



GLAXO GROUP LIMITED,
Opposer,

-versus-

PHARMA AG, INC.,
Respondent-Applicant.

X-----X

} IPC No. 14-2010-00238
} Opposition to:
} Appln. Serial No. 4-2009-710118
} Filed: 08 September 2009
} TM: "VENTOSIL"

NOTICE OF DECISION

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PHARMA AG INC.
Respondent-Applicant
No. 10, 3rd Street, Happy Valley
V. Rama, Cebu City

GREETINGS:

Please be informed that Decision No. 2013 - 221 dated November 19, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 19, 2013.

For the Director:

Edwin D. Dating
Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



GLAXO GROUP LIMITED,
Opposer,

- versus -

PHARMA AG, INC.,
Respondent-Applicant.

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IPC NO. 14 – 2010- 000238
Case Filed on: 13 October 2010

Opposition to:
Appln Serial No. 42009710118
Date filed: 08 September 2009
TM: "VENTOSIL"

DECISION NO. 2013 - 221

DECISION

GLAXO GROUP LIMITED. (Opposer)¹ filed an opposition to Trademark Application No. 4-2009-710118. The application filed by PHARMA AG, INC., (Respondent-Applicant)², covers the mark "VENTOSIL," for used on "*Pharmaceutical Anti-Asthmatic Salbutamol*" under Class 05 and Class 10 of the International Classification of Goods³

The Opposer's material allegations are quoted as follows:

"4. In 1969, Opposer launched VENTOLIN (salbutamol) for asthma. The said product was developed at Ware and marketed under the Allen and Hanburys name. Allen and Hanburys is part of the GSK Group of Companies. In fact, in the year 1999, Opposer celebrated the 30th anniversary of the launched of VENTOLIN (salbutamol). This 30th anniversary is marked as respiratory becomes Glaxo Wellcome's largest therapeutic area.

"5. The trademark VENTOLIN is registered in numerous jurisdiction throughout the world.

5.1. VENTOLIN is registered in the name of Opposer in approximately 160 countries, including the Philippines, for pharmaceutical products in classes 05 and 10.

¹ A corporation organized and existing under the laws of the England with business address at Glaxo Wellcome House, Berkely Avenue, Greenford, Middlesex UB6 0NN, England

² A corporation organized and existing under the laws of the Philippines with business address at #10 3rd Street, Happy Valley, V. Rama, Cebu City.

³ *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.*

5.2 In the Philippines, Opposer is the owner of Philippine Trademark Registration No. 4-2002-006235 for VENTOLIN in class 05 for “pharmaceutical preparations and substances for the prevention, treatment and/or alleviation of respiratory diseases and disorders all included in international class 05”, and in class 10 for “surgical and medical apparatus namely; inhalers; parts and fittings for the aforementioned all included in international class 10”, issued on February 10, 2005.

“6. The mark VENTOLIN is also widely used in different parts of the world such as in Argentina, Australia, Belgium, Canada, Czech Republic, Ecuador, Hong Kong, Hungary, Latvia, Lithuania, New Zealand, Peru, Slovak Republic, Slovenia, Spain, Switzerland, and Turkey.

6.1 The mark VENTOLIN was first used in 1969 for goods in class 05 in the UK and Ireland.

6.2. The mark VENTOLIN was first used by Respondent-applicant, in the Philippines, in 1973.

6.3 In the Philippines, VENTOLIN is the subject of valid and existing Certificate of Product Registration (CPRs) issued by the Food and Drugs Administration (FDA) for the approved indications of VENTOLIN x x x

“7. The pharmaceutical products covered by the trademark VENTOLIN is sold worldwide. In 2009 alone, the worldwide sales for VENTOLIN reached in excess of £384,057,000.

“8. Pharmaceutical product for which the trademark VENTOLIN is used is sold in various drugstores all over the Philippines. It is well-known in the local market, having been present since 1973. In 2009 alone, sales of VENTOLIN reached Php 1,200,110,994.00. Significant market share for VENTOLIN products in the Philippine from 2005 to 2009 has also been achieved. Therefore, it is a valuable product and trademark for Opposer.

“9. Opposer also invests heavily in advertising and publicizing the trademark VENTOLIN worldwide, thereby earning the trademark an international reputation and the product bearing the mark a significant market share in the pharmaceutical industry.

“10. As the creator and originator of the trademark VENTOLIN, Opposer’s earlier adoption and registration of this mark is therefore entitled to protection. Respondent-Applicant’s appropriation of the confusingly similar mark VENTOSIL, which has the same overall impression as that of the Opposer’s trademark VENTOLIN, is an act designed to dilute the distinctiveness and goodwill of the mark VENTOLIN.”

