



UNITED LABORATORIES, INC.,  
Opposer,

-versus-

PHARMA AG, INC.,  
Respondent-Applicant.

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}  
} IPC No. 14-2009-00292  
} Opposition to:  
} Appln. Serial No. 4-2008-710018  
} Date filed: 25 November 2008  
} TM: "PORFENAL"  
}  
}

**NOTICE OF DECISION**

**OCHAVE & ESCALONA**  
Counsel for Opposer  
No. 66 United Street, Mandaluyong City  
Metro Manila

**MARISOL L. HANGINAN**  
For Respondent-Applicant  
Block 18, Lot 39, Vet-Pal Estate, Pakigne  
Minglanilla, Cebu

**GREETINGS:**

Please be informed that Decision No. 2012 - 78 dated April 24, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 24, 2012.

For the Director:

*Catherine Socorro O. Estrada*  
**Atty. CATHERINE SOCORRO O. ESTRADA**  
Hearing Officer, BLA

CERTIFIED TRUE COPY  
*Sharon S. Alcantara*  
**SHARON S. ALCANTARA**  
Records Officer II  
Bureau of Legal Affairs, IPO



UNITED LABORATORIES, INC.,  
*Opposer,*

IPC No. 14-2009-00292  
Opposition to:

- versus -

Appln. Ser. No. 4-2008-710018  
Date Filed: 25 November 2008

PHARMA AG, INC.,  
*Respondent-Applicant.*

Trademark: **PORFENAL**  
Decision No. 2012 - 78

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## DECISION

UNITED LABORATORIES, INC.<sup>1</sup> ("Opposer") filed on 21 December 2009 a verified opposition to Trademark Application No. 4-2008-710018. The application, filed by PHARMA AG, INC.<sup>2</sup> ("Respondent-Applicant") covers the mark "PORFENAL" for use "*pharmaceutical product (mefenamic acide 500mg caps, 250mg caps, 50mg/gml susp.)*" under Class 05 of the International Classification of Goods<sup>3</sup>.

The Opposer alleges, among other things, that PORFENAL resembles the registered mark "DOLFENAL" owned by the Opposer. According to the Opposer, the resemblance of PORFENAL to DOLFENAL will likely cause confusion, mistake, and deception because the goods both marks are used for similar goods. The Opposer thus, claims that the registration of PORFENAL will violate Sec. 123 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). The Opposer's evidence consists of the following:

1. Exh. "A" to "A-1": computer print-out of Trademarks Published for Opposition released on 22 Sept. 2009;
2. Exh. "B": copy of the Certificate of Registration for the trademark DOLFENAL;
3. Exh. "C": copy of Deed of Assignment of Registered Trademark on 20 Jan. 2005;
4. Exh. "D": copy of Deed of Assignment of Registered Trademark on 27 Sept. 2005;
5. Exh. "E": copy of Deed of Assignment of Registered Trademark on 24 Oct. 2007;
6. Exh. "F": copy of Affidavit of Use for Fifth Anniversary filed on 11 Aug. 1995;
7. Exh. "G": copy of Affidavit of Use for Tenth Anniversary filed on 22 Aug. 2000;
8. Exh. "H": copy of Affidavit of Use for Fifteenth Anniversary filed on 27 Sept. 2005;
9. Exh. "I": sample product label bearing the trademark DOLFENAL;
10. Exh. "J": copy of the Certification and Sales Performance of DOLFENAL issued by the Intercontinental Marketing Services (IMS); and
11. Exh. "K": copy of BFAD Certificate of Product Registration for the mark

<sup>1</sup> A domestic corporation with principal business address at 66 United Street, Mandaluyong City, Philippines.

<sup>2</sup> A domestic corporation with principal business address at No. 10 3<sup>rd</sup> Street, Happy Valley, V-Rama Avenue, Cebu City, Philippines.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

DOLFENAL on 25 May 2007.

This Bureau issued a Notice to Answer a copy of which was served upon the Respondent-Applicant on 13 January 2009. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant's trademark application be allowed?

It is emphasized that the essence of the trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; 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 product<sup>4</sup>. Thus, Sec. 123.1 (d) of the 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.

Records and evidence show that at the time Respondent-Applicant filed its application on 25 November 2008, there is an existing trademark registration for the mark DOLFENAL issued to the Opposer's predecessor-in-interest, THERAPHARMA, INC. The trademark registration, assigned to the Opposer on 24 October 2007, covers "*medicinal preparation for use as analgesic, antidysmenorrhea and anti-inflammatory*" while the generic name of the product under the mark or brand is "*mefenamic acid*". Obviously, the goods on which DOLFENAL is attached as a mark or brand are exactly the same as those indicated in the Respondent-Applicant's trademark application.

But are the opposing marks identical or closely resemble each other so as to likely cause confusion, mistake or deception?

The only difference between the competing marks is that the Opposer's mark starts with the letters or syllable "DOL" as against the Respondent-Applicant's "POR". In this regard, the Opposer's mark is unique and highly distinctive. It appears to be an inventive or coined word, not even derived from the goods on which is attached to ("*mefenamic acid*").

Thus, considering that PORFENAL is also used on "*mefenamic acid*", there is a likelihood that the consumers will assume that it is only a variation of the mark DOLFENAL. It is also likely that the consumers will be led into thinking that there is a connection or affiliation between the parties' respective goods or products, or between the parties themselves, when in fact there is none. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the

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<sup>4</sup> See *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

Supreme Court:<sup>5</sup>

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. Here, 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.

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.<sup>6</sup>

The replacement of the syllable "DOL" in the Opposer's mark with "POR" failed to give the Respondent-Applicant's mark a character that is sufficiently and clearly distinct from the Opposer's. DOLFENAL is a unique mark, in the category of a fanciful mark, such that it is highly improbable for another person to come up with an identical or nearly identical mark for use on the same or related goods purely by coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the answered riddle is why, of the millions of terms and combination of letters and available, the Respondent-Applicant had come up with a mark identical or so clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.<sup>7</sup>

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2008-710018 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and proper action.

SO ORDERED.

Taguig City, 24 April 2012.

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

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<sup>5</sup> See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

<sup>6</sup> See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217.

<sup>7</sup> See *American Wire and Cable Co. v. Director of Patents, et. al* (SCRA 544), G.R. No. L-26557, 18 Feb. 1970.