



**GENZYME CORPORATION,**  
Opposer,

**-versus-**

**AMBROSIO V. PADILLA III,**  
Respondent –Applicant.

X-----X

} **IPC No. 14-2008-00312**  
} Opposition to:  
} Appln. Serial No. 4-2008-000419  
} Date Filed: 14 January 2008  
} **TM: "THYRADIN"**

### NOTICE OF DECISION

#### **SAPALO VELEZ BUNDANG & BULILAN**

Counsel for the Opposer  
11<sup>th</sup> Floor Security Bank Centre  
6776 Ayala Avenue, Makati City

#### **FORMOSO NAVARRO & FORMOSO LAW OFFICES**

Counsel for Respondent-Applicant  
No. 32 Jose Abad Santos Street  
Little Baguio, San Juan, Metro Manila

#### **GREETINGS:**

Please be informed that Decision No. 2014 - 104 dated April 14, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 14, 2014.

For the Director:

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



<b>GENZYME CORPORATION,</b>	}	<b>IPC NO. 14-2008-00312</b>
Opposer,	}	Opposition to:
	}	
-versus-	}	Appln. Ser. No. 4-2008-000419
	}	Date Filed: 14 January 2008
	}	
<b>AMBROSIO V. PADILLA III,</b>	}	Trademark: <b>THYRADIN</b>
Respondent-Applicant.	}	
x-----x	}	Decision No. 2014- 104

### DECISION

**GENZYME CORPORATION**, (Opposer)<sup>1</sup> filed on 26 November 2008 an opposition to Trademark Application Serial No. 4-2008-000419. The application, filed by **AMBROSIO V. PADILLA** (Respondent-Applicant)<sup>2</sup>, covers the mark "THYRADIN", for use on "Pharmaceutical preparation for the treatment of hyperthyroidism of any etiology, suppression of thyroid stimulating hormone (TSH) levels in the presence of goiter, nodules and after radiological and/or surgical treatment of thyroid cancer" under Class 5 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the following grounds:

"1. The Opposer is the first to adopt, use and register the trademark THYROGEN in the Philippines, for "pharmaceutical composition: namely, recombinant human thyrotropin for use in the diagnosis and treatment of thyroid conditions" and therefore enjoys under Sec. 147 of Republic Act (R.A.) No. 8293 the right to exclude others from registering or using an identical or confusingly similar mark such as Respondent-Applicant's trademark THYRADIN for similar and related goods such as "pharmaceutical preparation for treatment of hyperthyroidism of any etiology", among others.

"2. The THYRADIN mark nearly resembles the THYROGEN mark of Opposer in sound, spelling, and appearance as to be likely to deceive or cause confusion contemplated under Section 123 (d), R.A. 8293.

"3. The Opposer's THYROGEN mark used for "pharmaceutical composition: namely, recombinant human thyrotropin for use in the

<sup>1</sup> A corporation formed under the laws of the United States of America, with business address at 500 Kendall Street, Cambridge, Massachusetts

<sup>2</sup> Filipino, with address at 908, 88 Corporate Center, 1001 Sedenon corner Valero Streets, Salcedo Village, Makati City

<sup>3</sup> 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.



diagnosis and treatment of thyroid conditions” is well-known internationally and in the Philippines, taking into account the knowledge of the relevant sector of the public, as being a trademark owned by Opposer, hence, Respondent-Applicant’s THYRADIN trademark cannot be registered in the Philippines, especially for similar or related goods pursuant to the express provision of Section 123 (e) of R.A. No. 8293.

“4. The Respondent-Applicant, in adopting THYRADIN for “pharmaceutical preparation for treatment of hyperthyroidism of any etiology”, among others, is likely to cause confusion, or to cause mistake, or deceive as to affiliation, connection or association with the Opposer, or as to origin, sponsorship, or approval of its goods by the Opposer, for which it is liable for false designation of origin, false description, or misrepresentation under Section 169 of R.A. No. 8293.”

According to the Opposer, it is the first to adopt, use and register the trademark THYROGEN in the Philippines. The Opposer states that the THYROGEN mark is registered in several countries abroad and has been advertised and promoted worldwide. It alleges that the THYRADIN mark nearly resembles the THYROGEN mark which is well known internationally and in the Philippines.

To support its opposition, the Opposer submitted as evidence the following:

1. Copy of Registration Certificate No. 4-2005-012705 for the mark THYROGEN dated 26 February 2007;
2. Protection list showing worldwide registrations and applications for THYROGEN;
3. Copies of certificates of registrations of THYROGEN mark in several countries such as Republic of Armenia, Argentina, Australia, Office for Harmonization in Internal Markets (OHIM), Bolivia, Canada, Haiti, India, Indonesia, Kuwait, Latvijas Republic, Malaysia, Republic of Uzbekistan;
4. Sample packaging, labels and product specification with mark THYROGEN;
5. Print-out copy of E-Gazette showing application for the mark THYRADIN; and
6. Copies of sales invoices of sales of THYROGEN.<sup>4</sup>

The Respondent-Applicant filed his Answer on 2 March 2009, alleging among other things the following:

“1. Notwithstanding, the grounds for opposition, Respondent maintains its right to use and register the trademark THYRADIN with the Honorable Office and denies any likelihood of confusion, mistake or may deceive purchasers of Opposer’s pharmaceutical preparation for thyroid conditions bearing the trademark THYROGEN on the basis of the following averments:

---

<sup>4</sup> Exhibits “A” to “G”

"2. A comparison between the packaging of the Opposer's THYROGEN versus Respondent's THYRADIN box designs for 12.5 microgram (mcg.) 25- mcg, 50 mcg, 100 mcg and 150 mcg formulations shows that there are striking differences between the labels of both marks which would preclude the possibility of the purchasing public to confuse one pharmaceutical product from the other. The labels differ in packaging size, color, scheme, labeling layout and text arrangement.

