



OFFICE OF THE DIRECTOR GENERAL

UNITED AMERICAN  
PHARMACEUTICALS, INC.,  
Opposer-Appellant,

APPEAL NO. 14-2012-0003  
IPC No. 14-2010-00034

Opposition to Trademark  
Application No. 4-2009-007469

-versus-

YSS LABORATORIES CO., INC.,  
Respondent-Appellee.

Date Filed: 27 July 2009  
Trademark: ALERGIN

X-----X

NOTICE

OCHAVE & ESCALONA  
Counsel for Appellant  
No. 66 United Street  
Mandaluyong City

LENY B. RAZ  
Director, Bureau of Trademarks  
Intellectual Property Office  
Taguig City

JIMENEZ GONZALES BELLO VALDEZ  
CALUYA and FERNANDEZ  
Counsel for Appellee  
6<sup>th</sup> Floor, SOL Building,  
112 Amorsolo St., Legaspi Village,  
Makati City

IPOPHL LIBRARY  
Documentation, Information  
and Technology Transfer Bureau  
Intellectual Property Office  
Taguig City

NATHANIEL S. AREVALO  
Director, Bureau of Legal Affairs  
Intellectual Property Office  
Taguig City

GREETINGS:

Please be informed that on 22 April 2014, the Office of the Director General issued a Decision in this case (copy attached).

Taguig City, 22 April 2014.

Very truly yours,

*Robert Nereo B. Samson*  
ROBERT NEREO B. SAMSON  
Attorney V

  
CERTIFIED TRUE COPY  
DATE: *Jul*  
ROBERT NEREO B. SAMSON  
ATTORNEY V  
Office of the Director General

Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE  
Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center  
Fort Bonifacio, Taguig City 1634 Philippines  
T: +632-2386300 • F: +632-5539480 • www.ipophil.gov.ph

*4/25/2014*



OFFICE OF THE DIRECTOR GENERAL

UNITED AMERICAN  
PHARMACEUTICALS, INC.,  
Opposer-Appellant,

Appeal No. 14-2012-0003

-versus-

Inter Partes Case No. 14-2010-00034  
Opposition to:  
Application No. 4-2009-007469  
Date Filed: 27 July 2009

YSS LABORATORIES CO., INC.,  
Respondent-Appellee.

Trademark: ALERGIN

x-----x

DECISION

UNITED AMERICAN PHARMACEUTICALS, INC. ("Appellant") appeals the decision of the Director of the Bureau of Legal Affairs ("Director") dismissing the Appellant's opposition to the registration of the mark "ALERGIN".

Records show that YSS LABORATORIES CO., INC. ("Appellee") filed on 27 July 2009 Trademark Application No. 4-2009-007469 for ALERGIN for use on *antihistamine* which was published in the Intellectual Property Office Electronics Gazette for Trademarks on 01 December 2009. On 01 February 2010, the Appellant filed a "VERIFIED OPPOSITION" claiming that it will be damaged by the registration of ALERGIN and alleging that:

1. It is engaged in the marketing and sale of a wide range of pharmaceutical products and is the registered owner of the mark "ALLERIN";
2. It has extensively used in commerce in the Philippines ALLERIN and has dutifully filed affidavits of use to maintain the registration of this mark;
3. In order to legally market, distribute, and sell pharmaceutical preparations in the Philippines, it registered its products with the Bureau of Food and Drugs (BFAD); the BFAD issued a certificate of registration for ALLERIN;
4. It has acquired exclusive ownership over ALLERIN because of its uninterrupted use of this mark; ALLERIN is well-known among consumers as well as to internationally known pharmaceutical information provider;



CERTIFIED TRUE COPY  
DATE: \_\_\_\_\_

ROBERT NEREO B. SAMSON  
ATTORNEY V  
Office of the Director General

5. ALERGIN so resembles ALLERIN which will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that ALERGIN is applied for the same class of goods as ALLERIN, i.e. antihistaminic preparation;
6. The registration of ALERGIN will violate Sec. 123 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code") which provides that 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; and
7. The Appellee's use and registration of ALERGIN will diminish the distinctiveness and dilute the goodwill of ALLERIN.

