

PFIZER INC.,
Opposer,

IPC No. 14-2008-00179
Case Filed: 11 August 2008

- versus -

Opposition to:

Appl'n. Serial No. 4-2007-005883
Date Filed: 08 June 2007
Trademark: "ZITHROGEN"

UNITED AMERICAN
PHARMACEUTICALS, INC.
Respondent-Applicant.
x-----x

Decision No. 2009-109

DECISION

This is a verified NOTICE OF OPPOSITION filed by opposer Pfizer Inc. to the application for registration of the trademark "ZITHROGEN" bearing Application Serial No. 4-2007-005883 filed on June 08, 2007 by respondent-applicant United American Pharmaceuticals, Inc., covering the goods "Pharmaceutical preparations for use as antibiotic" under Class 05, appearing in the electronic gazette of the Intellectual Property Office of the Philippines (IP Philippines) which was released for circulation on April 11, 2008.

Opposer is a corporation organized under the laws of the State of Delaware, United States of America, having principal place of business at 235 East 42nd Street, New York, New York, 10017-5755, United States of America. Respondent-applicant is a corporation with business address at No. 750 Shaw Boulevard, Mandaluyong City.

The grounds for opposition are as follows:

"1. The registration of the ZITHROGEN mark is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act No. 8293, as amended, which prohibit the registration of a mark that:

"(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;*

(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: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(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.”

“2. Opposer is the owner of and has exclusive rights over the well-known ZITHROMAX trademark which is registered with the Philippine Intellectual Property Office (“IPO”) under class 5 for “An Antibiotic Preparation”. The details of the registration appear below:

Mark	Registration No.	Date Issued	Class
ZITHROMAX	4-2000-007549	05 August 2994	5

“3. Respondent-Applicant’s ZITHROGEN mark is confusingly similar to the well-known ZITHROMAX trademark as to be likely to deceive or cause confusion. The component “ZITHRO” in Respondent-Applicant’s ZITHROGEN mark is exactly the same in appearance, spelling and phonetics as the component “ZITHRO” in the well-known ZITHROMAX trademark. The use of a three-letter suffix further makes the ZITHROGEN mark more closely similar to the ZITHROMAX mark. There can be no other conclusion other than that the ZITHROGEN mark was adopted specifically to imitate the overall appearance of the ZITHROMAX mark. Hence, the registration of the Respondent-Applicant’s mark will be contrary to Section 123.1 (d) of Republic Act No. 8293.

“4. The 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, shall 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 Opposer is domiciled in the United States of America. Both the Philippines and United States of America are members of the Paris Convention for the Protection of Industrial Property. The Paris Convention provides:

“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 constitutes 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 x x x.”

“Article 10bis”

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

“5. The ZITHROMAX trademark is well-known and world famous. Hence, the registration of the Respondent-Applicant’s ZITHROGEN 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. Opposer and/or its subsidiaries, joint ventures, sister concerns, predecessors-in-title, licensees and assignees in several other countries have used the ZITHROMAX

trademark in the Philippines and elsewhere since 1992, and prior to the filing date of the application subject of this opposition. Opposer continues to use the ZITHROMAX mark in the Philippines and in numerous other countries.

“7. The Opposer and/or its subsidiaries, joint ventures, sister concerns, predecessors-in-title, licensees and assignees in several other countries have extensively promoted the ZITHROMAX trademark worldwide, and have obtained significant exposure for the goods upon which the ZITHROMAX trademark is used in various media, including advertisements, internationally well-known print publications, and other promotional events.

“8. The Opposer has not consented to the Respondent-Applicant’s use and registration of the ZITHROGEN trademark, or any other mark identical or similar to the ZITHROMAX trademark.

“9. The Respondent-Applicant uses the ZITHROGEN mark in Class 5 for “Pharmaceutical preparations for use as Antibiotic”. The Respondent-Applicant’s use of the mark on those goods and other goods that are similar, identical or closely related to the goods that are produced by, originate from, or are under the sponsorship of the Opposer, such as those covered by the registration for the ZITHROMAX trademark under Registration No. 4-2000-007549, will mislead the purchasing public into believing that the Respondent-Applicant’s goods are produced by, originate from, or are under the sponsorship of the Opposer. Potential damage to the Opposer will also be caused as a result of its inability to control the quality of the products offered or put on the market by Respondent-Applicant under the ZITHROGEN mark.