The grounds relied upon in the instant Opposition are as follows:

1. Respondent-Applicant’s trademark VENTOSIL nearly resembles Opposer’s trademark VENTOLIN.
2. Opposer’s trademark VENTOLIN is well-known internationally and in the Philippines making the registration of a confusingly similar trademark VENTOSIL in class 05 a violation of the provisions of Article 6bis of the

Paris Convention and Section 123.1 (e) and (f) of R.A. 8293 on well-known marks.

3. Respondent-applicant's registration and use of the mark VENTOSIL also constitute dilution of the distinctiveness of its well-known mark VENTOLIN.

To support its claims, the Opposer submitted the following Exhibits:

1. Exhibit "A" – Affidavit executed by Ms. Joanne Green
2. Exhibit "B" – Pages from the website: www.gsk.com/about/history.htm
3. Exhibit "C" – List of the worldwide trademark registration for the mark VENTOLIN.
4. Exhibit "C-1" – Certified True Copy of the certificate of Canada trademark registration no. TMA 185,241 for VENTOLIN
5. Exhibit "C-2" – Certified True Copies of the Certificates of United Kingdom trademark registration nos. 917177 and 1196000 for VENTOLIN
6. Exhibit "C-3" – Certified True Copy of the Certificates of Latvia trademark registration no. M18908 for VENTOLIN with verified English translation
7. Exhibit "C-4" – Certified True Copy of the certificate of Hong Kong trademark registration no. 19690705 for VENTOLIN
8. Exhibit "C-5" – Certified True Copies of the certificates of United States of America trademark registration nos. 2,013,681 and 1,095,668 for VENTOLIN.
9. Exhibit "C-6" – Certified True Copy of the certificates of Benelux trademark registration no. 0046266 for VENTOLIN
10. Exhibit "C-7" – Certified True Copy of the certificates of Spain trademark registration no. 582.810 for VENTOLIN with verified English Translation.
11. Exhibit "C-8" – Certified True Copy of the certificates of New Zealand trademark registration no. 88224 for VENTOLIN.
12. Exhibit "D" – Print out from IPO database of the trademark details of Philippine Trademark Registration No. 4-2002-006235 for VENTOLIN.
13. Exhibit "E" – Copy of the certificate of product registration no. DR-XY23941 issued by the Food and Drug Administration for VENTOLIN inhaler
14. Exhibit "E-1" – Copy of the certificate of product registration no. DR-XY13579 issued by the Food and Drug Administration for VENTOLIN Nebules.
15. Exhibit "E-2" – Copy of the certificate of product registration no. DR-XY4900 issued by the Food and Drug Administration for VENTOLIN
16. Exhibit "E-3" – Copy of the certificate of product registration no. DR-XY37089 issued by the Food and Drug Administration for VENTOLIN Rotapack
17. Exhibit "E-4" – Copy of the certificate of product registration no. DR-XY6009 issued by the Food and Drug Administration for VENTOLIN
18. Exhibit "E-5" – Copy of the certificate of product registration no. DR-XY8547 issued by the Food and Drug Administration for VENTOLIN Expectorant
19. Exhibit "E-6" – Copy of the certificate of product registration no. DR-XY10751 issued by the Food and Drug Administration for VENTOLIN Expectorant
20. Exhibit "F" – Copy of the package insert for product bearing the mark VENTOLIN Nebules in the Philippines
21. Exhibit "F-1" Photo of the product packaging bearing the mark VENTOLIN in the Philippines.

