at 187-88; *354 12/17 Tr., at 112 (Harfstrand); 12/20 Tr., at 227 (Gurreri). Pharmacia has not produced any evidence of any confusion between Xalatan and Travatan.

“118. Alcon also maintains a similar database. It has received no reports of any confusion between Xalatan and Travatan. Krueger 10/30 Tr., at 52-54; Def. Ex. E (D000335) (Krueger Decl., §26).

“119. Pharmacia did not conduct a confusion survey.

“120. There is no credible evidence in the record that patients are likely to confuse Xalatan and Travatan.

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[2] 5. To satisfy its burden on the merits, Pharmacia must prove that confusion from Alcon’s use of Travatan is likely *371 or probable among consumers. Checkpoint Sys., Inc. v. Check Point Software Tech., Inc., 269 F. 3d 270, 279-80 (3d Cir. 2001); Versa Prods. Co. v. Bifold Co., 50 F. 3d 189, 200 (3d Cir.), cert. den’d, 516 U.S. 808, 116 S.Ct. 54, 133 L.Ed. 2d 19 (1195). Pharmacia has failed to meet its burden of proof.

[3] 7. Pharmacia has not proved that there is a likelihood of confusion between Alcon’s use of the Travatan mark and Pharmacia’s use of the Xalatan mark. In determining whether confusion is likely, the following non-exclusive list of factors are relevant: (1) the degree of similarity between the marks; (2) the strength of the owner’s mark; (3) the price of the goods; *372 (4) the length of time the defendant has used the mark without evidence of actual confusion; (5) the intent of the defendant; (6) the evidence of actual confusion; (7) whether the goods are marketed through the same channels of trade; (8) the similarity of the sales targets; (9) the relationship of the goods in the mind of consumers; and (10) other facts suggesting that consumers might expect the prior owner to manufacture both products. A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc., 237 F.3d 198, 215 (3d Cir.2000) (Victoria’s Secret II). Not all the factors need be considered if some are dispositive. Checkpoint Sys., 269 F. 3d at 280. Moreover, the weight to be given any particular factor is a fact sensitive determination left to the discretion of the trier of fact.

8. Pharmacia has not proved that there is a likelihood of confusion between Alcon’s use of the Travatan mark and Pharamacia’s use of the Xalatan mark.

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10. Both Travatan and Xalatan have coexisted for over nine months. Thousands of prescriptions for each have been written and filled. Thousands of “detailing” visits have been made during this time period by representatives of both companies. Despite this, and despite the existence of voluntary and mandatory reporting systems that catalogue mix-ups between prescription products, there is no evidence in the record of any confusion. Although evidence of actual confusion is not necessary to prove likelihood of confusion, Ford Motor Co. v. Summit Motor Products, Inc., 930 F.2d, 292 (3d Cir. 1991), such concurrent use for a substantial period of time with no confusion may create a “presumption that there is little likelihood of confusion”, and weighs heavily against a finding of likely confusion. Barre- National, 773 F.Supp. at 744; see also, Pig nons S.A. de Mecanique de Precision v. Polariod Corp., 657 F. 2d 482 (1st Cir. 1981) Aktiebolaget Electrolux v. Armatron Int’l, Inc., 999 F.2d 1 (1st Cir. 1993) (“absence of actual confusion, or a negligible amount of it, between two products after a long period of coexistence on the market is highly probative in showing that likelihood of confusion exists”); Gruner + Jahr USA Publish. v. Meredith Corp., 793 F. Supp. 1222, 1232-33 (S.D.N.Y. 1992) (where both parties products have been on the market for six months, “we find that the absence of evidence of

actual confusion weighs heavily against a finding of likelihood of confusion"), aff'd, 991 F.2d 1072 (2d Cir. 1993); Mars, Inc. v. H.P. Mayer Corp., 1988 WL 86314, *2 (D.N.J. Aug. 17, 1988 (finding that where "defendants have been distributing]the product in question] for approximately six months without any evidence of actual confusion occurring, that there is little to no likelihood" of confusion).

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{5} 20. Although Pharmacia argues about possible medication errors later in the prescription chain, even assuming that such errors occur, they do not establish trademark confusion. Medication errors include missed doses, drugs given to the wrong patient, prescriptions filled with wrong dosages and many other kinds of errors caused by any number of reasons, including poor handwriting, verbal miscommunications or other breakdowns in the dispensing chain. Misreading or mishearing a prescription is not actionable under the Lanham Act, because trademark confusion is limited to consumer confusion in the context of a purchasing decision. See Harlem Wizards Entm't Basketball, Inc. v. NBA Properties, Inc., 952 F. Supp. 1084, 1098 (D.N.J. 1997) ("Actual confusion is not the same as clear mistake or misidentification on the part of consumers ... Moreover, there is no evidence that these purported instances of actual confusion could have any effect on consumer purchasing decisions"); Lang v. Ret. Living Publ'g Co., 949 F. 2d 576, 582-83 (2d Cir 1991) (rejecting mistaken communications as evidence of confusion because there was no link to any purchasing decision).

[6] 21. When a consumer knows the identity of the product or service he or she desires, but it mistakenly directed to another source (for example, because of a mistake by directory assistance), the error is not evidence of trademark confusion. Checkpoint Sys., 104 F. Supp. 2d at 463 (misdirected communications based on directory assistance "not actionable under the Lanham Act "). aff'd, 269 F. 3d 270, 298 (3d Cir. 2001) (distinguishing consumer confusion from error); citing Duluth News Tribune v. Mesabi Pub'g Co., 84 F. 3d 1093, 1098 (8th Cir. 1996); see also Prime Media, Inc. v. Primedia, Inc. 33 F.Supp. 2d 932, 939-40 (D.Kan. 1998 (calls misdirected to plaintiff by directory assistance *375 is not "the type of confusion the Lanham Act guards against"); Major League Baseball Props., Inc. v. Sed Non Olet Denarius, Ltd., 817 F. Supp. 1103, 1122 (S.D.N.Y. 1993) ("typographical errors" do not constitute trademark confusion).

