



BOEHRINGER INGELHEIM KG,
Opposer,

-versus-

YSS LABORATORIES COMPANY, INC.,
Respondent-Applicant.

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}
} IPC No. 14-2010-00241
} Opposition to:
} Appln. Serial No. 4-2009-011605
} Date filed: 12 Nov. 2009
} TM: "KARDIZ"
}
}
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 - 90 dated May 10, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 10, 2012.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer, BLA

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



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Decision No. 2012 - 90

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DECISION

BOEHRINGER INGELHEIM KG ("Opposer")¹ filed on 02 August 2010 an opposition to Trademark Application Serial No. 4-2009-011605. The application, filed by YSS LABORATORIES COMPANY, INC. ("Respondent-Applicant")², covers the mark "KARDIZ" for use on "beta blocker" under Class 5 of the International Classification of Goods.³

The Opposer alleges among other things that it is the owner of the trademark "MICARDIS" which is already registered in the Philippines. According to the Opposer, the mark KARDIZ is confusingly similar to MICARDIS. The Opposer's evidence consists of a copy a "Certificate of Corporation" stating the nature and status of the Opposer under the laws of the Federal Republic of Germany, a photocopy of a document showing the corporate profile of the Opposer, copy of the Power of Attorney executed by the Opposer in favor of its counsel of record, a copy of the General Information Sheet relating to the Opposer's registration with the Philippines' Securities and Exchange Commission, copy of the Cert. of Reg. No. 4-1996-111832 for the mark MICARDIS, printouts of various webpages, copies of certificates of registration for the marks "KYBCARDIS" and "JADCARDIS", a list of countries where the mark MICARDIS is registered or applied for registration; and the affidavits of Guido Hoeller and Mark Darwin A. Camara.⁴

The Respondent-Applicant filed its Answer on 16 February 2011 denying the allegation that KARDIZ is confusingly similar to the mark MICARDIS. It submitted as evidence a copy of the "Secretary's Certificate" issued by Nona F. Crisol, the Respondent-Applicant corporation's Corporate Secretary attesting as to her authority to execute and sign documents related to this instant case among other things, and her affidavit.⁵

¹ A foreign corporation organized and existing under the laws of the Federal Republic of Germany with principal office at Binger Strabe 148, 55216 Ingelheim, Germany

² A domestic corporation with principal place of business at 1133 United Nations Avenue, Paco, Manila

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.

⁴ Exhibits "A" to "UU"

⁵ Exhibits "1" and "2".

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

It is emphasized that the essence of trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; 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 to 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 product⁶. Thus, Sec. 123.1(d) of Rep. Act 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 earlier filing or priority date, in respect of the same goods or services or closely related goods or services or it nearly resembles such, 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 November 2009, the Opposer has existing trademark registration for the mark MICARDIS for use on "*pharmaceutical preparations namely pharmaceutical preparations for the treatment of heart and cardiovascular diseases*" under Class 5 (Reg. No. 4-1996-111832). The goods indicated in the Respondent-Applicant's trademark application are, therefore, similar and/or closely related to those covered by the Opposer's trademark registration.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The Opposer's mark MICARDIS consists of three syllables, the last two of which – CARDIS - define or give its distinctive character that appeals to the eyes and the ears. Obviously, "CARDIS" in the Opposer's mark is derived from or inspired by the word "*cardio*" which relate to the heart and the human body's circulatory system. But with an creative flair in starting the mark with the syllable "MI" and appending the letter "S" instead of the letter "O" at the end, the mark has become distinctive.

In this regard, the Respondent-Applicant appropriated the word CARDIS but changed its spelling into KARDIZ. Trademarks, however, are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made by the last two syllables CARDIS. Hence, CARDIS has become the "product identifier".

Aptly, although the spelling of KARDIZ is different from CARDIS, the sound is exactly the same/or identical. Thus, because the Respondent-Applicant will use or uses the mark KARDIZ on goods that are similar and/or closely related to those covered by the Opposer's registered trademark, the change in the spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. There is the likelihood that information, assessment, perception or impression about KARDIZ products delivered and conveyed through words and sounds and received by the ears

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 115508, 19 Nov. 1999.

may unfairly cast upon or attributed to the CARDIS products and the Opposer, and *vice-versa*.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close 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 other⁷. The conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term⁸. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁹

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.

It is inconceivable for the Respondent-Applicant to have come up with the mark "KARDIZ" without having been inspired by or motivated by an intention to imitate the mark "MICARDIS". 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 answered riddle is why, of the millions of terms and combination of letters and available, the Respondent-Applicant had come up with a mark identical or so clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark¹⁰.

WHEREFORE, premises considered, the Opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-011605 be returned, together with a copy of this Decision, to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 10 May 2012.


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



⁷ See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217

⁸ Ref.: *Continental Connector Corp. v. Continental Specialties Corp.*, 207 USPQ 60.

⁹ See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

¹⁰ See *American Wire and Cable Co. v. Director of Patents et. al* (SCRA 544), G.R. No. L-26557, 18 Feb. 1970.