

PFIZER, INC., and WARNER	}	IPC NO. 14-2008-00237
LAMBERT COMPANY, L.L.C.,	}	Case Filed : 03 October 2008
<i>Opposer,</i>	}	Opposition to:
	}	
-vs-	}	Appl'n. Serial No. : 4-2007-014169
	}	Date Filed : 21 December 2007
AMBICA INTERNATIONAL TRADING	}	Trademark : "LORID"
CORPORATION,	}	
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2009-82

DECISION

This pertains to the opposition for the registration of the mark "LORID" bearing Application Serial No. 4-2007-014169 filed on 21 December 2007 covering the goods "*pharmaceutical products namely antihistamine*" falling under Class 5 of the International Classification of goods which trademark application was published for opposition in the Intellectual Property Philippines (IPP) Electronic Gazette (E-Gazette), which was officially released for circulation on 06 June 2008.

The Opposer in the instant case are "PFIZER, INC.", a foreign corporation organized and existing under the laws of the State of Delaware, United States of America with principal office address located at No. 235 East 42nd Street, New York, New York 10017-5755, United States of America and "WARNER-LAMBERT COMPANY LLC.", likewise, a foreign corporation organized and existing under the laws of the State of Delaware, United States of America, formerly located at No. 201 Tabor Road, Morris Plains, New Jersey 07950, United States of America with principal address at No. 235 East 42nd Street, New York, New York, 10017-5755, United States of America.

On the other hand, the Respondent-Applicant is "AMBICA INTERNATIONAL TRADING CORPORATION", a domestic corporation with principal office address at No. 4 Vatican Street, Merville Park Subdivision, Parañaque City.

The grounds of the Opposition are as follows:

- "1. The registration of the "LORID" mark is contrary to the provisions of Section 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 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, rather than 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 Warner-Lambert Company LLS, a wholly owned subsidiary of Opposer Pfizer, Inc., and a member of the Pfizer group of companies, is the owner of and has exclusive rights over the well-known LOPID trademark, which is registered with the Philippine Intellectual Property Office (“IPO”) under class 5 for “*lipoprotein reducing preparations*”. The details of the registration appear below:

Mark	Registration No.	Date Issued	Class
LOPID	048682	18 July 1990	5

“3. Respondent-Applicant’s LORID mark is confusingly similar to the well-known LOPID trademark as to likely deceive or cause confusion, as between LORID and LOPID, there is only one letter in each mark to distinguish one from the other. LORID and LOPID, when read aloud, constitute *idem sonans* to a striking degree, which alone constitutes sufficient ground for this Honorable Office to rule that the two marks are confusingly similar. There can be no other conclusion other than that the LORID mark was adopted and specifically to imitate the overall appearance of the LOPID mark. Hence, the registration of the Respondent-Applicant’s mark will be contrary to Section 123.1 (d) of the Republic Act No. 8293.

“4. The Opposers are entitled to the benefits granted to foreign nationals under Section 3 of Republic Act 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 o 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 Opposers are domiciled in the United States of America. Both the Philippines and the United States of America are members of the Paris Convention for the Protection of Industrial Property. The Paris Convention provides:

Article 6*bis*
Marks: *Well-Known Marks*

- (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, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

x x x

Article 10*bis*
Unfair Competition

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



x x x

- “5. The LOPID trademark is well-known and world famous. Hence, the registration of Respondent-Applicant’s LORID mark will constitute a violation of Articles 6*bis* and 10*bis* of the Paris Convention in conjunction with Sections 3, 123.1 (e) and 123.1 (f) of Republic Act No. 8293.
- “6. Opposers and/or their respective subsidiaries, joint ventures, sister concerns, predecessors-in-title, licensees and assignees in several other countries have used the LOPID trademark in the Philippines and elsewhere since as early as 19 May 1985 and prior to the filing of the application subject of this opposition. They continue to use the LOPID mark in the Philippines and in numerous other countries.
- “7. The Opposers and/or their respective subsidiaries, joint ventures, sister concerns, predecessors-in-title, licensees and assignees in several other countries have promoted the LOPID trademark worldwide, and have obtained significant exposure for the goods upon which the LOPID trademark is used in various media, including television commercials, advertisements, internationally well-known print publications, and other promotional events.
- “8. The Opposers have not consented to the Respondent-Applicant’s use and registration of the LORID trademark, or any other mark identical or similar to the LOPID trademark.

