



UNITED LABORATORIES, INC.,
Opposer,

-versus-

JUSTRIGHT PHARMACEUTICALS,
Respondent- Applicant.

X-----X

}
} IPC No. 14-2011-00433
} Opposition to:
} Appln. Serial No. 4-2011-003357
} (Filing Date: 24 March 2011)
} TM: "DIZZINON"
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}
}

NOTICE OF DECISION

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JUSTRIGHT PHARMACEUTICALS
c/o GRACINIA MANALO
For the Respondent-Applicant
2163 Menandro Street
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GREETINGS:

Please be informed that Decision No. 2014 - 158 dated June 19, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 19, 2014.

For the Director:


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



UNITED LABORATORIES, INC.,
Opposer,

- versus -

JUSTRIGHT PHARMACEUTICALS,
Respondent-Applicant.
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IPC No. 14-2011-00433

Appln. Serial No. 4-2011-003357

Filing Date: 24 March 2011

Trademark : "DIZZINON"

Decision No. 2014 - 158

DECISION

UNITED LABORATORIES, INC.,¹ filed an opposition to Trademark Application Serial No. 4-2011-003357. The application, filed by JUSTRIGHT PHARMACEUTICALS, ("Respondent-Applicant")², covers the mark "DIZZINON" for use on "pharmaceutical: cinnarizine 25 mg tablet – for symptomatic treatment of nausea and vertigo caused by meniere's disease, prevention and treatment of motion sickness and management of various peripheral and cerebral vascular disease" under class 05 of the International Classification of Goods and Services³.

The Opposer alleges among other things the following:

"1. The trademark 'DIZZINON' so resembles the trademark 'DIZITAB', owned by Opposer. The trademark 'DIZZINON', 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 'DIZZINON' is also applied for the same class and goods as that of trademark 'DIZITAB', i.e. Class (5) for treatment of nausea.

"2. The registration of the trademark 'DIZZINON' 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 'DIZZINON' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'DIZITAB'.

"4. Opposer is the registered owner of the trademark 'DIZITAB', is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'DIZITAB' was filed with the Intellectual Property Office on 8 August 2005 by Opposer's sister company Unam Brands, LTD. ('Unam') and was approved for registration 3 September 2006 and valid for a period of ten (10) years. On 24 October 2007, UNAM assigned ownership of the mark 'DIZITAB' to herein Opposer, UNITED LABORATORIES, INC. ('UNILAB'). The Deed of Assignment was accordingly filed with the Intellectual Property Office on 12 November 2007.

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

x x x

¹ A domestic corporation with principal office address at No. 66 United St., Mandaluyong City.

² A domestic corporation with principal office address at No. 2163 Menendo 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.

"6. There is no doubt that by virtue of the above-mentioned Certificates, Opposer has acquired an exclusive ownership over the mark 'DIZITAB' to the exclusion of all others.

"7. 'DIZZINON' is confusingly similar to 'DIZITAB'.

x x x

"8. Moreover, Opposer's intellectual property right over its trademark is protected under Section 147 of Republic Act No. 8293, x x x

"9. To allow Respondent to continue to market its products bearing the 'DIZZINON' mark undermines Opposer's right to its marks. As the lawful owner of the mark 'DIZITAB', Opposer is entitled to prevent the respondent from using a confusingly similar mark in the course of trade where such would likely mislead the parties.

x x x

"10. By virtue of Opposer's prior and continued use of the trademark 'DIZITAB', 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 'DIZZINON' registered in the same class (Nice Classification 5) as the trademark 'DIZITAB' of Opposer will undoubtedly add to the likelihood of confusion among the purchasers of these two goods."

The Opposer's evidence consists of the following:

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|----------------|---|--|
| 1. Exhibit "A" | - | List of trademarks published for opposition; |
| 2. Exhibit "B" | - | Certificate of Registration for the trademark DIZITAB; |
| 3. Exhibit "C" | - | Deed of Assignment of Registered Trademark DIZITAB; |
| 4. Exhibit "D" | - | Declaration of Actual Use; |
| 5. Exhibit "E" | - | Actual packaging of DIZITAB; and, |
| 6. Exhibit "F" | - | Certificate of Product Registration, |

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 25 October 2011. Respondent-Applicant however, did not file an answer. Thus, in this Bureau's Order No. 2012-1172 dated 17 August 2012, the Respondent-Applicant was declared in default and the case is deemed submitted for decision.

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

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 24 March 2011, the Opposer has already an existing trademark registration for the mark DIZITAB in the Intellectual Property Office of the Philippines in 03 September 2006 with Registration No. 4-2005-007999.⁴

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

Dizitab

DIZZINON

Opposer's Trademark

Respondent-Applicant's Trademark

The first two syllables of the Respondent-Applicant's mark forming the word "DIZZI" are similar, except that it has two letter "Z", with that of the Opposer's "DIZI". "DIZZI" or "DIZI" are obviously derived from the word dizzy or dizziness, which is a whirling sensation in the head with a tendency to fall.⁵ This is among the ill feelings treated by the medicines DIZITAB and DIZZINON, as indicated in the registration certificate⁶ and the file wrapper records. Thus, it is not really unique if used as a trademark or as part of a trademark for pharmaceutical products. Indeed, "DIZI" or "DIZZI" are clearly suggestive as to the kinds of goods a mark with such component is attached to. What would make such trademark distinctive are the suffixes or appendages to the "DIZI" or "DIZZI" and/ or any devices, if any. Sustaining the opposition solely on the ground that the Respondent-Applicant's mark contains the syllable "DIZZI" is tantamount to giving the Opposer exclusive right to use the word "DIZZY" on a trademark or part thereof on its products that treats "dizziness".

In this regard, the last syllable in the Opposer's mark "TAB" is different from the last syllable in the Respondent-Applicant's mark "NON". This makes a fine distinction as to sound and appearance such that confusion or deception is unlikely to occur. There is a remote possibility for a consumer to assume or conclude that there is a connection between the parties solely because both marks start with "DIZI" or "DIZZI" since, as we discussed above, it is merely suggestive of the word dizzy or dizziness.

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.⁷

Clearly, the Respondent-Applicant satisfied this function test.

⁴ Exhibits "B" of Opposer.

⁵ Definition of dizzy, available at www.merriam-webster.com/dictionary/dizzy (last accessed 19 May 2014).


⁶ Id at 4.

⁷ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-003357 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 June 2014.



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