MEDICHEM PHARMACEUTICALS, INC., Opposer, **-versus-** **PACIFIC PHARMACEUTICAL GENERICS, INC.,** Respondent- Applicant.	}	**IPC No. 14-2010-00140** Opposition to: Appln. Serial No. 4-2009-004538 Date Filed: 11 May 2009 **TM: "RELIDOL"**

NOTICE OF DECISION

OCHAVE & ESCALONA
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PACIFIC PHARMACEUTICALS GENERICS, INC.
Respondent-Applicant
CNN Generics Distribution Inc.
3rd Floor, LC Building, 459 Quezon Avenue
Quezon City

GREETINGS:

Please be informed that Decision No. 2014 - 217 dated August 22, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 22, 2014.

For the Director:

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

MEDICHEM PHARMACEUTICALS, INC.,	}	**IPC No. 14-2010-00140**
Opposer,	}	Opposition to:
	}	Application No. 4-2009-004538
- versus -	}	Date Filed: 11 May 2009
PACIFIC PHARMACEUTICAL GENERICS, INC.,	}	Trademark: **RELIDOL**
Respondent-Applicant.	}	Decision No. 2014 - 217

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DECISION

MEDICHEM PHARMACEUTICALS, INC.[1] ("Opposer") filed on 12 July 2010 a Verified Notice of Opposition to Trademark Application No. 4-2009-004538. The contested application, filed by PACIFIC PHARMACEUTICAL GENERICS, INC.[2] ("Respondent-Applicant"), covers the mark RELIDOL for use on *"pharmaceutical product namely, opoid analgesic"* under Class 05 of the International Classification of goods[3].

The Opposer alleges, among other things, that:

> "1. The trademark RELIDOL so resembles REXIDOL trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark RELIDOL. The trademark RELIDOL, 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 RELIDOL is applied for the same class of goods as that of trademark REXIDOL, i.e. Class (5), analgesic.
>
> "2. The registration of the RELIDOL 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, 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
> > (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

1 A corporation duly organized and existing under the laws of the Philippines with principal office located at Mandaluyong City.

2 A domestic corporation with principal office address at 3rd Floor LC Building, 459 Quezon Avenue, Quezon City.

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.

or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

"3. Respondent's use and registration of the trademark RELIDOL will diminish the distinctiveness and dilute the goodwill of Opposer's trademark REXIDOL."

The Opposer submitted in evidence the following documentary exhibits:

1. Print-out of "Trademarks Published for Opposition" as published in the IPO e-Gazette dated 11 May 2010;
2. Certified true copies of Certificate of Registration No. 20524 for the trademark REXIDOL;
3. Certified true copies of the Affidavits of Use filed by Opposer involving the trademark REXIDOL;
4. Sample of product label bearing the trademark REXIDOL;
5. Certified true copy of the Certificate of Product Registration issued by the Bureau of Food and Drugs (BFAD); and
6. Copy of the certification and sales performance issued by the Intercontinental Marketing Services (IMS).[4]

This Bureau issued a Notice to Answer dated 27 July 2010 addressed to Danilo M. Talampas Jr., Respondent-Applicant's authorized representative. However, the said notice was not served upon the Respondent-Applicant for reason that Mr. Talampas is no longer connected with the Respondent-Applicant. The Notice to Answer was reissued and served upon the Respondent-Applicant on 04 June 2014. The Respondent-Applicant, however, failed to file its Answer.

The issue, therefore, is whether or not the Respondent-Applicant be allowed to register the trademark RELIDOL.

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, Section 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.

In this regard, the records and evidence show that at the time the Respondent-Applicant filed its trademark application on 11 May 2009, the Opposer has long been issued a certificate of registration (No. 20524) on 08 November 1973 for the trademark REXIDOL. The Opposer's mark is registered under Class 05 as *"a nonsalicylate antipyretic-analgesic for children"*. This good as compared with the Respondent-Applicant's are related being both

4 Exhibits "A" to "L".
5 See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

pharmaceutical products used as analgesic under Class 05.

But do the marks, as shown below, resemble each other that confusion, or even deception, is likely to occur?

REXIDOL	RELIDOL
Opposer's Mark	Respondent-Applicant's Mark

The marks are confusingly similar. They both have the same number of letters and syllables. Except with the third letter "L", all the remaining letters comprising the Respondent-Applicant's mark are exactly the same and arranged the same way as that of the Opposer's. This slight difference or change in the letter did not retract from the finding of confusion in the marks. Indeed, confusion cannot be avoided by merely dropping, adding or changing some of the 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.[6]

Moreover, because of the similarity in the syllables and arrangement of letters, the marks produced the same sound effect when pronounced. The Respondent-Applicant's second syllable /LI/ is hardly distinguishable from Opposer's /XI/ when pronounced altogether. Time and again, the court has taken into account the aural effects of the words and letters contained in the marks in determining the issue of confusing similarity.[7] Thus, in *Marvex Commercial Co., Inc. v. Petra Hawpia & Co., et al*[8]., the Court held:

> The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, Vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jass-Sea"; "Silver Flash" and "Supper Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "Trade-Mark Law and Practice", pp. 419–421, cities, as coming within the purview of the idem sonans rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In Co Tiong vs. Director of Patents, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in Sapolin Co. vs. Balmaceda, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.
>
> In the case at bar, "SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see Celanese Corporation of America vs. E. I. Du Pont, 154 F. 2d. 146, 148)."

6 *Societe Des Produits Nestle S. A. v. Court of Appeals*, G. R. No. 112012, April 4, 2001.
7 *Prosource International Inc. v. Horphag Research Management S. A.*, G. R. No. 180073, 25 November 2009.
8 G. R. No. L-19297, 22 December 1966.

Succinctly, because the Opposer's and Respondent-Applicant's marks both deal with pharmaceutical products intended as analgesics, the changes in the spelling therefore did not diminish the likelihood of the occurrence of mistake, confusion or even deception. As trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.[9] The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:[10]

> 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.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-004538 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 22 August 2014.

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

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9 *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

10 *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987