



**UNITED LABORATORIES
PHARMACEUTICALS, INC.,**
Opposer,

-versus-

XL LABORATORIES,
Respondent -Applicant.

x-----x

} **IPC No. 14-2011-00083**
} Opposition to:
} Appln. Serial No. 4-2010-008610
} Date filed: 06 August 2010
} **TM: "ALETOR"**

NOTICE OF DECISION

OCHAVE & ESCALONA

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GREETINGS:

Please be informed that Decision No. 2014 - 272 dated October 30, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 30, 2014.

For the Director:


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



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DECISION

UNITED AMERICAN PHARMACEUTICALS, INC., (“Opposer”)¹ filed an opposition to Trademark Application Serial No. 4-2010-008610. The application filed by XL LABORATORIES PVT. LTD, (“Respondent-Applicant”)², covers the mark “ALETOR” for pharmaceutical product namely “ANTI-HISTAMINE” under Class 5 of the International Classification of Goods or Services.³

The Opposer alleges that the mark ALETOR is confusingly similar to its registered mark “ALLERTA”. According to the Opposer, the registration of the mark ALETOR in the name of the Respondent-Applicant will violate Sec. 123 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) and with its use, will diminish the distinctiveness and dilute the goodwill of the mark ALLERTA. In support of its opposition, the Opposer submitted in evidence the following:

1. Annex “A” – page two (2) of the IPO E-Gazette with releasing date “2/7/2011”;
2. Annex “B” – certificate of registration for the mark ALLERTA;
3. Annex “C” – copy of the Declaration of Actual Use for the mark ALLERTA;
4. Annex “D” – sample product label bearing the mark ALLERTA; and
5. Annex “E” – copy of the Certificate of Product Registration issued by the Bureau of Food and Drugs for the product under the brand/mark ALLERTA.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant. However, the Respondent-Applicant did not file an answer.

Should the Respondent-Applicant's trademark application be allowed?

Sec. 123.1(d) of the IP Code provides that 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:

- 1 A corporation organized and existing under the laws of the Philippines with principal office located at Pionerr Street, Mandaluyong City
- 2 A foreign corporation with address at 1-14 Shivlok House-1, Karampura Commercial Complex, Shivaji Marg, New Delhi – 110015, India.
- 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.

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- (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;

As culled from the records and evidence presented, at the time the Respondent-Applicant filed its trademark application, the Opposer already has an existing trademark registration for the mark ALLERTA, used on ANTIHISTAMINE/ANTI-ALLERGY MEDICINAL preparation under Class 5, bearing Reg. No. 4-2004-011565 issued on 09 October 2006.

But are the competing marks, depicted below closely resemble each other such that mistake, confusion or even deception is likely to occur?

ALLERTA

ALETOR

Opposer's mark

Respondent-Applicant's mark

The Opposer's mark consists of seven letters and its last syllable is the syllable word "TA". The Respondent-Applicant's mark on the other hand consists of six letters and its last syllable is the syllable "TOR". The differences however are far outweighed by the similarities between the marks. In both marks, what is impressed upon the eyes and the ears are the letters "A", "L", "E", "R", and "T". Time and again, the court has taken into account the aural effects of the words and letters contained in the marks in determining the issue of confusing similarity.⁴ Thus, in *Marvex Commercial Co., Inc. v. Petra Hawpia & Co., et al*⁵, the 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 "Jass-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 "Trade-Mark 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.

⁴ *Prosource International Inc. v. Horphag Research Management S. A.*, G. R. No. 180073, 25 November 2009.

⁵ G. R. No. L-19297, 22 December 1966.

In the case at bar, "SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see *Celanese Corporation of America vs. E. I. Du Pont*, 154 F. 2d. 146, 148)."

Because the competing marks are used on the same pharmaceutical products, mistake or confusion therefore is likely to occur. In this regard, 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.⁶


It is emphasized that the essence of trademark registration is to give protection to the owner of the 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 products.⁷ The mark applied for registration by the Respondent-Applicant does not meet this function.

In conclusion, this Bureau finds that the registration of the mark ALETOR in favor of the Respondent-Applicant 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. 4-2010-008610 be returned to, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 30 October 2014.


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

⁶ *American Wire and Cable Co. v. Director of Patents, et. al.* (31 SCRA) G.R. No. L-26557, 18 February 1970

⁷ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114509, 19 Nov. 1999