



ALCON, INC.	}	IPC No. 14-2009-00033
<i>Opposer,</i>	}	Opposition to:
	}	Appln. Serial No. 4-2008-005515
-versus-	}	Date Filed: 12 May 2008
	}	
SUHITAS PHARMACEUTICALS, INC.,	}	TM: ORALCON-F
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2012- 66

DECISION

ALCON, INC. ("Opposer")¹, filed on 30 January 2009 an Opposition to Trademark Application No. 4-2008-005515. The application filed by SUHITAS PHARMACEUTICALS, INC., ("Respondent-Applicant")², covers the mark "ORALCON-F" for use on hormonal contraceptives and inhibition of ovulation under Class 05 of the International Classification of Goods³. The Opposer alleges among others, the following:

"1. The registration of the "ORALCON-F" mark in favor of the respondent-applicant violates Section 123.1 (d), (e) and (f) of Republic Act 8293, otherwise known as the "Intellectual Property Code of the Philippines" as amended, which states that:

x x x

"2. Opposer is the owner of the "ALCON" mark which has been registered with the IPPhil since 26 February 1993 for classes 03, 05, 09 and 10, bearing Trademark Registration Certificate No. 054523. The certified true copy of the trademark registration certificate no. 054523 is attached herewith as EXHIBIT "A".

"3. Opposer uses its "ALCON" mark as its house/company mark which opposer predominantly displays in the labeling and packaging of almost all of its products manufactured, marketed and distributed internationally as well as in the Philippines.

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

x x x

"5. Opposer is domiciled in Switzerland which, together with the Philippines, are both members of the Paris Convention for the protection of Industrial property. The Paris Convention provides that:

x x x

¹ A corporation organized and existing under the laws of Switzerland with principal address at Bosch 69 CH-6331, Hunenburg, Switzerland.

² A corporation organized and existing under the laws of the Philippines with business address at 3/F Centerpoint Bldg., Pason Tamo corner Export Bank Drive, Makati City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement concerning the International Classification of goods and services for the purpose of the Registration of marks cancelled in 1957.

"6. Concomitantly, the "ALCON" mark, in addition to being registered in the Philippines, is also well-known and world famous, such that the registration of Respondent-Applicant's "ORALCON-F" mark will constitute a violation of Articles 6bis and 10bis of the Paris Convention in conjunction with Sections 3, 123.1 (d)(ii), 123.1 (d)(iii), 123.1 (e) and 123.1 (f) of Republic Act No. 8293.

"7. Opposer exclusively owns and continuously uses its mark "ALCON" for goods such as " dermatological preparations, products for the care and cleaning of contact lenses (Class 03); ophthalmic and otolaryngological pharmaceutical preparations, dermatological preparations, products for the care and cleaning of contact lenses, contact lenses, containers for contact lenses (Class 05); optical lenses and instruments, intraocular lenses (Class 09); and surgical and medical instruments and apparatus, prosthetic devices (Class 10)."

"8. Opposer has exclusive proprietary right to the marks "ALCON" for Class 03, 05, 09 and 10, having the right and advantage of being the first filer and prior user of the mark.

"9. Respondent-Applicant's mark is applied for goods such as "hormonal contraceptives, inhibition of ovulation" in Class 05 and are closely-related to Opposer's goods under TM registration No. 054523 for "ALCON" house mark since the circumstances surrounding their marketing and distribution are such that they are likely to be encountered by the purchasing public under circumstances that would give rise to the mistaken belief that they originate from the same source considering that the "ALCON" mark is the company mark or house mark of Opposer the same being indicated prominently in the labels and packaging of all of its products that are distributed and marketed in the Philippines, among others. Verily, the use by respondent-applicant of the "ORALCON-F" mark for the goods covered by the application subject of this opposition will not only mislead and/or cause confusion among the purchasing public but it would also diminish and dilute the distinctiveness and identity of the Opposer's mark which have been established in the local market by the Opposer at great effort and expense. Thus, the goodwill that should grow and inure to the benefit of the Opposer would be impaired and prejudiced by the continued use of the term by the Respondent-Applicant.

"10. An examination and comparison of the formal drawings of the contesting marks undertaken from the viewpoint of a prospective buyer would reveal that by reason of over-all appearance, spelling and pronunciation, Respondent-Applicant's "ORALCON-F" mark is confusingly similar to the Opposer's "ALCON"."

The Opposer's evidence consists of the copy of IPO certificate of Trademark Registration No. 054523, affidavit of Stefan Basler and Martin Schneider, international trademark registrations of the mark ALCON, BFAD certificate of renewal of product registration, samples of product labels and packages, advertising and promotional materials, sales report and advertising expenses.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 09 March 2009. The Respondent-Applicant, however, did not file an Answer.

⁴ Exhibits "A" to "H" of the Verified Notice of Opposition.

Should the Respondent-Applicant's trademark application be allowed?

The Opposer anchors its case on Section 123.1 (d) of the Intellectual Property Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services, or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 12 May 2008, the Opposer has an existing registration for the mark ALCON. But are the competing marks used on similar or closely related goods? Or do they resemble each other such that confusion or deception is likely to occur?

Comparing the competing marks, it shows that the second and third syllables of the Respondent-Applicant's mark ("AL-CON") are the same with the Opposer's. However, the prefix "OR", the dash and letter "F" of the Respondent-Applicant's mark makes a fine distinction with that of the Opposer's mark as to sound and appearance such that confusion and deception is unlikely to occur.

What will further make mistake or confusion unlikely is the stark difference between the goods covered by the marks. The Opposer's mark is used on *"dermatological preparations, products for the care and cleaning of contact lenses under Class 03; ophthalmic and otolaryngological pharmaceutical preparations, dermatological preparations, products for the care and cleaning of contact lenses, contact lenses, containers for contact lenses under Class 05; optical lenses and instruments, intraocular lenses under Class 09; and surgical and medical instruments and apparatus, prosthetic devices under Class 10*. On the other hand, the Respondent-Applicant's pharmaceutical products covers *"hormonal contraceptives and inhibition of ovulation"*. Relative thereto, it was held that "goods are related when they belong to the same class or have the same attributes or essential characteristics with reference to their form, composition, texture, or quality. They may also be related because they serve the same purpose or are sold in grocery stores".⁵

Obviously, the goods covered by the marks while they belong to the same class, *i.e.* Class 05, are not related because they do not serve the same purpose. The Opposer's goods are basically medical devices and preparations used for eye care and treatment whereas, the Respondent-Applicant's goods are used for birth control and/or for treatment of female reproductive disorders. It is conceivable for a person buying a contraceptive to pick up, accept, and bring home instead a device, instrument or ointment which are obviously for eye care.


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 the 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.⁶ This Bureau finds that the Respondent-Applicant's mark adequately serve this purpose.

⁵ ESSO Standard eastern Inc. vs. Court of Appeals, G.R. No. L-29971, 31 August 1982.
⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2008-005515 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 16 April 2012.



ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs