



WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

BRACCO SUISSE S. A.,
Respondent- Applicant.

}
} **IPC No. 14-2010-00301**
} Opposition to:
} Appln. Serial No. 4-2010-008867
} Date Filed: 12 August 2010
} **TM: "CARDIOTEC"**
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 165 dated June 25, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 25, 2014.

For the Director:


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



WESTMONT PHARMACEUTICALS,
INC.,

Opposer,

- versus -

BRACCO SUISSE S. A.,
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IPC No. 14-2010-00301

Opposition to:

Application No. 4-2010-008867

Date Filed: 12 August 2010

Trademark: CARDIOTEC

Decision No. 2014 - 165

DECISION

WESTMONT PHARMACEUTICALS, INC.¹ ("Opposer") filed on 08 December 2010 a Verified Notice of Opposition to Trademark Application No. 4-2010-008867. The subject application, filed by BRACCO SUISSE S. A.² ("Respondent-Applicant"), covers the mark CARDIOTEC for use on "*pharmaceutical preparations for the treatment of cardiovascular diseases, central nervous system diseases and disorders, hypertension, stroke, cancer, inflammation and inflammatory diseases; pharmaceutical preparations for the prevention and treatment of stroke and ischemia*" under Class 05 of the International Classification of goods³.

The Opposer alleges the following:

"7. The mark CARDIOTEC owned by Respondent-Applicant so resembles the trademark CARDIOSEL owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark CARDIOTEC.

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

"9. The registration of the mark CARDIOTEC 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

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

2 A foreign corporation, with office address at Via Cantonale, Galleria 2, CH-6928 Manno, Switzerland.

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.

(iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion; x x x

"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."

In support of the opposition, the Opposer submitted the following pieces of evidence:

1. Exhibits "A" to "A-1" - Copies of the pertinent pages of the IPO e-Gazette bearing publication date of 08 November 2010;
2. Exhibit "B" - Certified true copy of the Certificate of Registration No. 49298 for the trademark CARDIOSEL;
3. Exhibits "C", "D" and "E" - Copies of the Deed of Assignment;
4. Exhibit "F" - Copy of the Petition for Renewal of Registration filed on 27 October 2010;
5. Exhibits "G", "G-1" to "G-2" - Certified true copies of the Affidavits of Use; and
6. Exhibit "H" - Certification and sales performance dated 23 November 2010.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 24 January 2011. The Respondent-Applicant, however, despite several motions for extension still failed to file its Answer.

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

The Opposer anchored its opposition on Sec. 123.1 (d) of R. A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines, 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:

- (iv) the same goods or services, or
- (v) closely related goods or services, or
- (vi) if it nearly resembles such a mark as to be likely to deceive or cause confusion; x x x

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 12 August 2010, the Opposer's sister company, THERAPHARMA, INC., has already been issued a certificate of registration (No. 49298) for the trademark CARDIOSEL on 30 October 1990. Subsequently, Therapharma, Inc. assigned the trademark CARDIOSEL to herein Opposer by virtue of a Deed of Assignment filed with this Office on 10 December 1990. The Opposer cause the renewal of registration of its mark on 27 October 2010.

Be that as it may, it is unlikely that the coexistence of the marks will cause confusion, much less deception, among the public. The only similarity between the Opposer's CARDIOSEL and Respondent-Applicant's CARDIOTEC is the prefix "CARDIO". In this

regard, since both marks are intended for the treatment of cardiovascular diseases, it can be properly inferred or deduced that the prefix "CARDIO" is derived from the word "cardiovascular". The prefix "CARDIO", therefore, is not really unique if used as a trademark or as part thereof for the subject goods. Indeed, "CARDIO" is clearly suggestive as to the kind of goods a mark with "CARDIO" as a component is attached to hence, a weak mark. The mark itself gives away or tell the consumers the goods or services and/or the kind, nature, use or purpose thereof.

Succinctly, what would make such trademark distinctive are the suffixes or appendages to the prefix "CARDIO" and/or the devices, if any. In this instance, the difference in the last syllable of the marks, namely, "SEL" for Opposer and "TEC" for Respondent-Applicant, makes a fine distinction between the competing marks 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 the word or syllable "CARDIO" since, as we discussed above, "CARDIO" is merely suggestive as to the kind of goods the marks are used.

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.⁴

Moreover, considering that the only similarity between the competing marks is the prefix "CARDIO", sustaining the opposition would have the unintended effect of giving the Opposer the exclusive right to use "CARDIO", which evidently describes the pharmaceutical goods involved. Taking judicial notice of the information in the Trademark Registry, it reveals that there are a number of registered marks with the prefix "CARDIO" for use on goods under Class 05, to cite a few:

1. "CARDIOSIM" (Registration No. 4-2007-006598) for use on "*antihyperlipidemic*";
2. "CARDIOMIN" (Registration No. 4-2002-006447) for use on "*pharmaceutical preparations for the treatment of cardiac disorders*";
3. "CARDIOVIST" (Registration No. 4-2006-003925) for use on "*pharmaceutical preparations namely, contrast media*";
4. "CARDIOFIT" (Registration No. 4-2006-012670) for use on "*pharmaceutical preparations being heart medications; vitamin preparations*";
5. "CARDIOTECH" (Registration No. 4-2010-012872) for use on "*pharmaceutical preparations*";
6. "CARDIOTEN" (Registration No. 4-2006-011849) for use on "*beta adrenoceptor blocker used to treat high blood pressure, congestive heart failure, abnormal heart rhythms and chest pains*"; and
7. "CARDIOVASC" (Registration No. 4-2010-011916) for use on "*pharmaceutical preparation*".

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

WHEREFORE, premises considered, the opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2010-008867 be returned, together with a copy of this Decision, to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 25 June 2014.



Atty. NATHANIEL S. AREVALO

Director IV

Bureau of Legal Affairs