

PFIZER PRODUCTS, INC.
Opposer,
- versus -

IPC 14-2006-00135

Opposition to:
TM Application No. 4-2005-008050
(Filing Date: 18 August 2005)

ELMER C. TENDERO
Respondent-Applicant.

TM: "NORVADIL"

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Decision No. 07-128

DECISION

This pertains to an Opposition filed on 22 September 2006 by herein opposer, PFIZER PRODUCTS, INC., a company organized under the laws of Connecticut, U.S.A., with principal place of business at Easter Point Road, Groton, Connecticut, 06340 U.S.A., against the application filed on 18 August 2005 bearing Serial No. 4-2005-008050 for the registration of the trademark "NORVADIL" used for goods in Class 05, of the Nice Classification of Goods namely pharmaceutical products for the treatment of hypertension, angina myocardial ischemia, congestive heart failure (CHF), which application was published in the Intellectual Property Office Official Gazette, officially released for circulation on 25 May 2006.

The respondent-applicant in this instant petition is Elmer C. Tendaro, with address on record at 160 Scout Limbaga Ext., Quezon City.

In support of this instant opposition, opposer enumerates the following grounds, to wit:

1. The registration of respondent-applicant's nearly resembles the Opposer's NORVASC as to be likely to deceive or cause confusion. Hence, registration thereof will be contrary to Section 123.1 (d) of Republic Act (R.A.) No. 8293.
2. The registration of Respondent-applicant's mark is likewise prohibited under Section 123.1 (e), and (f) of R.A. No. 8293.
3. Opposer is entitled to the benefits granted to foreign nationals under Section 3 of the International Convention and Reciprocity of Republic Act No. 8293.
4. The opposer is domiciled in the United States. Both the Philippines and the United States are members of the Paris Convention for the Protection of Industrial Property, which under Article 6bis and 10bis of the Convention provides protection to well known marks and effects protection against unfair competition.
5. The opposer's NORVASC mark is a well-known and famous mark. Hence, the registration of the respondent-applicant's mark will constitute a violation of Article 6bis and 10bis of the Paris Convention in conjunction with Sections 3, 123.1 (e) and 123.1 (f) of Republic Act No. 8293.
6. The use by the respondent-applicant of the NORVADIL mark on the enumeration of goods under 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 "pharmaceutical preparations having anti-anginal and antihypertensive properties" in class 5 will mislead the purchasing public into believing that the respondent-applicant's goods are produced by, originate from, or are under competition and will cause inability to control the quality of the products in the market.

7. The use by respondent-applicant of the NORVADIL mark in relation to any goods identical, similar or closely related to the opposer's good will take unfair advantage of dilute and diminish the distinctive character or reputation of the opposer's NORVASC mark.

The allegation of facts, in summary, are to wit:

1. The opposer is the owner of the NORVASC mark, which is registered in the opposer's name with the Intellectual Property Office under Registration No. 48241 issued on 29 May 1990 for goods in class 5, particularly; "pharmaceutical preparations having antianginal and antihypertensive properties."
2. The opposer has not consented to the respondent-applicant's use and registration of the NORVADIL mark or any other mark identical or similar to the opposer's NORVASC mark.
3. The NORVASC mark was first used in commerce in the United States of America in 1987 by Pfizer Inc., the opposer's predecessor in interest. Pfizer Inc. used the NORVASC mark in commerce in the Philippines as early as March 1992, or prior to the filing date of the application subject of this opposition. It has not abandoned the subject mark and has continually using it in trade and commerce in the Philippines and in other countries.
4. By virtue of the prior and continuous use by the opposer and its predecessors in interest of the NORVASC mark in the Philippines and elsewhere, the mark has become popular and well known internationally and in the Philippines and has established for the opposer valuable goodwill with the public, which has identified the opposer as the source of goods bearing the said mark.
5. The spelling, pronunciation and appearance of respondent-applicant's NORVADIL mark are confusingly similar to the opposer's NORVASC mark.
6. The opposer has extensively promoted the NORVASC mark worldwide. Over the years, the opposer has obtained significant exposure for its products use, in various media including medical journals, business newsletters and journals. The mark has also become well known as a result of its exposure in the internet at the website www.norvasc.com.

Subsequently, a Notice to Answer dated 05 October 2006 was released by this Bureau requiring respondent-applicant to file an Answer to the Verified Notice of Opposition within thirty (30) days from receipt of the said Notice. Since no Answer was received from respondent-applicant, this Bureau was prompted to issue an Alias Notice to Answer. It was personally served and received by a certain Jona Caballero at the address on record.

