



OFFICE OF THE DIRECTOR GENERAL

GLAXO GROUP LIMITED,
Appellant,

APPEAL NO. 14-2013-0028
IPC No. 14-2012-00484
Opposition to:

-versus-

Application No. 4-2012-007803
Date Filed: 29 June 2012
Trademark: LAMIART

DAEWOONG PHARMA
PHILIPPINES, INC.,
Appellee.

X-----X

NOTICE

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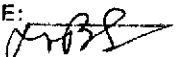
GREETINGS:

Please be informed that on 21 April 2014, the Office of the Director General issued a Decision in this case (copy attached).

Taguig City, 21 April 2014.

Very truly yours,


ROBERT NEREO B. SAMSON
Attorney V


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OFFICE OF THE DIRECTOR GENERAL

GLAXO GROUP LIMITED,
Opposer-Appellant,

Appeal No. 14-2013-0028

-versus-

IPC No. 14-2012-00484

Opposition to:

Application No. 4-2012-007803

Date Filed: 29 June 2012

DAEWOONG PHARMA
PHILIPPINES, INC.,

Respondent-Appellee.

Trademark: LAMIART

x-----x

DECISION

GLAXO GROUP LIMITED (“Appellant”) appeals the decision¹ of the Director of Bureau of Legal Affairs (“Director”) dismissing the Appellant’s opposition to the registration of the mark “LAMIART”.

Records show that DAEWOONG PHARMA PHILIPPINES, INC. (“Appellee”) filed on 29 June 2012 an application to register LAMIART for use on *anticonvulsant pharmaceutical preparation*. On 24 September 2012, the trademark application was published in the Intellectual Property Office Electronics Gazette for Trademark. On 23 November 2012, the Appellant filed an “OPPOSITION” claiming that it will be damaged by the allowance of the application and alleged that it is the owner, first user, original adopter, and registrant of the mark “LAMICTAL” used for *anti-convulsant preparations*.

The Appellant maintained that LAMIART is confusingly similar visually and aurally with LAMICTAL which is a well-known mark registered in countries worldwide. The Appellant averred that the Appellee’s adoption of LAMIART which has the same overall impression as LAMICTAL dilutes the distinctiveness of its mark which it has used in the Philippines since 1994. According to the Appellant, the Appellee’s use and attempted registration of LAMIART is done in bad faith with manifest intent to ride on the popularity and goodwill of LAMICTAL. The Appellant asserted that it has invested heavily in promoting LAMICTAL in the Philippines and worldwide, earning the trademark an international reputation in the pharmaceutical industry.

The Bureau Legal Affairs issued on 08 January 2013 a notice to the Appellee directing the Appellee to file its answer to the opposition. The Appellee did not file an answer and the case was deemed submitted for decision.²



¹ Decision No. 2013-98 dated 05 June 2013.
² Order No. 2013-574 dated 11 April 2013.

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Subsequently, the Director issued the decision holding that the Appellee sufficiently met the requirements of the law in registering LAMIART. The Director held that while the Appellant employs the phrase "ICTAL" after "LAM", the Appellee uses "IART" which is completely distinct. He ruled that even aurally, the two marks are distinguishable and are not pronounced alike and that the Appellant's mark contains three syllables while the Appellee's mark only has two syllables.

Not satisfied with the decision, the Appellant filed on 23 July 2013 an "APPEAL MEMORANDUM" reiterating its arguments in the Bureau of Legal Affairs. The Appellant contends that LAMIART cannot be registered because it nearly resembles the registered and well-known mark LAMICTAL as to likely to deceive or cause confusion. The Appellant argues that LAMIART is visually and aurally similar with LAMICTAL as the Appellee adopted the syllables "LA" and "MI" which are the dominant portion of the Appellant's mark. The Appellant cites another case decided by the Bureau of Legal Affairs that held the mark "LAMITOR" as confusingly similar with LAMICTAL, and that confusion cannot be avoided by merely changing some of the letters of a registered mark.

The Appellant claims that the confusing similarity between LAMICTAL and LAMIART will likely mislead the public into believing that the Appellee's goods originated from the Appellant or conversely, that the Appellant's goods came from the Appellee. The Appellant argues that the Appellee's registration and use of LAMIART will dilute the distinctiveness of LAMICTAL and that the registration of LAMIART amounts to trademark infringement.

This Office issued on 25 July 2013 an Order giving the Appellee thirty (30) days from receipt of the Order to submit comment on the appeal. The Appellee did not file its comment and this case was deemed submitted for decision.

The issue in this appeal is whether the Director was correct in dismissing the Appellant's opposition to the registration of the mark LAMIART in favor of the Appellee. Accordingly, the relevant question in this case is whether LAMICTAL is confusingly similar with LAMIART.

In trademark cases, particularly in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set of rules can be deduced. Each case is decided on its own merits.³ As the likelihood of confusion of goods or business is a relative concept, to be determined only according to the particular, and sometimes peculiar, circumstances of each case,⁴ the complexities attendant to an accurate assessment of likelihood of such confusion requires that the entire panoply of elements constituting the relevant factual landscape be comprehensively examined.⁵

³ Emerald Garment Manufacturing Corporation v. Court of Appeals, 251 SCRA 600 (1995).

