



OFFICE OF THE DIRECTOR GENERAL

THERAPHARMA, INC.,  
Opposer-Appellant,

-versus-

NOVARTIS AG,  
Respondent-Appellee.

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Appeal No. 14-2013-0055

IPC No. 14-2009-00224

Opposition to:

Application No. 4-2009-000547

Date Filed: 16 January 2009

Trademark: KOGREL

DECISION

THERAPHARMA, INC. (“Appellant”) appeals the decision<sup>1</sup> of the Director of Bureau of Legal Affairs (“Director”) which dismissed the Appellant’s opposition to the registration of the mark “KOGREL”.

NOVARTIS AG (“Appellee”) filed on 16 January 2009 Trademark Application No. 4-2009-000547 for KOGREL for use on pharmaceutical preparations, namely platelet aggregation inhibitors; dietetic substance adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, and dental wax. On 15 June 2009, the trademark application was published for opposition in the Intellectual Property Office Electronics Gazette for Trademarks. Subsequently, the Appellant filed on 14 September 2009 a “VERIFIED NOTICE OF OPPOSITION” alleging that it will be extremely damaged and prejudiced by the registration of KOGREL.

The Appellant claimed that it is engaged in the marketing and sale of a wide range of pharmaceutical products and is the registered owner of the mark “PLOGREL” that is used for *antiplatelet drug for the prevention of stroke and heart attack*. The Appellant maintained that KOGREL so resembles PLOGREL which will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that KOGREL is applied for the same class and goods as PLOGREL. The registration of KOGREL will violate the provision of the Intellectual Property Code of the Philippines (“IP Code”) that prohibits the registration of any mark which is similar to a registered mark in respect of similar or related goods. The Appellant asserted that as the lawful owner of PLOGREL it has the exclusive right to use and/or appropriate this mark and prevent all third parties not having its consent from using in the course of trade identical or similar marks where such would result in a likelihood of confusion.

<sup>1</sup> Decision No. 2013-207 dated 24 October 2013.

The Appellee filed on 05 January 2010 a “VERIFIED ANSWER” alleging that the registration of KOGREL will not violate the provisions of the IP Code. The Appellee maintained that KOGREL is not confusingly similar with PLOGREL as the first syllables of these marks are unique and distinct and only their last syllables are the same. The Appellee averred that these marks cover pharmaceutical preparations and it is settled that purchasers are known to be more wary of the nature of the goods when what they are buying are medicines, and therefore, the likelihood of confusion as to the medicine bought that may arise from the use thereon of similar marks is remote. The Appellee claimed that it has registered KOGREL in India as early as 29 April 2003 long before the Appellant filed its trademark application for PLOGREL.

After the appropriate proceedings, the Director issued a decision holding that KOGREL sufficiently meets the function of a trademark and that the differences between this mark and PLOGREL subdue a likelihood of confusion and deception. The Director ruled that KOGREL and PLOGREL have common suffix – “grel” and that there is sufficient reason to infer that these marks were coined out of the generic name “*clopidogrel*”. According to the Director, these marks are suggestive that they give away or tell the consumers what the goods are, and/or the kind, nature, use or purpose thereof.

On 09 December 2013, the Appellant filed an “APPEAL MEMORANDUM [Re: Decision No. 2013-207 dated 24 October 2013]” assigning the following error:

#### V. ASSIGNMENT OF ERROR

THE RULING OF THE HONORABLE BUREAU OF LEGAL AFFAIRS IN THE QUESTIONED DECISION THAT THERE IS NO CONFUSING SIMILARITY BETWEEN THE OPPOSER-APPELLANT’S TRADEMARK “PLOGREL” AND RESPONDENT-APPELLEE’S MARK “KOGREL” IS CONTRARY TO LAW AND SETTLED JURISPRUDENCE.

The Appellant reiterates its argument that KOGREL is confusingly similar with PLOGREL. The Appellant maintains that the Bureau of Legal Affairs cannot isolate the suffix “GREL” and solely use the same as reference in determining whether or not the marks are confusingly similar. According to the Appellant, PLOGREL is a coined mark and the Bureau of Legal Affairs should have compared this mark in its entirety against KOGREL.

The Appellee filed a “COMMENT (on Appellant’s Appeal Memorandum Dated 09 December 2013)” maintaining that the Bureau of Legal Affairs correctly ruled that KOGREL is not confusingly similar to PLOGREL. The Appellee claims that it is considered a world leader in providing medicines to protect health, prevent and treat diseases, and to improve well-being. According to the Appellee, it has received numerous awards for progress in research and development and for its corporate responsibility activities which indicate its prominence and success and, therefore, it has no need to ride upon the goodwill or reputation of another entity.

This Office referred this case to the IPOPHL Alternative Dispute Resolution (ADR) Services pursuant to Office Order No. 154, Series of 2010, Rules of Procedure for IPO Mediation Proceedings. Subsequently, on 24 July 2014, this Office received a notice from the IPOPHL ADR Services that the parties were not successful in settling the dispute through mediation.

