



PHARMAHEX, INC.,
Opposer,

-versus-

BELMAN COMPANIA INCORPORADA
DOING BUSINESS UNDER THE NAME &
STYLE "BELMAN LABORATORIES",
Respondent- Applicant.

}
} **IPC No. 14-2013-00390**
} Opposition to:
} Appln. Serial No. 4-2013-004642
} Date Filed: 23 April 2013
} **TM: "ORAHORB"**
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 225 dated September 16, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 16, 2014.

For the Director:


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



PHARMAHEX, INC,

Opposer,

IPC No. 14-2013-00390

Opposition to Trademark

-versus-

Application No. 4-2013-00004642

Date Filed: 23 April 2013

**BELMAN COMPANIA INCORPORADA
DOING BUSINESS UNDER THE NAME &
STYLE "BELMAN LABORATORIES",**

Trademark: **"ORAHORB"**

Respondent-Applicant.

x ----- x Decision No. 2014- 225

DECISION

Pharmahex, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-00004642. The contested application, filed by Belman Compania Incorporada doing business under the name and style "Belman Laboratories"² ("Respondent-Applicant"), covers the mark "ORAHORB" for use on "mouthwash" under Class 03 of the International Classification of Goods³.

The Opposer anchors its opposition on the provision of Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines (IP Code). It contends that Respondent-Applicant's mark "ORAHORB" and its own mark "ORAHORB" have aural/phonetic and visual similarities. Also, it believes that the confusion is even more likely as the goods are in direct competition and are sold along the same distribution channels. It avers that the mark "ORAHORB" can be broken down into "ORA" and "HEX". The word "ORA" is another term for mouth or a mouth-like opening while "HEX" is a shortened version of "chlorhexidine digluconate", the active ingredient of its product.

According to the Opposer, in 1995, Dr. Rannier Reyes and Dr. Bo Danielson jointly developed a formulation that uses chlorhexidine digluconate as its active ingredient, which is considered as the gold standard for active ingredients in mouthwashes in Europe but not yet available in the Philippines. It sought registration of the mark "ORAHORB" in 1996. Then in 2006, it reapplied for registration and was issued Certificate of Registration No. 4-2006-500110. It claims that its initial target customers were dental practitioners but starting 2002, its products were made available in drugstores and pharmacies.

In support its Opposition, the Opposer submitted the following as evidence:

1 A corporation duly organized and existing under the laws of the Republic of the Philippines with office address at J.A. Development Compound, No. 7 E. Rodriguez Jr. Avenue, Barangay Bagong Ilog, Pasig City, Metro Manila.

2 A domestic corporation with principal place of business at Belman, Building, 78 Cordillera St., corner Quezon Avenue, Quezon City.

3 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.

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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1. certified true copy of Trademark Registration No. 4-2006-500110;
2. certified true copy of Trademark Registration No. 4-2013-00004642;
3. printout from the IPO database with File No. 4-1996-107600;
4. certified true copy of Certificate of Registration No. 4-2006-500110;
5. list of clients and customers;
6. copy of the sales data; and
7. copy of the featured magazine article.⁴

For its part, Respondent-Applicant states that its company started in 1937 and steadily grew to become one of the trusted names in the Philippine pharmaceutical and chemical distribution company. It allegedly formulated its "ORAHORB" products in 2009, which was first available in supermarkets such as Pioneer Centre, Shoppersville and Sta. Lucia East and later on in Mercury Drugstores nationwide. It claims that the products are currently available in drugstores, groceries, convenience stores, pharmacies and supermarkets.

The Respondent-Applicant denies that its mark is confusingly similar with "ORAHORB" as they are different in colors, presentation and even in packaging. It also insists that the marks differently pronounced. Moreover, it argues that there are many trademark owners who use "ORA" in their marks for mouthwash and the products are placed near or beside each other on the market shelves. It furthers that simply because the words "herb" and "hex" have the same two letters warrant a conclusion that they are confusingly alike. It contends that the term "herb" connotes that "ORAHORB" is an herbal remedy or medicinal preparation and that its label even contains the tagline "Our daily Oral Care With Power of Herbs". It therefore asserts that consumers can surely differential and herbal mouthwash from a chemical rinse.

The Respondent-Applicant's evidence consists of the following:

1. partial list of drugstores, supermarkets, secondary and tertiary outlets nationwide where "ORAHORB" products are sold;
2. print advertisements appearing in The Philippine Star, Enrich Healthy Lifestyle & Living and Woman Today;
3. cd containing radio advertisements of "ORAHORB" and a written transcription thereof; and
4. cd containing the television commercials for "ORAHORB" and the frame by frame printout or storyboard.⁵

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. The parties, however, refused to mediate. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on

⁴ Marked as Exhibits "B" to "G".

⁵ Marked as Exhibits "1" to "10", inclusive.

27 March 2014. The parties were directed to submit their respective position papers. After which, the case is deemed submitted for decision.

The primordial issue in this case is whether the trademark "ORAHERB" should be allowed.

As culled from available records, the Bureau notes that the Opposer filed an application for the registration of the mark "ORAHEX" as early as 30 May 2006 and eventually allowed registration on 28 November 2008. On the other hand, the Respondent-Applicant only filed its application for registration of its mark "ORAHERC" on 23 April 201.

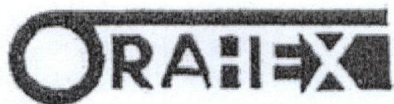
Section 123.1(d) of the IP Code, relied upon by Opposer, provides that:

"Section 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 x x x"***

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown below for comparison:

The image shows the logo for "ORAHEX". The word "ORAHEX" is written in a bold, sans-serif font. The letter "O" is significantly larger than the other letters and is enclosed within a thick, dark horizontal bar that extends to the right, partially overlapping the "R".

Opposer's mark

The image shows the word "ORAHERB" in a simple, bold, sans-serif font.

Respondent-Applicant's mark

Upon observation of the subject trademarks, it can be readily gleaned that the manifest similarity that can be observed is the prefix "ORA". In this regard, the Opposer itself admits that the said term connotes mouth or a mouth-like opening. It is noteworthy that both Opposer's and Respondent-Applicant's trademarks pertain to goods which are oral rinses or mouthwashes. A trademark which appropriates the prefix "ORA" and is used on this line of products is a suggestive mark; therefore, a weak mark. A mark or brand name itself gives away or tells the consumers the goods or service and/or the kind, nature, use or purpose thereof.

What easily comes to the mind one when one sees or hears a mark or brand name of oral antiseptics of which the prefix "ORA" is a part of is the very concept or idea of the goods. What will set apart or distinguish such mark from another which also includes the same prefix on oral antiseptics are the letters that comes after "ORA". In this case, it will be highly unlikely that the consumers will be misled, confused or deceived that the Respondent-Applicant's goods came from or are connected to or associated with that of the Opposer's. The Opposer's mark uses "HEX", which according to it has been derived from the active ingredient of its products chlorhexidine digluconate. On the other hand, the word "HERB" follows the prefix "ORA" in Respondent-Applicant's mark. The words "HEX" and "HERB" are easily distinguishable in view of their clear and obvious differences in spelling, pronunciation and meaning.

While the combination of the words "ORA" and "HEX" may have resulted in a mark that possesses distinctive quality which rendered it registrable, such mark is only considered a suggestive mark. It is a weak mark if ranged against another mark which, while bearing some resemblance, is endowed with other characteristics and features capable of distinguishing the same.

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 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.⁶ This Bureau finds that Respondent-Applicant's trademark fell short in meeting this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-00004642 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 September 2014.


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

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.