⁴ Esso Standard Eastern, Inc. v. Court of Appeals, 116 SCRA 336 (1982).

⁵ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001.

Below are the reproductions of the Appellant's and Appellee's marks:

LAMICTAL

Appellant's mark

LAMIART

Appellee's mark

At a glance, one can see the similarity in these marks which both contain identical first four letters "L", "A", "M", and "I" which can also be interpreted as the first two syllables of these marks, namely "LA" and "MI". While the last parts of these marks contain different letters and are pronounced differently, there is merit to the Appellant's arguments that the variance does not prevent a likelihood of confusion. As pointed out by the Appellant which cited a related case earlier decided by the Bureau of Legal Affairs:

10.6 It is most relevant to cite the case *The Wellcome Foundation Limited v. Torrent Pharma Phils. Inc.*, wherein herein opposer, on the basis of the same mark LAMICTAL, opposed the application for the mark LAMITOR. The Honorable Bureau applied the rule that the use of the same word as the primary element in a trademark is not counteracted by the addition of another term. In rejecting the trademark application for LAMITOR, the Honorable Bureau ruled that confusion cannot be avoided by merely changing some of the letters of a registered mark. Thus in LAMICTAL and LAMITOR, the likelihood of confusion is high as LAMITOR appropriated the dominant portions of Appellant's registered mark.

10.7. Therefore, contrary to the Honorable Bureau's position, it is clear from the foregoing that the minor variance between Appellee's "ART" and Appellant's "CTAL" after the syllables "LA" and "MI", barely makes LAMIART visually distinct from LAMICTAL.⁶

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 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.⁷

Thus, Sec. 123.1(d) of the IP Code, states that a mark cannot be registered if it:



⁶ APPEAL MEMORANDUM dated 23 July 2013, page 12.

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

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- (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;

The Appellant is the registered owner of the mark LAMICTAL which it has used for *anti-convulsant preparations* since 1990 and has registered in several jurisdictions worldwide.⁸ The Appellant, therefore, has the exclusive right to use this mark and is entitled to prevent the Appellee from using a mark which would likely deceive or cause confusion.

In this instance, the way these marks are presented and used for the same pharmaceutical products give the impression that they are owned by the same person. In other words, because of the similarity of these marks, it is not farfetched that one may consider the Appellee's mark as just a variation of the Appellant's mark. The Appellant and the Appellee are members of the pharmaceutical industry and it is not unlikely that the Appellee knew of the Appellant's products which have been in the market earlier than the Appellee's products. In this regard, the statement by the Supreme Court in one case is instructive:

Of course, as in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark.⁹

Significantly, the Appellee's lack of interest in participating in this opposition case betrays the weakness of the Appellee's position to register a confusingly similar mark. The Appellee has "millions of terms and combinations of letters and designs available" to use for its products. The Appellee's attempt to register LAMIART without giving any explanation as to how it arrived in using this mark only shows its intent to take advantage of the reputation generated by LAMICTAL. That the products of the parties are identical or closely related is not disputed. Consequently, not only would there be a likelihood of confusion as to the source or origin of the products covered by the mark LAMIART, it is also likely that the Appellant would be damaged by the continued use by the Appellee of this mark. The Appellant has no control on the quality of *anticonvulsant pharmaceutical preparation* covered by the mark LAMIART and which would be produced by the Appellee.

The allowance for publication of a trademark is only a presumption that the trademark application is compliant with the provisions of the IP Code. When a third party adduced contrary evidence, including evidence that it would be damaged by the registration of such trademark, the applicant must present substantial evidence to the contrary. Otherwise, the presumption is deemed overcome.

⁸ APPEAL MEMORANDUM dated 23 July 2013, page 3.

⁹ American Wire & Cable Company v. Director of Patents, G. R. No. L-26557, 18 February 1970.



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For even under the IP Code, a certificate of registration is only a prima facie evidence of the validity of the registration.¹⁰ Much more so in this case in which the subject matter is still considered a pending trademark application. Under the IP Code, any party who believes that it would be damaged by the registration of the trademark can challenge the application for registration.¹¹ The Appellant has established that it has used LAMICTAL for over two (2) decades now. As the registered owner of this mark, it is entitled to the exclusive right to use it and to prevent other persons from using a trademark that resembles its mark as to be likely to deceive or cause confusion. Being a business competitor, the Appellee's introduction of similar products bearing the confusingly similar mark LAMIART would cause a likelihood of confusion to the buying public. In a contest involving registration of trademarks, the determinative factor is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public.

WHEREFORE, premises considered, the appeal is hereby granted.

Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Legal Affairs for appropriate action. Further, let also the Director of the Bureau of Trademarks and the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this Decision for information, guidance, and records purposes.

SO ORDERED.


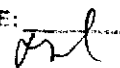
21 APR 2014 Taguig City


RICARDO R. BLANCAFLOR
Director General

¹⁰IP Code Sec. 138.

¹¹Section 134 of the IP Code provides in part that:

SEC. 134. Opposition.- Any person who believes that he would be damaged by the registration of a mark may, upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.2, file with the Office an opposition to the application.


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