



ROTAM LTD.,	}	IPC NO. 14-2012-00314
Opposer,	}	Opposition to:
	}	
-versus-	}	Appln. Ser. No. 4-2011-12366
	}	Date Filed: 13 October 2011
	}	
THE GENERICS PHARMACY, INC.,	}	Trademark: LODAM
Respondent-Applicant.	}	
x-----x		Decision No. 2014- 22

DECISION

ROTAM LTD., (Opposer)¹ filed on 10 September 2012 an opposition to Trademark Application Serial No. 4-2011-12366. The application, filed by THE GENERICS PHARMACY (Respondent-Applicant)², covers the mark "LODAM", for use on "Pharmaceutical preparation used in the management of pain and fever" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"1. Respondent-Applicant's mark LODAM so resembles Opposer's trademarks ROTAM and ROTAM & LEAF DEVICE that the use of the word LODAM would falsely tend to suggest a connection with the Opposer and would therefore constitute fraud and further cause dilution of the distinctiveness of the Opposer's marks to the prejudice and irreparable damage of the Opposer.

"2. The Respondent-Applicant's products and those of the Opposer's are related and are/confusingly belonging under an identical NICE class 5 such that use thereof by the Respondent-Applicant will likely cause confusion or mistake or deceive purchasers as to the source or origin of said goods to such extent that they may be mistaken by the unwary public as products originating from the Opposer.

"3. The registration of the Respondent-Applicant's mark would therefore violate Section 123.1(d)(ii) (iii) (e) & (f) of the IP Code (R.A. 8293) and the corresponding rules and regulations."

The Opposer relies on the following facts:

¹ A company organized and existing under the laws of Hong Kong with business address at 7/F, Cheung Tat Centre, 18 Chung Lee Street, Chaiwan, Hong Kong

² A Philippine corporation with address at 459 Quezon Avenue, Quezon City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

Republic of the Philippines

INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center
Fort Bonifacio, Taguig City 1634 Philippines

T: +632-2386300 • F: +632-5539480 • www.ipophil.gov.ph

"1. Opposer is one of forty-five companies under Rotam CropSciences Ltd., a fast growing international company key business focus in Crop Protection Products, with principal manufacturing base in China and operations split into ten regions: P.R.C. and Taiwan; Europe; North America; Southern Cone; Latin America North; Sub-Saharan Africa; North Africa; Middle east: Russia and CIS; Asia and West Africa.

"2. Rotam CropSciences Ltd. is a member of the Rotam Group, which has more than two thousand (2,000) employees around the world, and has direct operations in over 60 countries. The Rotam Group business includes crop protection, human medicine and veterinary medicine.

"3. For human medicine sector, the Rotam group formed a joint venture with India's Dr. Reddy laboratories Co. Ltd., by incorporating a company, Kunshan Rotam Reddy Pharmaceuticals Limited, on 31 December 1993, with address at No. 258, Huang Pu Jian (M) Road, Kunshan, Jiangsu, P.R. China. Its generic products include anti-gout drugs, drugs for central nervous system, cardiovascular drugs, digestive systems drugs, anti-allergic drugs, orthopaedic drugs, anti-fungal drugs, anti-viral drugs and weight loss drugs.

"4. Opposer is the owner of the marks ROTAM and ROTAM & DEVICE/LEAF LOGO, registered in various countries worldwide. In the Philippines, it owns the following trademark registrations and applications, namely:

4.1 Registration Certificate No. 4-2006-013016 dated 22 October 2007 for the mark ROTAM, covering "agricultural chemical", under NICE class 1.

4.2 Registration Certificate No. 4-2008-005725 dated 6 October 2008 for the mark ROTAM, covering "insecticides, herbicides, fungicides, parasiticides, preparations for destroying vermin".

4.3 Registration Certificate No. 4-2008-005874 dated 8 September 2008 for the mark ROTAM & LEAF DEVICE, covering "insecticides, herbicides, fungicides, parasiticides, preparations for destroying vermin".

4.4 Trademark Application No. 4-2012-007490 filed on 21 June 2012 for the mark ROTAM & DEVICE LOGO, covering "horticultural, agricultural and forestry grains and products not included in other classes; seeds, agricultural seeds, seedlings, young plants, and other plants or seeds for propagating," under NICE class 31; and "consultation services, scientific and

industrial research; all of these in horticulture, agriculture, forestry and seed planting,”

4.5 Trademark Application No. 4-2012-009711 filed on 6 August 2012 for ROTAM & DEVICE LOGO in Nice class 1, 25, 44 for the goods chemical products for use in horticulture, agriculture, forestry etc.; and Medical Services; hygienic and beauty care for human beings or animals; weed killing, vermin extermination; advisory services, information services etc.