"3. The packaging of Respondent's THYRADIN clearly indicates the source of the product. The stylized name of 'MedChoice Pharma' is clearly indicated at the top of the label while at the bottom thereof the words 'Manufactured for MEDCHOICE PHARMA INC.' and the company address are indicated for reference. Nowhere in the package or label does Respondent's use of the trademark THYRADIN indicate a connection, association, sponsorship or license- express or implied- with the Opposer or its product, and neither does Respondent capitalize on the purported 'distinct reputation' of the Opposer.

"4. The likelihood of confusion is unlikely in this case since purchasers of pharmaceutical products are not considering common or inexpensive items. Both THYRADIN and THYROGEN can only be dispensed with a medical prescription and consequently, the purchaser relies on the trained expert physician who recommends the product most suitable for the patient.

"5. Considered in their entirety, as they appear in their respective labels, the use of the trademark THYRADIN is permissible.

"6. The word "THYRADIN" is a purely invented word chosen to identify the product. It is a play of words based on the word 'thyroid' since the product is essentially a thyroid preparation. The suffix '-din' is used consistent with the practice of the manufacturer MedChoice Pharma Inc. with the permission of the applicant herein, of naming all its pharmaceutical products with such suffix.

"7. Unlike the Opposer's THYROGEN that is sold in vials, and administered through injection-

#### PROPER USE OF THIS MEDICATION

The recommended dose of THYROGEN is two doses of 0.9 mg thyrotropin alfa administered intramuscularly at 24 hour intervals. Your doctor or nurse will inject 1.0 ml of the THYROGEN solution to (0.9 thyrotropin alfa)

Respondent's THYRADIN is intended for sale and distribution in the Philippines in tablet form as stated in its product insert design



## DOSAGE AND ADMINISTRATION

**HYPOTHYROIDISM:** An initial adult dose of 50 to 100 mcg of Levothyroxine sodium daily by mouth may be increased by 25 to 50 mcg at intervals of about 4 weeks until the thyroid deficiency is corrected and a maintenance dose is established.

Maintenance dose: between 100 to 200 mcg daily.

In elderly patients with cardiovascular disorders, or in those with severe hypothyroidism of long standing, treatment should be introduced more gradually. Initial dose: 12.5 to 50 mcg daily increased by increments of 12.5 to 25 mcg at intervals of 4 weeks. Or as prescribed by the physician.

“8. Finally, on 6 June 2008, President Gloria Macapagal –Arroyo signed Republic Act No. 9502 otherwise known as the ‘Universally Accessible Cheaper and Quality Medicines Act of 2008.’ The law ensures the availability of affordable medicines by, among others, requiring a drug outlet to carry a variety of brands for each drug to give the consumer more choices. The registration and use of the trademark THYRADIN will not diminish the distinctiveness of THYROGEN nor affect the reputation of Opposer Genzyme Corporation, but the registration of Respondent’s mark will provide patients in dire need of thyroid treatment with a more affordable, less intrusive, locally manufactured and equally effective alternative.”

The Respondent –Applicant submitted as evidence the following:

1. Comparison between the packaging of THYROGEN and THYRADIN box designs;
2. Product insert design of THYRADIN; and
3. Foil designs for THYRADIN 12.5 mcg., 25 mcg., 100 mcg, 150 mcg formulations.<sup>5</sup>

The Hearing Officer issued on 4 March 2009 a notice setting the Preliminary Conference on 30 April 2009. On 2 July 2009, the Preliminary Conference was held and the Opposer, who was present at the proceedings was directed to file its position paper.

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

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

---

<sup>5</sup> Exhibits “1” to “3” inclusive of sub-markings

and different article as his product.<sup>6</sup> 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.

Records show that while at the time Respondent-Applicant applied for registration of the mark “THYRADIN” the Opposer already registered the mark THYROGEN under Certificate of Registration No. 4-2005-01275. Also the goods covered by the Opposer’s trademark registration are similar and/or closely related to those indicated in the Respondent-Applicant’s trademark application.

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

The competing marks are reproduced below:

**THYROGEN**

Opposer’s mark

**Thyradin**

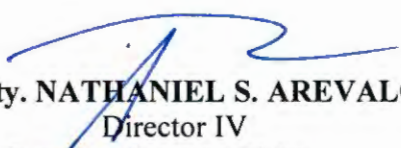
Respondent-Applicant’s mark

The marks are similar with respect to the prefix (“THY”) and the last letter, (“N”). Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. Admittedly, the pharmaceutical composition of both parties are for the treatment of thyroid disorders/conditions, thus, appropriating the first syllable of the word, “thyroid”, in combination with syllables as a mark for medicines that treat conditions of the human thyroid, is expected. A trademark which appropriates the prefix “THYR” or “THYRO” and used for treatment of thyroid conditions is a suggestive mark. However, the suffixes ROGEN and RADIN are phonetically dissimilar. Thus, in combination with the prefix THY, the resultant marks are visually and aurally different. Considered in their entirety, the marks are dissimilar, and considering further that their dosage and method of administration is different, confusion and deception is unlikely.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2008-000419 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 14 April 2014.

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

<sup>6</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.