

PFIZER CARIBE LIMITED,
Opposer,

PC 14-2006-00125

-versus -

Opposition to:
TM Application No. 4-2005-008053
(Filing Date: 15 August 2005)

ELMER C. TENDERO
Respondent-Applicant.

TM: "ZYTOX"

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Decision No. 2007-66

DECISION

This is an opposition filed by Pfizer Caribe Limited, a company organized in the United Kingdom with principal place of business at Coutts House, Le Tr ucho, St. Peter Port, Guernsey, GY1 1WD, successor in interest of Pharmacia & Upjohn Caribe, Inc., against the application for registration of the mark ZYTOX, under application Serial No. 4-2005-008053 of Elmer C. Tendaro filed on 18 August 2005.

The grounds for the opposition are as follows:

1. The registration of the mark subject of this opposition is contrary to Sections 123.1 (d), (e), (f) of Republic Act No. 8293, which prohibit the registration of a mark which:

(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 resembles such a mark as to be likely to deceive or cause confusion;

(e) Is identical with or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services

(f) Is identical with, or confusingly to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respects 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 interest of the owner of the registered mark are likely to be damaged by such use.

2. The Opposer is the owner of the ZYVOX mark, which is registered with the Intellectual Property Office in the name of Pharmacia & Upjohn Caribe, Inc., under Registration No. 4-1998-008930 issued on 20 March 2005 for goods in class 5, particularly: "pharmaceutical preparations and substances, namely antibiotics for human use veterinary and sanitary preparations; dietetic substances adapted for a medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin, fungicides, herbicides".

3. The Respondent-Applicant's mark nearly resembles the Opposer's ZYVOX mark as to be likely to deceive or cause confusion. Hence, the registration of the Respondent-Applicant's mark will be contrary to Section 123.1 (d) of Republic Act No. 8293.

4. Opposer is entitled to the benefits granted to foreign nationals under Section 3 of Republic Act No. 8293, which provides:

“Section 3. International Conventions and Reciprocity. - Any person who is a national or who is domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law, should be entitled to benefits to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled by this Act.”

The Paris Convention for the Protection of Industrial Property (the “Paris Convention”) provides that:

“Article 6bis

- (1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use of a trademark which a reproduction, an imitation, or a translation considered by competent authority of the country of registration or use to be well known in that country as being the mark of a person entitled to the benefits of this Convention and used for identical or similar goods xxx

“Article 10bis

- (2) The countries of the Union are bound to assure nationals of such countries effective protection against unfair competition”

5. The use by the Respondent-Applicant of the ZYTOX mark on “pharmaceutical product for the treatment of postpartum hemorrhage and use of the induction for labor, stimulation for labor in hypotonic uterine inertia, management of missed and incomplete abortion.” In class 5 and other goods that are similar, identical or closely related to goods that are produced by, originate from, or are under the sponsorship of the Opposer, such as those covered by the registration for XYVOX under Registration No. 4-1998-008930 will mislead the purchasing public into believing that the Respondent-Applicant's goods are produced by, originate from, or under the sponsorship of the Opposer. Respondent-Applicant's use of the ZYTOX mark will constitute unfair competition and potential damage to the Opposer will be caused as a result of the Opposer's inability to control the quality of the products put on the market by the Respondent-Applicant under the ZYTOX mark.

6. The use by the Respondent-Applicant of the ZYTOX mark in relation to any goods identical, similar or closely related to the Opposer's goods will take unfair advantage of, dilute and diminish the distinctive character or reputation of the Opposer's ZYVOX mark.

7. The Opposer's ZYVOX mark is well-known and world famous mark. Hence, the registration of the Respondent-Applicant's mark will constitute a violation of Articles 6bis and 10bis of the Paris Convention in junction with Sections 3, 123.1 (e) and 123.1 (f) of Republic Act No. 8293.

8. The denial of the application subject of this opposition is authorized under other provisions of Republic Act No. 8293.

This Bureau issued a Notice to Answer dated 15, September 2006, which was sent through registered mail on 15 September 2006. Respondent, however failed to file the required verified answer as well as the affidavit of his witnesses and supporting evidence,

The issues in this case are whether the marks “ZYTOX” and “ZYVOX” are confusingly similar and whether the opposer will be damaged by the respondent-applicant’s use of the mark ZYTOX considering that it is allegedly a well-known mark and that it has acquired goodwill.

The applicable provisions of law are Section 123 (d) of Republic Act No. 88293, which provides:

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

x x x

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

- a. The same goods or services, or
- b. Closely related goods or services, or
- c. If it nearly resembles such a mark as to be likely to deceive or cause confusion;

The opposer secured the registration of its mark ZYVOX in the Philippines under Certificate of Registration No. 1998-008930 issued on 20 March 2005. (Exhibit “D”) Based on its certificate of registration, ZYVOX is used on goods under class 5 namely: “Pharmaceutical preparations and substances, namely antibiotics for human use veterinary and sanitary preparations; dietetic substances adapted for a medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin, fungicides, herbicides.” Based on the certificates of products registrations for destroying vermin, fungicides, herbicides.” Based on the certificates of product registration issued by the Bureau of Food and Drugs, (Annexes B, C and D) annexed to the affidavit of Edgar Zaragoza (Exhibit “B”), opposer’s witness, ZYVOX has approved indications for “treatment of serious and life-threatening Gram-positive infections including methicillin resistant staphylococcus aureus infection and vancomycin resistant enterococcus infections.”

It appears from the records that respondent-applicant’s for the mark ZYTOX is also for goods under class 5. Respondent-applicant’s use of the mark ZYTOX is for “Pharmaceutical product for the treatment of postpartum hemorrhage and us of for the induction of labor, stimulation of labor in hypotonic uterine inertia, management of missed and incomplete abortion.”

