AVENTIS INC., Opposer, -versus- **MYLAN PHARMACEUTICALS PRIVATE LTD.,** Respondent- Applicant.	}	**IPC No. 14-2012-00292** Opposition to: Appln. Serial No. 4-2011-014973 Date Filed: 15 December 2011 TM: **"TELKAST"**

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 77 dated April 30, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 30, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs

AVENTIS INC.,
Opposer,

-versus-

MYLAN PHARMACEUTICALS PRIVATE LTD.,
Respondent-Applicant.
x----------x

IPC No. 14-2012-00292
Case Filed: 24 August 2012

Opposition to:
Appln. Serial No.: 4-2011-014973
Date Filed: 15 December 2011

TM: "TELKAST"

Decision No. 2013- 77

DECISION

AVENTIS INC. ("Opposer")[1] filed on 24 August 2012 a Verified Opposition to Trademark Application Serial No. 4-2011-014973. The application filed by MYLAN PHARMACEUTICALS PRIVATE LTD. ("Respondent-Applicant")[2] covers the mark "TELKAST" for use on "pharmaceutical preparations for respiratory system, gastrointestinal system, endocrine system, cardiovascular system, nervous system, musculoskeletal system, urinary system, integumentary system, reproductive system; for treatment of blood disease and disorder; for treatment of cancer; for treatments of colds, coughs and influenza; dermatologic pharmaceutical preparations; pharmaceutical preparations for ophthalmic use; for treatment of hypertension; for treatment of obesity; for treatment of gout; anti-inflammatory pharmaceuticals; antibiotics; anti allergic pharmaceutical preparations; pharmaceutical preparations for fungal infections, viral infections, anti-retroviral medicines; pharmaceutical preparations for anesthesia, for asthma, for arthritis; pharmaceutical preparations for diabetes; for benign prostatic hyperplasia; for tuberculosis; for malaria; hormonal preparations; vitamin preparations; immunosuppressants" under Class 5 of the International Classification of Goods and Services.[3]

The Opposer anchors its opposition on the ground that approval of the Respondent-Applicant's trademark application for the mark TELKAST is contrary to Section 123.1 (d) and Section 123.1 (f) of the Intellectual Property Code of the Philippines ("IP 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:

[1] A corporation organized and existing undet the laws of the United States of America with principal address at 3711 Kennet Pike, Suite 200, 19807 Greenville, Delaware, United States of America.
[2] With address at One India Bulls Center, Tower 2-B, 7th Floor, 841, Senapati Bapat Marg, Elphinstone Road (West) Mumbai-400 013 India.
[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 concluded in 1957.

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(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 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 the 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;

The Opposer's evidence consists of the following:

1. Exhibit "A" – The original, duly legalized and authenticated Special Power of Attorney executed by the Opposer in favor of Cesar C. Cruz and Partners Law Offices;

2. Exhibit "B" – Sampling of copies of trademark applications registrations obtained by the Opposer worldwide for its well-known trademark TELKAST;

3. Exhibit "C" – Affidavit of Ginalyn L. Verzano; and

4. Exhibit "D" – Affidavit of ANDRO ANTAZO.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant which was duly received on 20 September 2012. However, Respondent-Applicant did not file the required Verified Answer. Hence, the instant opposition is considered submitted for Decision based on the evidence and opposition filed by the Opposer.

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

It is emphasized that the essence of trademark registration is to give protection to the owner of the 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 products[4].

[4] Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

Thus, Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), 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.

The records show that at the time the Respondent-Applicant filed its trademark application on 15 December 2011, the Opposer has already an existing registration for the mark TELFAST under Reg. No. 4-1999-005718 issued by the Intellectual Property Office of the Philippines on 01 July 2004 for use on "antihistamine pharmaceutical preparation" under Class 5 of the International Classification of Goods and Services. The goods covered by the said registration are similar and/or closely related to most of the pharmaceutical products indicated in the Respondent-Applicant's trademark application like treatment of colds, coughs and influenza, anti-inflammatory, antibiotics and anti-allergic preparations.

In this regard, there is no doubt that the mark applied for registration by the Respondent-Applicant bears close resemblance to the Opposer's as shown below:

TELFAST	**Telkast**
Opposer's Mark	Respondent-Applicant's Mark

Practically, the Respondent-Applicant's mark is identical and/or confusingly similar to the Opposer's mark such that confusion or even deception is likely to occur. The only difference between the marks is the fourth letter which is "F" for the Opposer and "K" for the Respondent-Applicant. However, this distinction is of no consequence. The marks look and sound alike. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.[5]

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent 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.[6] The

[5] See Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.
[6] American Wire and Cable Co. v. Director of Patents et.al. (31 SCRA 544) G.R. No. L-26557, 18 February 1970.

likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court.[7]

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

The public interest, therefore, 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 inconceivable for the Respondent-Applicant to have come up with the mark "TELKAST" without having been inspired by or motivated by an intention to imitate the Opposer's mark. It is highly improbable for another person to come up with an identical or nearly identical mark for use on the same or related goods purely by coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combinations of letters are available, the Respondent-Applicant had come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.[8]

Thus, this Bureau finds the instant opposition meritorious. Accordingly, the Respondent-Applicant's trademark application is proscribed under Sec. 123.1 (d) of the IP Code.

It is stressed that the Respondent-Applicant was given opportunity to explain its side and defend its trademark application. However, it failed or chose not to do so.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-014973, be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO OREDRED.

Taguig City, 30 April 2013.

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

[7] Converse Rubber Corporation v. Universal Rubber Products, Inc. et.al. G.R. No. L-27906, 08 January 1987.
[8] American Wire and Cable Co. v. Director of Patents, et.al. (SCRA 544) G.R. No. L-26557, 18 February 1970.