



H. LUNDBECK A/S,
Opposer,

-versus-

INNOVISION PHARMA INC.,
Respondent-Applicant.

X-----X

}
} IPC No. 14-2011-00237
} Opposition to:
} Appln No. 4-2010-12871
} Date filed: 26 November 2010
} TM: "DEXAPRO"
}

NOTICE OF DECISION

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INNOVISION PHARMA, INC.
Respondent-Applicant
Unit 104 Brickyard Arcade, Greenfields Square
Sindalan, City of San Fernando, Pampanga

GREETINGS:

Please be informed that Decision No. 2014 - 320 dated December 12, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 12, 2014.

For the Director:


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



H. LUNDBECK A/S,	}	IPC No. 14-2011-00237
Opposer,	}	Opposition to:
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-versus-	}	Appln. Serial No. 4-2010-12871
	}	Date Filed: 26 November 2010
INNOVISION PHARMA INC.,	}	Trademark: "DEXAPRO"
Respondent-Applicant.	}	
x-----x		Decision No. 2014 - <u>320</u>

DECISION

H. LUNDBECK A/S (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2010-12871. The application filed by INNOVISION PHARMA INC. (Respondent-Applicant)² covers the mark "DEXAPRO" for use on "pharmaceutical preparations, namely otic suspensions, antibacterial" under class 5 of the International Classification of Goods³.

The opposition is anchored on the following grounds:

"9. Opposer believes that it would be damaged by the registration of the mark DEXAPRO in the name of the Respondent.

"10. The registration of the trademark "DEXAPRO" in the name of the respondent-applicant will violate and contravene Sections 123.1 (d), (e), (f), and (g) of the Intellectual Property Code, because said mark is confusingly similar to the internationally well-known mark 'LEXAPRO' owned, registered and unabandoned by the Opposer.

"11. Section 123. Registrability.-123.1, paragraph d, e, f and g provides:

Section 123. Registrability.-123.1. 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 of:
- (i) the same goods or services; or
- (ii) closely related goods or services; or

1 A corporation duly organized and existing under the laws of Denmark with principal address at 9 Otillavej, DK 2500 Valby, Denmark

2 A domestic corporation with address at Unit 104, Brickyard Arcade, Greenhills Square, Sindalan City

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

(iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion;

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark with which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(e) is identical with, or confusingly similar to, or constitutes a translation of, a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods and services, would indicate a connection between those goods and services, and the owner of the registered mark; Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;

(f) is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

“12. Opposer is the registered owner of the well-known mark ‘LEXAPRO’ said mark was used in Ireland in 2002.

“13. In the Philippines, the mark ‘LEXAPRO’ was first used in 20045, through the company’s local partner, Lunbeck Philippines, and is registered under Certificate of Registration No. 4-2002-10072, for goods under Class 5.

“14. Since its introduction, ‘LEXAPRO’ has captured a substantial market share and has become one of the more popular drugs in a long list of revolutionary and lifesaving drugs manufactured by Opposer.

“15. It should be noted that during the first four years since it was launched (2003-2006), ‘LEXAPRO’ has been sold and marketed in at least 26 countries, as follows xxx

“16. As further testament to the fame of ‘LEXAPRO’, during the last 12 years, Opposer’s worldwide sales of products bearing the mark ‘LEXAPRO’ totaled US 45, 117, 890, 725 details of which are as follows xxx

“17. In addition to the aforementioned Philippine registration, Opposer has likewise registered said mark in various countries and jurisdictions

including Armenia, Croatia, Estonia, Georgia, Kazakhstan, Krygystan, Latvia, Republic of Moldova, Slovenia, Tajikistan, Turkmenistan, Uzbekistan, Czech Republic, Slovakia, Lithuania, Russia Fed., Netherlands, Antilles, Aruba, EU Trademark, Surinam, El Salvador, Swaziland, Thailand, Turkey, Trinidad and Tobago, Taiwan, Ukraine, Uruguay, St. Vincent and Grenada, Vietnam, Yemen, Yugoslavia, South Africa, Zambia, Argentina, Finland, Denmark, United Kingdom, Ireland, Norway, Sweden, United Arab Emirates, Antigua and Barbuda, Albania, Austria, Australia, Barbados, Bulgaria, Bahrain, Bermuda, Bolivia, Bahamas, Bhutan, Botswana, Belize, Switzerland, Chile, China, Colombia, Costa Rica, Cuba, Dominican Republic, Algeria, Ecuador, Spain, France, Grenada, Greece, Guatemala, Guyana, Hong Kong, Honduras, Haiti, Hungary, Indonesia, Israel, India, Iran, Iceland, Italy, Jamaica, Jordan, Japan, Kenya, Korea North, Korea South, Kuwait, Cayman Islands, Lebanon, Saint Lucia, Liechtenstein, Lesotho, Morocco, Monaco, Mongolia, Mauritius, Mexico, Malaysia, Mozambique, Nigeria, Nicaragua, New Zealand, Oman, Panama, Peru, Philippines, Pakistan, Poland, Portugal, Paraguay, Qatar, Romania, Saudi Arabia, Sudan, Singapore, Sierra Leone, San Marino, Benelux and pending application in Bangladesh, Syrian Arab Rep., Tunisia, Venezuela, Brazil, Egypt, Japan, Sri Lanka, Libya. xxx

“22. Also attached to the Affidavit of Soren Ingemann Larsen, marked as Annex D, and made an integral part hereof, is a Certificate of Registration issued by the International Bureau of the World Intellectual Property Organization (WIPO) attesting the fact the LEXAPRO is registered in the aforementioned countries under the Madrid Protocol.”

