



GLAXO GROUP LIMITED,  
Opposer,

-versus-

DAEWOONG PHARMA PHILIPPINES, INC.,  
Respondent- Applicant.

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} IPC No. 14-2012-00484  
} Opposition to:  
} Appln. Serial No. 4-2012-007803  
} Date Filed: 29 June 2012  
} TM: "LAMIART"  
}

### NOTICE OF DECISION

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**DAEWOONG PHARMA PHILIPPINES, INC.**  
Respondent-Applicant  
Unit 2811, One Corporate Center  
Julia Vargas corner Meralco Avenue  
Ortigas Center, Pasig City

#### GREETINGS:

Please be informed that Decision No. 2013 - 98 dated June 05, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 05, 2013.

For the Director:

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



**GLAXO GROUP LIMITED,**  
Opposer,

-versus-

**DAEWOONG PHARMA PHILIPPINES, INC.**  
Respondent-Applicant.

X ----- X

IPC No. 14-2012-00484

Opposition to Trademark  
Appln No. 14-2012-007803  
Date Filed: 29 June 2012

Trademark: "**LAMIART**"

Decision No. 2013-98

### DECISION

Glaxo Group Limited<sup>1</sup> ("Opposer") filed, on 23 November 2012, an opposition to Trademark Application No. 4-2012-07803. The contested application, filed by Daewoong Pharma Philippines<sup>2</sup> ("Respondent-Applicant"), covers the mark "LAMIART" for use on "*anticonvulsant pharmaceutical preparation*" under Class 05 of the International Classification of Goods<sup>3</sup>.

Opposer states that it is the owner, first user, original adopter and registrant of the trademark "LAMICTAL", which is covered by Registration No. 50532 issued on 13 May 1991. The trademark was introduced on or about 1990 in Ireland. In the Philippines, it was first used in 1 April 1994 through the Opposer's subsidiary and authorized user, GlaxoSmithKline Philippines, Inc. Opposer likewise registered and/or applied for registration of its trademark in more than 100 jurisdictions worldwide. It claims to have heavily promoted the trademark in the country and abroad, thus, earning an international reputation in the pharmaceutical industry.

Opposer insists that Respondent-Applicant's trademark "LAMIART" is confusingly similar to its trademark "LAMICTAL", a well-known mark, owing to the fact that both use the prefix "LAMI". It asserts that since both marks pertain to anti-convulsant preparations, it will be more likely that the public will be misled that the goods of Opposer's and Respondent-Applicant's came from the same source or worse, that they are the same.

<sup>1</sup> A corporation organized under and by virtue of the laws of England, with principal place of business at Glaxo Wellcome House, Berkeley Avenue, Greenford Middlesex UB6 ONN England.

<sup>2</sup> With principal address at Unit 2811, One Corporate Center, Julia Vargas Corner Meralco Ave., Ortigas Center, Pasig City, Philippines.

<sup>3</sup> 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.

In support of its allegations, the Opposer submitted the following as evidence:

1. Affidavit executed by Emma S. Stopford attesting to the facts in support of the Opposition;
2. Copy of Philippine Trademark Certificate of Registration No. 50532 for LAMICTAL as it appears in the trademark database of the Intellectual Property Office of the Philippines;
3. An extract from the global pharmaceutical-in-use database for the mark LAMICTAL;
4. Certified copy of the CPR No. DA-00738;
5. A sample of the packaging LAMICTAL 50 mg tablets as used in the Philippines;
6. A product literature of LAMICTAL 50 mg as used in the Philippines;
7. A list of the various trademark registrations and/or applications for the mark LAMICTAL;
8. Sample promotional materials for the mark LAMICTAL;
9. A summary of the global sales (showing also sales per country) for LAMICTAL from 2006-2011;
10. A summary of the market share per country of LAMICTAL from 2006-2012;
11. Printouts of websites showing the mark LAMICTAL; and,
12. A printout of the list of registered drugs with the Food and Drug Administration of the Philippines (FDA) as of August 2012, showing the marks LAMICTAL, LAMITOR and LAMIART.

Despite due notice, Respondent-Applicant did not file its Answer. Consequently, a default order was issued and the case was submitted for decision.

Now, the issue to be resolved is whether the trademark application of Respondent-Applicant should be granted.

Records reveal that at the time Respondent-Applicant filed its application for trademark registration of "LAMIART" on 29 June 2012, the Opposer has a valid and existing registration for "LAMICTAL" under Registration No. 50532. It is undisputed that both cover the same goods, which are "*anti-convulsant preparations*" under Class 05. What is subject of the present controversy is whether the two marks are indeed confusingly similar as claimed by Opposer.

A trademark device is susceptible to registration if it is crafted fancifully or arbitrarily and is capable of identifying and distinguishing the goods of one

manufacturer or seller from those of another. Apart from its commercial utility, the benchmark of trademark registrability is distinctiveness.<sup>4</sup>

Visually comparing the two marks, it can be readily observed that both appropriate "LAMI" at the beginning of their words. According to Opposer, this part is the most distinct and most likely to be remembered by the consumers. However, it is noteworthy that the term, most specifically the letters "l", "a" and "m" or "lam", is connotative of its generic name *lamotrigine*.

Thus, sustaining the instant opposition solely on the ground that the competing marks both start with the syllables "LAMI" would have the effect of allowing the Opposer to have a monopoly over the syllable "LAMI" giving it undue advantage over its competitors. Technically, the registration would enable it to enforce its rights against parties who use a brand or name that starts with the syllable "LAMI", even including the generic name *lamotrigine*.

Aptly, what will distinguish the Opposer's mark from the others are the letters or phrases that succeed "LAM". While Opposer's mark employs the phrase "ICTAL" after "LAM", Respondent-Applicant uses "IART". The Bureau finds that "ICTAL" is completely distinct from "IART". The only similarity that can be readily seen is that the letter "i" immediately follows the prefix "lam". Even aurally, the two marks are distinguishable. Opposer's mark contains three syllables, "la-mic-tal", while that of the Respondent-Appellant only has two, which are "la-miart". Contrary to Opposer's argument, the beginning letters "l-a-m-i" in the competing marks are not pronounced alike. Hence, while the consumers would know that both pertain to the same kind of pharmaceutical product, they will not confuse one for the other.

Finally, it is emphasized that 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 and different article as his product.<sup>5</sup> It is found that Respondent-Applicant sufficiently met the requirements of the law.

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<sup>4</sup> Great White Shark Enterprises vs. Danilo M. Caralde, G.R. No. 192294, 21 November 2012.

<sup>5</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 19 1999.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2012-007803 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 05 June 2013.



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