“10. The use by the Respondent-Applicant of the mark subject of this Opposition in relation to its goods, whether or not 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 ZITHROMAX trademark

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

On January 05, 2009, Respondent-Applicant filed its VERIFIED ANSWER TO THE OPPOSITION. Respondent-applicant admitted the allegations in the introductory paragraph of the opposition as to the allegation that the mark “ZITHROGEN” was applied for registration by respondent-applicant on June 08, 2007, and that said application was published in the IP Phil.’s electronic gazette on April 11, 2008. Further, respondent-applicant made the following specific denials:

“2. Respondent specifically denies for lack of sufficient knowledge or information to form a belief as to the truth or falsity thereof the allegations in the following paragraphs in the Opposition:

2.1 The introductory paragraph of the Opposition regarding:

2.1.1 The corporate circumstances and address of the Opposer.

2.1.2 The belief that Opposer will be damaged by the registration of the trademark Zithrogen.

2.2 Paragraph No. 2 of the Opposition insofar as it is alleged that Opposer owns the mark ZITHROMAX and registered with the IPO.

2.3 Paragraph No.5 of the Opposition insofar as it is alleged that the Opposer is a well-known mark.

2.4 Paragraph No. 6 of the Opposition insofar as it is alleged that:

2.4.1 Opposer and/or its subsidiaries, joint ventures, sister concerns, predecessors-in-title, licensees and assignees in several other countries have used the ZITHROMAX trademark in the Philippines and elsewhere since 1992;

2.4.2 Opposer continues to use the ZITHROMAX mark in the Philippines and in numerous other countries;

2.5 Paragraph No. 7 of the Opposition insofar as it is alleged that:

2.5.1 Opposer and/or its subsidiaries, joint ventures, sister concerns, predecessors-in-title, licensees and assignees in several other countries have extensively promoted the ZITHROMAX trademark worldwide, and have obtained significant exposure for the goods upon which the ZITHROMAX trademark is used in various media, including advertisements, internationally well-known publications, and other promotional events.

2.6 Paragraph No. 9 of the Opposition insofar as it is alleged that potential damage to the Opposer will also be caused as a result of its inability to control the quality of the products offered or put on the market by Respondent under Zithrogen trademark.

“3. For reasons and facts stated in the Affirmative Defenses set forth hereunder, Respondent specifically denies the allegations in the following paragraphs:

3.1 Paragraph 3 of the grounds for Opposition insofar as it is asserted that:

3.1.1 Respondent’s Zithrogen mark is confusingly similar to ZITHROMAX;

3.1.2 The component Zithro in Respondent’s Zithrogen mark is exactly the same in appearance, spelling and phonetics as the component Zithro in the Zithrogen Trademark;

3.1.3 The use of a three-letter suffix further makes the Zithrogen mark more closely similar to ZITHROMAX mark;

3.1.4 There can be no other conclusion other than that the Zithrogen mark was adopted specifically to imitate the overall appearance if the ZITHROMAX mark;

3.1.5 The registration of Respondent’s mark will be contrary to Section 123.1 (d) of Republic Act No. 8293.

3.2 Paragraph No. 5 of the Opposition in respect of the allegation that:

3.2.1 Registration of the Zithrogen mark will constitute a violation of Articles 6bis and 10bis of the Paris Convention in conjunction with Sections 3, 123.1 (e), and 123.1 (f) of Republic Act 8293;

3.3 Paragraph No. 9 of the Opposition insofar as it is alleged that:

3.3.1 The Respondent's use of the mark (ZITHROGEN) on those goods that are similar, identical or closely related to the goods that are similar, identical or closely related to the goods and other goods that are similar, identical or closely related to the goods that are produced by, originate from or are under the sponsorship of the Opposer, such as those covered by the registration for the ZITHROMAX trademark under Registration No. 4-2000-007549, will mislead the public into believing that Respondent's goods are produced by, originate from, or are under the sponsorship of the Opposer.

3.4 Paragraph No. 10 of the Opposition insofar as it is alleged that:

3.4.1 The use by the Respondent of the mark subject of this Opposition in relation to its goods, whether or not it is 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 ZITHROMAX trademark.

3.5 Paragraph No. 11 of the Opposition insofar as it is alleged that the denial of the application subject of the Opposition is authorized under other provisions of Republic Act No. 8293.