22. Exhibit "F-2" – Photo of the product bearing the mark VENTOLIN in the Philippines.
23. Exhibit "F-3" – Photo of the product packaging bearing the mark VENOLIN in the Philippines
24. Exhibit "F-4" – Photos of the various products and their packaging bearing the mark VENTOLIN in the Philippines.
25. Exhibit "F-5" – Copy of the package insert for the products bearing the mark VENTOLIN Actuation inhaler in the Philippines.
26. Exhibit "F-6" – Photo of the product bearing the mark VENTOLIN Inhaler in the Philippines
27. Exhibit "F-7" – Photo of the product bearing the mark VENTOLIN Rotacap in the Philippines
28. Exhibit "F-8" – Copy of the package insert for the products bearing the mark VENTOLIN Rotacap in the Philippines.
29. Exhibit "F-9" – Photo of the product bearing the mark VENTOLIN Rotahaler in the Philippines.
30. Exhibit "F-10" – Copy of the package insert for the products bearing the mark VENTOLIN Rotacap and Rotahaler in the Philippines.
31. Exhibit "F-11" – Photo of the product packaging bearing the mark VENTOLIN Rotacap in the Philippines
32. Exhibit "F-12" – Copy of the package insert for the product bearing the mark VENTOLIN Syrup in the Philippines.
33. Exhibit "F-13" – Photo of the product packaging bearing the mark VENTOLIN Accuhaler
34. Exhibit "F-14" – Photo of the product bearing the mark VENTOLIN Accuhaler.
35. Exhibit "F-15" – Photo of the product packaging bearing the mark VENTOLIN Accuhaler
36. Exhibit "F-16" – Photo of the product packaging bearing the mark VENTOLIN Inhaler.
37. Exhibit "F-17" – Photo of the product bearing the mark VENTOLIN ROTACAP in the Philippines
38. Exhibit "F-18" – Photo of the product packaging bearing the mark VENTOLIN Solution for Intravenous Infusion
39. Exhibit "F-19" – Photo of the products bearing the mark VENTOLIN Nebule
40. Exhibit "F-20" – Photo of the product and product packaging bearing the mark VENTOLIN Syrup
41. Exhibit "F-21" – Photo of the product packaging bearing the mark VENTOLIN Respirator Solution
42. Exhibit "F-22" – Product packaging, package insert, and sample of the product bearing the mark VENTOLIN Expectorant in the Philippines.
43. Exhibit "F-23" – Product packaging, package insert, and photo of the products bearing the mark VENTOLIN in Belgium.
44. Exhibit "F-24" – Photos of the products, products packaging and package inserts bearing the mark VENTOLIN in Latvia.
45. Exhibit "F-25" – Photos of the product packaging bearing the mark VENTOLIN in Slovakia
46. Exhibit "F-26" – Photos of the product, product packaging, and package inserts bearing the mark VENTOLIN in Slovenia.

47. Exhibit "F-27" – Photos of the products, products packaging and package inserts bearing the mark VENTOLIN in the United States of America.
48. Exhibit "F-28" – Product packaging and package inserts of the products bearing the mark VENTOLIN in Switzerland.
49. Exhibit "F-29" – Product packaging, package insert, and sample of the product bearing the mark VENTOLIN in the United Kingdom
50. Exhibit "30" – Photos of the product packaging and package inserts of the products bearing the mark VENTOLIN in Argentina
51. Exhibit "31" – Photos of the product packaging bearing the mark VENTOLIN in Turkey.
52. Exhibit "32" – Photos of the products, product packaging and package inserts bearing the mark VENTOLIN in Australia
53. Exhibit "33" – Copies of Resolucion Directorals issued by the Bureau of Health in Peru, which shows the grant of regulatory approval of the sanitary registration (license) to commercialize products bearing the mark VENTOLIN in Peru, as well as copies of the packaging and package inserts of the products bearing the mark VENTOLIN in Peru.
54. Exhibit "G" – Copies of the promotional materials for VENTOLIN Accuhaler in the internet
55. Exhibit "G-1" – Copies of the promotional materials for VENTOLIN Evohaler in the internet
56. Exhibit "G-2" – Copies of the promotional materials for VENTOLIN Injection in the internet
57. Exhibit "G-3" – Copies of the promotional materials for VENTOLIN Nebules in the internet
58. Exhibit "G-4" – Copies of the promotional materials for VENTOLIN Respirator Solution in the internet
59. Exhibit "G-5" – Copies of the promotional materials for VENTOLIN Solution for IV Infusion in the internet
60. Exhibit "G-6" – Copies of the promotional materials for VENTOLIN Syrup in the internet
61. Exhibit "G-7" – Copies of the promotional materials for VENTOLIN in www.medswellnessprescription.com
62. Exhibit "G-8" – Copies of the promotional materials for VENTOLIN in <http://united-kingdom.mercattel.com/html/ad/430571/buyventolin-aer>
63. Exhibit "G-9" – promotional materials for VENTOLIN Nebules in the Philippines
64. Exhibit "G-10" to "G-11" – promotional materials for VENTOLIN Nebules in the Philippines
65. Exhibit "G-12" – promotional materials for VENTOLIN Syrup in the Philippines
66. Exhibit "G-13" to "G-16" – Photo of the promotional materials for VENTOLIN Rotacap in the Philippines
67. Exhibit "G-17" to "G-20" – Photo of the promotional materials for VENTOLIN Syrup in the Philippines
68. Exhibit "G-21" – Photo of promotional materials for VENTOLIN Nebules in the Philippines
69. Exhibit "G-22" – Promotional materials for VENTOLIN Expectorant in the Philippines
70. Exhibit "G-23" – Promotional materials for VENTOLIN in Switzerland
71. Exhibit "G-24" – Promotional materials for VENTOLIN in Ireland

72. Exhibit "G-25" – Promotional materials for VENTOLIN in Belgium
73. Exhibit "G-26" – Promotional materials for VENTOLIN in Peru
74. Exhibit "G-27" – Promotional materials for VENTOLIN in United Kingdom
75. Exhibit "H" – Articles about Ventolin from "Doctor's Guide –Global Edition
76. Exhibit "H-1" – Details of 138 articles with references to the trademark VENTOLIN obtained via GSK's competitor information and News Portal from Northern Light
77. Exhibit "H-2" – Articles available from the Lancet.com, containing reference to the trademark VENTOLIN
78. Exhibit "H-3" – Print out from BMJ.com containing details of 117 reference to trademark VENTOLIN.

