



GLAXO SMITHKLINE BIOLOGICALS S.A.,
Opposer,

-versus-

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

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} IPC No. 14-2012-00171
} Opposition to:
} Appln. Serial No. 4-2011-014732
} Date filed: 12 December 2011
} TM: "PIOREX"
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NOTICE OF DECISION

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Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2014 - 31 dated February 07, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 07, 2014.

For the Director:


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

"1.2 Opposer's trademark **PRIORIX**, with Philippine Trademark Registration No.4-1997-126032 enjoys more than fourteen (14) years of priority and seniority over Respondent-Applicant's Application No. 4-2011-014732 for **PIOREX**, counted from the very first filing of the trademark application for **PRIORIX** in October 27, 1997. Even if the priority and seniority will be reckoned from the filing of the subsequent trademark applications for **PRIORIX & DEVICE** with Philippines Trademark Registration No. 4-1998-000449 in January 22, 1998 as well as **PRIOREX-TETRA** with Philippine Trademark Registration No.4-2010-501070 in July 23,2010, Opposer still enjoys priority and seniority over Respondent-Applicant's **PIOREX** mark.

"1.3 Respondent-Applicant's trademark **PIOREX** also designates the same goods in the same class 05. While **PIOREX** is used for '(pharmaceutical product) – prescription drug of the class thiazolidinedione (TZD) with hypoglycemic (antihyperglycemic, antidiabetic) action', Opposer's trademark **PRIORIX** is used for 'pharmaceutical and medicinal preparations and substances for human use; vaccines.' This is likely to cause confusion among pharmacists and consumers.

"1.4 Respondent-Applicant's trademark **PIOREX** is visually and aurally similar to Opposer's trademark **PRIORIX**. **PIOREX** is also similar to **PRIORIX** in overall impression likely to deceive or to cause confusion.

1.4.1 The trademark **PIOREX** consists of the first syllable '**PIO**', which is aurally similar to the first syllable '**PRIO**' of **PRIORIX**.

1.4.2 Moreover, the two trademarks have the aurally similar last syllables '**REX**' and '**RIX**', and the more dominant and distinctive features of Opposer's trademark **PRIORIX** is found in Respondent-Applicant's trademark **PIOREX**.

1.4.3 In comparing both marks, the letters '**P**','**I**', '**O**', '**R**', '**X**' are identical. The only difference between Respondent-Applicant's trademark **PIOREX** and Opposer's trademark **PRIORIX** is the letter '**E**' in Respondent-Applicant's trademark **PIOREX**, and the letters '**R**' and '**I**' in Opposer's mark **PRIORIX**. Respondent-Applicant's trademark **PIOREX** contains five (5) letters '**P**', '**I**', '**O**', '**R**' and '**X**' of Opposer's registered mark **PRIORIX**. Hence, both trademarks have the same overall impression.

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1.4.4 In fact, when handwritten, as in written prescription, the marks are undoubtedly confusingly similar as shown below:

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1.4.5 In addition, both Respondent-Applicant's trademark **PIOREX** and Opposer's trademark **PRIORIX** consist of only three syllables.

"1.5 Is clear from the foregoing that the resemblance and similarities between Opposer's trademark **PRIORIX** and Respondent's-Applicant's trademark **PIOREX**, and the goods for which these marks are used, are such that **PIORIX** is likely to deceive or to cause confusion, more specifically, where the pharmaceutical products are marketed under marks which look and sound alike.

"1.6 Due to the resemblance to Opposer's trademark **PRIORIX** of Respondent-Applicant's trademark **PIOREX**, the public is likely to think that Respondent-Applicant's goods originated from Opposer. Respondent-Applicant's use of the trademark **PIOREX** may falsely and misleadingly suggest a connection between it and



Opposer's goods on the one hand, or Respondent-Applicant and Opposer's goods bearing the trademark **PRIORIX** and other hand. Hence, under 123.1 (d) subsection (iii) of R.A. 8293, the registration of trademark '**PIOREX**' should be proscribed.

"2. Further, it is well settled that if the competing trademarks contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place.

2.1 Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. The ordinary customer does not scrutinize details of the label. He forgets and overlooks there, but retains a general impression, or central figure, or a dominant characteristic.

2.2. Moreover, the goods or services do not need to be identical or even competitive to justify a determination that there is a likelihood of confusion. It is sufficient that the goods or services of the applicant and registrant are related in some manner, or that the circumstance surrounding their marketing are such that they are likely to be encountered by the same persons under the circumstances that would give rise, because of the marks used thereon, to the mistaken belief that they originate from or are in some way associated with the same producer.