Respondent-applicant then makes the following special and affirmative defenses:

“Respondent's trademark ZITHROGEN is not confusingly similar to ZITHROMAX.

4.1 Respondent's trademark Zithrogen is not confusingly similar to Opposer's trademark ZITHROMAX as to be likely to cause confusion, mistake and deception on the part of the purchasing public. Evidently, Opposer's ground for its opposition has no factual or legal basis.

4.1 The question to be answered in deciding whether a trademark is confusingly similar to another is: Is there a likelihood that the trademark may cause confusion or mistake or may deceive purchasers that said product is the same as the other or is manufactured by the same company? In answering this question, the Supreme Court had, in many occasions, ruled that all the surrounding circumstances should be considered.

4.1.1 In the case of Mead Johnson & Company vs. N.V.J. Van Drop, Ltd., et.al., 7 SCRA 768,771 [1963], the Supreme Court held that “In determining whether two trademarks are confusingly similar, the two marks in their entirety as they appear in the respective labels must be considered in relation to the goods to which they are attached. 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.”

In the above cited case, NV.J. Van Dorp applied for the registration of the trademark Alaska which was opposed by Mead Johnson who owned the trademark Alacta. In finding that there was no confusing similarity between the two, the Supreme Court stressed that while “there are similarities in spelling, appearance and sound for both are composed of six letters of three syllables each and each syllable has the same vowel, but in determining if they are confusingly similar a comparison of said words is not the only determining factor. The two marks in their entirety as they appear in the respective labels must also be considered in relation to the goods to which they are attached.”

4.2 Again, in *Etepha, A.G. vs. Director of Patents and Westmon Pharmaceuticals, Inc.*¹ the Supreme Court emphasized:

“A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be done from the view point of the prospective buyer. Some factors such as sound, appearance, form, style, shape, size or format, color, ideas connoted by the marks, the meaning, spelling and pronunciation of words used, and setting in which the words appear may be considered. “

4.3 Applying this test in the present case, it is readily evident that the similarities between Zithrogen and ZITHROMAX are completely undermined by the material differences of the two.

4.3.1 The first letter of the respondent's mark (“Z”) is significantly bigger than the other letters compared to that of the Opposer's mark;

4.3.2 The suffixes of the two marks are completely different, i.e. “G-E-N” and “M-A-X”

4.3.3 With these differences, one can at once be impressed more by the dissimilarities than by the similarities in such a way that no confusion would likely occur.

4.4 The extent of confusion can be gauged from the consumer's viewpoint. As enunciated by the Supreme Court in *Del Monte Corporation v. CA*, 181 SCRA 410:

“The question is not whether the two articles are distinguishable by their labels when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting 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 goods, is the touchstone.”

4.4.1 Relevantly, in *American Cyanamid Company vs. The Director of Patents*², the Supreme Court held that: “In this case of SULMET and SULMETINE, the product is for medicinal veterinary use and consequently, the purchaser will be more wary of the nature of the product he is buying”.

4.4.2 Likewise, in *Fruit of the Loom, Inc. vs. Court of Appeals*³, the High Court, citing *Carnation Co. vs. California Growers Wineries*, (97 F. 2d 80) held that “the ordinary purchaser must be thought of as having, and credited with, at least a modicum of intelligence to be able to see the obvious differences between the trademarks in question.

4.4.3 In the present case, the glaring differences between the two trademarks as mentioned above would definitely and instantly catch the attention of the buying public. Hence, confusion and deception are avoided.

4.5 The instant case approximates that of *Bristol Myers Company vs. The Director of Patents*⁴. In that case, United American Pharmaceuticals filed a

1 G.R. No. L-20635 March 31, 1966.

2 G.R. No. L-23954. April 29, 1977

3 G.R. No. L-32747 Nov. 29, 1984

4 G.R. No. L-21587, May 19, 1966

petition for the registration of its trademark "BIOFERIN" intended for the treatment of common colds, influenza, etc. This application was opposed by Bristol Myers Company which is the owner in the Philippines of the trademark "BUFFERIN", also intended for relief in cases of simple headaches, neuralgia, colds, menstrual pain and minor muscular aches on the ground that both are practically the same in spelling and pronunciation. The Court through Justice J.P. Bengzon held that although the two words "BIOFERIN" and "BUFFERIN" have the same suffix and similar sounding prefixes, they appear in their respective labels with striking different backgrounds and surroundings, as to color, size and design, and consequently there is no confusing similarity between the trademarks. "Opposer has neither exclusive nor any vested right to use ZYTHRO and, thus, has no right to prevent others from utilizing the same.