- “9. The Respondent-Applicant uses the LORID mark in class 5 for “*pharmaceutical products namely antihistamine.*” The Respondent-Applicant’s use of the mark on said goods and other goods that are similar, identical or closely related to the goods that reproduced by, originate from or are under the sponsorship of the Opposers, such as those covered by the registration for the LOPID trademark under Registration No. 048685, will mislead the purchasing public into believing that Respondent-Applicant’s goods are produced by, originated from or are under the sponsorship of the Opposers. Potential damage to the Opposers will also be caused as a result of their inability to control the quality of the products offered or put on the market by Respondent-Applicant under the LORID 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 Opposers’ goods will take unfair advantage of, dilute and diminish the distinctive character or reputation of the LOPID trademark.
- “11. The denial of the application subject of this opposition is authorized under other provisions of Republic Act No. 8293.

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

Exhibit/Annex	Description
Exhibit “A”	Original legalized Verified Notice of Opposition
Exhibit “A” and “A-1”	Original legalized certificates on the authority of Richard A. Friedman to verify the notice of opposition and the authority of Opposer’s counsel to represent Opposers
Exhibit “B”	Certified true copy of Registration No. 048622 for the mark “LOPID”
Exhibit “C”	Legalized Affidavit of Richard A. Friedman
Annexes “A” and “A-1”	Actual product labels showing the “LOPID” mark (Opposer’s Exhibits “C-1” and “C-2”)
Annexes “B” to “B-9”	Product packaging inserts of “LOPID” from several jurisdiction including the Philippines, Hong Kong, Taiwan, India, Ireland, the United States of America, Denmark, Mexico and Indonesia (Opposer’s Exhibit “C-3” to “C-12”)
Exhibit “C-13”	Copies of the relevant pages of the Philippine Index of Medical Specialties
Exhibit “C-14”	Screen shots of the relevant webpages
Exhibit “D”	Original legalized Affidavit of Richard Friedman
Exhibit “D-1”	Table showing the details of applications and registrations for the mark “LOPID”
Exhibit “D-2”	Representative copies of registrations of “LOPID” all over the world
Exhibit “E”	Original notarized Affidavit of Richard A. Friedman
Exhibit “E-1”	Master detail price
Exhibit “E-2”	Back to back leave behind
Exhibit “E-3”	Ballpen
Exhibit “E-4”	Desk calculator
Exhibit “E-5”	Toiletry kit

	
Opposer's mark	Respondent-Applicant's mark

Visually, the two trademarks are almost the same or identical. Both are composed of five (5) letters each and two (2) syllables. Their distinction lies only in one letter. Letter "R" is present in the Respondent-Applicant's mark LORID while letter "P" is present in Opposer's LOPID. Likewise, when pronounced, the contending trademarks are almost the same. However, the slight distinction of the contending trademarks is insignificant because it does not negate the presence of confusing similarity.

In "American Wire & Cable Company 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 challenge mark would actually cause confusion or deception of the purchasers, but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. In short, to constitute an infringement of an existing trademark 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 is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it."

In another case, Emerald Garments Manufacturing Corp. vs. Court of Appeals, (251 SCRA 600) [G.R. No. L-100098, December 29, 1995], the Supreme Court stated:

"The essential element of infringement is *colorable imitation*. This term has been defined as "such a close or ingenious imitation as to be calculated to deceive ordinary purchasers, or such resemblance of the infringing mark to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other."

Another factor to be considered in this particular case is the goods/products covered by the contending trademarks primarily pharmaceutical products falling under the same class 5 of the International Classification of goods and as such there will be a danger that patient will be mistaken one from the other into buying the drug used for different illness due to confusing similarity of the two trademarks.

Evidence at hand will show that the Opposer's mark "LOPID" has been registered with the Intellectual Property Office of the Philippines bearing Registration No. 48632 on July 18, 1990 under class 5 (Exhibit "B").

"Section 138. *Certificates of Registration*. – 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."

The Supreme Court in the case “Chuan Chow Soy & Canning Co. vs. The Director of Patents and Rosario Villapanta [G.R. No. L-13947, June 30, 1960]” stated:

“When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark this is not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill.”

WHEREFORE, with all the foregoing, the opposition is, as it is hereby SUSTAINED. Consequently, Trademark Application No. 4-2007-014169 for the mark “LORID” filed on December 21, 2007 by AMBICA INTERNATIONAL TRADING CORPORATION is, as it is hereby REJECTED.

Let the filewrapper of the trademark “LORID” 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, 10 June 2009.

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