22. Because the evidence of record demonstrates that doctors (who play the role of the ultimate consumer in prescription drug cases) are not confused, to the extent that pharmacist make mistakes, they are analogous to mistaken directory assistance operators. More importantly, however, Pharmacia has no evidence of any misprescriptions between Xalatan and Travatan.

23. The sophistication of consumers strongly favors Alcon.

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41. Because pharmacia has no marketplace evidence of likely or actual confusion, it emphasizes evidence in the form of expert opinion testimony. This evidence is insufficient to overcome the marketplace evidence that confusion is unlikely. Apart from consumer surveys, "[L]ay or even expert opinion about the likelihood of confusion is inadmissible or entitled to little weight." Richard L. Kirkpatrick, Likelihood of Confusion in Trademark Law, §1.8.c, at 1-45 (PLI 1995); Barnes Group, 793 F. Supp. at 1293, 1301-02 (expert opinion that confusion was

likely, offered without any supporting empirical data or marketplace observations, could not be relied on).

[13] 42. The opinions of Dr. Eisenberg and Mr. Di Domizio with regard to the likelihood of confusion between Travatan and Xalatan are based primarily on a subjective evaluation of the marks in light of their experience in the pharmaceutical industry (Di Domizio) or as an ophthalmologist (Eisenberg). There are no reported trademark cases in which a court has based its findings of a likelihood of confusion or dilution on the types of "opinions" on which Pharmacia relies. The bases for these opinions stand in stark contrast to the survey conducted by Professor Shari S. Diamond, J.D., Ph.D., which demonstrates persuasively a confusion rate of 1.5%. See John H. Harland Co. v. Clarke Checks, Inc., 711 F. 2d 966, 979 n. 23 (11th Cir. 1983) (lay opinion of bank president *378 and opinion of attorney with no experience in relevant industry and who conducted no confusion survey entitled to little weight).

14] 43. Dr. Lambert's opinion on the likelihood of confusion similarly is entitled to little weight. His statistical model cannot predict with meaningful reliability in the real world whether Xalatan and Travatan are accurately characterized as an "Error Pair," or if instead they represent a "false positive"- that is, a pair of drug names improperly classified by Dr. Lambert as confusingly similar. Because in the real world there are many, many more non- confusing drug name pairs than confusingly similar ones, it follows from the application of basic statistical principles that the Travatan-Xalatan pair is likely to be a false positive. In any event, Dr. Lambert, was unable to opine with any degree of certainty what numbers should be used to determine his model's reliability, much less whether Travatan and Xalatan ever will be confused in the real world. Lambert Tr., at 144-46

44. Because the Court must assess confusion based on a well-defined set of factors intended to measure what is likely to happen in the real world, Checkpoint Sys., 269 F. 3d at 279-80, Dr. Lambert's model lacks significant probative value for the purposes for which it is offered. Daubert v. Merrell Dow Pharms, Inc., 509 U.S. 579, 594, 113 S.Ct. 2786, 125 L.Ed.2d 469 (1993) (courts should consider error rate of scientific technique); Kumho Tire Co. v. Carmichael,526 U.S. 137, 153-54, 119 S.Ct. 1167, 143 L.Ed.2d 238 (1999) (question is not whether method is useful in general, but whether method is reasonable in reaching conclusion about specific event at issue); General Electric Co. v. Joiner, 522 U.S. 136, 146, 118 S.Ct. 512,139 L.Ed.2d 508 (1997) CA court may conclude that there is simply too great an analytical gap between the data and the opinion proffered."). The model is entitled to very little weight in a Lanham Act case and cannot serve as the basis for a finding of likely confusion, especially in light of contrary marketplace evidence and the FDA's regulatory determination.

45. None of the expert opinions remaining after the Court's November 28 in Limine ruling, therefore, is sufficiently compelling to overcome the marketplace evidence demonstrating that confusion is not likely." (Emphasis supplied)

"15. The rulings in the United States courts above-cited can likewise be made applicable in this jurisdiction, because pharmacists and medical professionals are obligated by law, especially 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. As previously mentioned, ultimately, the decision to purchase the prescription drugs, and the implementation thereof, are in the capable hands of specially licensed and trained professionals. Moreover, the supply chain for prescription of drugs does not involve ordinary purchasers. Drug wholesalers, pharmacists, doctors and medical personnel are

very knowledgeable and capable of making fine distinctions about drugs, drug names, and uses, and more than usually careful in identifying them, thus eliminating the likelihood of confusion.

The likelihood of confusion is made even more remote especially with the enactment of the Generics Act of 1988, which mandates that the labeling and prescription of drug shall be in generic or scientific nomenclature.

