



WESTMONT PHARMACEUTICALS, INC.,	}	IPC No. 14-2012-00022
	}	Opposition to:
Opposer,	}	
	}	Application No. 4-2011-011411
- versus -	}	Date Filed: 22 September 2011
	}	
OEP PHILIPPINES, INC.,	}	Trademark: CARDIOZAR
Respondent-Applicant.	}	
x-----x	x	Order No. 2014 - <u>1477</u>

ORDER

The records show that this Bureau issued Decision No. 2014-294 dated 05 November 2014. This Bureau finds merit in the opposition that, as discussed in the decision, the mark **CARDIOZAR** is confusingly similar to the Opposer's mark **CARDIOSEL**. However, the dispositive portion of the decision inadvertently stated that the opposition is "DISMISSED", when in fact the opposition is **SUSTAINED**.

Accordingly, to correct the records and in the interest of justice, Decision No. 2014-294 dated 05 November 2014 is hereby **AMENDED**, the dispositive portion of which, to read as follows:

"WHEREFORE, premises considered, the instant Opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-011411 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED."

SO ORDERED.

Taguig City, 25 November 2014.

Atty. **NATHANIEL S. AREVALO**
Director IV, Bureau of Legal Affairs

Copy furnished:

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

OEP PHILIPPINES, INC.
Respondent-Applicant
Unit 606 SEDDCO I Building
corner Rada and Legaspi Streets
Legaspi Village, Makati City

RECEIVED

By: _____
Signature: [Signature]
Date: 11/26/14

[Signature] 11-26-14



S = 11-11-14

WESTMONT PHARMACEUTICALS, INC.,
Opposer,

IPC No. 14-2012-00022
Opposition to:
Appln. Serial No. 4-2011-011411
Date Filed: 22 September 2011
TM: "CARDIOZAR"

-versus-

OEP PHILIPPINES, INC.,
Respondent-Applicant.

X-----X

NOTICE OF DECISION

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

RECEIVED
By: _____
Signature: [Signature]
Date: 11/26/14

OEP PHILIPPINES, INC.,
Respondent-Applicant
Unit 606 SEDCCO I Building
Corner Rada and Legaspi Streets
Legaspi Village, Makati City

[Signature] 11-24-14

GREETINGS:

Please be informed that Decision No. 2014 - 294 dated November 05, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 05, 2014.

For the Director:

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



WESTMONT PHARMACEUTICALS, INC., }
 Opposer, }
 -versus- }
 OEP PHILIPPINES, INC., }
 Respondent-Applicant. }

x-----x

IPC No. 14-2012-00022
 Case Filed: 13 January 2012
 Opposition to:
 Application No. 4-2011-011411
 Date Filed: 22 September 2011
 Trademark: "CARDIOZAR"

Decision No. 2014- 294

DECISION

WESTMONT PHARMACEUTICALS, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-011411. The application, filed by OEP Philippines, Inc.² ("Respondent-Applicant"), covers the mark "CARDIOZAR" for use on "pharmaceutical/drug product taken orally indicated for the treatment of hypertension, alone or in combination with other antihypertensive agents" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"GROUNDS FOR OPPOSITION

"The grounds for this opposition are as follows:

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

"2. The registration of the trademark "CARDIOZAR" in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", which provides, in part, that a mark cannot be registered if it:

x x x

¹A corporation duly organized and existing under the laws of the Philippines with principal office located at 4th Floor Bonaventure Building, Greenhills, San Juan City, Philippines.

²With address at Unit 606 SEDCCO I Bldg., cor. Rada&Legaspists., Legaspi Village, Makati City, Philippines.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"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 "CARDIOZAR" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "CARDIOSEL".

"ALLEGATIONS IN SUPPORT OF THE OPPOSITION

"In support of this Opposition, Opposer will rely upon and prove the following facts:

"4. Opposer, the registered owner of the trademark "CARDIOSEL", is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark "CARDIOSEL" was originally filed with the Intellectual Property Office on 14 February 1989 by Opposer's sister company, THERAPHARMA, INC. (Therapharma) and was approved for registration by this Honorable Office on October 30, 1990 and valid for a period of twenty (20) years. Thereafter, the ownership of the mark "CARDIOSEL" was transferred to herein Opposer. However, on 21 March 2009, Opposer transferred the ownership to another sister company, L.R. IMPERIAL, INC. ("LRI"). Recently, LRI executed a Deed of Assignment in favor of the herein Opposer transferring back the ownership of the trademark "CARDIOSEL". Hence, Opposer's registration of the "CARDIOSEL" trademark subsists and remains valid to date. x xx

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

"5.1 Opposer dutifully filed Affidavits of Use pursuant to the requirement of law, to maintain the registration of "CARDIOSEL" in force and effect. A Copy of the Affidavit of Use filed by Opposer is hereto attached as Annexes "D", "E" and "F".

