



L.R. IMPERIAL, INC.,
Opposer,

-versus-

LABORATORI GUIDOTTI S.P.A.,
Respondent – Applicant.

}
} IPC No. 14-2011-00498
} Opposition to:
} Appln. Serial No. 4-2011-003862
} Date filed: 04 April 2011
} TM: "GLIMETFOR"
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 32 dated February 06, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 06, 2014.

For the Director:


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



L.R. IMPERIAL, INC.,

Opposer,

- versus -

LABORATORI GUIDOTTI S.P.A.,

Respondent-Applicant.

IPC NO. I4-2011-00498

Opposition to:

Appln. Ser. No. 4-2011-003862

(Filing Date: 04 April 2011)

TM: "GLIMETFOR"

Decision No. 2014- 32

DECISION

L.R. IMPERIAL, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-003862. The application, filed by LABORATORI GUIDOTTI S.P.A.² ("Respondent-Applicant"), covers the mark "GLIMETFOR" for use on "*oral antidiabetics*" under Class 05 of the International Classification of goods³.

The Opposer alleges, among other things, that GLIMETFOR resembles its registered trademark GLUMET. According to the Opposer, the registration of GLIMETFOR will violate Sec. 123.I (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), because its use will likely cause confusion, mistake and deception on the part of the public since it covers goods similar to those bearing the mark GLUMET, particularly, "*anti-diabetic medicinal preparation vis-à-vis hypoglycemic medicinal preparation*". To support its opposition, the Opposer submitted or presented as evidence the pertinent pages of the "IPO Gazette", and documents pertaining to the mark GLUMET particularly, certified copies of Cert. of Reg. No. 4-2001-003304 and Declaration of Actual Use/Affidavit of Use, sample product label, GLUMET, copy of the certification and sales performance, and Certificate of Product Registration issued by the Bureau of Food and Drugs (now Food and Drugs Administration)⁴.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 23 November 2011. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 12 October 2012 Order No. 2012-1321 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant be allowed to register the mark GLIMETFOR?

The essence of the trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; 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

¹ A domestic corporation duly organized and existing under the laws of the Philippines, with principal business address at 2nd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Metro Manila.

² A foreign corporation, with office address at Via Livornese 897, La Vettola (Pisa), Italy.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a 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.

⁴ Marked as Exhibits "A" to "F", inclusive.

article, to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product⁵. Thus, Sec. 123.I (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 mark as to be likely to deceive or cause confusion.

Records and evidence show that at the time the Respondent-Applicant filed its trademark application on 04 April 2011, the Opposer already has an existing trademark registration for the mark GLUMET (Reg. No. 4-2001-003304). Also, the Respondent-Applicant's trademark application indicates goods or pharmaceutical products that are similar to those covered by the Opposer's trademark registration, particularly, anti-diabetic medicinal preparations under Class 05.

This Bureau noticed that the Respondent-Applicant filed on 25 June 2008 an application to register the mark GLIMETFOR, and on 01 April 2009, was issued Reg. No. 4-2008-007572. The registration, however, was canceled for failure to submit the required Declaration of Actual Use. In this regard, while a mark may have been registered before and is canceled is not a guarantee that the same mark will be registered again in favor of the same person or entity. The new application will undergo examination and subject to opposition. In fact, at the time the Respondent-Applicant first filed an application in 2008 and obtained registration a year later, the Opposer had long been using the mark and registered it since 2001.

Now, the question is: Is the mark applied for registration by the Respondent-Applicant resembles the Opposer such that confusion, even deception, is likely to occur? The competing marks are depicted below:

Glumet

Opposer's mark

GLIMETFOR

Respondent-Applicant's mark

The first six letters or two syllables of the mark applied for registration by the Respondent-Applicant ("GLIMET") is almost identical to the Opposer's registered mark. Considering that the marks are used on similar and/or closely related goods, there is the likelihood of confusion among the consumers. That the Respondent-Applicant added the syllable "FOR" to "GLIMET" is of no moment as it did not diminish the likelihood of confusion. The first two syllables "GLIMET" are the features in the Respondent-Applicant's applied mark that the eyes immediately encounter. The peculiar clicking sound of "*gli-met*" also leaves a lasting impression upon the ears. "GLUMET" and "GLIMET" look and sound alike.

In this regard, 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 other⁶. Also, 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 tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive

⁵ *Prihadas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

⁶ *Societe Des Produits Nestle, SA v. Court of Appeals*, G.R. No. 112012, 4 April 2001, 356 SCRA 207, 217

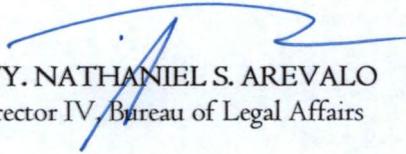
parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁷. Succinctly, because the Respondent-Applicant will use or uses the mark on goods and services that are similar and/or closely related to those dealt in by the Opposer, consumers may even assume that GLIMETFOR is just a variation of the Opposer's.

This Bureau thus finds and concludes that the registration of the mark GLIMETFOR in favor of the Respondent-Applicant is proscribed by Sec. 123.I(d) of the IP Code.

WHEREFORE, premises considered the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2011-003862 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 February 2014.



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

⁷ *Emerald Garment Manufacturing Corp. v. Court of Appeals*, G.R. No. 100098, 29 Dec. 1995.