After reasonable lapse of time, no Answer or any motion relative thereto has been filed by Respondent-Applicant. Hence, this case is deemed submitted for decision after the following pieces of documentary evidence of Opposers are admitted for whatever purpose they may be worth, to wit:

Exhibits	Description
"A"	Verified and authenticated Notice of Opposition
"B"	Affidavit of Eleanor Lopez
"B-1"	Copy of an actual product label showing NORVASC mark

“B-2”	Certificate of Product Registration No. DR-XY15374 for Norvasc, 5 mg.
“B-3”	Certificate of Product Registration No. DR-XY16948 for Norvasc, 10 mg.
“C”	Affidavit of Frank Maldari
“C-1”	List of countries and the launch date of NORVASC
“C-2”	Table on the details of NORVASC applications and registrations
“C-3”	Representative copies of registration of the NORVASC mark
“D”	Copy of Philippine Trademark Registration No. 48241
“E”	Authenticated certification on authority of FRANK MALLARI to verify the notice of opposition and execute the certificate of non-forum shopping.

The issue –

WHETHER OR NOT THERE IS CONFUSING SIMILARITY BETWEEN OPPOSER’S REGISTERED MARK “NORVASC” AND RESPONDENT-APPLICANT’S APPLIED MARK “NORVADIL”, BOTH COVERING CLASS 5 GOODS.

Section. 123.1 (d) of the Intellectual Property Code or R.A. 8293 provides the criteria for the registration of a trademark, to wit:

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

x x x

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

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

x x x

In a contest involving registration of trademark, the determinative factor is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would likely cause confusion or mistake on the part of the buying public.

It does not require that the competing trademarks must be so identical as to produce actual error or mistake. It is rather sufficient that the similarity between the two trademarks is such that there is a possibility or likelihood of the older brand mistaking the newer brand for it.

The existence of confusion of trademark or the possibility of deception to the public hinges on “colourable imitation”, which has been defined as “such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade name in their overall presentation or in their essential and substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.” (Emerald Garment Mfg. Corp. vs. Court of Appeals, 251 SCRA 600)

In resolving the issue of confusing similarity, the law and jurisprudence has developed two kinds of tests – the Dominancy Test as applied in a litany of Supreme Court decisions including Asia Brewery, Inc. vs. Court of Appeals, 224 SCRA 437; Co Tiong vs. Director of Patents, 95 Phil. 1; Lim Hoa vs. Director of Patents, 100 Phil. 214; American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544; Philippines Nut Industry, Inc. vs. Standard Brands, Inc., 65 SCRA 575; Converse Rubber Corp. vs. Universal Rubber Products, Inc., 147 SCRA 154; and the *Holistic Test* developed in Del Monte Corporation vs. Court of Appeals, 181 SCRA 410; Mead Johnson & Co. vs. N.V.J. Van Dorp, Ltd., 7 SCRA 771; Fruit of the Loom, Inc. vs. Court of Appeals, 133 SCRA 405.

As its title implies, the Test of Dominancy focuses on the similarity of the prevalent features, or the main, essential and dominant features on the similarity of the competing trademarks which might cause confusion or deception.

The Holistic Test on the other hand, requires that the entirety of the marks in question be considered in resolving confusing similarity. Comparison of words is not the only determining factor. In the case of Mighty Corporation vs. E & J Gallo Winery, 434 SCRA 473, “the discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other.

The honourable Supreme Court has consistently relied on the Dominancy Test in determining questions of infringement of trademark. Thus, in the land mark case of Mc Donald’s Corporation vs. LC Big Mak, 437 SCRA 10, it was ruled that:

“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.”

In fact, the test of dominancy is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the “colourable imitation of a registered mark x x x or a dominant feature thereof.”

Now, as to what constitutes a dominant feature of a label, no set of rules can be deduced. Usually, these are signs, color, design, peculiar shape or name, or some special, easily remembered earmarks of the brand that easily attracts and catches the eye of the ordinary consumer.

Relatively, in Marvex Commercial Co. Inc. vs. Petra Hawpia & Co., 18 SCRA 1178, the Supreme Court held:

“The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that “SALONPAS” and “LIONPAS” are confusingly similar in sound: “Gold Duct” and “Gold Drop “, “Jantzen” and “Jazz-Sea”, “Silver-splash”

and "Supper-Flash"; "Cascarete" and "Charseurs", and "Celborite", "Celluloid" and "Cellonite", "Charseurs", "Cutes and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo-hoo" Leon Amdur, In his book "Trademark Law and Practice", pp. 419-421, cites, as coming within the purview of the idem sonans rule. "Yusea" and "U-C-A", "Steinway Pianos" and "Stienberg Pianos" and "Seven-up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Condura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.