"5.2 A sample product label bearing the trademark "CARDIOSEL" actually used in commerce is hereto attached as Annex "G".

"5.3 In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, we registered the products with the Bureau of Food and Drugs (formerly BFAD). A copy of the Certificate of Product Registration issued by the BFAD for the mark "CARDIOSEL" is hereto attached as Annex "H".

"6. There is no doubt that by virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark "CARDIOSEL", and the fact that they are well known among consumers, the Opposer has acquired an exclusive ownership over the "CARDIOSEL" marks to the exclusion of all others.

"7. "CARDIOZAR" is confusingly similar to "CARDIOSEL".

"7.1 There are no set rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or is a colorable imitation of, another. Nonetheless, jurisprudence provides enough guidelines and tests to determine the same.

"7.1.1 In fact, in Societe' Des Produits Nestle', S.A. vs. Court of Appeals [356 SCRA 207, 216,] the Supreme Court, citing Ethepa v. Director of Patents, held "[i]n determining if colorable imitation exists, jurisprudence has developed two kinds of tests - the Dominancy Test and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitute infringement. On the side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity."

"7.1.2 It is worthy to note at this point that in Societe' Des Produits Nestle', S.A. vs. Court of Appeals [Supra, p. 221,] the Supreme Court held "[T]he totality or holistic test only relies on visual comparison between two trademarks whereas the dominancy test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks."

"7.1.3 Relative thereto, the Supreme Court in McDonalds' Corporation vs. L.C. Big Mak Burger, Inc. [437 SCRA 10] held:

x xx

"7.1.4 Applying the dominancy test, it can be readily concluded that the trademark "CARDIOZAR", owned by Respondent, so resembles the trademark "CARDIOSEL", that it will likely cause confusion, mistake and deception on the part of the purchasing public.

"7.1.4.1 First, 'CARDIOZAR' appears and sounds almost the same as 'CARDIOSEL';

"7.1.4.2 Second, both marks are composed of nine (9) letters;

"7.1.4.3 Third, both marks are composed of three (3) syllables;

"7.1.4.4 Fourth, the first and second syllables of both marks are exactly the same i.e. 'CAR' 'DIO'

"7.1.5 Clearly, the Respondent adopted the dominant features of the Opposer's mark 'CARDIOSEL';

"7.1.6 As further ruled by the High Court in McDonald's case [p.33]

x xx

"7.2 The trademark 'CARDIOSEL' and Respondent's trademark 'CARDIOZAR' are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

"7.2.1 Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed trademark 'CARDIOZAR' is applied for the same class and goods as that of trademark 'CARDIOSEL', i.e. Class (5); for treatment of hypertension, to the Opposer's extreme damage and prejudice.

"7.3 Yet, Respondent still filed a trademark application for 'CARDIOZAR' despite its knowledge of the existing trademark registration of 'CARDIOSEL' which is confusingly similar thereto in both its sound and appearance.

"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"), which states:

x x x

"9. To allow Respondent to continue to market its products bearing the 'CARDIOZAR' mark undermines Opposer's right to its marks. As the lawful owner of the marks 'CARDIOSEL', 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.

"9.1 Being the lawful owner of 'CARDIOSEL', Opposer has the exclusive right to use and/or appropriate the said marks 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.

"9.2 By virtue of Opposer's ownership of the trademark 'CARDIOSEL', it also has the right to prevent third parties, such as Respondent, from claiming ownership over Opposer's marks or any depiction similar thereto, without its authority or consent.

"9.3 Moreover, following the illustrative list of confusingly similar sounds in trademarks which the Supreme Court cited in McDonald's Corporation, McGeorge Food Industries, Inc. vs. L.C. Big Mak Burger, Inc., 437 SCRA 268 (2004), it is evident that the mark 'CARDIOZAR' is aurally confusingly similar to Opposer's mark 'CARDIOSEL'.

