



GLAXO GROUP LIMITED,
Opposer,

-versus-

LUMAR PHARMACEUTICAL LABORATORY,
Respondent –Applicant.

} IPC No. 14-2011-00518
} Opposition to:
} Appln. Serial No. 4-2011-005506
} Filing Date: 16 May 2011
} TM: "ZINETT"
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}
}
}

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NOTICE OF DECISION

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LUMAR PHARMACEUTICAL LABORATORY
Respondent-Applicant
No. 5 First Bulacan Industrial City
Malolos City, Bulacan

GREETINGS:

Please be informed that Decision No. 2014 - 62 dated February 26, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 26, 2014.

For the Director:


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



GLAXO GROUP LIMITED,
Opposer,

IPC No. 14-2011-00518

-versus-

Appln. Serial No. 4-2011-005506
Filing Date: 16 May 2011
Trademark: "ZINETT"

LUMAR PHARMACEUTICAL LABORATORY
Respondent-Applicant.

Decision No. 2014 - 62

x -----x

DECISION

GLAXO GROUP LIMITED ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2011-005506. The application, filed by LUMAR PHARMACEUTICAL LABORATORY ("Respondent-Applicant")², covers the mark "ZINETT" for use on "medicine, antibacterial, chloramphenicol preparations" under class 05 of the International Classification of Goods and Services³. The Opposer alleges among other things the following:

"2. Opposer is the owner of the trademark ZINNAT registered with the Honorable Office under registration for 'pharmaceutical preparations and substances' in class 5.

The subject trademark ZINETT under Application No. 4-2011-005506 nearly resembles the trademark ZINNAT as to be likely to deceive or cause confusion. x x x

"3. ZINNAT was registered with this Honorable Office in respect of 'pharmaceutical preparations and substances' on 14 November 1988, or more than twenty (20) years ahead of the subject Trademark Application o. 4201100550, ZINNAT has been used in the Philippines by oppose for an antibacterial preparation since (date). x x x

"4. The confusing similarity between the trademark ZINETT and ZINNAT, coupled by the similarity in their designated goods, will likely mislead the public into believing that respondent-applicant's products under the trademark ZINETT originated from oppose, or conversely, that opposer's products under the trademark ZINNAT emanated from respondent-applicant. x x x

"5. Being in the same industry as opposer, respondent-applicant should have known better than to adopt ZINETT as its own trademark when oppose has already registered in its name, more than twenty (20) years ago, the trademark ZINNAT in respect of class 5 goods. x x x

"6. The confusion and deception that will result from respondent-applicant's use of ZINETT despite opposer's prior use and registration of ZINNAT will certainly cause damage and prejudice to the latter, whose statute and reputation as one of the leading companies in the pharmaceutical industry is indisputable.

¹ A company organized under the laws of the United Kingdom, of Berkeley Avenue, Greenford Middlesex, England.

² A company organized under the laws of the Philippines with principal place of business is at No. 5 First Bulacan Industrial City, Malolos City, Bulacan.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

"7. In view of the foregoing, the interests of opposer, as the owner, original adopter and first user of the registered trademark ZINNAT will be damaged and prejudiced by the continuous use and adoption by respondent-applicant of the trademark ZINETT. x x x

"8. As aforesaid, opposer is the owner, original adopter, first user, and registrant of the trademark ZINNAT. x x x.

"9. ZINNAT was first used in the Philippines in February 1991 and has been continuously used until today. x x x

"10. To obtain worldwide protection for its trademark ZINNAT, opposer has sought and obtained its registration in numerous jurisdictions worldwide. x x x

"11. Opposer, though its subsidiaries/affiliates, invests heavily in promoting the trademark ZINNAT in the Philippines and worldwide, making the trademark well-known internationally and in the Philippines. x x x

"12. Due to its long use in the local market, ZINNAT has acquired valuable goodwill and is well-known to Philippine consumers. x x x

"13. It is apparent from the foregoing that the trademark ZINNAT has been widely used for more than two (2) decades and is registered in major jurisdictions worldwide. Opposer invests in promoting and advertising to further establish the renown and reputation of the trademark. ZINNAT is a valuable intellectual property of opposer and opposer's rights thereto must be protected by this Honorable Office in view of its registration and prior user.

The Opposer's evidence consists of the following

1. Exhibit "A" - Legalized affidavit of David Butler;
2. Exhibit "A-1" - Certificate of Registration of ZINNAT;
3. Exhibit "A-2" - Listings of worldwide registration of ZINNAT;
4. Exhibit "A-3" - Certificate of Registration of ZINNAT issued in Malaysia;
5. Exhibit "A-4" - Certificate of Registration of ZINNAT issued in Mexico;
6. Exhibit "A-5" - Certificate of Registration of ZINNAT issued in Singapore;
7. Exhibit "A-6" - Certificate of Registration of ZINNAT issued in United Kingdom;
8. Exhibit "A-7" - Certificate of Registration of ZINNAT issued in United Arab Emirates; and,
9. Exhibit "A-8" - Product Advertisements.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 25 January 2012. Respondent-Applicant however, did not file an answer. Thus, the Respondent-Applicant was declared in default and the case deemed submitted for decision.

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

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 or 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.⁴

Thus, Section 123.1 paragraph (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 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 mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 16 May 2011, the Opposer has already an existing trademark registration for the mark ZINNAT bearing Registration No. 041714 issued on 14 November 1988⁵, and renewed accordingly.

But, are the contending marks, depicted below, resemble each other such that confusion, even deception, is likely to occur?

ZINNAT

Opposer's Trademark

ZINETT

Respondent-Applicant's Trademark

The foregoing marks show apparent similarities in aural and visual appearance. Both marks consist of six (6) letters which are identical except for the "A" in Opposer's ZINNAT and the "E" in Respondent-Applicant's ZINETT. The sound of the marks when pronounced are almost similar and the difference in the vowels does not produce a distinguishable sound. The visual presentation shows slight difference which is not sufficient to readily distinguish ZINNAT from ZINETT.

Hence, because of the close resemblance between the marks, there is likelihood of confusion. Respondent-Applicant's mark ZINETT covers medicine, anti-bacterial and chloramphenicol preparations. Chloramphenicol is known as a broad-spectrum antibiotic, effective against infections cause by a wide variety of bacteria.⁶ On the other hand, Opposer's trademark registration covers pharmaceutical preparations and substances. The term "pharmaceutical preparation and substances" is so broad that they could include the goods/products indicated in the Respondent-Applicant's trademark application.

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 other.⁷ Colorable imitation does not

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

⁵ Trademark Search, available at <http://www.ipophil.gov.ph> (last accessed 26 February 2014).

⁶ Net doctor, available at <http://www.netdoctor.co.uk/infections/medicines/chloramphenicol-capsules.html> (last accessed 20 February 2014).

⁷ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.⁸

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.⁹ 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:¹⁰

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. Hence, 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.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2011-005506 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 26 February 2014.


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

⁸ Emerald Garment Manufacturing Corp. V. Court of Appeals, G.R. No. 100098, 29 December 1995.

⁹ American Wire and Cable Co. v. Director of Patents, et al., (31 SCRA 544) G.R. No. L-26557, 18 February 1970.

¹⁰ Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.