



**MERCK SHARP & DOHME CORP.,**  
Opposer,

**-versus-**

**SUN PHARMA PHILIPPINES, INC. (PH),**  
Respondent-Applicant.

} **IPC No. 14-2013-00338**  
} Opposition to:  
} Appln No. 4-2013-007318  
} Date filed: 24 June 2013  
} **TM: "TIMODOL"**  
}  
}  
}  
}

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### NOTICE OF DECISION

#### **SANTOS PILAPIL & ASSOCIATES**

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#### **JOECYL P. VALERIO**

Respondent-Applicant's Agent  
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104 H.V. Dela Costa Street  
Salcedo Village, Makati City

#### **GREETINGS:**

Please be informed that Decision No. 2014 - 239 dated October 07, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 07, 2014.

For the Director:

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

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IPC No. 14-2013-00338

Opposition to Trademark  
Application No. 4-2013-007318  
Date Filed: 24 June 2013

Trademark: **"TIMODOL"**  
Decision No. 2014- 239

### DECISION

Merck Sharp & Dohme Corporation<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-007318. The contested application, filed by Sun Pharma Philippines, Inc. (PH)<sup>2</sup> ("Respondent-Applicant"), covers the mark "TIMODOL" for use on "*pharmaceutical preparation*" under Class 05 of the International Classification of Goods<sup>3</sup>.

The Opposer claims to be the creator and owner of the mark "TEMODAL" covered by Registration No. 4-2001-009310 issued on 14 December 2003 for use on "*alkylating cytotoxic agent for the treatment of various types of cancer*". It contends that the mark "TIMODOL" is a colorable imitation of and confusingly similar to "TEMODAL" especially as they will be used on similar or related goods. It avers that the Respondent-Applicant just deleted the two letters in its mark, namely "e" and "a", and replaced them with "i" and "o". It asserts that the general impression is one of similarity as "TIM" and "TEM" sounds almost the same as well as "DOL" and "DAL". It accuses the Respondent-Applicant of riding on the popularity of its mark and fears that the latter will cause dilution of the advertising value and image of its "TEMODAL" mark.

In support of its Opposition, the Opposer submitted the following:

1. four labels/photographs of its mark;
2. certified true copy of Registration No. 4-2001-009310;
3. duplicate original of the 6<sup>th</sup> year Declaration of Actual Use (DAU) filed on 6 March 2009; and
4. sworn statement of Lynn Brumfield.<sup>4</sup>

<sup>1</sup> A foreign company incorporated under the laws of the State of New Jersey, United States of America.

<sup>2</sup> With address at Unit 604, 6<sup>th</sup> Floor, Liberty Center Building, 104 H.V. Dela Costa St., Salcedo Village, Makati City, Philippines.

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

<sup>4</sup> Marked as Exhibits "A" to "F".

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 03 December 2013. However, the Respondent-Applicant failed to file its Answer prompting the Hearing Officer to issue on 21 April 2014 Order No. 2014-507 declaring Respondent-Applicant in default and the case deemed submitted for resolution.

The issue to be resolved is whether Respondent-Applicant's mark "TIMODAL" may be allowed registration.

In this regard, Section 123.1 (d) of Republic At No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

**"123.1. 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; xxx"**

Records reveal that at the time Respondent-Applicant filed an application for registration of its mark "TIMODAL" on 24 June 2013, the Opposer has a valid and existing registration of the mark "TEMODAL" under Certificate of Registration No. 4-200-009310 issued on 14 December 2003.

In this regard, the marks of the parties are depicted for comparison:

**TEMODAL**

*Opposer's mark*

**TIMODOL**

*Respondent-Applicant's mark*

The marks differ from each other only in respect to the second and sixth letters. The commonality between them, the letters "T", "M", "O", "D" and "L", however, makes the mark applied for registration by the Respondent-Applicant in close resemblance to the Opposer's mark. Not only does "TIMODOL" look like "TEMODAL", the sound created in pronouncing it is very hard to distinguish from that of "TEMODAL". 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 purchased as to cause him to purchase the one supposing it to be the other.<sup>5</sup> According to the Supreme

<sup>5</sup> Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

Court in **Marvex Commercial Co., Inc. vs. Petra Hawpia**<sup>6</sup>, similarity of sound is sufficient ground for the Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties. In this case, as the Respondent-Applicant broadly indicates that it uses or intends to use its applied mark on "*pharmaceutical preparation*", this means that it may also cover cancer medications that are indicated in the Opposer's registration or for goods that are similar or related thereto. Time and again, the courts have taken into account the aural effects of the words and letters in determining the issue of confusing similarity. Thus, in the same Marvex case<sup>7</sup>, the Supreme 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 'Jazz-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 'TradeMark Law and Practice', pp. 419-421, cites, 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."*

Furthermore, settled is that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."<sup>8</sup> Thus, even assuming that consumers takes extra caution in buying pharmaceutical products as not to confuse one for the other, there is still possibility of deception such that they may be led to believe that both goods originate from the same source.

Finally, 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

<sup>6</sup> G.R. No. L-19297, 22 December 1966.

<sup>7</sup> Ibid.

<sup>8</sup> Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

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>9</sup> Respondent-Applicant's mark failed to meet this function.

Accordingly, this Bureau finds and concludes 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. 4-2013-003718 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 07 October 2014.

  
**ATTY. NATHANIEL S. AREVALO**  
Director IV  
Bureau of Legal Affairs

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<sup>9</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.