



MSD INTERNATIONAL HOLDINGS GMBH,  
Opposer,

-versus-

METRO PHARMA PHILIPPINES, INC.,  
Respondent –Applicant.

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}  
} IPC No. 14-2012-00561  
} Opposition to:  
} Appln. Serial No. 4-2012-008881  
} Date Filed: 20 July 2012  
} TM: "LEZTROL"  
}  
}  
}  
}

**NOTICE OF DECISION**

**SANTOS PILAPIL & ASSOCIATES**  
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Suite 1209, Prestige Tower  
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**PADLAN SALVADOR COLOMA & ASSOCIATES**  
Counsel for the Respondent-Applicant  
Suite 307, ITC Building  
337 Sen. Gil Puyat Avenue  
Makati City

**GREETINGS:**

Please be informed that Decision No. 2014 - 96 dated April 02, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 02, 2014.

For the Director:

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



**MSD INTERNATIONAL HOLDINGS GMBH,**  
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**METRO PHARMA PHILIPPINES, INC.,**  
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Date Filed: 20 July 2012

**TM: LEZTROL**

**Decision No. 2014- 96**

## DECISION

MSD INTERNATIONAL HOLDING GMBH ("Opposer")<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2012-008881. The application, filed by METRO PHARMA PHILIPPINES, INC. ("Respondent-Applicant")<sup>2</sup>, covers the mark "LEZTROL" for use on "pharmaceutical preparation" under Class 5 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer anchors its opposition on the ground that the mark "LEZTROL" being applied for registration by the Respondent-Applicant is a colorable imitation of and confusingly similar to Opposer's registered mark "EZETROL", hence proscribed under Section 123.1 paragraph (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), which provides:

(d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) the same goods or services, or
- (ii) closely related goods or services, or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion.

To support its opposition, the Opposer submitted in evidence the following:

1. Exhibit "A" – sworn statement in duplicate, the original of which is duly notarized, legalized and authenticated by the Philippine Consulate;
2. Exhibit "B" – certified true copies of Certificate of Reg. No. 4-2001-003331 for the trademark EZETROL;
3. Exhibit "C" – copy of the accepted 3-year Declaration of Actual Use evidencing compliance with Section 124.2 of the IP Code;

<sup>1</sup> A limited liability company organized and existing under the laws of Netherlands with principal offices located at Wim de Korvestraat 35, NL-5831, AN Boxmeer, Netherlands.

<sup>2</sup> With principal address at 600 Shaw Boulevard, Pasig City.

<sup>3</sup> 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. Exhibit "D" – copy of the accepted 6<sup>th</sup> year Declaration of Actual Use evidencing compliance with Section 145 of the IP Code; and
5. Exhibit "E" – copy of the recorded change of name of registrant Schering-Plough Ltd. To MSD INTERNATIONAL HOLDINGS GMBH.

On 06 May 2013, Respondent-Applicant filed its Verified Answer admitting some of the allegations of the opposition and denying all the material allegations thereof and argues that its mark is not confusingly similar with the Opposer's mark.

In defense of its trademark application, the Respondent-Applicant submitted in evidence the following:

1. Exhibit "1" – affidavit of Norman Z. Baza;
2. Exhibit "2" – Corporate Secretary's Certificate authorizing Norman Z. Baza to represent Respondent Metro Pharma;
3. Exhibit "3" – Certificate of Incorporation and Articles of Incorporation of Metro Pharma Phils., Inc.;
4. Exhibit "4" – certified true copies of License-to-Operate (LTO) of Respondent Metro Pharma from the Food and Drug Administration (FDA) – under LTO No. RDI-MM-DI/W-1258;
5. Exhibit "4-a" – FDA Official Receipt No. 0406332 for renewal of FDA registration for the years 2012-2013;
6. Exhibit "5" – certified true copies of Certificate of Product Listing issued by the FDA for LEZTROL;
7. Exhibits "6" to "10" – pictures of LEZTROL and EZETROL with comparative side-by-side pictures;
8. Exhibit "11" – actual product sample of LEZTROL; and
9. Exhibit "12" – actual product sample of EZETROL.

Should the Respondent-Applicant's trademark application be allowed?

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 products.<sup>4</sup>

Records show that at the time the Respondent-Applicant filed its trademark application on 20 July 2012, the Opposer has existing trademark registration for the mark "EZETROL" used on cholesterol absorption inhibitor under Class 5 of the International Classification of Goods and Services, bearing Reg. No. 4-2001-003331 date of registration 11 March 2004.

But, are the competing marks as shown below, identical or closely resemble each other that confusion or deception is likely to occur?

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<sup>4</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999

# EZETROL

*Opposer's Mark*

# LEZTROL

*Respondent-Applicant's Mark*

Both marks end with the syllable "TROL". Also, the first three (3) letters in the mark applied for registration by the Respondent-Applicant "LEZ" bears resemblance, in looks and sound, to the first three (3) letters of the Opposer's mark ("EZE"). The slight difference in the spelling would not avoid the likelihood of confusion. In the Respondent-Applicant's trademark application, the coverage is broadly stated as "pharmaceutical preparation". This means that if registered, the Respondent-Applicant can use it on goods or products covered by the Opposer's mark.

It is emphasized that 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 other<sup>5</sup>. Because the competing marks are confusingly similar, consumers may also likely assume, that the Respondent-Applicant's mark is just a variation of or related to the Opposer's and/or the goods or services originate or provided by one party alone or the parties themselves are connected or associated with one another while in fact there is none. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origins thereof as held by the Supreme Court<sup>6</sup>.

Accordingly, the registration of the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 paragraph (d) of the IP Code.

**WHEREFORE**, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-008881 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

**SO ORDERED.**

Taguig City, 02 April 2014.

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

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<sup>5</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 4 April 2001, 356 SCRA 207, 217.

<sup>6</sup> Converse Rubber Corp., v. Universal Rubber Products, Inc. et.al. G.R. No. L-27906, 08 Jan. 1987.