In the instant case, this Bureau finds several dominant features in the competing trademarks to cause the likelihood of confusion. First, the visual and aural similarities between the marks are patently obvious. Both marks consist of beginning words "NORVA", which effects the same cadence when initially pronounced. The difference in the ending syllable "DIL" for "NORVADIL" and the last two letters "SC" for "NORVASC" do not sound remarkably because of the similarity in "NORVA" sufficient for retention in the memento of the purchasing public.

This is the application of the idem sonans rule as held in the case of *Sapolin Co. Balmaceda*, 67 Phil. 795, which provides that confusion is likely to arise between contending marks which when pronounced sounds alike.

Second. The Font and style of the contending marks as marked, appear similar, as shown in opposer's product label; in its Exhibit "B-1" and respondent-applicant's file wrapper records.

Third. Records, consisting of opposer's Exhibit "D" (NORVASC Philippine Trademark Registration), and NORVADIL's filewrapper records reveal that the contending marks cover the same class 5 of goods classification. They are competing goods because they serve the same purpose, for the treatment of hypertension and angina pectorals; and, they flow through the same channel of trade, as they are marketed in drugstores which do not always require doctor's prescription when dispensed. As a practical observation, a customer who was unable to purchase NORVASC would probably get NORVADIL perceiving its same benefits in an ailment or probably, that it originates from the same source as the other. Under these circumstances, the damage that can be incurred by the opposer to the business it has created since its application and the subsequent issuance of registration in its favour way back in 1990 is not far-fetched. This is intention and spirit of the trademark law in affording protection to the trademark owners.

Jurisprudence has not disregard the fact that differences in contending marks still exist. But these differences appear insignificant by reason of evident similarity in the dominant feature and the overall appearance of the marks. As a matter of fact, considering the following:

"It is not necessary, to constitute trademark "infringement", that every word of a trade-mark should be appropriated, but it is sufficient that enough be taken to deceive the public in the purchase of a protected article". (*Bunte Bros. vs. Standard Chocolates*, D.C. Mass, 45 F. Supp. 478,481).

"Infringement of trade-mark does not depend on the use of identical words, not on the question whether they are so similar that a person looking at one would be deceived into the belief that it was the other, it being sufficient if one mark is so like another in form, spelling, or sound that one with not a very definite or clear recollection as to the real mark is likely to be confused or misled".

Respondent-applicant's non-submission of answer merited its failure to prove better right over the opposer nor dislodge the superior right of opposer over the product.

Anent opposer's position that its mark is well-known and therefore, be protected under the law on well-known marks, this Bureau is not convinced. It is a basic rule that opposer has the onus probandi in establishing and proving that its mark is well-known internationally and in the Philippines.

In the instant case, opposer failed to submit eloquent proof to prove that the mark has actually gained and enjoyed a worldwide reputation internationally and in the Philippines, in accordance to the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers, particularly Rule 102, which enshrines the criteria to determine a well-known mark, to wit:

"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."

Opposer, in the case at bar, did not meet the enumerated criteria or any combination thereof of a well-known mark. Opposer's Exhibits "C-1" representing list of countries and the launch date of NORVASC, Exhibits "B-2" and "B-3", the Certificates of Product Registration and other evidence presented will not vest opposer's mark of a well-known status. It bears stressing that the pieces of evidence do not show the duration, extent and geographical area of its alleged promotion or advertisements, if any. In the case of Prescilla Nedia, et al vs. Celso D. Lavina, et al, September 26, 2005, the Honorable Supreme Court ruled that, "Mere allegation is not evidence and is not equivalent to proof." Thus, the allegation of opposer's NORVASC mark as well-known has no leg to stand on. While the trademark "NORVASC" may be famous, it failed to prove that it is well-known.

WHEREFORE, premises considered the Notice of Opposition filed by Pfizer Products, Inc., is as it is hereby SUSTAINED. Accordingly, Application Serial No. 4-2005-008050 filed by respondent-applicant, Elmer C. Tendero on 18 August 2005 for the mark "NORVADIL" under Class 5, is as it is hereby, REJECTED.

Let the file wrapper of "NORVADIL", subject matter of this case be forwarded to the Bureau of Trademarks for appropriate action in accordance with this decision.

SO ORDERED.

Makati City, 04 September 2007.

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