



AVENTIS, INC.,
Opposer,

-versus-

SUHITAS PHARMACEUTICALS, INC.,
Respondent-Applicant.

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IPC No. 14-2012-00454
Opposition to:
Appln. Serial No. 4-2010-009166
Date filed: 20 August 2010
TM: "TEKAST"

NOTICE OF DECISION

CESAR C. CRUZ AND PARTNER LAW OFFICES

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SUHITAS PHARMACEUTICALS, INC.

Respondent-Applicant
3rd Floor Centerpoint Building
Pasong Tamo Export Bank Drive
Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 128 dated July 12, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 12, 2013.

For the Director:

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

CERTIFIED TRUE COPY
Sharon S. Alcantara
SHARON S. ALCANTARA
Records Officer II
Bureau of Legal Affairs, IPO



AVENTIS, INC.,
Opposer,

IPC No. 14-2012-00454
Case Filed: 10 December 2012

-versus-

Opposition to:
Appln. Serial No. 4-2010-009166
Date Filed: 20 August 2010

SUHITAS PHARMACEUTICALS, INC.,
Respondent-Applicant.

TM: "TEKAST"

x-----x

Decision No. 2013- 128

DECISION

AVENTIS, INC., ("Opposer")¹ filed on 10 December 2012 an opposition to Trademark Application Serial No. 4-2010-009166. The application, filed by SUHITAS PHARMACEUTICALS, INC. ("Respondent-Applicant")², covers the mark "TEKAST" for use on "pharmaceuticals (anti-asthma)" under Class 5 of the International Classification of Goods and Services³.

The Opposer anchors its opposition on the ground that approval of the Respondent-Applicant's trademark application for the mark TEKAST 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:
 - (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;

- (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

¹ Is a corporation organized and existing under the laws of the United States of America with principal address at 3711 Kennett Pike, Suite 200, 19807 Greenville, Delaware, United States of America.

² With address at 3/F, Centerpoint Bldg., Pasong 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 concluded in 1957.

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” – The original, duly legalized and authenticated certified copy of Corporate Resolutions showing the authority of Mr. Joseph M. Palladino; and
3. Exhibit “C” – Sampling of copies of the trademark registrations obtained by the Opposer worldwide for the mark TELKAST attached to the affidavit of Mr. Joseph M. Palladino.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant which was duly received on 25 January 2013. 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 products⁴.

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 20 August 2010, 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

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

registration are similar and/or closely related to the pharmaceutical products indicated in the Respondent-Applicant's trademark application like pharmaceutical products (anti-asthma) under Class 5.

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

TEKAST

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 omission of the letter "L" in the Respondent-Applicant's mark and in the fourth letter which is "F" for the Opposer and letter "K" in the 3rd letter of the Applicant. However, this distinction is of no consequence or without any significance because the aural and visual similarity of the marks is so clear. The competing marks look and sound alike. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Because the Respondent-Applicant will use or uses the mark applied for registration on the goods that are similar and/or closely related to those covered by the Opposer's registered mark, the slight distinction or variance did not diminish the likelihood of the occurrence of mistake, confusion or even deception cannot be avoided. Consumers will likely assume that the Respondent-Applicant's mark is just a variation of the Opposer's and/or the goods and services originate or provided by one party alone, or the parties are connected or associated with one another which in fact there is none. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origin thereof as held by the Supreme Court.⁵

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 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 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.

⁵ Converse Rubber Corp. v. Universal Rubber Products, Inc. et.al. G.R. No. L-27906, 08 Jan. 1987.

It is inconceivable for the Respondent-Applicant to have come up with the mark "TEKAST" 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.⁶

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. 4-2010-009166, be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 12 July 2013


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

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⁶ American Wire and Cable Co. v. Director of Patents, et.al. (SCRA 544) G.R. No. L-26557, 18 February 1970.