This Bureau issued a Notice to Answer and served a copy thereof by private courier to the Respondent-Applicant on 16 June 2012.

However, the Respondent-Applicant did not file an answer to the Opposition. In view thereof, an Order dated 13 September 2013 was issued declaring the Respondent-Applicant to have waived its right to submit an answer. Consequently, this case was submitted for Decision based on the Verified Notice of Opposition and evidence submitted by the Opposer.

The issue to resolve in the present case is whether the Respondent - Applicant should be allowed to register the trademark "VENTOSIL."

The competing marks are reproduced below for comparison:

VENTOLIN

VENTOSIL

Opposer's Trademark

Respondent-Applicant's Trademark

After examination of the two competing trademarks and the evidence submitted by the Opposer, this office finds merit to the contentions of the opposer.

At the outset, it is important to note that both competing word marks have eight (8) letters each and seven (7) of these eight (8) letters are identical with each other, namely, the letters "V," "E," "N," "T," "O," "L," and "I."

Also, taking in consideration both the visual and aural characteristics, the two word marks closely resemble each other since they are both composed of three (3) syllables with almost identical sounds.

The Supreme Court has consistently held that trademarks with *idem sonans* or similarities of sounds are sufficient ground to constitute confusing similarity in trademarks.⁴

⁴ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

Thus, the Court ruled that the following words: Duraflex and Dynaflex;⁵ Lusolin and Sapolin;⁶ Salonpas and Lionpas;⁷ and Celdura and Cordura⁸ are confusingly similar. In addition, the Supreme Court, citing Unfair Competition and Trade Marks, 1947, vol. 1 by Harry Nims, recognized the confusing similarities in sounds of the following trademarks: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jazz-Sea"; "Silver Flash" and "Supper-Flash"; "Cascarete" and Celborite"; "Celluloid and Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and Fermetex"; and "Zuso" and "HooHoo."⁹ Evidently, the subject trademarks "VENTOSIL" and "VENTOLIN" fall squarely within the purview of this *idem sonans* rule.

Furthermore, this office also notes that the two products subject of the competing trademarks, are closely related goods. The products subject of the Opposer's mark are pharmaceutical preparations for the prevention, treatment and/or alleviation of respiratory diseases and disorder that include anti-asthmatic-salbutamol which is the product subject of respondent-applicant's trademark. Definitely, there is high probability that the product of the respondent-applicant may be confused with the Opposer's product or the public may be deceived that respondent-applicant's product may have originated from the Opposer, or at the very least there is a connection between them.

Unfair appropriation of other's goodwill, which is one of the evil sought to be prevented by our intellectual property law, is very real in the instant case as records show that the Opposer has been using trademark "VENTOLIN" since 1969 and was applied for registration in the country by the Opposer last 2002 or seven years earlier than the respondent-applicant. No doubt, the Opposer has already acquired high goodwill with the public from its long use and marketing of its Ventolin products.

Verily, the field from which a person may choose a trademark is practically unlimited. As in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of design available, the Respondent-Applicant had to 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.¹⁰

Time and again, it has been held in our jurisdiction that 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.¹¹ Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.¹² Because the respondent-applicant will use his mark on goods that are similar and/or closely related to the opposer's, the consumer is likely to assume that the respondent-applicant's goods originate from or sponsored by the opposer or believe that there

⁵ American Wire & Cable Company vs. Director of Patents and Central Banahaw Industries, G.R. L-26557 18 February 1970

⁶ Sapolin Co. vs. Balmaceda, 67 Phil 795

⁷ Marvex Commercial Co., Inc. vs. Petra Hawpa and Co, G.R. No. L-19297, 22 December 1966

⁸ Co Tiong vs. Director of Patents, 95 Phil 1

⁹ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

¹⁰ American Wire & Cable Company vs. Dir. Of Patent, G.R. No. L-26557, February 18, 1970.

¹¹ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

¹² Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

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is a connection between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof.¹³

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 4-2009-710118 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-710118 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 19 November 2013



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

¹³ Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987