



THERAPHARMA, INC.,
Opposer,

-versus-

EDMUND DEL ROSARIO,
Respondent –Applicant.

}
} IPC No. 14-2010-00217
} Opposition to:
} Appln. Serial No. 4-2009-012176
} Date Filed: 02 August 2009
} TM: "AMBLOC"
}

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 41 dated February 27, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 27, 2014.

For the Director:


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



THERAPHARMA, INC.,
Opposer,

IPC No. 14-2010-00217

-versus-

Appln. Serial No. 4-2009-12176
Filing Date: 27 November 2009
Trademark: "AMBLOC"

EDMUND DEL ROSARIO,
Respondent-Applicant.

Decision No. 2014 - 61

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DECISION

THERAPHARMA, INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2009-12176. The application, filed by EDMUND DEL ROSARIO ("Respondent-Applicant")², covers the mark "AMBLOC" for use on "pharmaceutical used in the treatment of hypertension and angina pectoris" under class 05 of the International Classification of Goods and Services³. The Opposer alleges among other things the following:

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

"2. The registration of the trademark 'AMBLOC' 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.

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 'AMBLOC' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'AMVASC'.

"4. Opposer, the registered owner of the trademark 'AMVASC', is engaged in the marketing, and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'AMBASC' was filed with the Intellectual Property Office on 16 January 2006 by Opposer and was approved for registration by this Honorable Office on 19 March 2007 and valid for a period of ten (10) years. Hence, Opposer's registration of the 'AMVASC' trademark subsists and remains valid to date.

¹ A company organized under the laws of the Philippines with principal place of business at 3rd Floor, Bonaventure Plaza, Ortigas Ave., Greenhills, San Juan City.

² With address at 2163 Menandro St., Pandacan, Manila.

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.

"5. The trademark 'AMVASC' has been extensively used in commerce in the 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 'AMVASC', and the fact that they are well known among consumers as well as to internationally known pharmaceutical information provider, the Opposer has acquired an exclusive ownership over the 'AMVASC' marks to the exclusion of all others.

"7. 'AMBLOC' is confusingly similar to 'AMVASC'. 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 Philippine Intellectual Property Code, x x x.

"9. To allow Respondent to continue to market its products bearing the 'AMBLOC' mark undermines Opposer's right to its marks. As the lawful owner of the mark 'AMVASC', 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 'AMVASC', 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 'AMBLOC' registered in the same class (Nice Classification 5) as the trademark 'AMVASC' of Opposer will undoubtedly add to the likelihoods of confusion among the purchasers of these two goods.

The Opposer's evidence consists of the following

1. Exhibit "A" - Listings of Trademarks Published for Opposition;
2. Exhibit "B" - Certificate of Registration of AMVASC issued by Intellectual Property Office of Philippines;
3. Exhibit "C" - Declaration of Actual Use;
4. Exhibit "D" - Sample Packaging of AMVASC;
5. Exhibit "E" - Certification issued by IMS Health Philippines, Inc.;
6. Exhibit "F" - "F-1" - Certificate of Product Registration;
7. Exhibit "G" - Sample Packaging of CALCIBLOC;

The Respondent-Applicant filed its Verified Answer on 03 February 2011 alleging among other things the following:

"The similarities between the Opposer's products are the following:

- a. The trademark 'AMVASC' has the same first two (2) letters as the applicant's 'AMBLOC'. As such, only the prefix 'AM' is the same;
- b. The intended use of both products is essentially the same – the Certificate of Registration of 'Amvasc', states that the same is intended for the 'treatment of hypertension, chronic stable angina and myocardial ischemia due to vasospastic angina,' while the Answering

Respondent's 'AMBLOC', as stated in its own Certificate of Product Registration states that the drug is to be 'used in the management of hypertension and angina pectoris.'

The similarities, however, END THERE.

x x x

" 'AMBLOC' IS A PRESCRIPTION DRUG WHICH WHEN PRONOUNCED DOES NOT SOUND THE SAME AS 'AMVASC'

Evidently, the only similarity between the two names is the fact that they have the same first two (2) letters. While this respondent is not privy to the reason why the Opposer used the name 'Amvasc', on its part, the name 'AMBLOC' was arrived at with the intention of finding syllable or words suggestive of the generic name, classification, action and/or the ailments which they are intended to be used for.

Accordingly, the name 'AMBLOC' was a result of an intensive marketing scheme in that the primary intention is to somehow entice the buying public to patronize the same, considering that the trademark applied for was taken from the generic name 'AMLODIPINE' and to its classification (use) which is as a 'CALCIUM CHANNEL BLOCKER.'