The Appellee filed on 18 June 2010 an answer to the opposition alleging the following:

1. ALERGIN is not confusingly similar with ALLERIN and that by just looking at the images, it is readily noticeable that the respective packaging for ALERGIN and ALLERIN use different color schemes; ALERGIN uses a color scheme of aquamarine, light blue, and white while ALLERIN's syrup packaging employs a color scheme of blue and yellow and ALLERIN's softgel capsule's packaging uses a gradient color scheme combining blue and white;
2. The names of the manufacturers and the logo for ALERGIN and ALLERIN are easily seen on all packages which will show that ALERGIN is not a product of the Appellant and would alert the buying public the products of the Appellant and the Appellee;
3. ALERGIN is a prescription drug which will only be dispensed by licensed pharmacists upon the presentation of a prescription from licensed physicians; and
4. The Bureau of Trademarks affirmed the registrability of ALERGIN when it allowed the trademark application after examination and without citing the Appellant's mark as an obstacle to the registration.

After the appropriate proceeding, the Director ruled that ALERGIN and ALLERIN are not confusingly similar. According to the Director, confusion or deception is unlikely and that consumers can easily distinguish one mark from the other. The Director noted that the pharmaceutical product covered by the Appellee's application may be dispensed only through doctor's prescription.



CERTIFIED TRUE COPY  
DATE: *[Signature]*

ROBERT NEREO B. SAMSON  
ATTORNEY V  
Office of the Director General

On 07 March 2012, the Appellant filed an "APPEAL MEMORANDUM" contending that ALERGIN is confusingly similar to ALLERIN and that the Director gravely erred in ruling that there can be no confusion because the Appellee's mark can be dispensed only by prescription.

The Appellee filed on 20 April 2012 a "COMMENT (ON OPPOSER-APPELLANT'S APPEAL MEMORANDUM DATED 06 MARCH 2012)" maintaining that there is no confusing similarity between ALERGIN and ALLERIN and that the Director did not commit grave error in ruling that dispensation of ALERGIN through a prescription negates confusion.

The issue in this appeal is whether the Director was correct in dismissing the Appellant's opposition and in ruling that ALERGIN is not confusingly similar with ALLERIN.

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>1</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>2</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>3</sup>

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



*Appellant's mark*

**ALERGIN**

*Appellee's mark*

As can be gleaned above, the competing marks are both word marks which have the same first two letters, "A" and "L", and last two letters, "I" and "N". However, these similarities are not sufficient for this Office to rule that ALERGIN is confusingly similar with ALLERIN.



<sup>1</sup> Emerald Garment Manufacturing Corporation v. Court of Appeals, 251 SCRA 600 (1995).

<sup>2</sup> Esso Standard Eastern, Inc. v. Court of Appeals, 116 SCRA 336 (1982).

<sup>3</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001.

DATE: \_\_\_\_\_

ROBERT NEREO B. SAMSON  
ATTORNEY V  
Office of the Director General

The Appellant is not disputing that ALERGIN covers pharmaceutical products that are to be dispensed only upon presentation by a doctor's prescription. In this regard, it is not likely that a person who intends to buy the Appellant's products bearing the mark ALLERIN will be given the Appellee's product for ALERGIN. Similarly, it is unlikely that a person who was given a prescription for ALERGIN would be given ALLERIN. There is, therefore, no likelihood of confusion that ALERGIN would be mistaken as ALLERIN or vice versa.

