



ALPHARMA INC.,
Opposer,

-versus-

MERCK KGAA,
Respondent- Applicant.

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}
} IPC No. 14-2009-00106
} Opposition to:
} Appln. Serial No. 4-2006-013082
} Date File: 5 December 2006
} TM: "ALPHAPHARM"
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}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 140 dated May 20, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 20, 2014.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



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-versus-
MERCK KGAA,
Respondent-Applicant.
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} Application No. 4-2006-013082
} Date filed : 5 December 2006
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} Trademark: ALPHAPHARM
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} Decision No. 2014- 140

DECISION

ALPHARMA INC. (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2006-013082. The application, filed by MERCK KGAA (Respondent-Applicant)², covers the mark “ALPHAPHARM”, for use on “pharmaceutical preparations for the treatment of diabetes, cardiovascular diseases and disorders, diseases and disorders of the peripheral and central nervous system, gastrointestinal diseases and disorders, osteoporosis, menopausal symptoms and disorders, anti-infective preparations, anti-viral preparations immunological preparations and analgesic preparations, dietetic substances adapted for medical use, food for babies, plasters, materials for dressings, disinfectants” under Class 05; and “medical and veterinary services, hygienic and beauty care for human beings and animals under Class 44 of the International Classification of Goods and Services³.

The Opposer relies on the following grounds in support of its Opposition:

“8. The Respondent-Applicant’s application for registration of the mark ALPHAPHARM should not be given due course by this Honorable Office because the registration of such mark is contrary to Section 123.1 (d) of the Intellectual Property Code, which prohibits 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

¹ A corporation organized and existing under the laws of the United States of America with address at One Executive Drive Fort Lee New Jersey, U.S.A.

² A corporation incorporated in Germany with address at Frankfurter Strasse 250, 64293 Darmstadt, Germany

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

- (ii) closely related goods or services; or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion.

“9. The Opposer has openly and continuously been using and has registered its ALPHARMA & LOGO mark in the Philippines and elsewhere in the world, prior to the filing date of Respondent-Applicant’s trademark application for ALPHAPHARM on December 5, 2006.

“9.1. The Opposer also has been openly and continuously using the word mark ALPHARMA worldwide.

“10. The Respondent-Applicant’s ALPHAPHARM mark is confusingly similar to the Opposer’s ALPHARMA & LOGO and ALPHARMA marks which would deceive the public and/or cause confusion of goods and business, in that:

“10.1 Both marks consist of three (3) syllables which substantially sound the same.

“10.2. Both marks begin with the word ALPHA.

“10.3 Out of the eight (8) letters that make up the Opposer’s mark, the Respondent-Applicant’s ALPHAPHARM mark contains ALL of them, namely the letters, A-L-P-H-A-R-M- and A.

“10.4. Both marks appear in all capital letters.

“10.5. Both marks are written in relatively same style and size.

“10.6. A cursory glance at both marks makes it appear as though the marks are exactly the same and will likely cause confusion as to the origin of the goods.

“11. Of all the combination of letters in the English language alphabet, the Respondent-Applicant chose to employ the exact same combination of letters for its mark ALPHAPHARM as those used in the Opposer’s mark ALPHARMA & LOGO and ALPHARMA, which the Opposer appropriated years before. The Respondent-Applicant merely repositioned one letter in an evident and deliberate attempt to confuse the public into believing its goods bearing the mark ALPHAPHARM are the goods of the Opposer.

“12. The Respondent-Applicant’s adoption of a confusingly similar mark for its bearing the marks ALPHARMA & LOGO and ALPHARMA is clearly an attempt to trade unfairly on the goodwill, reputation and awareness of the Opposer’s marks that the Opposer has built over the years.

“13. The goods covered by the Respondent-Applicant’s ALPHAPHARM mark are not only related but are identical to the Opposer’s goods bearing the trademark ALPHARMA & LOGO, making the probability of confusion of goods and business inevitable.

“14. The confusion of goods created by the registration of Respondent-Applicant’s ALPHAPHARM will endanger the health and safety of the consumer of the products since the goods involved relate to medicinal, veterinary and cosmetic products which, when mistakenly or improperly used, may even cause death to user.

“15. Moreover, the Opposer’s mark ALPHARMA & LOGO and ALPHARMA are internationally well-known marks.”

The Opposer submitted as evidence the following:

1. Copy of Certificates of Registration for the mark ALPHARMA in various countries such as United States of America, Brasil, Malaysia, Singapore, Canada, India, Indonesia; and
2. Notarized and authenticated Affidavit of Carol Wrenn dated 26 March 2009.⁴

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 30 April 2009. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark ALPHAPHARM?

The records show that when the Respondent-Applicant filed its application on 5 December 2006, the Opposer already has an existing registration for the trademark ALPHARMA AND LOGO⁵ issued on 12 APRIL 2002 covering goods under classes 1,3,5 and 31 namely: “bulk chemical uses in the manufacture of human and animal pharmaceutical products, non-medicated and medicated animal and poultry feed additives, cosmetics namely skin lotions, skin moisturizers, skin creams, essential oils for personal use, skin gels, and petroleum jelly for cosmetic purposes, full line of pharmaceutical prescription and over the counter preparations covering a wide range of therapeutic categories in vaccine, liquid, cream, suppository, tablet, capsule, granular and inhaler form for human use and for veterinary use, antibiotics sold in bulk form for human and veterinary use, medicated skin lotions and medicated shampoos, medicated animal and poultry feed additives”. The Respondent-Applicant’s trademark application therefore indicates goods that are similar and/or closely related to those covered by the Opposer’s trademark registration. The Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer’s, particularly, pharmaceutical preparations, which flow through the same channels of trade. In Mighty Corporation and La Campana

⁴ Annex “A” to “C”, inclusive of submarkings

⁵ Exhibits “C”

Fabrica de Tabaco, Inc. v. E. & J. Gallo Winery and the Andresons Group, Inc.⁶, the Supreme Court held:

“In resolving whether goods are related, several factors come into play:

- (a) the business (and its location) to which the goods belong
- (b) the class of product to which the goods belong
- (c) the product's quality, quantity, or size, including the nature of the package, wrapper or container
- (d) the nature and cost of the articles
- (e) the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality
- (f) the purpose of the goods
- (g) whether the article is bought for immediate consumption, that is, day-to-day household items
- (h) the fields of manufacture
- (i) the conditions under which the article is usually purchased and
- (j) the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold.”

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

ALPHARMA

Opposer's mark

ALPHAPHARM

Respondent-Applicant's mark

The eight (8) literal elements of the Opposer's mark are present in the Respondent-Applicant's mark. Both marks consist of three syllables which when pronounced are identical, if not substantially the same. A cursory glance at the marks reveal that the same are capitalized, in block style lettering or font. That the Opposer's mark utilizes a circular device in addition to the word ALPHARMA is of no consequence. When the marks are applied on related goods, confusion and deception is likely to result. Visually and aurally, the competing marks are confusingly similar.

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former

⁶ G.R. 154342, July 14, 2004

reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁷

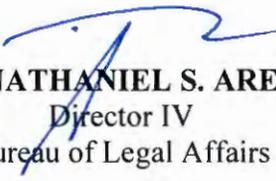
The public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.⁸

The Respondent-Applicant despite the opportunity given, did not file an Answer in order to defend its trademark application and explain how it arrived at using a mark that is practically identical/confusingly similar to the Opposer's registered mark.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2006-013082 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 May 2014.


Atty. **NATHANIEL S. AREVALO**
Director IV
Bureau of Legal Affairs

⁷ *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁸ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).