The main issue in this case is whether the Director was correct in dismissing the Appellant's opposition to the registration of KOGREL in favor of the Appellee. Moreover, the relevant question in this appeal is whether KOGREL is confusingly similar to PLOGREL.

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.<sup>2</sup> 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,<sup>3</sup> 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.<sup>4</sup>

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

**Plogrel**

*Appellant's mark*

**KOGREL**

*Appellee's mark*

PLOGREL and KOGREL are both word marks with similar last syllable containing the letters "g", "r", "e", and "l" or "grel". However, they have different first syllable with the Appellant's mark consisting of the three letters "p", "l", and "o" or "plo" while the Appellee's mark consists of the two letters "k" and "o" or "ko". In this regard, this difference in the first syllable is enough to distinguish these two word marks. As correctly discussed by the Director:

Thus the issue of whether the competing marks are confusingly similar is to be determined by the other components thereof. This Bureau finds that the differences between the marks with respect to the letters preceding the suffix "grel" are sufficient to subdue a likelihood of confusion, much less deception. One can easily see, and remember, the contrasts between the lines, strokes, and configuration of the letters "P" and "L" in the Opposer's mark, and of the letter "K" in the

<sup>2</sup> Emerald Garment Manufacturing Corporation v. Court of Appeals, 251 SCRA 600 (1995).

<sup>3</sup> Esso Standard Eastern, Inc. v. Court of Appeals, 116 SCRA 336 (1982).

<sup>4</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001.

Respondent-Applicant's. The visual difference is amplified by the fact that the letters comprising each of the competing marks are presented in different font styles and cases. Also, uttering a syllable that starts with the letter "P" requires the upper lip to come into contact with lower lip. This is not the case in respect of the letter "K". Hence, the sound produced by the syllables "PLO" is clearly discernible from that of when uttering the syllable "KO".<sup>5</sup>

In addition, the products covered by PLOGREL and KOGREL include pharmaceutical products which are not the everyday common goods or household items bought at a minimal cost. These products especially the medicines require a prospective buyer to be more aware and cautious in the purchase of the product. The purchasing public is the ordinary purchaser that is thought of, as having, and credited with, at least a modicum of intelligence.<sup>6</sup> It does not defy common sense to assert that a purchaser would be cognizant of the product he is buying.<sup>7</sup> As a general rule, an ordinary buyer does not exercise as much prudence in buying an article for which he pays a few centavos as he does in purchasing a more valuable thing. Expensive and valuable items are normally bought only after deliberate, comparative and analytical investigation.<sup>8</sup> Hence, a person who would buy the Appellant's or Appellee's products would do so not on the basis of the mistaken belief that the product is that of the Appellant's or Appellee's but because that is the product the person intends to buy.

In the related case of *Etepha, A. G. vs. Director of Patents and Westmont Pharmaceutical, Inc.*<sup>9</sup>, the Supreme Court of the Philippines held that:

6. In the solution of a trademark infringement problem, regard too should be given to the class of persons who buy the particular product and the circumstances ordinarily attendant to its acquisition. The medicinal preparations, clothed with the trademarks in question, are unlike articles of everyday use such as candies, ice cream, milk, soft drinks and the like which may be freely obtained by anyone, anytime, anywhere. Petitioner's and respondent's products are to be dispensed upon medical prescription. The respective labels say so. An intending buyer must have to go first to a licensed doctor of medicine: he receives instructions as to what to purchase; he reads the doctor's prescription; he knows what he is to buy. He is not of the incautious, unwary, unobservant or unsuspecting type; he examines the product sold to him; he checks to find out whether it conforms to the medical prescription. The common trade channel is the pharmacy or the drugstore. Similarly, the pharmacist or druggist verifies the medicine sold. The margin of error in the acquisition of one for the other is quite remote.

Accordingly, under the circumstances of this case, the Appellee's use and registration of KOGREL will not likely cause confusion or deception.

Wherefore, premises considered, the appeal is hereby dismissed. Let a copy of this Decision be furnished to the Director of Bureau of Legal Affairs and the

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<sup>5</sup> Decision No. 2013-207 dated 24 October 2013, page 10.

<sup>6</sup> *Fruit of the Loom, Inc. v. Court of Appeals and General Garments Corporation*, G.R. No. L-32747, 29 November 1984.

<sup>7</sup> *Acoje Mining Co., Inc. v. Director of Patents*, 38 SCRA 480 (1971).

<sup>8</sup> *Del Monte Corporation v. Court of Appeals*, G.R. No. 78325, 25 January 1990.

<sup>9</sup> G. R. No. L-20635, 31 March 1966.

Director of Bureau of Trademarks for their appropriate action and information. Further, let a copy of this Decision be furnished to the library of the Documentation, Information and Technology Transfer Bureau for records purposes.

SO ORDERED.

03 NOV 2014 , Taguig City.



RICARDO R. BLANCAFLOR  
Director General