"16. The most compelling argument 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 1988"[10]. The relevant provision of law provides, to wit:

> Sec. 6. Who shall use generic terminology. –
>
> (b) All medical, dental and veterinary practitioners, including private practitioners, shall write prescriptions using generic name. The brand name maybe included if so desired. (Emphasis supplied)
>
> Sec. 12. Penalty. (A) Any person who shall violate Section 6(a) or 6(b) of this Act shall suffer the penalty graduated hereunder, viz;
> (a) For the first conviction, he shall suffer the penalty of reprimand, which shall be officially recorded in the appropriate books of the Professional Regulation Commission.
>
> (b) The second conviction, the penalty of fine in the amount of not less than two thousand pesos (P2, 000)
>
> (c) For the third conviction, the penalty of fine in the amount of not less than five thousand pesos (P5,000) but not exceeding ten thousand pesos (P1 0,000) and suspension of his license to practice his profession for thirty days at the discretion of the court.
>
> (d) For the fourth subsequent convictions, the penalty of fine not less than ten thousand pesos (P10,000) and suspension of his license to practice his profession one year or longer at the discretion of the court.
>
> Any juridical person which violates Section 6 (c), 6 (d), 7 or 8 shall suffer the penalty of a fine of not less than five thousand pesos (P5, 000) nor more than ten thousand pesos (P10, 000) and suspension or revocation of license to operate such drug establishment or drug outlet at the discretion of the Court: Provided, that its officers directly responsible for the violation shall suffer the penalty of fine and suspension or revocation of license to practice profession. If applicable, and by imprisonment of not less than six (6) months nor more than one (1) year or both fine and imprisonment at the discretion of the Court: and Provided, further that if the guilty party is an alien, he shall be ipso facto deported after service of sentence without need of further proceedings.
>
> (B) The Secretary of Health shall have the authority to impose administrative sanctions such as suspension or cancellation of license to practice profession to the Professional Regulation Commission, as the case may be, for the violation of the Act. (Emphasis supplied)

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10 September 13, 1988

"17. Moreover, the Implementing Rules and Regulations of the Generics Act of 1988 provide, to wit:

> Administrative Order No. 51 Series of 1988[11] (Implementing Guidelines for Department of Health Compliance with R.A. 6675, Generics Act of 1988):
>
> 11. Procurement of Drugs and Medicines
>
> 11.1. In addition to existing regulations on procurement, drugs and medicines shall be procured on the basis of their generic use. For this purpose, all heads of agencies that procure drugs and medicines from regular budget. Local aid or trust funds shall specify all drug and medicine items in their generic names. All such as RIV's bid documents, purchase orders, vouchers and others, shall specify drug product item in their generic name…
>
> 12. Prescribing and Ordering
>
> All prescriptions and orders for drugs and medicines in DOH facilities shall be specified in generic terminology. In all written orders, the generic name of the drug's active ingredient shall be stated. While initially brand names may also be added, eventually all orders shall use generic names exclusively.
>
> 13. Dispensing and Administration
>
> 13.3 All persons and units that dispense drugs and medicines in DOH agencies (pharmacies, clinics, other service outlets) shall adopt, and practice generic dispensing) i.e. filling doctor's prescriptions and orders on the basis of the specified generic name of the active ingredient, dose level, dosage form and delivery mode ...

Administrative Order No. 62, Series of 989[12].

> Section 4. Violative, Erroneous, and Impossible Prescriptions.
>
> 4.1 Violative Prescriptions
>
> 4.1.1 Where the generic name is not written;
> 4.1.2Where the generic name is not legible and a brand name which is legible is written;
> 4.1.3Where the brand name is indicated and instructions added, such as the phase 'No Substitution' which tend to obstruct, hinder or prevent proper generic dispensing.
>
> 4.2 What to do with Violative Prescriptions.
>
> Violative prescriptions shall not be filed. They shall be kept and reported by the pharmacist of the drug outlet or any other interested party to the nearest DOH Officer for appropriate action. The pharmacist shall advise the prescriber of the problem and/ or instruct the customer to get the proper prescription.
>
> 4.3 Erroneous Prescriptions:
>
> 4.3.1 When the brand name precedes the generic name.
> 4.3.2Where the generic name is the one in parenthesis.

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11 November 16, 1988. Section 7, Phase 3 of Administrative Order No. 62 was amended by Administrative Order No. 76 dated August 28, 1989 by postponing to January 01, 1990 the effectivity of the sanctions and penalties for violations of the law, provided in Sections 6 and 12 of the Generics Act.
12 March 09, 1989

4.3.3Where the brand name in (sic) not in parenthesis.
4.3.4Where more than one drug product is prescribed in one prescription form.
4.4 What to do with erroneous prescriptions. Erroneous prescriptions shall be filled. Such prescriptions shall also be kept and reported by the pharmacist of the drug outlet or any other interested party to the nearest DOH Office for appropriate action.

"18. Under the Generics Act of 1988, it is mandatory that generic terminology of medicines is indicated in medical prescriptions. The use of the "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 Generic 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 physicians should write in their prescriptions the generic name of the medicine or drug and should they choose to write the brand name of such medicine or drug, the latter should be deemphasized and must be in parenthesis. In the case of Del Rosario v. Bengzon, (G.R. No. 88265, December 21, 1989), the Supreme Court ruled in an en banc resolution that the Generics Act of 1988 is constitutional and physicians are mandated to strictly apply the provisions of the Generics Act. Failure to comply with this mandatory requirement shall subject the erring doctors to stiff penalties.

"19. Applied in the instant case, there will definitely be no confusion or any likelihood of confusion as the generic names of the two competing products are different. For the mark "NORTEN" its generic name is "IMIDAPRIL HYDROCHLORIDE" while for the mark "CO-NORMOTEN" its generic name is "LOSARTAN POTASSIUM + HYDROCHLOROTHIAZIDE." Therefore, following the Generics Act of 1988, should a physician prescribe the product "CO-NORMOTEN", the prescription should be: LOSARTAN POTASSIUM + HYDROCHLOROTHIAZIDE (co-normoten). If on the other hand, a doctor prescribes the product "NORTEN", the prescription should be: IMIDAPRIL HYDROCHLORIDE (norten). Under pain of sanctions of a fine and or revocation of license, physicians and other medical practitioners more likely than not will comply with the mandate of the Generics Act of 1998. Thus, in view of the stringent prescription procedures required by the Generics Act of 1998, which is in fact primarily designed to eliminate erroneous dispension of medicines and or drugs, the likelihood of confusion on the part of the marks in the instant case is made even more remote.

