



UNITED AMERICAN
PHARMACEUTICALS, INC.,
Opposer,

-versus-

PHIL SHINPOONG PHARMA, INC.,
Respondent- Applicant.

X-----X

}
} IPC No. 14-2013-00090
} Opposition to:
} Appln. Serial No. 4-2012-009606
} Date filed: 03 August 2012
} TM: "PEPTRAD"
}
}
}
}

NOTICE OF DECISION

OCHAVE & ESCALONA

Counsel for the Opposer
No. 66 United Street
Mandaluyong City

PHIL SHINPOONG PHARMA, INC.,

Respondent-Applicant
Unit 2314 Medical Plaza Ortigas Building
San Miguel Avenue, Ortigas Center
Pasig City

GREETINGS:

Please be informed that Decision No. 2013 - 235 dated December 04, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 04, 2013.

For the Director:


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



UNITED AMERICAN PHARMACEUTICALS, INC., Opposer,	}	IPC No. 14-2013-00090
	}	Opposition to:
- versus -	}	Appln. Serial No. 4-2012-009606
	}	Date Filed: 03 August 2012
PHIL SHINPOONG PHARMA, INC., Respondent-Applicant.	}	Trademark: PEPTRAD
x-----x	}	Decision No. 2013 - <u>235</u>

DECISION

UNITED AMERICAN PHARMACEUTICALS, INC.¹ ("Opposer") filed on 27 February 2013 a Verified Notice of Opposition to Trademark Application No. 4-2012-009606. The application, filed by PHIL SHINPOONG PHARMA, INC.² ("Respondent-Applicant"), covers the mark PEPTRAD for use on "*pharmaceutical product - solution for injection, used for the relief of mild to moderate pain*" under Class 5 of the International Classification of goods³.

The Opposer alleges the following:

"7. The mark PEPTRAD owned by Respondent-Applicant so resembles the trademark PIPTAZ owned by Opposer and duly registered with the IPO prior to the publication for opposition of the mark PEPTRAD.

"8. The mark PEPTRAD will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark PEPTRAD is applied for the same class and goods as that of Opposer's trademark PIPTAZ, i.e. Class 05 of the International Classification of Goods as pharmaceutical product.

"9. The registration of the mark PEPTRAD in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, 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:

- (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

1 A domestic corporation duly organized and existing under the laws of the Philippines, with office address at 132 Pioneer Street, Mandaluyong City, Philippines.
2 Appears to be a domestic corporation, with office address at Unit 2314, Medical Plaza Ortigas Building, San Miguel Avenue, Ortigas Center, Pasig City, Philippines.
3 Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

likely to deceive or cause confusion; (Emphasis supplied)

x x x

Under the afore-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."

To support its opposition, the Opposer submitted the following pieces of evidence:

1. Copy of the pertinent page of the IPO e-Gazette bearing publication date of 28 January 2013;
2. Certified true copy of Certificate of Registration No. 4-2006-010078 for the trademark PIPTAZ;
3. Certified true copies of the Declaration of Actual Use and Affidavit of Use; and
4. Sample product label bearing the trademark PIPTAZ.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 18 March 2013. The Respondent-Applicant, however, did not file its Verified Answer. Thus, this Bureau issued Order No. 2013-1428 dated 21 October 2013 declaring the Respondent-Applicant in default and submitting the case for decision on the basis of the opposition, affidavit of witness and documentary or object evidence submitted by the Opposer.

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

The Opposer anchored its opposition on Sec. 123.1 (d) of the Intellectual Property Code ("IP Code"), which provides 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:

- (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.

In this regard, records and evidence show that at the time the Respondent-Applicant filed its trademark application on 03 August 2012, the Opposer already has an existing trademark registration (No. 4-2006-010078) for PIPTAZ issued on 28 May 2007 for use on "*anti-infective medicinal preparation*" under Class 05.

⁴ Exhibits "A" to "E".

But are the competing marks, as shown below, identical or closely resemble each other such that confusion or deception is likely to occur?

PIPTAZ

Opposer's Mark

PEPTRAD

Respondent-Applicant's Mark

In terms of appearance and sound, the marks are clearly distinguishable from each other. The similarity in the first, third and fourth letters comprising the letters "P", "P" and "T" does not make them confusingly similar to each other. On the contrary, when the marks are pronounced and presented, they gave different sounding effect and commercial impression.

Also, while both marks are used for goods under Class 05, namely pharmaceutical products, they are intended for different purposes. The Opposer's PIPTAZ is used as an anti-infective preparation while the Respondent-Applicant's PEPTRAD is intended for the relief of mild to moderate pain. In this instance, it is very unlikely that the consumers will be misled or confused into believing that the Respondent-Applicant's goods originated from or is associated with the Opposer's.

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

Clearly, the Respondent-Applicant satisfied this function test.

WHEREFORE, premises considered, the opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-009606 be returned, together with a copy of this Decision, to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 04 December 2013.


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

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