



WESTMONT PHARMACEUTICALS INC.,
Opposer,

-versus-

GRUPPO MEDICA, INC.,
Respondent-Applicant.

}
} IPC No. 14-2013-00089
} Opposition to:
} Application No. 4-2011-009171
} Date filed: 4 August 2011
} TM: "IMMUNO MAX"
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NOTICE OF DECISION

OCHAVE AND ESCALONA

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CASTILLO LAMAN TAN PANTALEON & SAN JOSE

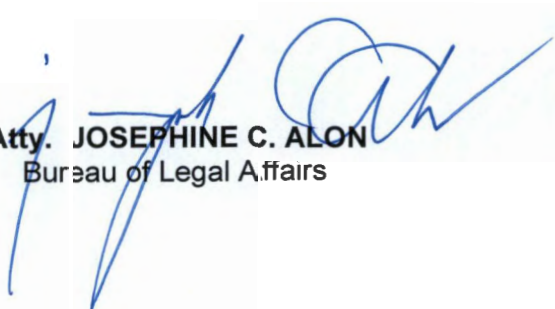
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GREETINGS:

Please be informed that Decision No. 2014 - 167 dated June 25, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 25, 2014.

For the Director:


Atty. JOSEPHINE C. ALON
Bureau of Legal Affairs



WESTMONT PHARMACEUTICALS INC., } IPC NO. 14-2013-00089
Opposer, } Opposition to:
-versus- }
} Appln. Ser. No. 4-2011-009171
} Date Filed: 4 August 2011
} Trademark: IMMUNO MAX
GRUPPO MEDICA, INC., }
Respondent-Applicant. }
x-----x } Decision No. 2014- 167

DECISION

WESTMONT PHARMACEUTICAL INC., (Opposer)¹ filed on 27 February 2013 an opposition to Trademark Application Serial No. 4-2011-009171. The application, filed by GRUPPO MEDICA INC. (Respondent-Applicant)², covers the mark “IMMUNO MAX”, for use on “Immuno-modulating preparation, food supplement, capsules for pharmaceutical purposes, pharmaceutical preparations” under Class 5 and “advertising and promotions” under class 35 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

“1. The mark ‘IMMUNO MAX’ owned by Respondent-Applicant so resembles the mark ‘IMMUNOSIN’ owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark ‘IMMUNOMAX’.

“2. The mark ‘IMMUNO MAX’ will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark ‘IMMUNO MAX’ is applied for the same class and goods as that of Opposer’s trademark ‘IMMUNOSIN’, i.e. Class 05 of the International Classification of Goods for pharmaceutical/medicinal preparation used to improve the immune system.

“3. The registration of the mark ‘IMMUNO MAX’ 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:

¹ A domestic corporation duly organized and existing under Philippine laws with principal address at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines

² A domestic corporation with principal address at 16th Floor, The Paragon Corporate Center, Madrigal Business Park, Alabang, Muntinlupa City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

(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;

Under the above-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.”

The Opposer also alleges, among others, the following facts:

“10.1 Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. The trademark application for the trademark ‘IMMUNOSIN’ was filed with the Bureau of Patents, Trademarks and Technology Transfer on 2 August 1988 by the Opposer’s sister company, General Drug and Chemical Company (“GenDrug”) and was approved for registration in 23 November 1989 to be valid for a period of twenty (20) years or until 23 November 2009.

“10.2. On 18 September 1999, GenDrug assigned the trademark ‘IMMUNOSIN’ to herein Opposer.

“10.3. Prior to the expiration, Opposer filed an application for renewal which was accordingly granted by the IPO to be valid for a period of ten (10) years from 23 November 2009 to 23 November 2019. Thus, the registration of the trademark ‘IMMUNOSIN’ subsists and remains valid to date.

“11. The trademark ‘IMMUNOSIN’ has been extensively used in commerce in the Philippines.

“11.1. Opposer’s sister company, Gen Drug, and Opposer have dutifully filed Affidavit of Use pursuant to the requirement of the law to maintain the registration of the trademark ‘IMMUNOSIN’ in force and effect.

“11.2. A sample product label bearing the trademark ‘IMMUNOSIN’ actually used in commerce is hereto attached and made an integral part hereof as Exhibit ‘H’.

“11.3. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, Opposer registered the product with the Bureau of Food and Drugs (‘BFAD’).