The application of the dominancy and holistic tests in the instant case confirms that TPPI's mark "CO-NORMOTEN" is not confusingly similar to Opposer's mark "NORTEN" as to cause a likelihood of confusion to the purchasing public.

"20. In support of its Verified Opposition, Opposer contends that the trademark "NORTEN" and Respondent's trademark "CO-NORMOTEN" are practically identical marks in sound and appearance and that, the latter is aurally confusingly similar to the former such that they leave the same commercial impression upon the public. Opposer moreover proposes citing McDonalds Corporation, McGeorge Food Industries, Inc. vs. L.C. Big Mak Burger, Inc. 437 SCRA 268 (2004), ("McDonalds" for brevity) that the dominancy test as interpreted by the Supreme Court in the said case should be applied in the instant case to demonstrate that TPPI's trademark "CO-NORMOTEN" infringes on its trademark "NORTEN".

"21. At the outset, it must be noted that the Supreme Court's characterization of trademark cases, particularly in the determination of likelihood, as one, which is to be decided relatively or on a case-to-case basis. Thus, in Societe Des Produits Nestle, SA v. Court of Appeals, 356 SCRA 207, 216 (2001), the Supreme Court held that:

It must be emphasized that in infringement or trademark cases in the Philippines, particularly in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set rules can be deduced. Each case must be decided on its own merits. In Esso Standard, Inc, v, Court of Appeals, we ruled that the likelihood of confusion is a relative concept; to be determined only according to the particular, and sometimes peculiar, circumstances of each case. In trademark cases, even more than in any other litigation, precedent must be studied in light of the facts of the particular case. The wisdom of the likelihood of confusion tests lies in its recognition that each trademark infringement case presents its own unique set of facts. Indeed, the complexities attendant to an accurate assessment of likelihood of confusion require that the entire panoply of elements constituting the relevant factual landscape be comprehensively examined. [Emphasis supplied]

"22. Likewise, in the recent case of McDonalds Corporation v. MacJoy Fastfood Corporation, G.R. No. 166115, February 02, 2007, the Supreme Court ruled to wit:

In determining similarity and likelihood of confusion, jurisprudence has developed two tests, the dominancy test and the holistic test. The dominancy test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion or deception. In contrast, the holistic test requires the court to consider the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity. Under the latter test, a comparison of the words is not the only determinant factor.

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Notably, in McDonalds Corp. v. LC Big Mak Burger, Inc., a case where the trademark "Big Mak" was found to be confusingly similar with the "Big Mac" mark of the herein the petitioner, the Court explicitly held:

This Court, xxx, has relied on the dominancy test rather than the holistic test. The dominancy test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under the dominancy 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.

"23. Opposer contends that applying the dominancy test above-cited, TPPI's trademark "CO-NOR MOTEN" so resembles and adopts the dominant features of its trademark "NORTEN". Applying the test employed by the Supreme Court in McDonalds, Opposer argues that both marks share the same suffix "TEN", have the same letters "N-O-R", and that the second and last syllables of both marks have exactly the same sound and appearance.

"24. Opposer's reliance on the McDonalds ruling to demonstrate and prove that TPPI's trademark "CO-NORMOTEN" infringed on its trademark "NORTEN" is entirely misplaced. As previously mentioned, in trademark cases, even more than in any other litigation, precedent must be studied in light of the facts of the particular case. In McDonalds Corporation v. MacJoy Fastfood Corporation, G.R. No. 16615, February 02, 2007, the Supreme Court categorically ruled that:

In trademark cases, particularly in ascertaining whether one trademark is confusingly similar to another, no set rules can be deduced because each case must be decided on its merits. In such cases, even more than in any other litigation, precedent must be studied in the light of the facts of the particular case. That is the reason why in

trademark cases, jurisprudential precedents should be applied only to a case if they are specifically in point. (Emphasis supplied).

"25. A cursory reading of the Supreme Court's decision in the McDonalds case reveals that there is no parity of facts between the former and the instant case, hence Opposer's reliance on it is bereft of factual and legal basis. In McDonalds, the subject matter was hamburger sandwiches, which are for immediate consumption. In the case at bar, what it involved are pharmaceutical products, which are dispensed upon medical prescription so, as emphasized above, the margin of error in the acquisition of one for the other is quite remote. In the McDonalds case what both parties are selling is a hamburger sandwich, which is for immediate consumption so that a buyer may easily be confused or deceived into thinking that the Big Mak burger he bought is a food product of McDonalds or a subsidiary or allied outlet. Thus, the McDonalds Court characterized the ordinary purchaser as a person who is "too hungry to discriminate between," to wit:

An average person who is hungry and wants to eat a hamburger sandwich may not be discriminating enough to look for a McDonald's restaurant and but a "B[ig] M[ac]" hamburger. Once he sees a stall selling hamburger sandwich, in all likelihood, he will dip into his pocket and ~order a "B[ig] M[ak]" hamburger sandwich.

"26. Such characterization of the prospective purchaser however, cannot be said in the case of the prescription drugs involved in the instant case. It bears stressing that what are involved in this case are marks not for immediate consumption but marks for expensive and valuable items. The ruling in Doral Pharmamedics, Inc. v. Pharmaceutical Generic Developers, Inc., 148 F. Supp. 2d 127 (June 19, 2001) citing Astra Pharmaceutical v. Beckman Instruments, 718 F.2d 1201 (15t Cir. 1983) is instructive, wherein the First Circuit stated that:

"Perhaps the most critical factor that weighs against [plaintiff] in our consideration of this issue is the sophistication of the class of prospective purchasers of the subject products. If likelihood of confusion exists, it must be based on the confusion of some relevant person; i.e. a customer or purchaser. And there is always less likelihood of confusion where goods are expensive and purchased after careful consideration. [cites omitted] (Emphasis supplied)

"27. In addition, while TPPI concedes that the dominancy test which according to the McDonalds case is the controlling test for trademark infringement cases as explicitly incorporated in Section 155.1 of the Intellectual Property Code, its proper application in the instant case readily reveals that the former's trademark of "CO-NORMOTEN" does not resemble nor adopt the dominant features of Opposer's trademark "NORTEN" to the extent of causing a likelihood of confusion on prospective purchasers of the products subject of the instant case.

