

MERIAL LIMITED
Opposer,

IPC No. 14-2008-00287
Opposition to:

Appln. Serial No. 4-2008-003206
Date Filed: March 18, 2008

- versus -

Trademark: "AVOMET"

PT DEXA MEDICA,
Respondent-Applicant.
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Decision No. 2010-54

DECISION

MERIAL LIMITED, ("Opposer"), a corporation organized and existing under the laws of England, with principal office at 27 Knightsbridge, London, SW1X 7QT England, filed on 06 November 2008 an opposition to Trademark Application Serial No. 4-2008-003206. The application, filed by PT DEXA MEDICA ("Respondent-Applicant"), with address at Jalan Letjan Bambang Utoyo 138 Palembang 30114, Indonesia, on 18 March 2008, covers the trademark "AVOMET" for use on goods under Class 05¹: pharmaceutical preparation for treatment of nausea and vomiting; symptoms of functional dyspepsia.²

The grounds for opposition are as follows:

"2. In the Philippines, Opposer has filed an application for the registration of its mark IVOMEK on January 15, 2002 and was granted registration on February 10, 2005, under Certificate of Registration No. 42002-000322 for Class 5.

On the other hand, the application for AVOMET was only filed by Respondent on March 18, 2008 for the same class of goods, Class 5.

"3. Clearly, Opposer's mark IVOMEK was registered and used much earlier than Respondent.

"4. Opposer has been using its mark for 27 years now, having first used and adopted the same as early as 1981. In the Philippines, Opposer has first used the mark IVOMEK on January 25, 2000.

"5. Clearly, Opposer is the rightful owner of the mark IVOMEK having used, adopted and registered the same in the Philippines and on several countries in the world much earlier than Respondent.

"6. Being the owner of the mark, Opposer has registered the mark IVOMEK and IVOMEK derivatives in numerous countries of the world, including Philippines, Thailand, Taiwan, Malaysia, Singapore, China, Japan, Australia, USA, United Kingdom, France.

"7. Opposer has developed goodwill and reputation for its mark IVOMEK through extensive promotion, worldwide registration and use.

1 The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

2 The application was published in the Intellectual Property Office Official Gazette, officially released for circulation on 11 July 2008.

“8. Opposer has built, for its mark IVOMECE, superior quality-image or reputation through its long use characterized by high standards.

“9. x x x it is apparent that Opposer’s mark satisfies the criteria set by the Rules and Regulations Implementing RA 8297 to be considered as a well-known mark, entitled to protection under Section 123 (e) and (f) of R. A.8293.

“10. In presentation, general appearance and pronunciation, Respondent-Applicant’s mark AVOMET and Opposer’s IVOMECE are confusingly similar, and hence, will cause confusion among their prospective market, considering that the goods are similar or related belonging in the same classes and sold in the same channels.

x x x

“12. Opposer’s mark IVOMECE, will indicate a connection between the latter’s goods and those of Respondent’s, and will likely mislead the buying public into believing that the goods of Respondent’s are produced or originated from, or are under the sponsorship of Opposer, to the detriment and damage of Opposer’s interests, considering the goods are the same and belong to the same class. Likewise, the use of Respondent of the mark AVOMET will diminish or demean or dilute the superior quality image and reputation of Opposer’s mark and products characterized by high standards which Opposer has carefully built through its long use.

“13. Opposer hereby alleges that the Respondent-Applicant’s adoption of AVOMET trademark which is confusingly similar to that of Opposer’s IVOMECE was clearly done with the illegal intent of riding on the popularity and goodwill of Opposer’s quality-built reputation and will cause great and irreparable damage and injury to the Opposer.

“14. Further, Respondent-Applicant is clearly in bad faith in so using and adopting the same trademark as that of Opposer’s IVOMECE, which Opposer has, because of its prior use and registrations, gained worldwide notoriety for said mark.

The Opposer’s evidence consist of the following:

1. Exhibit “A” - Authentication and legalization of the Verified Opposition;
2. Exhibit “B” - Authentication and legalization of the Affidavit Testimony of Horace Disston Nalle;
3. Exhibit “C” - Certificate of Registration of trade mark IVOMECE;
4. Exhibit “D”, “D-1” to “D-7” - Foreign Certificates of Registration of trade mark IVOMECE; and
5. Exhibit “E” - Authentication and legalization of Special Power of Attorney.