Secondly, and most coincidentally, it just so happened that the third letter in the applied for trademark is 'B' (from the word 'blocker'). This detail is very important because the company's marketing team intended to take advantage of the fact that the trademark would have the second letter in the alphabet ('B') inasmuch as there are several generic brands for AMLODIPINE.

x x x

" 'AMBLOC' IS A MEDICAL FORMULATION WHICH IS INTENDED TO ADDRESS HYPERTENSION AND ANGINA PECTORIS

Amlodipine (as besylate, mesylate or maleate) and as defined in Wikipedia, is a long-acting calcium blocker (dihydropyridine class) used as an anti-hypertensive and in the treatment of angina. In layman's terms, the drug is used to treat high blood pressure (hypertension) or chest pain (angina).

And as can be clearly seen from the list above, there are at least THIRTY NINE (39) different available products manufactured by different pharmaceutical companies, ALL AIMED at helping the buying public 'cure' their hypertension and/or angina pectoris

x x x

"EVEN FROM A SUBSTANTIVE VIEWPOINT, THE APPLICATION FOR THE TRADEMARK 'AMBLOC' CANNOT BE CONSIDERED AS CONSTITUTIVE OF 'UNFAIR COMPETITION' FOR THE OPPOSER.

It is most respectfully submitted that the registration of the trademark 'AMBLOC' will not violate the provisions of Sec. 123 of Republic Act 8293, otherwise known as the 'Intellectual Property Code of the Philippines' because the elements which would hinder its application are not present.

Stated otherwise, although it is admitted that like the Opposer's 'AMVASC' the product 'AMBLOC' is intended to address the problem of hypertension or angina pectoris, and that the drug would be in the same class of goods or services, using the Therapharma's arguments, there should be THIRTY SEVEN (37) other brands which it should also consider as 'unfair competitors' because all of these other drugs as indicated in the list of generic medicines of Amlodipine, are currently being sold in the market just like AMBLOC and AMVASC."

The Respondent-Applicant's evidence consists of the following:

1. Exhibit "1" - Special Power of Attorney;
2. Exhibit "2" - Certificate of Product Registration for AMBLOC;
3. Exhibit "3" - "3-A" - List of Amlodipine Available Brands/Company;
4. Exhibit "4" - Product Insert for AMBLOC;
5. Exhibit "5" - Sample Packaging for AMBLOC;
6. Exhibit "5-A" - Certificate of Registration of AMVASC issued by the Intellectual Property Office Philippines; and,
7. Exhibit "6" - Product Lists.

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

The instant opposition is anchored on Section 123.1 paragraph (d) of the IP Code which 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 its trademark application on 27 November 2009, the Opposer has already an existing trademark registration for the mark AMVASC bearing Registration No. 4-2006-000470 issued on 19 March 2007.⁴ This registration covers "medicinal preparation for the treatment of hypertension, chronic stable angina and myocardial ischemia due to vasospastic angina" under Class 5. Hence, the competing marks are used on similar or closely goods.

Nevertheless, it is unlikely that the coexistence of the marks will cause confusion, much less deception, among the public. The competing marks are reproduced as follows:

Amvasc

Opposer's mark

AMBLOC

Respondent-Applicant's mark

The only similarities between the marks are the prefix "AM" and the number of letters involved. These are insufficient to conclude the resemblance between the two marks. The succeeding letters after "AM" differ from each other both in spelling and pronunciation. Opposer's AMBLOC can never mistaken for Respondent-Applicant's AMVASC. The presence of the letters "B", "L" and "C" in AMBLOC produces a different sound, setting it apart from AMVASC which is distinctive because of the letter "A" in its last syllable.

The contending marks both contain the prefix "AM" which appears to have been derived from its generic name "AMLODIPINE", a common ingredient in the Opposer and Respondent-Applicant's

⁴ Exhibit "B" of Opposer.

pharmaceutical products. A trademark that begins with the prefix "AM" and is used as hypertensive drug/preparation is, therefore, a suggestive mark, which is a weak mark. The mark or brand name itself gives away or tells the consumers the goods or services, and/or the kind, nature, use of purpose thereof.

Succintly, what easily comes to the mind when one sees or hears a mark or brand name for hypertension drugs of which the prefix "AM" is a part of, is the very concept or idea of the goods. What will set apart or distinguish such mark from another mark which also includes the same prefix used for the same treatment, are letters and/or syllables that follows "AM". In this instant case, it is very unlikely that a consumer will be mislead or confused into believing that the Respondent-Applicant's goods came or originated from or connected to or associated with the Opposer's. The Respondent-Applicant's mark ends with the syllable "BLOC" which are different, visually and aurally, from "VASC" in the Opposer's mark.

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.⁵

Moreover, taking into account that the only similarity between the competing marks is the prefix "AM", sustaining the instant opposition would have the unintended effect of giving the Opposer the exclusive right to use "AM", which evidently and sufficiently describes the pharmaceutical goods involved, i.e. pharmaceutical used in the treatment of hypertension.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-12176 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 27 February 2014.


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

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.