"28. Contrary to Opposer's argument that the trademarks should be dissected word by word, the dominancy test as applied by the Supreme Court in the McDonalds case requires that the mark should be treated in its entirety. Thus, the Supreme Court held

The "Big Mac" mark, which should be treated in its entirety and not dissected word for word... [13]

"29. The case of Pharmacia Corp. v. Alcon Laboratories, Inc., 201 F. Supp. 2d 335 (May 14 2002), wherein the United States District Court of New Jersey ruled that the dominant features of mark "TRAVA TAN" are not similar to "XALATAN", hence there was no trademark infringement held to wit:

13 437 SCRA 268 (2004).

34. Pharmacia bases its infringement and dilution claims on the shared "ATAN" suffixes of the two names, ignoring the many dissimilarities in the spelling, pronunciation and presentation of the marks. However, "marks should be viewed in their entirety," rather than dissected. Victoria's Secret II, 237 F.3d at 216.

[10] 35. Dissection of marks is particularly inappropriate in the pharmaceutical context because suffix similarity is not uncommon and, for that very reason, not likely to confuse highly trained doctors. See Upjohn Co., v. Schwartz, 246 F.2d 254, 262 (2d Cir 1957) ("Syrocol") [and] 'Cheracol'... do not look or sound alike enough to justify a holding of trademark infringement. The only similarity is in the last syllable, and that is not uncommon in the names given drug compounds.") (Emphasis Supplied)

"30. In the McDonalds case, the Supreme Court applied the dominancy test and found that:

Applying the dominancy test, the Court finds that respondents' use of the "Big Mak" mark results in likelihood of confusion. First, "Big Mak" sounds exactly the same as "Big Mac." Second, the first word in "Big Mak" is exactly the same as the first word in "Big Mac." Third, the first two letters in "Mak" are the same as the first two letters in "Mac." Fourth, the last letters in "Mak" while a "k" sounds the same as "c" when the word "Mak" is pronounced. Fifth, in Filipino, the letter "k" replaces "c" in spelling, thus "Caloocan" is spelled "Kalookan."

In short, aurally the two marks are the same, with the first word of both marks phonetically the same, and the second word of both marks also phonetically the same. Visually, the two marks have both two words and six letters, with the first word of both marks having the same letters and the second word having the same first two letters. In spelling, considering the Filipino language, even the last letters of both marks are the same.

"31. In the instant case, the two competing marks must be viewed in its entirety and not dissected word for word to determine if TTPI's trademark "CO-NORMOTEN" so resembles and adopts the dominant features of Opposer's trademark "NORTEN". Clearly, both marks cannot be confused from each other. First "CO-NORMOTEN" does not sound exactly the same as "NORTEN". In fact, the syllable "CO" phonetically and aurally distinguishes the former from the latter. Second, the first word in "CO-NORMOTEN" is not the same as that of "NORTEN". Third, while it is true that both marks share the same syllables "NOR" and "TEN", such similarity is not uncommon in the names given to drug compounds which for that very reason shall not likely confuse physicians and other medical personnel. As held by the Supreme Court in Etepha vs. Director of Patents, et. al., 16 SCRA 495 (1966), 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.

"32. Finally, taken and viewed in their entirety, both marks cannot be confused with each other because the English Equivalents or the respective meanings of these marks are different. In the case of the mark "CO-NORMOTEN, its English Equivalent is derived from the word "CO" which means joint or auxiliary,[14] "NORMO"[15] which means Normal and the word "TEN" which in turn is the abbreviated version of the word "HYPERTENSION". The syllable "CO" has special significance to the relevant purchaser that distinguishes "CO-NORMOTEN" from any other competing drug such as Opposer's "NORTEN" since it indicates that the drug has two auxiliary chemical ingredients working together to treat

14 co-| pref. The American Heritage® Stedman's Medical Dictionary. Retrieved June 04, 2008, from Dictionary.com website: http://dictionary.reference.com/browse/co

15 Online Medical Dictionary, http://cancerweb.ncl.ac.uk/cgi-bin/omd?normo-, last accessed on July 13, 2007. (normo-Normal, usual. Origin: L. Normalis, according to pattern, 05 March 2000)

the indicated disease. In the case of “CO-NORMOTEN”, losartan potassium and hydrochlorothiazide are combined together to make the product more effective - that is it is indicated for the treatment of hypertension, unresponsive to either Losartan Potassium or Hydrochlorothiazide monotherapy (Attached hereto as Exhibit “5” is a copy of the Package Insert of “CO-NORMOTEN”“). On the other hand, in the case of the mark ‘NORTEN”, the word “NOR” in English is a contraction of the word “neither”.[16] Therefore, the English Equivalent of the words “NORMO” and “NOR” are completely different. No likelihood of confusion thus arises.

