



UNITED AMERICAN
PHARMACEUTICALS, INC.,
Opposer,

-versus-

LUMAR PHARMACEUTICAL LABORATORY,
Respondent –Applicant.

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}
} IPC No. 14-2011-00517
} Opposition to:
} Appln. Serial No. 4-2011-005506
} Filing Date: 16 May 2011
} TM: "ZINETT"
}
}
}
}

NOTICE OF DECISION

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LUMAR PHARMACEUTICAL LABORATORY
Respondent-Applicant
No. 5 First Bulacan Industrial City
Malolos City, Bulacan

GREETINGS:

Please be informed that Decision No. 2014 - 60 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



UNITED AMERICAN
PHARMACEUTICALS, INC.,
Opposer,

IPC No. 14-2011-00517
Opposition to:

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Appln. Serial No. 4-2011-005506
Filing Date: 16 May 2011
Trademark: "ZINETT"

LUMAR PHARMACEUTICAL LABORATORY
Respondent-Applicant.

Decision No. 2014 - 60

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DECISION

UNITED AMERICAN PHARMACEUTICALS, INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2011-005506. The application, filed by LUMAR PHARMACEUTICAL LABORATORY ("Respondent-Applicant")², covers the mark "ZINETT" for use on "medicine, antibacterial, chloramphenicol preparations" under class 05 of the International Classification of Goods and Services³. The Opposer alleges among other things the following:

"1. The trademark 'ZINETT' so resembles 'ZENITH' trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark 'ZINETT'. The trademark 'ZINETT', 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 'ZINETT' is applied for the same class of goods as that of trademark 'ZENITH', i.e. Class (5); anti-bacterial.

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

"3. Respondent's use and registration of the trademark 'ZINETT' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'ZENITH'.

The facts are as follows:

"4. Opposer, the registered owner of the trademark 'ZENITH', is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'ZENITH' was filed with the Intellectual Property Office on 25 September 2009 by Opposer and was approved for registration by this Honorable Office on 27 May 2010 and valid for a period of ten (10) years. Hence, Opposer's registration of the 'ZENITH' trademark subsists and remains valid to date.

x x x

"5. The trademark 'ZENITH' has been extensively used in commerce in the Philippines.

¹ A company organized under the laws of the Philippines, with principal place of business at Pioneer St. Mandaluyong City.

² A company organized under the laws of the Philippines with principal place of business is at No. 5 First Bulacan Industrial City, Malolos City, Bulacan.

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.

x x x

"6. There is no doubt that by virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark 'ZENITH', and the fact that they are well known among consumers especially with its aggressive advertisements, the Opposer has acquired an exclusive ownership over the 'ZENITH' marks to the exclusion of all others.

"7. 'ZINETT' is confusingly similar to 'ZENITH'.

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 ('IPCode'), x x x.

"9. To allow Respondent to continue to market its products bearing the 'ZINETT' mark undermines Opposer's right to its marks. As the lawful owner of the marks 'ZENITH', 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 'ZENITH', the same have become well-known and established valuable goodwill to the consumers and the general public as well. The 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 'ZINETT' registered in the same class as the trademark 'ZENITH' of Opposer plus the fact that both are ANTI-BACTERIAL will undoubtedly add to the likelihood 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 for the trademark ZENITH;
3. Exhibit "C" - Sample of product label bearing the trademark ZENITH; and,
4. Exhibit "D" - Certificate of Product Registration issued by the FDA for ZENITH;

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 09 December 2011. Respondent-Applicant however, did not file an answer. Thus, the Respondent-Applicant was declared in default and the case deemed submitted for decision.

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

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 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.⁴

Thus, Section 123.1 paragraph (d) of Rep. Act 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 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 16 May 2011, the Opposer has already an existing trademark registration for the mark ZENITH bearing Registration No. 4-2009-009769 issued on 27 May 2010.⁵

But, are the contending marks, depicted below, resemble each other such that confusion, even deception, is likely to occur?

ZENITH

Opposer’s Trademark

ZINETT

Respondent-Applicant’s Trademark

The foregoing marks show compound similarities in both its visual and aural presentation. The letters are almost similarly positioned such that, when the words are pronounced, they produce similar sound which is sufficient to cause confusion to another person’s faculty of hearing.

Moreover, a perusal of the records shows that the products covered by the contending marks are likewise similar. Respondent-Applicant’s mark ZINETT covers medicine, anti-bacterial and chloramphenicol preparations. Chloramphenicol is known as a broad-spectrum antibiotic, effective against infections cause by a wide variety of bacteria.⁶ On the other hand, Opposer’s mark ZENITH covers antibiotic pharmaceutical preparation. Thus, both pharmaceutical products both serve the same purpose in treating an illness or disease of humans.

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.⁷ Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their

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

⁵ Exhibit “B” of Opposer.

⁶ Net doctor, available at <http://www.netdoctor.co.uk/infections/medicines/chloramphenicol-capsules.html> (last accessed 20 February 2014).

⁷ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.⁸

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁹ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:¹⁰

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. Hence, 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

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

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2011-005506 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

⁸ Emerald Garment Manufacturing Corp. V. Court of Appeals, G.R. No. 100098, 29 December 1995.

⁹ American Wire and Cable Co. v. Director of Patents, et al., (31 SCRA 544) G.R. No. L-26557, 18 February 1970.

¹⁰ Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.