2.3 Thus, any use if the mark **PIOREX** which is colorable imitation of the registered mark **PRIORIX** or, which contains the dominant features of the registered mark, constitutes trademark infringement under Sec. 155 of the IP Code, which states:

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"3. Opposer's trademark **PRIORIX** is well-known internationally and in the Philippines. Hence the registration of a confusingly similar trademark **PIOREX** in class 05 will dilute the distinctiveness of Opposer's mark, and will constitute a breach of the clear provisions of Article 6bis of the Paris Convention and Section 123.1 (e) and (f) of R.A. 8293 on well-known marks, which states that:

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"3.1 Respondent-applicant's registration and use if the mark **PIOREX**, which is confusingly similar to Opposer's well-known mark **PRIORIX** of the same goods in class 05, also constitute trademark dilution, which is the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of: (1) competition between the owner of the famous mark and other parties; or (2) likelihood of confusion, mistake or deception.

"Opposer will rely on the following facts to support its opposition:

"4. In 1997, Opposer's products bearing the trademark **PRIORIX** were launched.

4.1 The mark **PRIORIX** is also widely used in the following countries: Albania, Australia, Austria, Bahrain, Bangladesh, Barbados, Benelux, Bosnia and Herzegovina, Botswana, Brazil, Bulgaria, Cambodia, Canada, China (People's Republic), Colombia, Costa Rica, Croatia, Cyprus, Czech Republic, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Estonia, Finland, France, Georgia, Germany, Ghana, Greece, Guatemala, Honduras, Hong Kong, Hungary, Iceland, India, Ireland, Israel, Italy, Jamaica, Jordan, Kazakhstan, Kenya, Kuwait, Latvia, Lebanon, Lithuania, Malaysia, Malta, Mauritius, Mexico, Morocco, New Zealand, Nigeria, Oman, Pakistan, Panama, Paraguay, Peru, Philippines, Poland, Portugal, Romania, Russian Federation, Saudi

Arabia, Republic of Serbia, Singapore, Slovak Republic, Slovenia, South Africa, Republic of South Korea, Spain, Sri Lanka, Sweden, Switzerland, Taiwan, Thailand, Trinidad and Tobago, Tunisia, Turkey, United Kingdom, Ukraine, United Arab Emirates, United States of America, Uzbekistan, Venezuela and Vietnam.

4.2 The mark **PRIORIX** was first used in the Philippines by the Opposer in 1999 for 'pharmaceutical and medicinal preparations and substances for human use; vaccines' in class 05.

4.3 **PRIORIX** and **PRIORIX-TETRA** are also the subject of the following valid and existing Certificates of Product Registration (CPRs) issued by the food and Drug Administration (FDA) of the Philippines for the approved indications of **PRIORIX** and **PRIORIX-TETRA**:

Product Name in CPR	Date of Issuance of CPR
PRIORIX Lyophilized Powder for Solution for Injection (S.C.)	May 4, 2006
PRIORIX-TETRA	November 4, 2010

"5. The pharmaceutical products covered by the trademark **PRIORIX** are sold worldwide.

5.1 In 2012 alone, the worldwide sales for **PRIORIX** reached more than L149 million.

5.2 In the Philippines, the sales figures in volume of **PRIORIX** from 2009-2011, were in excess of 177,000 in 2009, 152,000 in 2010, 122,000 in 2011.

"6. The trademark **PRIORIX** is registered in numerous jurisdictions throughout the world. There are over 115 trademark registrations for **PRIORIX** worldwide, including the Philippines, for pharmaceutical products in class 05.

6.1 **PRIORIX** was first registered in United Kingdom on 29 may 1996.

6.2 In the Philippines, Opposer owns Philippines Trademark Registration No. 4-1997-126032 for **PRIORIX** in class 05 for 'pharmaceutical and medicinal preparations and substances for human use; vaccines', issued on October 18, 2001.

6.3 Opposer is also the owner of Philippine Trademark Registration No. 4-1998-000449 for **PRIORIX & DEVICE** in class 05 for 'pharmaceutical and medicinal preparations and substances for human use; vaccines', as well as in class 42 for 'vaccination and healthcare services', issued on April 21, 2003; and Philippine Trademark Registration No. 4-2010-501070 for **PRIORIX-TETRA** in class 05 for 'vaccines for human use', issued on December 31, 2010.

"7. The pharmaceutical product for which the trademark **PRIORIX** is used is sold in various drugstores all over the Philippines. It is well-known in the local market, which makes it a valuable product and trademark for Opposer.

"8. Opposer also invests heavily in advertising and publicizing the trademark **PRIORIX** and **PRIORIX-TETRA** worldwide, thereby earning the trademark an international reputation, and the product bearing the mark a significant market share in the pharmaceutical industry.

"9. Given the foregoing, there is no doubt that the interests of Opposer, as the registered owner of the trademark **PRIORIX** and its variant marks **PRIORIX & DEVICE** and **PRIORIX-TETRA**, and as a well-recognized leader in the pharmaceutical industry, will be damaged and prejudiced by the registration and use by Respondent-Applicant of the trademark **PIOREX**.