“5. The term ROTAM was first coined and adopted by the Opposer, which was registered in Hong Kong Companies Registry on 10 September 1985.

“6. Opposer first adopted and commercially used the marks ROTAM and ROTAM & LEAF DEVICE on various products, specifically “agricultural chemical, insecticides, herbicides, fungicides, parasitides, preparations for destroying vermin” on 10 September 1985, and on medicines and drugs by its sister company ROTAM Pharmaceutical Company Limited in 1991.

“7. In the Philippines, Opposer first used the mark ROTAM and ROTAM & LEAF DEVICE for “insecticides, herbicides, fungicides, parasitides and preparations for destroying vermins.

“8. Opposer, by itself and through its sister/ affiliate companies, has used the ROTAM and ROTAM & LEAF DEVICE as part of its business and spent substantial amounts in promoting said marks.

“9. Opposer is in the process of developing under the ROTAM and ROTAM & LEAF DEVICE brands for the Philippine market covering a wide range of pharmaceutical products, such as anti-gout drugs, drugs for central nervous system, cardiovascular drugs, digestive system drugs, anti-allergic drugs, orthopaedic drugs, anti-fungal drugs, anti-viral drugs and weight loss drugs.

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

1. Certified true copy of Registration Certificate No. 4-2006-0130016 dated 22 October 2007 for the mark ROTAM for agricultural chemical (Exhibit “A”);
2. Certified true copy of Registration Certificate No. 4-2008-005725 dated 6 October 2008 for the mark ROTAM, covering “insecticides, herbicides, fungicides, parasitides, preparations for destroying vermin (Exhibit “B”);
3. Certified true copy of Registration Certificate No. 4-2008-005874 dated 8 September 2008 for the mark ROTAM & LEAF DEVICE, covering “insecticides, herbicides, fungicides, parasitides, preparations for destroying vermin (Exhibit “C”);

4. Duplicate of trademark application no. 4-2012-007490 filed on 21 June 2012 for the mark ROTAM & DEVICE LOGO, covering "horticultural, agricultural and forestry grains and products not included in other classes; seeds, agricultural seeds, seedlings, young plants, and other plants or seeds for propagating," under NICE class 31; and "consultation services, scientific and industrial research; all of these in horticulture, agriculture, forestry and seed planting (Exhibit "D");
5. Trademark Application No. 4-2012-009711 filed on 6 August 2012 for ROTAM & DEVICE LOGO in Nice class 1, 35, 44 for the goods chemical products (Exhibit "E");
6. Certified copy of three year Declaration of Actual Use for registration no. 4-2006-0130016 (Exhibit "F");
7. Certified copy of three year Declaration of Actual Use for registration no. 4-2008-005725 (Exhibit "G");
8. Certified copy of three year Declaration of Actual Use for registration no. 4-2008-005874 (Exhibit "H");
9. Legalized affidavit of Chick Yuk Ching with attached advertisements and product labels (Exhibit "I");
10. Company brochures (Exhibit "J");
11. Pharmaceutical brochures (Exhibit "K");
12. Product labels for ROTAM & LEAF DEVICE (Exhibit "L");
13. Pharmaceutical product label for "Nicergoline Tablets" (Exhibit "M");
14. Pharmaceutical product label for "Ramipril tablets" (Exhibit "N");
15. Corporate Website showing the brand ROTAM(Exhibit "O").

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 26 September 2012. The Respondent-Applicant, however did not file an Answer. Thus, this Bureau issued Order No. 2013-350 dated 28 February 2013 declaring the Respondent-Applicant to have waived its right to file an Answer.

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

The essence of trademark registration is to give protection to the owners of 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 product.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.

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:

	
---	--

Opposer's mark

Respondent-Applicant's mark


The marks are similar with respect to the second ("O") and the last two letters, ("AM"). Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur.

Records show that while at the time Respondent-Applicant applied for registration of the mark "LODAM" the Opposer already has trademark registrations⁵ for the mark "ROTAM", the goods indicated in the Respondent-Applicants 's application are different from those covered by the Opposer's trademark registrations. The Opposer's trademark registrations cover: agricultural chemicals under class 1 and insecticides, herbicides, fungicides, and parasitides. These goods are different as to composition, purpose and application from the Respondent-Applicant's.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-012366 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 January 2014.


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

⁵ Exhibits "B" and "C"