



TORRENT PHARMA PHILS., INC.,
Opposer,

-versus-

ZYNOVA PHARMACEUTICALS, INC.,
Respondent-Applicant.

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IPC No. 14-2010-00149
Opposition to:
Appln. Serial No. 4-2009-012703
Date Filed: 10 December 2009
TM: "DECLLOT"

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 199 dated October 16, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 16, 2013.

For the Director:

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



TORRENT PHARMA PHILS., INC.,
Opposer,

IPC No. 14-2010-00149
Case Filed: 21 July 2010

-versus-

Opposition to:
Appln. Serial No.: 4-2009-012703
Date Filed: 10 December 2009

ZYNOVA PHARMACEUTICALS, INC.,
Respondent-Applicant.

Trademark: "DECLOT"

x-----x

Decision No. 2013 - 199

DECISION

TORRENT PHARMA PHILS., INC. ("Opposer")¹ filed on 21 July 2010 an opposition to Trademark Application Serial No. 4-2009-012703. The application, filed by ZYNOVA PHARMACEUTICALS, INC. ("Respondent-Applicant")², covers the mark "DECLOT" for use on "clopidogrel bisulphate, a medicine indicated for the reduction of thrombotic events following recent MI or recent stroke and in patients with established peripheral artery disease or acute coronary syndrome" under Class 5 of the International Classification of Goods and Services³.

The Opposer anchors its case on Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("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 a mark as to be likely to deceive or cause confusion. In support of its Opposition, the Opposer submitted the following:

1. Annex "A" - Secretary's Certificate;
2. Annex "B" - Certificate of Registration No. 4-2008-003726 for the mark DEPLATT date of Registration 21 July 2008;
3. Annex "C" - BFAD Registration No. DR-XY37232 issued on 21 December 2009 for the Brand Name Deplatt;

¹ A corporation existing by virtue of Philippine laws and a wholly-owned subsidiary of Torrent Pharmaceuticals Limited, with principal address at Unit 401-C ITC Bldg., 337 Gil Puyat Ave., Makati City.

² A corporation existing by virtue of Philippine laws with principal address at Unit 18-B Strata 2000 Bldg., No. 9 F. Ortigas Jr. Road, Ortigas Center, Pasig 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.

4. Annex "D" - Affidavit of SRINIVAS CHAKRA VARTHY MADDALI dated 08 July 2010;
5. Annex "D-1" - Certificate of Reg. No. 612871 issued on 05 March 2007 by the Government of India for the mark "DAPLATT";
6. Annex "D-2" - Certificate of Reg. of the mark Deplatt in Venezuela;
7. Annex "D-3" - Printout of <http://www.torrentpharma.com>;
8. Annex "D-4" - Printout of <http://www.torrentpharma.com>; and
9. Annex "E" - Actual packaging of Deplatt's product.

On 11 October 2010, the Respondent-Applicant filed its Verified Answer denying all the material allegations of the opposition and further argued that its mark is absolutely not similar and/or confusingly similar with Opposer's mark.

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 products⁴. 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.

In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 10 December 2009, the Opposer has an existing registration for the trademark DEPLATT (Reg. No. 4-2008-003726) issued on 21 July 2008. The Respondent-Applicant's trademark application indicates that it is used for "clopidogrel bisulphate, a medicine indicated for the reduction of thrombotic events following recent MI or recent stroke and in patients with established peripheral artery disease or acute coronary syndrome" which is similar or closely related to the goods covered by the Opposer's registration, such as, "pharmaceutical preparations namely, anticoagulant, antithrombotic, fibrinolytic" under Class 5 of the International Classification of Goods and Services⁵.

But do the marks resemble each other that confusion, or even deception, is likely to occur?

The marks are depicted below:

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

⁵ Annex "B".

DEPLATT

DECLOT

Opposer's Mark

Respondent-Applicant's Mark

The contending marks are both word marks in plain letterings without any unique device or design. Visually, the marks are distinguishable from each other although they are both printed in capital bold letters with similar font style. The Opposer's last syllable consists of "PLATT" while the Respondent-Applicant's "CLOT". However, when the two words are pronounced, they give the same sound effects. The Opposer's DEPLATT and the Respondent-Applicant's DECLOT are, therefore, confusingly similar in sound.

Time and again, it has been ruled that similarity of sound is sufficient ground to rule that the marks are confusingly similar. In the case of *Marvex Commercial Co., Inc. vs. Petra Hawopia & Co. and the Director of Patents*⁶, the Supreme Court categorically ruled that:

"Two letters of "SALONPAS" are missing in "LIONPAS": the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance (Co Tiong Sa vs. Director of Patents, 95 Phil. I, citing Nims, *The Law of Unfair Competition and Trademarks*, 4th ed., Vol. 2, pp. 678-679). The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must depend entirely on the ear (Operators, Inc. vs. Director of Patents, supra).

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Marks*, 1947, Vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jass-Sea"; "Silver Flash" and "Supper Flash"; "Cascarete" and Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "Trade-Mark Law and Practice", pp. 419-421, cities, as coming within the purview of the idem sonans rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.

In the case at bar, "SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the

⁶ G. R. No. L-19297, December 22, 1966.

same descriptive properties (see *Celanese Corporation of America vs. E. I. Du Pont*, 154 F. 2d. 146, 148)."

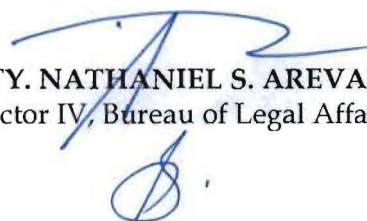
Moreover, since the Respondent-Applicant seeks to register its mark for goods under Class 5 particularly, "clopidogrel bisulphate, a medicine indicated for the reduction of thrombotic events following recent MI or recent stroke and in patients with established peripheral artery disease or acute coronary syndrome", which is similar or closely related with those covered by the Opposer's registration, it is highly probable that the purchasers will be led to believe that Respondent-Applicant's products originated from or is sponsored by Opposer. It is settled that likelihood of confusion extends 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, "defendants 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* where "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."

It is emphasized that the registration of trademarks involves public interest. Public interest, therefore, requires that only marks that would not likely cause deception, mistake or confusion should be registered. The consumers must be protected from deception, mistake or confusion with respect to the goods or services they buy. Trademarks serve to guarantee that the product to which they are affixed comes up to a certain standard quality. Modern trade and commerce demands that deprecations on legitimate trademarks should not be countenanced. The law against such deprecations is not only for the protection of the owner but also, more importantly, for the protection of consumers from confusion, mistake, or deception as to the goods they are buying.⁷

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2009-012703 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 October 2013.


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

⁷ *Le Chemise Lacoste S. A. v. Oscar C. Fernandez, et. al.*, G. R. Nos. 63796-97 and G. R. No. 65659, 21 May 1984.