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

Opposer's evidence consists of the following:

1. Exhibit "A" - Affidavit of Mr. David Butler;
2. Exhibit "B" - List of worldwide trademark registrations and applications for the mark **PRIORIX**;
3. Exhibit "B-1" to "B-5" - certified true copies of trademark registrations issued by the European Community, Malaysia, Vietnam, Taiwan, and Canada;
4. Exhibit "C" - printout from the IPO database of Trademark Registration No. 4-1997-126032 for **PRIORIX**;
5. Exhibit "D" - printout from the IPO database of Trademark Registration No. 4-1998-000449 for **PRIORIX & DEVICE**;
6. Exhibit "E" - printout from the IPO database of Trademark Registration No. 4-2010-501070 for **PRIORIX-TETRA**;
7. Exhibits "F" to "F-6" - photos, packaging and package inserts of the products bearing the trademarks **PRIORIX**, **PRIORIX & DEVICE** and **PRIORIX - TETRA**;
8. Exhibits "G" and "G-1" - certified copy of Certificate of Product Registration for **PRIORIX** Lyophilized Powder for Solution for Injection (S.C.) and **PRIORIX_TETRA** issued by the Food and Drug Administration (formerly BFAD);
9. Exhibits "H" to "H-3" - copy of the promotional materials for **PRIORIX** and **PRIORIX-TETRA** in various websites; and
10. Exhibits "I" to "I-8" - copies of promotional materials of **PRIORIX**, **PRIORIX & DEVICE** and **PRIORIX-TETRA** in the Philippines and internationally.

This Bureau issued on 14 June 2012 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant on 25 June 2012. The Respondent-Applicant, however, has not filed his Answer. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark **PIOREX**?

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. Thus, Sec. 123.1 (d) of the

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.

The records show that at the time the Respondent-Applicant filed its application for the mark PIOREX on 12 December 2011, the Opposer has already been issued a registration for its trademark PRIORIX on 18 October 2001, covering goods falling under Class 05, namely, "pharmaceutical and medical preparations and substances for human use; vaccines" under Registration No. 4-1997-126032. It has also a registration for its marks PRIORIX & DEVICE for goods falling under Classes 05 and 42 issued on 22 January 1998 and PRIORIX-TETRA covering goods under Class 05 issued on 31 December 2010.

But, are the competing marks identical or confusingly similar and used on the same or closely related goods as to likely deceive or cause confusion?

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PRIORIX-TETRA

Opposer's Marks

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Respondent-Applicant's Mark

A perusal of the composition of the competing trademarks involved in this case show that both marks contain two syllables. Opposer's mark contains the syllables "PRIO" and "RIX" while Respondent-Applicant's contains the syllables "PIO" and "REX". In comparing both marks, the letters 'P', 'T', 'O', 'R', 'X' are identical. The only difference between Respondent-Applicant's trademark PIOREX and Opposer's trademark PRIORIX is the letter 'E' in Respondent-Applicant's trademark PIOREX, and the letters 'R' and 'T' in Opposer's mark PRIORIX. Respondent-Applicant's trade mark PIOREX contains five (5) letters 'P', 'T', 'O', 'R' and 'X' of Opposer's registered mark PRIORIX. Hence, they have similar overall impression. Although the marks are not entirely the same, there are no appreciable disparities between the two marks so as to avoid the likelihood of confusing one for the other. The subject marks may differ in spelling but when Respondent-Applicant's PIOREX mark is pronounced, it produces the same sound as that of Opposer's PRIORIX mark because the letter "R" in Opposer's mark becomes undistinguishable. Trademarks 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 in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

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 other⁴. Colorable imitation does not mean such similitude as amounts 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 trade name with that of the other mark or trade name 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 article⁵.

As to the goods upon which the competing marks are used, it may appear that the competing marks are used on different goods/services, that is, Opposer's mark is used on pharmaceutical and medical preparations and substances for human use and vaccines under Class 05 while Respondent's mark is being applied for (pharmaceutical product) - prescription drug of the class thiazolidinedione (TZD) with hypoglycemic (antihyperglycemic, antidiabetic) action under Class 05. Considering that the goods of the parties are both for pharmaceutical preparations, there is likelihood that any impression, perception or information about the goods advertised under the mark PIOREX may be unfairly attributed or confused with Opposer's PRIORIX, and vice versa.

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. 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:

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.⁶

It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.⁷

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

⁵ See *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

⁶ See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

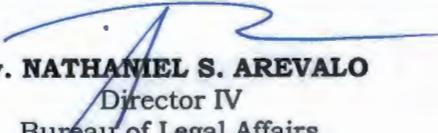
⁷ See *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990

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 filewrapper of Trademark Application Serial No. 4-2011-014732, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 February 2014.


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