



THERAPHARMA, INC.,
Opposer,

-versus-

THE GENERICS PHARMACY, INC.,
Respondent- Applicant.

}
} IPC No. 14-2011-00423
} Opposition to:
} Appln. Serial No. 4-2011-000680
} Date Filed: 21 January 2011
} TM: "HEMOXAN"
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NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for Opposer
66 United Street
Mandaluyong City

THE GENERICS PHARMACY, INC.
For the Respondent-Applicant
67 Scout Fuentebella Street
Tomas Morato, Quezon City

GREETINGS:

Please be informed that Decision No. 2014 - 199 dated August 01, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 01, 2014.

For the Director:

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



THERAPHARMA, INC.,
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THE GENERICS PHARMACY, INC.,
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IPC No. 14-2011-00423
Opposition to:

Appln. Serial No. 4-2011-000680
Date Filed : 21 January 2011
Trademark: **"HEMOXAN"**

Decision No. 2014 - 199

DECISION

THERAPHARMA, INC., ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2011-000680. The application, filed by THE GENERICS PHARMACY, INC., (Respondent-Applicant)², covers the mark "HEMOXAN" for use on "pharmaceutical product categorized as antifibrinolytics"³.

The Opposer alleged:

"1. The trademark 'HEMOXAN' so resembles 'HEMOSTAN' trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark 'HEMOXAN'. The trademark 'HEMOXAN', 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 'HEMOXAN' is applied for the same class of goods as that of trademark 'HEMOSTAN', i.e. Class (5); for treatment of bleeding.

"2. The registration of the trademark 'HEMOXAN' in the name of the Respondent will violate Section 123 of Republic Act No. 8293, otherwise known as the 'Intellectual Property Code of the Philippines', 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 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 'HEMOXAN' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'HEMOSTAN'.

"4. Opposer, the registered owner of the trademark 'HEMOSTAN', is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'HEMOSTAN' was filed with the Philippine Patent Office on 8 August 1969 by Opposer and was approved for registration by this Honorable Office on 18 October 1971 and valid for a period of twenty (20) years. Prior to expiration, Opposer applied for a renewal of its registration which was approved and valid for another twenty years effective 18 October 2011.

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at 3rd Floor, Bonaventure Plaza, Ortigas Ave., Greenhills, San Juan City.

² A domestic corporation with principal office address at 459 Quezon Ave., Quezon City.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a Multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

"5. The trademark 'HEMSOTAN' has been extensively used in commerce in the Philippines.

x x x

"6. There is no doubt that by virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark 'HEMOSTAN' for almost forty (40) years, and the fact that they are well known among consumers, the Opposer has acquired an exclusive ownership over the 'HEMOSTAN' mark to the exclusion of all others.

"7. 'HEMOXAN' is confusingly similar to 'HEMOSTAN'.

x x x

"8. Moreover, Opposer's intellectual property right over its trademark is protected under Section 147 of Republic Act No. 8293, otherwise known as the Philippine Intellectual Property Code ('IP Code'), x x x.

"9. To allow Respondent to continue to market its products bearing the 'HEMOXAN' mark undermines Opposer's right to the mark. As the lawful owner of the mark 'HEMOSTAN', Opposer is entitled to prevent the Respondent from using a confusingly similar mark in the course of trade where such would likely mislead the public.

x x x

"10. By virtue of Opposer's prior and continued use of the trademark 'HEMOSTAN', the same have become well-known and established valuable goodwill to the consumers and the general public as well. The registration and use of Respondent's confusingly similar trademark on its goods will enable the latter to obtain benefit from Opposer's reputation, goodwill and advertising and will tend to deceive and/or confuse the public into believing that Respondent is in any way connected with the Opposer.