"5. Opposer has neither exclusive nor vested right to use the ZYTHRO and, thus, has no right to prevent others from utilizing the same.

5.1 The Opposer, as alleged in its opposition is the registered owner of the mark "ZITHROMAX" but definitely not ZITHRO. It is thus, a mistake on the part of the Opposer to allege that the use of the mark Zithrogen by the respondent will be damaged by the registration of the respondent's mark.

5.2 It is more than clear that the Opposer's mark was lifted from the generic name "Azithromycin Dihydrate". It is well settled rule that any applicant-registrant cannot claim for its exclusive use of the words taken from a generic term.

5.3 Clearly, there is no valid reason for the opposition of the application for registration of the Respondent's trademark Zithrogen.

"The registration of the ZITHROGEN mark will not constitute a violation of Articles 6bis and 10bis of the Paris Convention in conjunction with Sections 3, 123. 1(e), and 123.1 (f) of Republic Act 8293.

6. The registration of the Zithrogen mark will not constitute a violation of Articles 6bis and 10bis of the Paris Convention in conjunction with Sections 3, 123.1 (e), and 123.1 (f) of Republic Act 8293;

6.1 It bears to stress that the cited provision of the Opposer provides:

"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 constitutes a reproduction, an imitation, or a translation ...xxx" (underscoring ours)

6.2 As clearly explained above, there is even no confusing similarity between the two marks. Therefore, it would be stretching too much to say that the respondent's mark is a reproduction, an imitation, or a translation of the Opposer's mark.

"Both marks are used on medicines that require prescription when bought in drugstores and, thus, there can be no confusion among the buying public."

7. Both marks are used on medicines that require prescription from physicians when bought in drugstores and, thus, there can be no confusion among the buying public.

7.1 Significantly, in *Etepha vs. Director of Patents* (ibid), the Supreme Court had the occasion to rule that "Petitioner's PERTUSSIN and Respondent's ATUSSIN

are both to be dispensed upon medical prescription. The respective labels say so. 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; 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 drugstore. Similarly, the pharmacist or druggist verifies the medicine sold. The margin of error in the acquisition of one for the other is remote." (Underscoring ours).

7.2 In the instant case, and as clearly shown in Exhibit "B-1" to "B-3" of the Opposition, the medicine ZITHROMAX requires doctor's prescription. Thus, the presence of not just one but two intermediaries, the doctor and the pharmacist, would make the margin of error in the acquisition of one for the other is very remote.

7.3 Clearly, the theory of the Opposer about the possible confusion is without basis.

"At any rate, Respondent-Applicant previously applied for the registration of the mark ZITHROGEN with the Intellectual Property Office and was accordingly registered."

8. At any rate Respondent-Applicant previously applied for the registration of the mark Zithrogen with the IPO and was accordingly registered.

8.1 On 19 July 2004 Respondent-Applicant filed a similar application for the registration of the mark Zithrogen under class 5 for "pharmaceutical preparation for use as antibiotic";

8.2 After due examination, the IPO found that "the requirements of registrability under Sec. 123 have been met" (Attached herewith is a copy of the Registrability Report marked as Annex "1");

8.3 Considering that no opposition was filed after its publication in the IPO electronic gazette, the trademark Zithrogen was accordingly registered in the name of Respondent-Applicant (Attached herewith is a copy of the Certificate of Registration marked as Annex "2");

8.4 For reasons known only to the Respondent-Applicant, it decided to abandon the registration on 03 October 2007;

8.5 Clearly, when the IPO issued the aforesaid certificate of registration it found no reason whatsoever that the same was confusingly similar to the mark of the Opposer nor to any other marks. Significantly, no opposition was likewise filed by the herein Opposer which clearly suggests that it found no reason to oppose the same.

9. From the foregoing, it is abundantly clear that there is no valid reason for the opposition of the application for registration of the Respondent's trademark Zithrogen.

10. In support of the foregoing, the Instant Answer is herein verified by Mr. Eliezer Salazar which likewise serves as his affidavit (Nasser v. Court of Appeals, 191 SCRA 783 [1990]).

Preliminary conference ensued on February 10, 2009 and terminated on the same day.

