QUALIFIRST HEALTH, INC.,
Opposer,

-versus-

THE CATHAY YSS DISTRIBUTORS CO., INC.,
Respondent- Applicant.

IPC No. 14-2012-00341
Opposition to:
Appln. Serial No. 4-2012-000224
Date Filed: 06 January 2006
TM: "METAZ"

NOTICE OF DECISION

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THE CATHAY YSS DISTRIBUTORS CO., INC.
Respondent-Applicant
2nd Floor, Vernida 1, Amorsolo St.,
Legaspi Village, Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 88 dated May 24, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 24, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs

QUALIFIRST HEALTH, INC.,
Opposer,

-versus-

THE CATHAY YSS DISTRIBUTORS CO., INC.,
Respondent-Applicant.
x----------x

IPC No. 14-2012-00341
Case Filed: 25 July 2012

Opposition to:
Appln. Serial No. 4-2012-000224
Date Filed: 06 January 2006

TM: "METAZ"

Decision No. 2013- 88

DECISION

QUALIFIRST HEALTH, INC. ("Opposer")[1] filed on 25 July 2012 a Verified Opposition to Trademark Application Serial No. 4-2012-000224. The application, filed by THE CATHAY YSS DISTRIBUTORS CO., INC. ("Respondent-Applicant")[2] covers the mark "METAZ" for use on " non-insulin treatment for diabetes" under Class 5 of the International Classification of Goods and Services.[3]

The Opposer alleges, among other things, the following:

1. The trademark "METAZ" so resembles "CETAZ" trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark "METAZ". The trademark "METAZ", 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 "METAZ" is applied for the same class of goods as that of trademark "CETAZ", i.e. Class (5);

2. The registration of the trademark "METAZ" 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", which provides, in part, that a mark cannot be registered if it:

> "(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:

[1] A corporation duly organized and existing under the laws of the Philippines with principal office located at Unit 902 Citystate Condominium Corporation, 709 Shaw Blvd., Oranbo, Pasig City.
[2] A domestic corporation with principal office address at 2nd Floor Vernida I, Amorsolo St., Legaspi Village, Makati 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.

(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; (Emphasis supplied)

Under the above-quoted provision, any mark which is similar to a registered mark shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

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

In support of its opposition, Opposer submitted in evidence the following:

1. Annex "A" – Page three of the IPO E-Gazette;
2. Annex "B" – Copy of the Certificate of Registration for the mark CETAZ;
3. Annex "C" – Sample of product label bearing the mark "CETAZ" actually used in Commerce; and
4. Annex "D" – Certificate of Product Registration issued by the BFAD for the mark CETAZ.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant which was duly received on 23 August 2012. However, the Respondent-Applicant did not file the required Verified Answer. Hence, the instant opposition is considered submitted for Decision based on the evidence and the opposition filed by the Opposer.

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

It is emphasized that the essence of trademark registration is to give protection to the owner 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 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[4].

Thus, 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 a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 06 January 2006, the Opposer has already an existing Registration No. 4-2008-013227 issued

[4] Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

on 16 February 2009 covering the mark "CETAZ" for antiprotozoal pharmaceutical preparation under Class 5 of the International Classification of Goods and Services.

The competing marks are reproduced for comparison and scrutiny:

Cetaz	METAZ
Opposer's Mark	Respondent-Applicant's Mark

Jurisprudence says that 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 the 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; color; idea connoted by the mark; the meaning; spelling and pronunciation of the words used; and the setting in which the words appear may be considered for indeed, trademark infringement is a form of unfair competition[5].

The competing marks are consisting of two syllables and their first syllables are entirely distinct and different from each other both in spelling and pronunciation. The Opposer's first syllables is "CE" and the Respondent-Applicant is "ME". Further, the Opposer's mark start with a capital letter "C" and all the other letters are written in small font. The Respondent-Applicant's mark on the other hand start wit a capital letter "M" and all the other letters are likewise written in capital letter. This distinction makes the two marks distinguishable from each other as to visual presentation as well as to composition. It is often, the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered. The first word, prefix or syllable in a mark is always the dominant part. In sum, the two marks are obviously not identical and/or confusingly similar to each other.

Further, the goods and/or products covered by the competing marks are not the same and the illness to be treated by the use of the product are entirely distinct and different from each other more specifically the generic name of the Opposer's METRONIDAZOLE is for the treatment of severe intra-abdominal and gynecological infections or treatment of infections due to anaerobic bacteria. On the other hand, the Respondent-Applicant's mark is being used for the treatment for diabetes, a different illness. Finally, CETAZ can only be obtained on prescription by a physician, hence chances of procuring one from the other is a remote possibility.

Thus, the likelihood of the consumers being deceived or confused is remote, much less the chances of physicians, pharmacists, sales clerks and those dispensing drugs and medicines committing mistakes.

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[5] Clarke v. Manila Candy Co. Phil. 100, Co Tiong S.A. v. Director of Patents, 95 Phil. 1, 4.

In conclusion, therefore, this Bureau finds that the Respondent-Applicant's trademark application is not proscribed by Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

WHEREFORE, premises considered the instant opposition is hereby **DENIED**. Let the filewrapper of Trademark Application Serial No. 4-2012-000224 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 24 May 2013.

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

/pausi/joanne