This Bureau issued a Notice to Answer on 26 November 2008 and served a copy upon the Respondent-Applicant on 08 December 2008. The Respondent-Applicant, however, did not file an Answer. Thus, the instant opposition case was deemed submitted for decision on the basis of the opposition, the affidavits of witnesses and the documentary evidence submitted by the Opposer.³

The issues to be resolved in this case are:

- I. Whether the Opposer’s trademark IVOIVIEC is a well-known mark, and

³ Rule 2, Section 11 of the Regulations on Inter Partes Proceedings, as amended.

- II. Whether the Opposition to Trademark Application Serial No. 42008-00287 should be sustained on the ground of confusing similarity between the marks IVOMECE and AVOMET.

On the first issue, the Opposer seeks the declaration of “well-known” status on its mark “IVOMECE”. Rule 102 of the Rules on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers, provides:

Rule 102. Criteria for determining whether a mark is well-known. -In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

This Bureau finds the Opposer’s evidence insufficient to declare its mark well-known using the foregoing criteria. Said criteria were not satisfied by mere presentation of registrations (in photocopies) in foreign countries and in the Philippines. The fact of being well-known has to be established in foreign places as well as in the Philippines not alone through registrations, granting that the evidence are admissible in evidence, but also by evidence of use, adoption and promotion of goods in order to acquire a distinction and reputation for its trademark. This was not met by the evidence submitted by the Opposer.

Furthermore, the requirement that account shall be taken of the knowledge of the relevant sector of the public obtained as a result of the promotion of the mark⁴ was not substantiated by sufficient documents.

⁴ Sec. 123.1 (e), R.A. No. 8293.

Going now to the second issue, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly tile origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁵

The Opposer anchors its opposition on Sec. 123.1 pars (d) and (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines C'IP Code”).

Sec. 123. Registrability. -123.1. A mark cannot be registered if it: xxx

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
 - (ii) Closely related goods or services, or
 - (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;
- x x x

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided, further, That the interests of the owner of the registered mark are likely to be damaged by such use;

(Emphasis Supplied)

Sec. 123.1 (f), of the IP (ode does not apply because of the foregoing findings that because of the insufficiency of the evidence submitted by the opposer, IVOMECE, cannot be declared well-known.

Hence, the question is: Is the Respondent-Applicant's trademark application proscribed by Sec. 123.1 (d) of the IP (ode on the ground that the competing marks, as shown below, are confusingly similar?

IVOMECE

Opposer's trademark

AVOMET

Respondent-Applicants trademark

Obviously, the competing marks are not identical. The initial and ending letters of the marks: "I" and "C" of the Opposer; and, "A" and "T" of the Respondent-Applicant, creates an aural and visual distinction from each other. Such that, the holistic cadence and effect of articulation of the marks distinguish the Opposer's mark from that of the Respondent-Applicants. Even in a hand stroke appearance, the difference in letters is highlighted because tile letters "I" and "C" of IVOMECE cannot be mistaken as the letters "A" and "T" of AVOMET.

⁵ *Pribhda J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 Nov.1999,citing *Etepha v. Dir. of Patents, supra* , *Gabriel v. Perez*, 55 SCRA 406 (1974) . See also Article 15, par. (1), Art. 16, par 91), of the Trade related Aspect of Intellectual Property (TRIPS Agreement).

Moreover, the Respondent-Applicants goods, although belonging to the same classification no. 05, pertain to pharmaceutical or drug products of distinct nature, composition, purpose and channels of trade, from that of the Opposer. The mark or brand IVOMEC covers antiparasitic preparation for veterinary use. On the other hand, AVOMET is a brand or mark for the treatment of nausea and vomiting, including symptoms of functional dyspepsia. The former is for the treatment of animal disease, while the latter is for the treatment of human illness. It is highly improbable, as practical mind dictates, to confuse a medicine for man for that of animals. They are also purchased in different stores such that committing mistake in buying one thinking that what was purchased is the other, is nil.

The situation is not the same as when two competing brands cater to or treat the same or related diseases. It is unlikely that the consumers will associate the Respondent-Applicants mark and product with the Opposer's and. As such, adverse effect on the reputation or goodwill of the Opposer's mark, cannot be fairly inferred.

Even assuming, *en arguendo*, that the Opposer's mark is well-known, Sec. 123.1 (f) of the IP Code still does not apply. The protection accorded to well-known marks under the said provision of law lies only if the competing marks are confusingly similar, which is not the case in this instance.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby DENIED. Let the file wrapper of Trademark Application No. 4-2007-014167 be returned together with a copy of this Decision to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Makati City, 29 July 2010.

NATHANIEL S. AREVALO
Director, Bureau of Legal Affairs
Intellectual Property Office