



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

- “3. Respondent-Applicant’s use and registration of the trademark “TUSEDEX” will diminish the distinctiveness and dilute the goodwill of Opposer’s trademark “TUSERAN”.

The Opposer relied on the following facts in support of its opposition:

- “4. Opposer, the registered owner of the trademark “TUSERAN”, is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark “TUSERAN” was originally filed with the Philippine Patent Office on 29 July 1963 by and was approved for registration by the same office on 20 February 1964 and valid for a period of twenty (20) years. On September 20, 1983, Opposer filed an application for renewal which was approved by the same Office on 22 November 1983 and valid for another period of twenty (20) years starting from 20 February 1984. Prior to the expiration of its registration, Opposer again filed an application for renewal which was approved by the Intellectual Property Office and valid for ten (10) years starting 20 February 2004. Hence, Opposer’s registration of the “TUSERAN” trademark subsists and remains valid to date. Attached are copies of Certificate of Registration Number 003254 marked as Annexes “B”, “C” and “D”.
- “5. The trademark “TUSERAN” has been extensively used in commerce in the Philippines.
- 5.1 Opposer dutifully filed Affidavits of Use pursuant to the requirement of law, to maintain the registration of “TUSERAN” in force and effect. A copy of the Affidavits of Use filed by Opposer is hereto attached as Annexes “E”, “F”, “G” and “H”.
- 5.2 A sample of product label bearing the trademark “TUSERAN” actually used in commerce is hereto attached as Annex “I”.
- 5.3 No less that the Intercontinental Marketing Services (IMS) itself, the world’s leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand “TUSERAN” as the leading brand on the Philippines in the category of “*anti-tussive*” in terms of market share and sales performance. (Attached is a copy of the certification and sales performance marked as Annex “J”.)
- 5.4 In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, we registered the products with the Bureau of Food and Drugs (BFAD). A copy of the Certificate of Product Registration issued by the BFAD for the mark “TUSERAN” is hereto attached as Annex “K”.
- “6. There is no doubt that by the virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark “TUSERAN”, and the fact that they are well-known among consumers as well as to internationally known pharmaceutical information provider, the Opposer has acquired an exclusive ownership over the “TUSERAN” marks to the exclusion of others.

“7. “TUSEDEX” is confusingly similar to “TUSERAN”.

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

7.1.1 In fact, in *Societe Des Produits Nestle S.A. vs. Court of Appeals* [356 SCRA 207, 216] the Supreme Court, citing *Etepha vs. Director of Patents*, held “[i]n determining of colorable imitation exists, jurisprudence has developed two kinds of tests – 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 relies on visual comparison between two trademarks whereas the dominancy test relies not only on the visual but also on the aural and connotative comparison and overall impressions between the two trademarks.”

7.1.3 Relative thereto, the Supreme Court in *Mc Donald’s Corporation vs, L.C. Big Mak Burger, Inc.*, [147 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 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 vs. 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 take place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. (*G. Heliman 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., F. 2d 588;....) (Emphasis Supplied.)

xxx”

- 7.1.4 Applying the dominancy test, it can be readily conclude that the trademark “TUSEDEX”, owned by the Respondent-applicant, so resembles the trademark “TUSERAN”, that it will likely cause confusion, mistake and deception on the part of the purchasing public.
  - 7.1.4.1 First “TUSEDEX” sounds almost the same as “TUSERAN”;
  - 7.1.4.2 Second, “TUSEDEX” appears almost the same as “TUSERAN”;
  - 7.1.4.3 Third, both marks are composed of three (3) syllables;
  - 7.1.4.4 Fourth, both marks start with the same four (4) letters “TUSE”;
  - 7.1.4.5 Fifth, the first and second syllables of both marks are the same in sound and appearance;
  - 7.1.4.6 Sixth, both marks are pronounced in the same intonation;
- 7.1.5 Clearly, the Respondent-Applicant adopted the dominant features of the Opposer’s mark “TUSERAN”;
- 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 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.

x x x”

“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 “TUSERAN” and Respondent’s trademark “TUSEDEX” 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 “TUSEDEX” is applied for the same class and goods as that of trademarks “TUSERAN”, i.e. Class (5), to the Opposer’s extreme damage and prejudice.
- 7.3 Yet, Respondent still filed a trademark application for “TUSEDEX” despite its knowledge of the existing trademark registration of “TUSERAN” 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 likelihood of confusion.” [Emphasis supplied]
- “9. To allow Respondent to continue to market its products bearing the “TUSEDEX” mark undermines Opposer’s right to its marks. As the lawful owner of the mark “TUSERAN”, 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.
- “10. By virtue of Opposer’s prior and continued use of the trademark “TUSERAN”, the same have become well-known and established valuable goodwill to the consumers and general publics 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 in any way connected with the Opposer.
- “11. Likewise, the fact that Respondent seeks to have its mark “TUSEDEX” registered in the same class (NICE Classification 5) as the trademark “TUSERAN” of Opposer will undoubtedly add to 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-Applicant of the trademark “TUSERAN”. In support of the foregoing, the instant Opposition is herein verified by Mr. Eliezer J. Salazar which likewise serves as his affidavit (*Nasser vs. Court of Appeals, 191 SCRA 786 [1990]*).

Opposer submitted the following as its exhibits in support of its opposition.



The contending trademarks are reproduced below for comparison and scrutiny.

<b>TUSERAN</b>	<b>TUSEDEX</b>
Opposer's mark	Respondent-Applicant's mark

It is observed that the two (2) trademarks are composed of three syllables each. The first two (2) syllables are exactly the same and they differ only in the last syllables.

In the instant case, the first two (2) syllables "TUSE" of both trademarks are exactly the same in *spelling* and *pronunciation* and this part of the contending trademarks comes first as the most pronounced and easily attracts the eyes and mind of the buying public.

One of the factors essential in determining whether two trademarks are confusingly similar is whether or not there is a similarity in their general appearance. This may be known by means of a physical examination and comparison thereof. As shown by comparison of the contending trademarks, they are *almost similar in appearance* and compounding the likelihood of confusion and deception is the fact that the goods upon which Respondent-Applicant's mark are to be used are identical, as well as closely related to the goods of the Opposer under Class 5, *anti-tussive or for cough treatment*.

Where goods are advertised over the radio, similarity of sound is of special significance. Similarity of sound is a sufficient ground for holding that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.

In the case of "American Wire & Cable Co., vs. Director of Patents, et. al. (31 SCRA 544) [G.R. No. L-26557, February 18, 1970]", the Supreme Court ruled:

"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 such mark would likely to cause confusion or mistake on the part of the buying public. in short, to constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels us such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it."

It is worthy to note that the Opposer's trademark "TUSERAN" has been registered with the Intellectual Property Philippines (IPP) bearing Registration No. 10860 on February 20, 1964 (Annex "B") and said registration was renewed under Registration No. R-3254 on February 20, 2004 (Annex "D"), and the Affidavit of Use filed accordingly (Annexes "E", "F", "G" and "H"). The use and adoption by the Respondent-Applicant of substantially the same mark as subsequent user can only mean that applicant wishes to reap the goodwill and benefit from the advertising value and reputation of Opposer's mark.

WHEREFORE, approval of Respondent-Applicant's trademark application is contrary to Section 123.1 (d) of Republic Act No. 8293.

IN VIEW of all the foregoing, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, Trademark Application No. 4-2007-008760 filed on 10 August 2007 by MEDHAUS PHARMA, INC., for the mark "TUSEDEX" is, as it is hereby, REJECTED.

Let the filewrapper of the trademark "TUSEDEX" 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, 13 May 2009.

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