As correctly pointed out by the Director:

The foregoing facts notwithstanding, this Bureau finds the competing marks not confusingly similar. While the first four letters of the Respondent-Applicant's mark ("ALER") are similar to the first five letters of the Opposer's mark ("ALLER") and that both marks end with the letters "I" and "N", confusion or deception is unlikely. Consumers can readily distinguish one mark from the other. This is so because the presence of the letter "G" in the Respondent-Applicant's mark has rendered it a visual and aural character that sets it apart from the Opposer's. This Bureau noted that the pharmaceutical product covered by the Respondent-Applicant's application may be dispensed only through doctor's prescription. It is very remote for a pharmacist or sales clerk to commit mistake in reading the prescription. The outward and bulging curves of the capital letter "G" as well as the curves and downward "tail" of the letter if written or printed in the lower case, are prominent features that immediately catch or draw one's eyes. These features are lacking in the Opposer's mark. Also, due to the presence of the letter "G", pronouncing the Respondent-Applicant's mark produces a sound that is distinct from the sound created when the Opposer's mark is pronounced. The syllabifications, for one, are different - "ALLE-RIN" as compared to "A-LER-GIN".<sup>4</sup>

In addition, a person who would buy the Appellee's products would do so not on the basis of the mistaken belief that the product is that of the Appellants' but because that is the product the person intends to buy. In one case decided by the Supreme Court of the Philippines, it was held that the ordinary purchaser must be thought of, as having, and credited with, at least a modicum of intelligence.<sup>5</sup> Furthermore, the products of the parties are not the everyday common goods or household items bought at a minimal cost. The nature and cost of the goods of the parties require a prospective buyer to be more aware and cautious in the purchase of the product.

The products covered by ALLERIN and ALERGIN are pharmaceutical preparations which are not the everyday common goods or household items. The purchasing public would be more cautious in the purchase of medicinal products including pharmaceutical preparations that are covered by ALLERIN or ALERGIN. Accordingly, a likelihood of confusion that the products bearing the mark ALERGIN would be mistaken or considered as ALLERIN is very remote in this case.

In the related case of *Etepha, A. G. vs. Director of Patents and Westmont Pharmaceutical, Inc.*<sup>6</sup>, the Supreme Court of the Philippines held that:

<sup>4</sup> Decision No. 2012-14 dated 26 January 2012, page 7.

<sup>5</sup> *Fruit of the Loom, Inc. v. Court of Appeals*, G.R. No. L-32747, 29 November 1984.

<sup>6</sup> G. R. No. L-20635, 31 March 1966.



CERTIFIED TRUE COPY  
DATE: \_\_\_\_\_

ROBERT NEREO B. SAMSON  
ATTORNEY V  
Office of the Director General

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.

Also, the presence of the generic names accompanying the trademarks under consideration negates the Appellant's claim of confusing similarity between ALLERIN and ALERGIN. The Appellee commented that:

27. It is also worth noting that ALERGIN and ALLERIN have different generic names. ALERGIN's generic name is "cetirizine dihydrochloride", while ALLERIN's generic name is "diphenhydramine hydrochloride" for the ALLERIN capsules and "diphenhydramine hydrochloride phenylpropanolamine hydrochloride" for the ALLERIN reformulated syrup. Note that in the Philippines, physicians are mandated by law to write the generic name of the medicines they are prescribing. In addition, pharmaceutical drug companies are required to prominently indicate the generic names of the medicines in their packaging.<sup>7</sup>

WHEREFORE, premises considered, the instant appeal is hereby DISMISSED. Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Legal Affairs for appropriate action. Further, let also the Director of the Bureau of Trademarks and the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this decision for information, guidance, and records purposes.

SO ORDERED.

'22 APR 2014 Taguig City

  
RICARDO R. BLANCAFLOR  
Director General



<sup>7</sup> COMMENT (ON OPPOSER-APPELLANT'S APPEAL MEMORANDUM DATED 06 MARCH 2012) dated 20 April 2012, pp. 10-11.

DATE: 

ROBERT NEREO B. SAMSON  
ATTORNEY V  
Office of the Director General