"11. Likewise, the fact that Respondent seeks to have its mark 'HEMOXAN' registered in the same class (Nice Classification 5) as the trademark 'HEMOSTAN' of Opposer plus the fact that both are medicinal preparation for treatment of bleeding will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

The Opposer's evidence consists of the following

1. Exhibit "A" - IPO E-Gazette officially released on 15 August 2011;
2. Exhibit "B" - Certificate of Registration for the trademark HEMOSTAN;
3. Exhibit "C" - Affidavit of Use for 15th Anniversary for the trademark HEMOSTAN;
4. Exhibit "D" - Affidavit of Use for 5th Anniversary for the trademark HEMOSTAN;
5. Exhibit "E" & "F" - Affidavits of Use/Non-Use; and,
6. Exhibit "G" - Certificate of Product Registration.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 10 October 2011. Respondent-Applicant however, did not file an answer. Thus, this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark HEMOXAN?

The instant opposition is anchored on Section 123.1 paragraph (d) of the IP Code which 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 mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 21 January 2011, the Opposer was issued Registration Certificate No. 16926 for HEMOSTAN on 18 October 1971.⁴ It was renewed and the registration remains active.⁵ The registration covers 'pharmaceutical product categorized as antifibrinolytics under class 5.⁶ Hence, the competing marks are used on similar and related goods.

The competing marks are reproduced as follows:

HEMOSTAN

Opposer's mark

HEMOXAN

Respondent-Applicant's mark

Both marks start with the prefix or term "HEMO". "HEMO" is a Latin prefix which pertains to blood.⁷ It appears that the word HEMO, taken singly or in combining form is a suggestive mark, and is therefore a weak mark. It gives away or tells the consumers the goods or services, and/or the kind, nature, use and purpose of the medicine which has relation to the treatment of any blood illness.

This Bureau takes cognizance via judicial notice of the Trademark Registry which shows that HEMO is commonly used as a prefix or component of trademarks used on pharmaceutical products on blood related illness. Among which are: HEMOTREX (Registration No. 42006008550); HEMOBION (Registration No. 42005004113); HEMOXID (Registration No. 42008009863); and HEMOKINE (Registration No. 41995102481)⁸.

Succinctly, what will set apart or distinguish two trademarks that both contain the prefix HEMO and used on similar goods are letters and/or syllables that follow or accompany the said affix trademarks. In this instant case, Respondent-Applicant's mark ends with the syllable "XAN"; whereas Opposer's mark ends with "STAN". The letter "X" in "XAN" and the letters "S" and "T" in "STAN" produced a

⁴ Exhibit "B" of Opposer.

⁵ Trademark Database available at <http://www.wipo.int/branddb/ph/en/> (last accessed 31 July 2014).

⁶ File wrapper records.

⁷ The Free Dictionary by Farlex, available at <http://www.thefreedictionary.com/hemo-> citing McGraw-Hill Concise Dictionary of Modern Medicine, 2002 by The McGraw-Hill Companies, Inc. (last accessed 01 August 2014).

⁸ IPOPHL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 32 July 2014).

comparatively relative sound. The ending letters in both syllables, consisting of "A" and "N" create visual and aural similarity since they are identical letters, and the sound is very similar when pronounced. Under the idem sonans rule, two trademarks used on identical or related goods may be confusingly similar if they have similar sound or pronunciation.⁹

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 purchaser as to cause him to purchase the one supposing it to be the other.¹⁰ Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.¹¹

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.¹² 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:¹³

Callman notes two types of confusion. The first is the confusion of goods in which even 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. Hence, 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.

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 or 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.¹⁴ The trademark applied for registration by the Respondent-Applicant does not meet this function.

⁹ Sapolin Co. vs. Balmaceda, 67 Phil. 795 (1939).

¹⁰ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

¹¹ Emerald Garment Manufacturing Corp. V. Court of Appeals, G.R. No. 100098, 29 December 1995.

¹² American Wire and Cable Co. v. Director of Patents, et al., (31 SCRA 544) G.R. No. L-26557, 18 February 1970.

¹³ Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.

¹⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-000680 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 01 August 2014.


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