“11.4. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark ‘IMMUNOSIN’ to the exclusion of all others. xxx

“12. The registration of Respondent-Applicant’s mark ‘IMMUNO MAX’ will be contrary to Section 123.1 (d) of the IP Code. ‘IMMUNOMAX is confusingly similar to Opposer’s trademark ‘IMMUNOSIN’.”

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of IPO e-Gazette showing the Respondent-Applicant’s trademark application published for opposition;
2. Copy of Certificate of Registration No. 46980 for the trademark “IMMUNOSIN”;
3. Copy of Deed of Assignment dated 18 September 1999;
4. Copy of Renewal of Registration No. 046980 for the trademark “IMMUNOSIN”;
5. Affidavits of Use filed by GenDrug and Opposer;
6. Sample product label of “IMMUNOSIN”; and
7. Copy of Certificate of Product Registration issued by the Bureau of Food and Drugs dated 5 November 2007⁴

The Respondent-Applicant filed its Answer on 20 May 2013, alleging among other things, the following:

“1. The Respondent-Applicant is primarily engaged in the business of manufacturing and trading in pharmaceutical products and supplements. Gruppo belongs to the Meneses Group of companies which has been in the pharmaceutical, food supplement, cosmetic and veterinary industries for almost 30 years and has offered not only stability but opportunities for growth to its expanding family.

“2. Respondent-Applicant filed an application for registration of the trademark ‘IMMUNO MAX’ on 9 December 2009, bearing Application Serial No. 4-2009-012747 for goods under Nice Classification 5.

“3. Respondent-Applicant’s trademark ‘IMMUNO MAX’ is for the food supplement CM-Glucan, which is *carboxymethyl glucan*. Glucan is a Beta-(1-3)- linked polyglucose of high molecular weight and belongs to the class of substances known today as biological response modifiers. Glucan from baker’s yeast is a very potent stimulator of the immune system by activating macrophages and other cells. Therefore, glucan preparations have been extensively studied in wound healing, infectiology,

⁴ Exhibits “A” to “J” inclusive of sub-markings

and oncology. CM-Glucan is a water-soluble form of glucan which exhibits the same property as *B*-glucan.

“4. CM-Glucan belongs to the family of *B*-glucans. *B*-Glucans is derived from the cell walls of *Saccharomyces cerevisiae*, a baker’s yeast. While glucan from yeast is a very potent simulator of the immune system, it has low solubility that makes it difficult to be absorbed in the digestive tract. Gruppo’s product CM-glucan has undergone carboxymethylation, a Swiss-patented process exclusive to “IMMUNO MAX,” which can easily be absorbed and used by the body. CM-Glucan has the ability to bind with the receptors of the macrophages, activating these along with neutrophils and eosinophils, and other white blood cells to stimulate the immune system, the defense mechanism of our body. CM-Glucan increases phagocytosis, the process by which white blood cells engulf and destroy invading bacteria, virus and fungi. By enhancing phagocytosis, the CM-Glucan also sets off the entire immune system cascade of *B*-lymphocytes, T-lymphocytes and the component system.

“5. CM-Glucan is available with another food supplement comprising of multivitamins and Chlorella Growth Factor (CGF), popularly known as ‘Cherifer.’ Gruppo manufactures the food supplement combination which is popularly known as ‘Cherifer.’ Gruppo manufactures the food supplement in combination which is popularly known as ‘Cherifer IMMUNO MAX’ for kids. ‘Cherifer IMMUNO MAX’ is an innovative health supplement that contains CM-Glucan and Cherifer. Gruppo ingeniously coined the mark ‘IMMUNO MAX’ from the prefix and medical term ‘immuno’ and ‘max’ for maximum or maximal immune protection. It stands for Gruppo’s tagline ‘IMMUNO –protection to the MAX.’

“6. Gruppo’s product ‘IMMUNO MAX’ is not an anti-viral agent. It is a food supplement for which Gruppo has established goodwill. The product ‘Cherifer IMMUNO MAX’ is listed in the Philippine Pharmaceutical Directory 16th Edition 2009/2010, under the Pediatric Vitamins & Minerals. Further, the webpage of MIMS Philippines likewise lists ‘Cherifer IMMUNO MAX’ as one of the known pediatric food supplements available in the Philippines.”