The issues to be resolved herein are as follows:

1. Whether the opposer's mark "ZITHROMAX" is confusingly similar to respondent-applicant's mark "ZITHROGEN"; and
2. Whether respondent-applicant is entitled to the registration of the mark "ZITHROGEN"

Opposer's mark is depicted below:



Meanwhile, respondent-applicant's mark is depicted below:



A careful perusal of the respective marks shows that they are confusingly similar: Both have the prefix "ZITHRO" written in uppercase letters. Both are spelled and pronounced similarly. The prefix is the feature of both marks that immediately catches one's eyes. Such prefix, thus, appears to be the dominant feature of both marks. 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: Both are antibiotic preparations.

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 "ZITHROGEN" 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; *Urn Hoa v. Director of Patents*, G. R. No. L-8072, October 31, 1956; *Co Tiong Sa v. Director of Patents, et al.*, 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 candies 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 packaging 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 Diamicon, 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, this Bureau rules in the affirmative.

Respondent-applicant avers that it applied for registration of its mark "ZITHROGEN" for Class 05 goods, namely, "Pharmaceutical preparation for use as antibiotic" on July 19, 2004 per Application Serial No. 4-2004-006363, and was granted registration on September 03, 2006 (Annex "2"). Respondent-applicant further avers that this Office did not find its mark confusingly similar to opposer's mark, and that opposer found no reason to oppose respondent-applicant's mark in aforesaid application as opposer did not file an opposition within the reglementary period.

It appears that respondent-applicant filed for two (2) applications for registration of the mark "ZITHROGEN" for Class 05 goods, both exactly for "Pharmaceutical preparation/s for use as antibiotic": Application Serial No. 4-2004-006363 filed on July 19, 2004 to which registration was granted on September 03, 2006 and Application Serial No. 4-2007-005883 filed on June 08, 2007 which is the subject of this opposition. Though both applications appear to be exactly the same- for the purpose of having the mark "ZITHROGEN" registered for pharmaceutical preparation/s for use as antibiotic under Class 05- and notwithstanding the registration of the mark "ZITHROGEN" pursuant to Application Serial No. 4-2004-006363, this Bureau shall resolve the opposition to Application Serial No. 4-2007-005883 as this is the application that is the subject of said opposition.

Records show that opposer has applied on September 06, 2000 for the registration of the mark "ZITHROMAX" per Application Serial No. 4- 2000-007549 for antibiotic preparation under Class 05, and has secured therefor Registration No. 4-2000-007549 on August 05, 2004. Meanwhile, respondent-applicant applied for registration of the confusingly similar mark "ZITHROMAX" on June 08, 2007 per Application Serial No. 4-2007-005883.

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”

In view of the aforesaid provision of law, the subject application must be rejected. Opposer has secured a registration for its mark “ZITHROMAX” to which respondent-applicant’s mark “ZITHROGEN” nearly resembles as to be likely to confuse; Respondent-applicant may argue that it has already secured a registration- Registration No. 4-2004-006363- of the same mark “ZITHROGEN” for the same goods under the same Class in its other application- Application Serial No. 4-2004-006363. However, opposer was able to both apply for and secure a registration of its mark prior to respondent-applicant’s having applied for and secured a registration for its own mark, albeit in another application proceeding before the Bureau of Trademarks (BOT). Thus, in view of Section 123.1 (d) of the IP Code, opposer has a right to prevent through this particular opposition case the registration of respondent-applicant’s mark “ZITHROGEN” which was applied for under Application Serial No. 4-2007-005883.

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 “ZITHROMAX” 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, the Bureau rules in the negative as to the second issue.

As to Registration No. 4-2004-006363 issued to respondent-applicant for the same mark “ZITHROGEN” and also under Class 05 for pharmaceutical preparation/s for use as antibiotic, this Bureau shall not make any ruling as this is not a matter subject of this case and should be dealt with according to corresponding procedure/s.

WHEREFORE, premises considered, the VERIFIED OPPOSITION is, as it is, hereby SUSTAINED. Consequently, Application Serial No. 4-2007-005883 for the registration of the mark “ZITHROGEN” filed on June 08, 2007 is, as it is hereby, REJECTED.

Let the filewrapper of the trademark “ZITHROGEN” subject matter under consideration be forwarded to the Bureau of Trademark (BOT) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, 07 August, 2009.

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