"9.4 To allow Respondent-Applicant to use its 'CARDIOZAR' mark on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the 'CARDIOZAR' products of Respondent originate from or is being manufactured by Opposer, or at the very least, is connected or associated with the 'CARDIOSEL' products of Opposer, when such connection does not exist.

"9.5 In any event, as between the newcomer, Respondent, which by the confusion loses nothing and gains patronage unjustly by the association of its products bearing the 'CARDIOZAR' mark with the well-known 'CARDIOSEL' mark, and the first user and actual owner of the well-known mark, Opposer, which by substantial investment of time and resources and by honest dealing has already achieved favor with the public and already possesses goodwill, any doubt should be resolved against the newcomer, Respondent, considering that

Respondent, as the latter entrant in the market had a vast range of marks to choose from which would sufficiently distinguish its products from those existing in the market.

"10. By virtue of Opposer's prior and continued use of the trademark 'CARDIOSEL', 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-applicant seeks to have its mark 'CARDIOZAR' registered in the same class (Nice Classification 5) as the trademark 'CARDIOSEL' of Opposer, plus the fact that both are for treatment of hypertension, will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

"12. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent of the trademark 'CARDIOZAR'. In support of the foregoing, the instant Opposition is herein verified by Mr. Renato T. Castaneda which likewise serves as his affidavit (Nasser v. Court of Appeals, 191 SCRA 783 [1990]).

The Opposer's evidence consists of a copy of the IPO E-Gazette officially released on 13 December 2011; a copy of the certificate of registration No. 49298 for the trademark "CARDIOSEL"; a copy of the affidavit of use for the trademark "CARDIOSEL"; sample product label bearing the trademark "CARDIOSEL"; and a copy of the certificate of product registration issued by BFAD for the mark "CARDIOSEL".⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant, OEP Philippines, Inc., on 14 February 2012. Said Respondent-Applicant, however, did not file an Answer.

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

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

Sec. 123. Registrability. - 123.1. A mark cannot be registered if it:

x xx

- (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 :

⁴Marked as Annexes "A" to "H".

- (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;"

Sec. 147. *Rights Conferred.* - 147.1. The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

This Bureau takes cognizance via judicial notice of the fact that, based on the records of the Intellectual Property Office of the Philippines, the Opposer filed a trademark application for CARDIOSEL on 14 February 1989. The application covers cardiovascular preparations under Class 05. On the other hand, the Respondent-Applicant filed the trademark application subject of the opposition on 22 September 2011.

Hence, the question, does CARDIOZAR resemble CARDIOSEL such that confusion or deception is likely to occur? The marks are shown below:

CARDIOSEL

Cardiozar

Opposer's trademark

Respondent-Applicant's mark

There is no doubt that the first two syllables of the contending marks "CARDIO" is from the Greek word *Kardia*, meaning "heart". In the Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, there are registered marks covering pharmaceutical preparations or drugs that have the prefix - "CARDIO", such as Cardioten with Reg. No. 11849, Cardiovist with Reg. No. 3925, and Cardiotect with Reg. No. 12872, which are owned by entities other than the Opposer. Hence, this Bureau cannot sustain the opposition solely on the ground that both marks contain or start with "CARDIO". To do so would have the unintended effect of giving the Opposer exclusive right over the prefix "CARDIO". To determine whether two marks that contain the prefix "CARDIO" are confusingly similar, there is a need to examine the other letters or components of the trademarks. In this regard, when the syllable "ZAR" is appended to "CARDIO", the resulting mark when pronounced can hardly be distinguished from CARDIOSEL. Confusion is likely in this instance. Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"⁵, "SAPOLIN" and LUSOLIN"⁶,

⁵ *MacDonalds Corp, et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

"CELDURA" and "CORDURA"⁷, "GOLD DUST" and "GOLD DROP". The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, to wit:


Two letters of "SALONPAS" are missing in "LIONPAS": the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance...."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.⁸

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2011-011411 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 05 November 2014.


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

⁶ *Sapolin Co. v. Balmaceda and Germann & Co.*, 67 Phil. 705.

⁷ *Co Tiong SA v. Director of Patents*, G.R. No. L- 5378, 24 May 1954; *Celanes Corporation of America vs. E. I. Du Pont de Nemours & Co.* (1946), 154 F. 2d 146 148.)

⁸ *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297, 22 Dec. 1966.