“33. In addition, any exclusive claim by Opposer to the prefix “NOR” and suffix “TEN” is presumptuous to say the least since there are other pharmaceutical products in the same class as that of the Opposer’s product which uses the prefix “NOR” and the suffix “TEN” such as (“CARDIOTEN”, “NORMADIL”, and “NORVASC”). Again, the likelihood of confusion is greatly reduced since the numerous marks logically induces and enables the consumers to make fine distinctions. Moreover, the prominent display of the house marks of TPPI and L.R. Imperial Inc., as well as the distinctive packaging used by each company, further weigh against the likely confusion. Thus, n the case of Pharmacia Corp. v. Alcon Laboratories, Inc., 201 F.Supp.2d 335 (May 14, 2002), the United States District Court of New Jersey ruled:

> 36. Any claim by Pharmacia to exclusive rights to the suffix “ATAN” is weak because of the number of other pharmaceutical products that use the suffix (e.g. Rynatan, Phenatan, Germatan), and because of the existence of similar marks in the glaucoma market (e.g. Alphagan, Betagan, Lumigan). 2 McCarthy § 11:85, at-11-163 (“[I]n a ‘crowded’ field of similar marks, each member of the crowd is relatively ‘weak’ in its ability to prevent use by others in the crowd.”); see also Victoria’s Secret II, 237 F. 3d at 223-224 (third-party use weighs against finding mark strength and likely confusion); Accu Personnel, Inc. v. AccuStaff, Inc. 823 F. Supp. 1161, 1166 (D.Del. 1993) numerous similar marks enable consumers to distinguish “on the basis of minute distinctions”) (citation omitted); Restatement § 13, at 110
>
> [11] 37. No particular number of other products or users are necessary to show that concurrent use weakens claims to exclusivity. Castle Oil Corp. v. Castle Energy Corp., Civ. A. No. 90-6554, 1992 WL 394932, at *12 (E.D. Pa. Dec. 29, 1992).
>
> [12] 38. The relevant market regarding third party use is not limited to ophthalmic solutions but is the overall pharmaceutical market. Barre-National, 773 F.Supp. at 471 (liquid pharmaceuticals market too narrow; market was all pharmaceutical products); A & H Sportswear Co., F.Supp. at 1267 (entire market within which goods were registered); Hershey Foods Corp. v. Mars, Inc., 998 F. Supp. 500, 517 (M.D. Pa.1998) (“food industry,” not just candy market, is relevant); see also Victoria’s Secret II, 237 F.3d at 223 (“[T]he extensive use of the term in other [related] markets may also have a weakening effect on the strength of the mark.”).
>
> 39. The prominent display of the Pharmacia and Alcon house marks, along with the distinctive packaging used by each company, further weigh against likely confusion. Victoria’s Secret II, 237 F.3d at 218-219 (house marks are significant in determining overall impression); Nabisco, Inc. v. Warner-Lambert Co., 220 F.3d 43,46 (2d Cir. 2000) (house mark “significantly reduce, if not altogether

16 http://www.merriam-webster.com/cgi-bin/dictionary (3 chiefly British: NEITHER Main Entry: 1nor Pronunciation: n&r, 'nor, Southern also 'nar, Function: conjunction, Etymology: Middle English, contraction of nother neither, nor, from nother, pronoun & adjective, neither - more at NEITHER, 1- used as a function word to introduce the second or last member or the second and each following member of a series of items each of which is negated <neither here nor there> <not done by you nor me nor anyone>, 2 - used as a function word to introduce and negate a following clause or phrase), last accessed on August 06,2007.

eliminates," any likelihood of consumer confusion); Bristoll- Myers Squibb Co. v. McNeil-P.P.C., Inc., 973 F.2d 1033, 1046 (2d Cir. 1992) (same); American Cyanamid, 800 F.2d at 309 (2d Cir. 1986) (same); Richards v. Cable News Network, Inc., 15 F.Supp.2d 683, 690-691 (E.D. Pa.1998) ("World Beat" and "World Beat" not confusingly similar because of differences in presentation); Harlem Wizards Entm's Basketball, 952 F. Supp. at 1096 (same; "Harlem Wizards _and "Washington Wizards"); Pfizer, Inc. v. Astra Pharm. Prods. 858 F.Supp at 1324 (same); Genevese Drug Stores, Inc. v. TGC Stores, Inc., 939 F.Supp. 340, 346 distinguished "Barre" and "Barr"); Schmid Labs v. Youngs Drugs Prods. Corp., 482 F.Supp, 14, 18, (D.N.J. 1979) (same); 3 McCarthy § 23:52, at 23-141 to 23-142. Alcon made its mark even more distinct by using ALL CAPS. Barnes, 793 F. Supp. At 1032.

40. This factor strongly favors Alcon as well (Emphasis supplied).

"34. Moreover, using the holistic test, a comparison of the entirety of the competing marks shows that the differences between the two trademarks outweigh their similarities; thereby confusing similarity is also unlikely. Applying this test to the subject trademarks, although the words "CO-NORMOTEN" and "NORTEN" have similar-sounding suffixes, they appear in their respective labels with strikingly different backgrounds and surroundings, as to color, size and design. For convenience, we sum up these differences, as follows:

Relevant Factors	"CO-NORMOTEN"	"NORTEN"
1. Shape and Size of Label	Rectangular, about 15.5cm X 7.5 cm	Rectangular, about 14cm x 6cm
2. Color of Label	Black	Green
3. Color of background of word-mark	Blue	Light Yellow
4. Over-all Layout	At the top center-generic name "LOSARTAN POTASSIUM + HYDROCHOLOTHIAZIDE" in blue background; below it the word-mar "CO-NORMOTEN" also in blue background; below it are dosage and indication in red background ; at bottom left "TORRENT PHARMACEUTICALS LTD." in white background; and at bottom right "TORRENT PHARMA PHILIPPINES, INC." also in white background.	At the top center-generic name "Imidapril HCI" in yellow background; below it the word mark "Norten" also in yellow background; below it are dosage and indication in yellow background; below it, "UNITED LABORATORIES, INC. in yellow background.
5. Form of Product	Tablets ---label says "50 mg + 12.5 mg Tablet	Tablets – label says "5mg TABLET"

Accordingly, taken as they will appear to a prospective customer, the trademarks in question are not apt to confuse.