To support its opposition, the Opposer submitted as evidence the following:

1. Legalized and authenticated Special Power of Attorney dated 24 March 2011;
2. Notarized Verification and Certification Against Forum Shopping dated 21 June 2011;
3. Print-out of E-gazette page showing details of Respondent-Applicant's application for registration of “DEXAPRO”;
4. Print-out of E-gazette page showing details of the status of Opposer's mark “LEXAPRO”
5. Print-out of google pages of websites of EXAPRO; and
6. Authenticated Affidavit of Soren Ingemann Larsen.⁴

The respondent-Applicant, in its Answer dated 15 August 2011, alleged among other thing, the following:

“The mark DEXAPRO owned by herein Respondent-Applicant is not confusingly similar with the mark LEXAPRO owned by the Opposer and will not likely cause confusion and mistake and deception on the part of the purchasing public.

⁴ Exhibits “A” to “F”

“4. By definition, trademark means a distinctive sign or indicator used by an individual, business organization, or other legal entity that the product or services to consumers with which the trademark appears originate from a unique source and to distinguish the product or services from those of others.

“5. Opposer seeks the denial of trademark application for DEXAPRO on grounds of its being ‘CONFUSINGLY SIMILAR’ with its registered trademark LEXAPRO anchoring its argument heavily on the dominancy test.

“6. There is no possibility of causing confusion, mistake on the part of the buying public since there are components in the mark which sufficiently differentiate one from the other. The mark when taken together IN THEIR ENTIRETY, more than sufficiently differentiate one from the other and negate the possibility of confusion or deception.

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“14. Visually, if placed side by side, they are again distinct and different from one another. The principle of ‘moron in a hurry’ that is a phrase used as an informal rejection of a claim that a trader has made a misrepresentation damaging another trader’s goodwill is one of the applicable concepts in this case.

“16. It should also be regarded that ‘ethical products’ are prescribed by experts in the field of medicine. By way of clarification, the end-users in the sales process of medicines are the medical practitioners and not the buying public. This is purely the essence of and the product of what is termed ‘ETHICAL PROMOTION’ and contrary to consumer products wherein the target audience and the decision makers are the consumers themselves, the target doctors are the ones who write the prescriptions. In effect, if a company promotes their products properly and in good faith, then any kind of confusion will be eradicated. In short it would be very important to note that medical practitioners are intellectual professionals who are very knowledgeable of the medicines prescribe and are least likely to commit any error especially if they write their preferred brand. In essence end-users of our products are the least likely individuals to be affected by ‘CONFUSING SIMILARITIES’ because of this fact.”

To support its defense, the Respondent-Applicant submitted as evidence the following:

1. Copy of Securities and Exchange Commission (SEC) Certificate of Incorporation dated 25 October 2007;

2. Copy of License to Operate issued by the Bureau of Food and Drugs dated 15 March 2010;
3. Sample packaging of "DEXAPRO";
4. Copy of Notice of Allowance from the IPO dated 13 January 2011; and
5. Secretary's Certificate dated 15 August 2011.⁵

The Preliminary Conference was terminated on 9 January 2012 where the hearing directed the Opposer to file its position paper and the Respondent-Applicant declared to have waived its right to file its position paper failure to appear at the preliminary conference.

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

It is emphasized that the function of a trademark is to point out distinctively the origin or ownership of the goods to which it is affixed; to secure 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 manufactured against substitution and sale of an inferior and different article as his product.⁶

Records show that at the time Respondent-Applicant applied for registration of the mark "DEXAPRO" the Opposer already registered the mark LEXAPRO under Certificate of Registration No. 4-2002-010072 dated 20 November 2006. The goods covered by the Opposer's trademark registration are also under Class 05, same as indicated in the Respondent-Applicant's trademark application.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:

LEXAPRO

Opposer's Mark

DEXAPRO

Respondent-Applicant's mark

⁵ Exhibits "1" to "5"

⁶ Pribhdas J. Mirpuri v. Court of Appeals, G. R. No. 114508, 19 November 1999, citing Etepha v. Director of Patents, supra, Gabriel v. Perez, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

The marks are similar with respect to the six letters, "E-X-A-P-R-O" of their six literal elements. The substitution by the Respondent-Application of the first letter of the mark "D" for "L" is of no moment. The resultant marks when pronounced are *idem sonans* or phonetically similar. Visually and aurally the marks are confusingly similar.

The Supreme Court in the case of *Marvex Commercial Co., Inv. V. Petra Hawpia & Co. and the Director of Patents*⁷ is instructive on the matter, 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 advised over the radio, similarity in sound is of especial significance (*Co Tiong Sa vs. Director of Patents*, 95 Phil. 1 citing *Nims, The Law of Unfair Competition and Trademarks*, 4th ed., vol. 2, pp. 678-679). xxx

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 "Jazz-Sea"; "Silver Flash" and "Supper-Flash"; "Cascarete" and "Celborite"; "Celluliod" and "Cellonite"; "Chartreuse" and "Chaseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Admur, in his book "Trademark 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 "Condura" are confusingly similar in sound; this court held *Sapolin Co. vs. Balmeceada*, 67 Phil. 705 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.

In the case 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.

⁷G. R. No. L-19297, 22 December 1966

Succinctly, the public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. While the pharmaceutical products covered by the Opposer's trademark registration are not squarely similar to those indicated in the Respondent-Applicant's trademark application, the fact that the marks are nearly identical underscores the need to prevent confusion or mistake. At stake, or at risk for that matter, is the health and safety of patients. One mistake in the dispensation could result into tragic consequences.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-12871 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for Information and appropriate action.

SO ORDERED.

Taguig City, 12 December 2014.


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