



MEDICHEM PHARMACEUTICALS, INC.,
Opposer,

-versus-

MEDHAUS PHARMA, INC.,
Respondent-Applicant.

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}
} IPC No. 14-2009-00290
} Opposition to:
} Appln. Serial No. 4-2007-010249
} Filing Date: 17 Sept. 2007
} TM: "ZOLMED FORTE"

NOTICE OF DECISION

OCHAVE & ESCALONA

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Mandaluyong City

ADONISAI M. DELOS REYES

For Respondent-Applicant
No. 139 K First Street
Kamuning, Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 22 dated February 05, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 05, 2013.

For the Director:


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



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Decision No. 2013- 22

DECISION

MEDICHEM PHARMACEUTICALS, INC.¹ ("Opposer") filed on 21 December 2009 an opposition to Trademark Application Serial No. 4-2007-010249. The application, filed by MEDHAUS PHARMA, INC.² ("Respondent-Applicant"), covers the mark ZOLMED FORTE for use on "*antibacterial which is used in the treatment of genito-urinary infections, respiratory infections and gastrointestinal infections*" under Class 5 of the International Classification of Goods or Services³.

The Opposer alleges, among other things, that ZOLMED FORTE is confusingly similar to its mark "ZOLDEM". According to the Opposer, the registration of ZOLMED FORTE in favour of the Respondent-Applicant will violate Sec. 123.1 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

To support its opposition, the Opposer submitted as evidence a computer printout of trademarks published for opposition released on 22 September 2009 and documents relating to the mark ZOLDEM specifically: 1) certified true copies of Cert. of Reg. No. 4-2006-005900, Declaration of Actual Use, Cert. of Product Registration issued by the Bureau of Food and Drugs, and 2) sample product label.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 05 February 2010. The Respondent-Applicant, however, did not file an Answer.

The Opposer anchors its case on Section 123.1, par. (d), of the IP Code which 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.

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at 750 Shaw Boulevard, Mandaluyong City.

² A domestic corporation with principal address at 139 K First St., Kamuning, Quezon City.

³ 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.

⁴ Marked as Exhibits "A" to "E".

Records and evidence shows that at the time the Respondent-Applicant filed its trademark application on 17 September 2007, the Opposer has already an existing trademark registration for the mark ZOLDEM bearing Reg. No. 4-2006-005900 issued on 30 April 2007.

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some factors such as sound; appearance; form; style; shape and size or format; color; use; and the setting in which the words appear may be considered, for indeed, trademark infringement is a form of unfair competition⁵. Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance or meaning, would make it possible for the consumers to believe that the goods or products, to which the mark are attached, emanated from the same source or are connected or associated with one another.

In this regard, this Bureau noticed that the Opposer's mark ZOLDEM is derived from the generic name "ZOLPIDEM TARTRATE". ZOLDEM therefore should be considered a suggestive mark. A suggestive mark is a weak mark considering that the mark or brand name itself gives away or tells the consumers the goods or service, and/or the kind, nature, use or purpose thereof.

Aptly, the only similarity between the marks is the syllable "ZOL". The second syllable in the Respondent-Applicant's mark – "MED" – may have been composed of the letters that can also be found in the second syllable of the Opposer's mark. However, the arrangement of the said letters and the presence of the word "FORTE" have conferred on the Respondent-Applicant's mark visual and aural properties that are obviously distinct from that in the Opposer's.

Moreover, this Bureau finds that the goods covered by the Opposer's trademark registration are not similar or closely related to those indicated in the Respondent-Applicant's trademark application. While it is true that the goods all fall under Class 5, this does not mean that they are already similar or closely related. The Opposer's trademark registration covers "*sedative/hypnotic pharmaceutical preparation*". This is different from "*antibacterial*".

Thus, this Bureau finds that allowing the marks to co-exist would not cause confusion, mistake, much less deception. Because of the vast differences between the goods, it is unlikely that one who encounters the mark ZOLMED FORTE would have the mark ZOLDEM in mind.

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.⁶ This Bureau finds the Respondent-Applicant's mark consistent with this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2007-010249

⁵ *Clarke v. Manila Candy Co.*, 36 Phil. 100, 106.

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 05 February 2013.



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