The allegation of the Opposer that the trademark "NORMOTEN" is confusingly similar in sound to the trademark "NORTEN" is erroneous.

"35. Furthermore, Opposer claims that that TPPI's trademark "CO-NORMOTEN" is aurally confusingly similar to its mark "NORTEN". To buttress its allegation, Opposer contends that the mark "CO-NORMOTEN" is aurally confusingly similar to Opposer's

mark “NORTEN” based on the illustrative list of confusingly similar sounds in the trademarks cited in McDonald’s Corporation, McGeorge Food Industries, Inc. vs. L.C. Big Mak Burger, Inc., G.R. No. 143993, August 18, 2004, 437 SCRA 10. To reiterate, reliance on the McDonalds case as well as on the illustrative list of confusingly similar sounds cited in the McDonalds case is totally misplaced. There is no parity of facts between the said case and the instant case, thus Opposer’s reliance on the said authority is unfounded. Furthermore, it is presumptuous on Opposer to contend that the random list of confusingly similar sounds in the matter of trademarks cited in the McDonald’s case is applicable in the instant case. The said random list of confusingly similar sounds does not make any distinction if the said marks for immediate consumption or if the marks are for expensive and valuable items. Failure on the part of the Opposer to make the distinction attests to its unjustified reliance on the said list.

“36. In the 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. In that case, it was ruled, to wit:

“True, it would not be guilty of infringement on the basis alone of the similarity in sound. Admittedly, the pronunciations of the two do not, by themselves, create confusion.”

“37. In the Amigo case, the Bureau of Patents did not rely on the idem sonans test (similarly 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 competing marks are “CO-NORMOTEN” versus “NORTEN”. In the case of “CO-NORMOTEN”, the second and last syllables are the same, however, the first syllable “CO” and between the first and last syllables are the letters “MO” make the mark distinct from the Opposer’s mark “NORTEN”. Therefore, there can be no confusing similarity in sound of the subject marks.

“38. Moreover, 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 side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspicious and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of good is the touchstone... Among these, what essentially determines the attitude of the purchaser, specifically his inclination to be cautious, is the cost of the goods. Expensive and valuable items are normally bought only after a deliberate, comparative and analytical investigation. (Emphasis supplied)

“39. In the Del Monte case what is involved are competing marks for the product “catsup” which, according to the Supreme Court belongs to the category of mass products, low priced articles in wide use, and matters of everyday purchase requiring frequent replacement and which are bought by the casual consumer without care, thus confusion and deception is inevitable. This doctrine finds no application to this case because a repeatedly emphasized above the subject marks are marks for prescription medicines which are valuable items and they do not belong to the category of products for immediate consumption. Therefore, confusion and deception is less likely.

"40. 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, Um 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)

"41. The doctrines of the abovementioned 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.

"42. 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 rile is emphasized by the increase of radio advertisements in which 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 are marks for products that are dispensed only upon medical prescription. Thus, the idem sonans test cannot be arbitrarily applied in the instant case.

"43. On the strength of all the foregoing legal and factual considerations, it is the submission of the Respondent-Applicant TPPI that the Verified Notice of Opposition of L.R. Imperial, Inc. does not deserve any consideration for being bereft of any merit Attached as Exhibit "6" is the affidavit of Mr. Chakravarthy to attest to the fact that TPPI is the lawful owner of the subject mark and to support this Verifed Answer.

The issues to be resolved are as follows:

1. Whether opposer's mark "NORTEN" and respondent-applicant's mark CO-NORMOTEN" are confusingly similar; and

2. Whether or not the respondent-applicant is entitled to the registration of the mark "CO-NORMOTEN".

Opposer's mark is depicted below:

NORTEN

Respondent-applicant's mark is likewise depicted below:

CO-NORMOTEN

A comparison of both marks shows that they are almost identical. Looking at both marks in their entirety, opposer's mark appears to be a contraction of respondent-applicant's mark. Opposer's mark consists of the word "NORTEN" while respondent-applicant's mark is partly

composed of the syllables “NOR” and “TEN” with the addition of “CO” at the beginning and “MO” between “NOR” and “TEN”. Looking at both marks in their entirety, thus, the impression conveyed is that the dominant features of both marks are said syllables. Moreover, the pronunciation of both marks is almost similar such that likelihood of confusion may arise as to which mark one actually pronounces: The stress is on the syllable “NOR” while the remaining syllable for either mark is/are de-stressed. This Bureau notes, too, that both marks are written in almost identical Arial-like, uppercase fonts. Visually and aurally, respondent-applicant’s mark is confusingly similar with opposer’s mark.

The likelihood of confusion is heightened by the fact that respondent-applicant’s goods not only belong to the same class of goods as opposer’s- Class 05- but also by the fact that the goods of both parties are of the same nature: They are medical preparations for the treatment of arterial ailments. Opposer’s goods are indicated as “medicinal preparation for the treatment of hypertension” while respondent-applicant’s goods are indicated as “pharmaceutical preparation - angiotensin II antagonists”. Hypertension is defined as an arterial disease characterized by an elevation of the blood pressure (Dictionary. com, citing Random House Dictionary ©Random House, Inc. 2009). Meanwhile, angiotensin II is defined as a variety of oligopeptides (protein fragments/molecules) that elevate blood pressure and stimulate the adrenal cortex (outer portion of the adrenal glands that produces several steroid hormones) to secrete aldosterone (a hormone instrumental in the regulation of sodium and potassium reabsorption by certain cells in the kidney) (Dictionary. com, citing Random House Dictionary ©Random House, Inc. 2009, supra.). As respondent-applicant’s medical preparations are indicated as “angiotensin II antagonists (Underscoring supplied.), these are in effect preparations that fight off hypertension.

