



THERAPHARMA, INC.,
Opposer,

-versus-

ASTRAZENECA, AB,
Respondent- Applicant.

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} IPC No. 14-2010-00288
} Opposition to:
} Appln. Serial No. 4-2010-501041
} Date Filed: 21 July 2010
} TM: "GABAMAX"
}
}
}
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 10 dated January 15, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 15, 2014.

For the Director:


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



THERAPHARMA, INC.

Opposer,

-versus-

ASTRAZENECA, AB,

Respondent-Applicant.

x ----- x

IPC No. 14-2010-00288

Opposition to Trademark

Application No. 4-2010-501041

Date Filed: 21 July 2010

Trademark: "GABAMAX"

Decision No. 2014- 10

DECISION

Therapharma, Inc.¹ ("Opposer") filed on 25 November 2010 an opposition to Trademark Application Serial No. 4-2010-501041. The contested application, filed by Astrazeneca, AB² ("Respondent-Applicant"), covers the mark "GABAMAX" for use on "*pharmaceutical preparations and substances*" under Class 05 of the International Classification of Goods³.

Opposer anchors its opposition on the provision of Section 123.1 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). It contends that the Respondent-Applicant's mark "GABAMAX" will likely cause confusion, mistake and deception on the part of the purchasing public most especially considering that the opposed mark is applied to the same class and goods as that of its own mark "AVAMAX". It further explained in this wise:⁴

"12.1.6.1 Respondent-Applicant's mark 'GABAMAX' appears and sounds almost the same as Opposer's trademark 'AVAMAX'.

12.1.6.2. Both marks are composed of three (3) syllables /GA-/BA-/MAX/ and /A-/VA-/MAX/.

12.1.6.3. The last syllable of both marks is exactly the same.

12.1.6.4. The second syllable of both marks /BA/ and /VA/ can be similarly pronounced.

¹ A domestic corporation duly organized and existing under the laws of the Philippines, with office address at 3rd Floor Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

² Appears to be a foreign corporation, with office address at SE-151 85 Sodertalje, Sweden.

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 See Verified Opposition, p. 9.

12.1.6.5. Respondent-Applicant merely added the letter 'G' at the beginning of its mark 'GABAMAX', which shows that Opposer's trademark 'AVAMAX' is contained in Respondent-Applicant's mark 'GABAMAX.'"

According to Opposer, its company is engaged in marketing and sale of a wide range of pharmaceutical products. It maintains that "AVAMAX" has been extensively used on commerce in the Philippines and that no less than the Intercontinental Marketing Services ("IMS"), the world's leading provider of business intelligence and strategic consulting services for pharmaceutical and healthcare industries with operations in more than one hundred (100) countries, acknowledged and listed the said brand as one of the leading brands in the Philippines under the category "C10A - Cholest and Trigly. Regulator" in terms of market share and sales performance. It further avers that it registered its "AVAMAX" products with the Bureau of Food and Drugs (BFAD) in order to legally market, distribute and sell the same.

In support of the allegations in the Opposition, the Opposer submitted the following as evidence:

1. copy of pertinent pages of the IPO E-Gazette wherein Respondent-Applicant's mark was published for opposition;
2. certified true copy of Certificate of Registration No. 4-2009-002292 for the mark "AVAMAX";
3. sample product label bearing the trademark "AVAMAX";
4. copy of the sales performance and certification from IMS; and,
5. certified true copy of the Certificate of Product Registration issued by BFAD.

On 25 January 2011, a Notice to Answer was served to Respondent-Applicant. Despite receipt thereof, the latter failed to comply. This prompted the Hearing Officer to issue Order No. 2013-801 on 30 May 2013 declaring Respondent-Applicant in default and submitting the case for decision.

The issue to be resolved is whether Application Serial No. 4-2010-501041 should be allowed.

Records reveal that at the time Respondent-Applicant filed its application for registration of the mark "GABAMAX" on 21 July 2010, the Opposer holds a valid and existing registration of its mark "AVAMAX" issued on 06 February 2010. The latter filed

its application for registration of its mark as early as 04 March 2009. Clearly, Opposer is the prior registrant.

Now, to determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown below for comparison:

Avamax **GABAMAX**

Opposer's mark

Respondent-Applicant's mark

Upon scrutiny of the subject trademarks, it can be readily gleaned that the two marks are confusingly similar. Opposer's mark "AVAMAX" covers a drug with generic name *atorvastatin calcium*. Observably, "ava" is derived from its generic name. However, the syllable "max" does not have any correlation to pharmaceutical preparations in general and is therefore neither generic nor descriptive of the products involved. And yet, the last syllable "max" is likewise appropriated by Respondent-Applicant. While it may be argued that "max" is a common word which may connote "maximum", the fact remains that Respondent-Applicant failed to lend its mark the distinctiveness required by law. Besides their common last syllable, the first two syllables of the marks, i.e. "ava" and "gaba", nearly resemble each other. The letters "b" and "v" are almost the same sounding. Hence, despite the addition of the letter "g" at the beginning of Respondent-Applicant's mark, which is the only major difference between the two marks, the likelihood of confusion remains.

Succinctly, 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.⁵ Aptly, the Supreme Court held in the case of **Del Monte Corporation vs. Court of Appeals**⁶, thus:

"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As

⁵ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, April 4, 2001.

⁶ G.R. No. L-78325, January 25, 1990.

observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."

Noteworthy, the trademarks "AVAMAX" and "GABAMAX" both refer to goods under Class 05 thus creating greater probability of confusion and/or deception. After all, it has long been settled that proof of actual confusion need not be shown. It suffices that confusion is probably or likely to occur.⁷ Even assuming that their respective goods will be packaged and marketed differently, it is highly likely that consumers may have the mistaken notion that the Opposer merely expanded business and manufactured a new product by the name of "GABAMAX". In **Societe des Produits Nestle, S.A. vs Martin T. Dy, Jr.**, the Supreme Court explained thus⁸:

"Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two types of confusion. The first is the confusion of goods 'in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other.' In which case, 'defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation.' The other is the confusion of business: 'Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist.'"

Finally, it is emphasized that 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.⁹ Respondent-Applicant's trademark fell short in meeting this function.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

⁷ Philips Export, B.V. vs. Court of Appeals, G.R. No. 96161, 21 February 1992.

⁸ G.R. No. 172276, 08 August 2010.

⁹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-501041 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 January 2014.



ATTY. NATHANIEL S. AREVALO

Director IV

Bureau of Legal Affairs