



**MEDICHEM PHARMACEUTICALS
INCORPORATED,**
Opposer,

-versus-

PFIZER A.G.,
Respondent-Applicant.

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IPC No. 14-2010-00063
Opposition to:
Appln. Serial No. 4-2009-009539
Date filed: 18 September 2009
TM: "TISDERAN"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 73 dated March 17, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 17, 2014.

For the Director:

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



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INCORPORATED,**
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Appln. Serial No. 4-2009-009539
Filing Date: 18 September 2009
Trademark: **"TISDERAN"**

PFIZER A.G.,
Respondent-Applicant.

Decision No. 2014 - 73

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DECISION

MEDICHEM PHARMACEUTICALS INCORPORATED ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2009-009539. The application, filed by PFIZER A.G. ("Respondent-Applicant")², covers the mark "TISDERAN" for use on "pharmaceutical, veterinary and sanitary preparations, dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides" under class 05 of the International Classification of Goods and Services³.

The Opposer alleges among other things the following:

"1. The trademark 'TISDERAN' so resembles 'TUSERAN' trademark owned by Opposer, registered with this Honorable office prior to the publication for opposition of the mark 'TISDERAN'. The trademark 'TISDERAN', which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'TISDERAN' is applied for the same class of goods as that of trademark 'TUSERAN', i.e. Class (5).

"2. The registration of the trademark 'TISDERAN' in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the 'Intellectual Property Code of the Philippines', x x x

"3. Respondent's use and registration of the trademark 'TISDERAN' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'TUSERAN'.

"4. Opposer, the registered owner of the trademark 'TISDERAN', is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'TUSERAN' was originally filed with the Philippine Patent Office on 29 July 1953 by Opposer and was approved for registration on 20 February 1964 and valid for a period of twenty (20) years. On 20 September 1983, Opposer filed an application for renewal which was approved by the same Office on 22 November 1983 and valid for another period of twenty (20) years starting from 20 February 1984. Prior to the expiration of its registration, Opposer again filed an application for renewal which was approved by the Intellectual Property Office and valid

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

² A foreign corporation with principal office address at Scharenmoosstrasse 99, 8052 Zurich, Switzerland.

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.

for a period of ten (10) years starting 20 February 2004. Hence, Opposer's registration of the 'TUSERAN' trademark subsists and remains valid to date. x x x

"5. The trademark 'TUSERAN' has been extensively used in commerce in Philippines.
x x x

"6. There is no doubt that by virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark 'TUSERAN', and the fact that they are well known among consumers, the Opposer has acquired an exclusive ownership over the 'TUSERAN' marks to the exclusion of all others.

"7. 'TISDERAN' is confusingly similar to 'TUSERAN'.
x x x

"8. Moreover, Opposer's intellectual property right over its trademark is protected under section 147 of Republic Act No. 8293, otherwise known as the IP Code.

"9. To allow Respondent to continue to market its products bearing the 'TISDERAN' mark undermines Opposer's right to its marks. As the lawful owner of the marks 'TUSERAN', Opposer is entitled to prevent the Respondent from using a confusingly similar mark in the course of trade where such would likely mislead the public.
x x x

"10. By virtue of Opposer's prior and continued use of the trademark 'TUSERAN', the same have become well-known and established valuable goodwill to the consumers and the general public as well. The registration and use of Respondent's confusingly similar trademark on its goods will enable the latter to obtain benefit from Opposer's reputation, goodwill and advertising and will tend to deceive and/or confuse the public into believing that Respondent is in any way connected with the Opposer.

"11. Likewise, the fact that Respondent seeks to have its mark 'TISDERAN' registered in the same class (Nice Classification 5) as the trademark 'TUSERAN' of Opposer will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

The Opposer's evidence consists of the following

1. Exhibit "A" - Publication of Trademarks for Opposition dated 01 February 2010;
2. Exhibit "B" - Certificate of Renewal of Registration of TUSERAN issued by the Intellectual Property Office of the Philippines;
3. Exhibit "C" - Certificate of Renewal of Registration of TUSERAN issued by the Philippine Patent Office;
4. Exhibit "D" - Certificate of Principal Registration of TUSERAN issued by the Philippine Patent Office;
5. Exhibit "E" - Affidavit of Use for 5th anniversary for TUSERAN;
6. Exhibit "F" - Affidavit of Use for 15th anniversary for TUSERAN;
7. Exhibit "G" - Affidavit of Use for 10th anniversary for TUSERAN;
8. Exhibit "H" - Affidavit of Use/Non-Use;
9. Exhibit "I" - Sample packaging box of TUSERAN; and,
10. Exhibit "J" - Certificate of Product Registration.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 26 March 2010. Respondent-Applicant however, did not file an answer. On 24 July 2012, this Bureau issued Order No. 2012-1070 declaring Respondent-Applicant was declared in default and submitting this case for decision.

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

Sec. 123.1 (d) of R.A. 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 the subject trademark application on 18 September 2009, the Opposer has an existing registration for the mark TUSERAN. The Opposer originally filed with the Philippine Patent Office on 29 July 1963 the application for trademark registration for TUSERAN, which was issued registration on 20 February 1964.⁴ Thereafter, the registration of mark TUSERAN was renewed and remains valid for ten (10) years starting from 20 February 2004.⁵

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

TUSERAN

Opposer's Trademark

TISDERAN

Respondents-Applicants' Trademark

The similarities of the competing marks consist of having three (3) syllables with the same initial letter "T", middle letters "S" and "E" and the suffix "RAN". However, the presence of "U" in Opposer's TUSERAN, as against "I" and "D" in Respondent-Applicant's "TISDERAN", confer upon the mark visual and aural properties that enables one to easily distinguish one mark from the other.

Moreover, a scrutiny of the Respondent-Applicant's trademark application shows that the coverage of the mark TISDERAN is not the same with that of the Opposer's TUSERAN. TISDERAN qualifies its goods as: pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants, preparations for destroying vermin; fungicides, herbicides.⁶ TUSERAN on the other hand, is more particular in covering non-narcotic cough⁷ only. The illness to be treated by the use of the product is entirely distinct from each other; not to mention that the other goods covered by Respondent-Applicant are not medicines but baby food, medical supplies and the like. Thus, while both fall under Class 05 of the International Classification of Goods, the purpose and use of both marks are different. It is very remote, because of the mentioned dissimilarities for the buyers to be confused or commit mistake in buying their goods.

⁴ Exhibit "D" of Opposer.

⁵ Exhibits "B" and "C" of Opposer.

⁶ File wrapper records.

⁷ Exhibit "B" of Opposer.

It is emphasized that the essence of 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 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.⁸ This Bureau finds the Respondent-Applicants' mark consistent with this function.

WHEREFORE, premises considered, the Opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-009539 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 March 2014.


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

⁸ *Fribhdas J. Mirpuri v. Court of Appeals*, G.R. No., 115508, 19 Nov. 1999.