The Respondent-Applicant submitted as evidence, the following:

1. Print-out from websites describing CM-Glucan activities and uses, at:
<http://www.ncbi.nlm.nih.gov/pubmed/3840858>;
<http://www.sciencemag.org/cgi/content/short/199/4335/1340>;
<http://www.ncbi.nlm.nih.gov/pubmed/397198>;
<http://www.ncbi.nlm.nih.gov/pubmed/7656994>;
<http://www.mims.com.ph/Page.aspx?menuid=mng&name=Cherifer+Immunomax+sy&CTRY=PH&brief=false3Description>;
2. Print-out of website explaining medical term “immune” at
http://intermed.ph/cgi-bin/news_updates/news_details.asp?news_id+2;
3. Print-out of IPO electronic library of trademarks of marks with the prefix “immuno”;

4. Print-out of online Medical Dictionary,
<http://medical.yourdictionary.com/immuno>;
5. Print-out of pages 122 of the Philippine Pharmaceutical Directory 18th Edition;
6. Printed copy of http://intermed.ph/images/news/immunomax_1.jpg; and
7. Affidavit of Atty. Aurora M. Hipol

The Preliminary Conference was terminated on 24 September 2014 where the Hearing Officer directed both parties to file their respective position papers. The Opposer and Respondent-Applicant filed their position papers on 22 October 2013 and 7 October 2013, respectively. On 4 April 2014, the Respondent-Applicant filed a Motion to Consolidate the instant case, with IPC No. 12-2010-00100, an opposition to Application Serial No, 4-2011-009171, alleging similarity of the parties and the issues raised therein. The Hearing Officer issued on 16 May 2014, Order No. 2014-653 giving the Opposer time within which to comment on the motion. After the lapse of five days from receipt of the order and there being no comment from the Opposer, the Hearing Officer issued on 23 June 2014, Order No. 2014-791, granting the motion to consolidate. In the meantime, the Bureau rendered on 15 April 2014, a decision on IPC No. 12-2010-00100.

Should the Respondent-Applicant be allowed to register the trademark IMMUNO MAX?

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 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.⁵ 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.

Records show that while at the time Respondent-Applicant applied for registration of the mark "IMMUNO MAX" the Opposer already registered the mark IMMUNOSIN under Certificate of Registration No. 46980. The goods covered by the Opposer's trademark registration are also under Class 05, same as indicated in the Respondent-Applicant's trademark application.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:

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

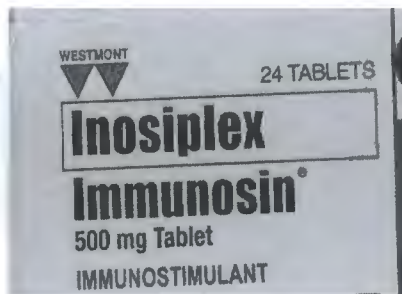
Immunosin

Opposer's mark

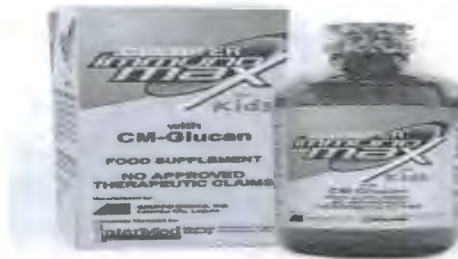


Respondent-Applicant's mark

The marks are similar with respect to the prefix ("IMMUNO"). Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. The Respondent-Applicant points out the existence of several registered trademarks using the prefix immune, namely: IMMUNOCOF, IMMUNOPROTEIN, IMMUNOCAP, IMMUNOCAL, IMMUNOREL, IMMUNOFLU, IMMUNO-ACTIVE, IMMUNO GOLD, IMMUNO BUILDER, IMMUNO-POWER, IMMUNO BOOSTERS, IMMUNO-C.⁶ Admittedly, the Opposer's pharmaceutical product is an anti-viral agent with *inosiplex* as its generic name.⁷ The Opposer's mark IMMUNOSIN is applied to prescription or Rx drugs while the Respondent-Applicant's trademark is applied on non-Rx/food supplements designed as immune booster or immune enhancer. The prefix "IMMUNO" is a medical prefix for immune, immune system or immunology.⁸ The prefix when used as part of a trademark merely connotes and suggests the immune system. Moreover, the suffixes SIN and MAX are phonetically dissimilar. Thus, in combination with the prefix IMMUNO, the resultant marks are visually and aurally different. The contending marks as they appear in their respective labels are shown below:



Opposer's mark



Respondent-Applicant's mark

Considered in their entirety, the marks are dissimilar, and considering further, that the use of the contending marks as health supplement and prescription drug is different, confusion and deception is unlikely.

⁶ Exhibits "7" to "20"
⁷ Exhibit "H"
⁸ Exhibit "21"

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-012747 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 25 June 2014.


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