Per the Dominancy Test which considers the dominant features of the competing marks, or which gives greater weight to the similarity of the appearance of the product arising from the dominant features of the mark attached to said product in determining whether such mark is confusingly similar with another mark, the mark “CO-NORMOTEN” gives the same visual and aural impressions to the public’s mind in the light of the goods to which they are used respectively by opposer and respondent-applicant (McDonald’s Corporation v. MacJoy Fastfood Corporation, G. R. No. G.R. No. 166115. February 2,2007; McDonalds Corporation v. L. C. Big Mak, Inc., G. R. No. 143993, August 18, 2004). Neither duplication/imitation, or the fact that the infringing label suggests an effort to emulate, is necessary. The competing marks need only contain the main, essential or dominant features of another; and that confusion and deception are likely (Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft, G.R. No. L-19906, April 30, 1969; Lim Hoa v. Director of Patents, G. R. No. L-8072, October 31, 1956; Co Tiong Sa v. Director of Patents, et aI., G. R. No. L-5378, May 24, 1954).

It may be argued that opposer’s and respondent-applicant’s products are pharmaceutical products which are generally dispensed/sold upon presentation of a doctor’s prescription which abates the likelihood of confusion between opposer’s and respondent-applicant’s respective pharmaceutical products.

This Bureau is not unaware of the jurisprudence enunciated in Etepha v. Director of Patents, 16 SCRA 495 (1966) to the effect that the margin of mistaking a particular pharmaceutical product with that of another pharmaceutical product is nil because a buyer must first secure from a licensed doctor the required prescription, present this to the pharmacist who reads and then matches the pharmaceutical product to the prescription based on what is written on said product, and the buyer checks if the product given him is the one stated in the medical prescription. It was further enunciated that pharmaceutical products are not like articles of everyday use such as sugar or candles that are freely purchased and obtained anywhere. This Bureau is also not unaware that pharmaceutical products require prescription in their generic names, not necessarily in their brand names or trademarks per Section 6, Paragraph (b) of R.A. No. 6675, the Generics Act of 1988.

However, as stated earlier, the competing trademarks which would be indicated in their packagings are confusingly similar notwithstanding their generic names. Moreover, as stated

earlier too, the goods of the parties are of the same nature and belong to the same Class. It is very likely, thus, that even if the generic names of the products of the respective parties are written in prescriptions together with their respective marks, likelihood of confusion of the marks and of the respective goods of opposer and respondent-applicant may still set in.

It is worthy to note a very recent case promulgated by the Supreme Court: Mercury Drug Corporation v. Baking, G.R. No. 156037, May 25, 2007.

Succinctly, respondent Baking, who was diagnosed with high blood sugar and triglyceride in November 1993, was sold Dormicum, a potent sleeping tablet, instead of the prescribed Diamicron, in an Alabang branch of the Mercury Drug Corporation because the latter's sales representative had misread his prescription. Unaware that he was given the wrong medicine, Baking took one pill of Dormicum for three consecutive days. On the third day, he fell asleep on the wheel, causing his car to collide with another vehicle. The Supreme Court ordered Mercury Drug Corporation (Mercury Drug) to pay P 50,000.00 and P 25,000.00 in moral and exemplary damages, respectively, due to its employee's error in selling the wrong medicine to a customer. It appears, then, that it was not only the sales representative who mistook one drug as the other drug but even the purchaser himself committed the same error, notwithstanding the existence of a prescription.

As to the first issue, thus, Bureau rules in the affirmative.

Records show that opposer's mark "NORTEN" was applied for on July 13, 1999 and registered on July 08, 2004 per Certificate of Registration No. 4-1999-004989. Meanwhile, respondent-applicant's confusingly similar mark, albeit for goods similar to opposer's goods, was applied for registration only on June 19, 2007.

Section 123.1 (d) of the IP Code provides"

> "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
> (ii) Closely related goods… or
> (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion"

Moreover, Section 138 of the IP Code provides:

> "A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate."

Considering, then, that opposer has a certificate of registration for its mark "NORTEN" to which respondent-applicant's mark nearly resembles as to be likely to deceive or cause confusion, and which are applied for registration for goods of the same nature and Class as that of opposer's goods. Significant also, is the fact that aside from the similarity in the mark itself, it must be pointed out that the goods which both parties carry is similar or related and belonging to the same Class. As such, both goods flow through the same channels of trade and therefore makes the likelihood of confusion or mistake all the more apparent than remote.

In case of grave doubt, the rule is that, as between a newcomer who by the confusion has nothing to lose and everything to gain and one who, by honest dealing has already achieved favor with the public, any doubt should be resolved against the newcomer inasmuch as the field

from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.

In the case of American Wire & Cable Co. vs Director of Patents, 31 SCRA 544, it was observed that:

"Why of the million of terms and combination of letters and designs available, the appellee had to choose a mark so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark"

Thus, this Bureau rules in the negative as to the second issue of whether or not respondent-applicant is entitled to the registration of the mark "CO-NORMOTEN".

WHEREFORE, the VERIFIED OPPOSITION is, as it is, hereby SUSTAINED. Consequently, Application Serial No. 4-2007-007687 filed by Torrent Pharma Phils. Inc. on June 19, 2007 for the registration of the mark "CO-NORMOTEN" used for goods under Class 05, namely, "Pharmaceutical Preparation- Angiotensin II Antagonists" is, as it is hereby, REJECTED.

Let the filewrapper of this case be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, July 30, 2009.

ESTRELLITA BELTRAN-ABELARDO
Director Bureau of Legal Affairs
Intellectual Property Office