The Supreme Court, in determining whether or not there is confusing similarity between trademarks, has relied on the dominancy test or the assessment of the essential or dominant features in the competing trademarks. Even the spelling and the similarity in sounds and pronunciation are taken into consideration.

A side by side of the two (2) competing marks clearly shows that Opposer’s ZYVOX and respondent-applicant’s ZYTOX are confusingly similar. The style in which the letters are written and spelled are almost the same, both containing two (2) syllables and similar prefixes and suffixes. Subject marks have both five (5) letters, the only difference are the third letters thereof such that when the two words are pronounced, the sound is almost the same. ZYTOX is not at all phonetically different from ZYVOX. For purposes of illustration, this Bureau has adopted the declaration of the Court in the case of CELANES Corporation of America vs. E.I. Du Pont de Nemours & Co. (1946), 154F. 2d 146 148 which held that “the following words have the same significance or have the same appearance and meaning:

“CELDURA” and “CORDURA” – That both marks considered as a whole are similar in meaning and appearance cannot be doubted. When spoken as written they sound very much alike. Similarly of sound alone, under such circumstances, is sufficient to cause the marks to be regarded as confusingly similar when applied to merchandise of the same descriptive properties.”

In like manner, the Supreme Court made the following pronouncements to the effect that:

“The tradename “LIONPAS” for medicated plaster cannot be registered because it is confusingly similar to “SALONPAS”, a registered trademark also for medicated plaster. x x x Although the two letters of “SALONPAS” are missing in “LIONPAS”, the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. “(Marvex Commercial Co vs. Hawpia & Co., 18 SCRA 1178),

“The similarity between the two competing trademarks, DURAFLEX and DYNAFLEX is apparent. Not only are the initial letters and the last half of the appellations identical but the difference exists in only two out of the eight literal elements of the designations. Coupled with the fact that both marks cover insulated flexible wires under Class 20; x x x no difficulty is experienced I reaching the conclusion that there is deceptive similarity that would lead the purchaser to confuse one product with the other.” (American Wire and Cable Co. vs. Director of Patents, 31 SCRA 544),

The marks of the contending parties are reproduced below for better scrutiny. The label that bears opposer’s mark is also reproduced hereunder.



Respondent-applicant’s mark



Opposer’s mark (Exhibit "D")

Moreover, the goods involved are the same; they pertain to pharmaceutical products falling under Class 5 of the International Classification of Goods. As stated at the outset, opposer’s Certificate of Registration No. 1998-008930 for the trademark ZYVOX covers goods falling under Class 5 namely: Pharmaceutical preparations and substances, namely antibiotics for human use veterinary and sanitary preparations; dietetic substances adapted for a medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin, fungicides, herbicides while respondent-applicant’s trademark ZYTOX also covers falling under the same class namely: Pharmaceutical product for the treatment of postpartum hemorrhage and use of the induction for labor, stimulation for labor in hypotonic uterine inertia, management of missed and incomplete abortion. Thus, applying these competing marks to the same goods, which passed through the same channels of trade and marketed similarly may lead or result to confusion in the mind of the prospective buyers between the two trademarks.

Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with

reference to their form, composition, texture or quality. They may also relate because they serve the same purpose or sold in grocery stores. (Esso Standard Eastern, Inc., CA 116 SCRA 336)

Thus, in the case of Co Tiong SA vs. Director of Patents (95 Phil 1), the application for the registration of the trademark "FREEDOM" was rejected due to existing of the mark "FREEMAN" over the class of goods.

Further, as enunciated in the case of Sta. Ana vs. Maliwat, 24 SCRA 1018, modern Law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trademark or trade name is likely to lead to a confusion of source, as where protective purchasers would be misled into thinking that the complaining party has extended his business into field (148 ALR 56 seq; 52 Am. Jur. 576) or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business (v. 148 ALR, 77, 84; 52 Am. Jur. 576, 577).

Opposer has sufficiently proved that it is dealing in the distribution and sale of goods under Class 5 bearing the trademark ZYVOX in several countries worldwide such as that its distribution and sale of its goods in the Philippines is a potential expansion of its business. To allow the registration of respondent-applicant's trademark ZYTOX used on goods falling under the same class not only forestalls opposer's expansion but is likely to cause confusion and deception of the buying public as to the source of goods.

Finally, opposer claims to have and distributed ZYVOX products in the Philippines starting 2002 by an attached label; of its product. (Annex "A" of Exhibit "B"). In the affidavit-testimony of Arthur Silvertein (Exhibit "C"), he provided a tabular outline of total figures of purported worldwide sales in US dollars since 2000 of the ZYVOX product. It is its position that its mark has become well-known through health awareness campaigns and advertisements (Exhibit "C") launched with regard to such products. By the mere fact that has been registered in other jurisdictions (Exhibit "E" to "L") and that it has been advertised to increase public awareness of its health benefits does not merit the automatic finding that a mark is well-known. To sustain such finding the mark must have gained immense popularity, distinction and goodwill.

WHEREFORE, premises considered, the OPPOSITION filed by Pfizer Caribe Limited, is, as it is hereby, SUSTAINED. Consequently, Application bearing Serial No. 4-2005-008053 filed by respondent-applicant, Elmer C. Tendero, on 18 August 2005 for the mark "ZYTOX" used on "pharmaceutical product for the treatment of postpartum hemorrhage and use for the induction of labor, stimulation of labor in hypotonic uterine inertia, management of missed and incomplete abortion" under Class 5, is as it is hereby, REJECTED.

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

SO ORDERED.

Makati City, 05 June 2005

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