



L.R. IMPERIAL, INC.,
Opposer,

-versus-

SUHITAS PHARMACEUTICALS, INC.,
Respondent-Applicant.

x-----x

}
} IPC No. 14-2014-00028
} Opposition to:
} Appln. Serial No. 4-2013-00011620
} Date Filed: 26 September 2013
} TM: "ROSUTIN"
}
}
}

NOTICE OF DECISION

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

SUHITAS PHARMACEUTICALS, INC.
Respondent-Applicant
3F Centerpoint Building
Pasong Tamo corner Export Bank Drive
Makati City

GREETINGS:

Please be informed that Decision No. 2014 - 032 dated December 22, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 22, 2014.

For the Director:


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



L. R. IMPERIAL, INC.,	}	IPC No. 14-2014-00028
Opposer,	}	Opposition to:
	}	
- versus -	}	Application No. 4-2013-00011620
	}	Date Filed: 26 September 2013
SUHITAS PHARMACEUTICALS, INC.,	}	
Respondent-Applicant.	}	Trademark: ROSUTIN
x-----x	x	Decision No. 2014 - <u>322</u>

DECISION

L. R. IMPERIAL, INC.¹ ("Opposer") filed a Verified Notice of Opposition to Trademark Application No. 4-2013-00011620. The contested application, filed by SUHITAS PHARMACEUTICALS, INC.², ("Respondent-Applicant"), covers the mark ROSUTIN for use on "*pharmaceutical preparations (antibacterial)*" under Class 05 of the International Classification of goods³.

The Opposer alleges, among other things, that:

"7. The mark "ROSUTIN" applied for by Respondent-Applicant so resembles the trademark "ROSWIN" owned by Opposer and duly registered with this Honorable Bureau prior to the publication of the application for the mark "ROSUTIN".

"8. The mark "ROSUTIN" will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark "ROSUTIN" is applied for the same class as that of Opposer's trademark "ROSWIN", *i.e.*, Class 5 of the International Classification of Goods.

"9. The registration of the mark "ROSUTIN" in the name of the Respondent-Applicant will violate Sec. 123.1 (d) of the IP Code, which provides, in part, that a mark cannot be registered if it:

x x x

(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 domestic corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines, with office address at 2nd Floor Bonaventure Plaza, Greenhills, San Juan, Metro Manila, Philippines.
2 Appears to be a domestic corporation, with office address at 3F Conterpoint Building, Pasong Tamo corner Export Bank Drive, Makati City, Philippines.
3 Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This 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.

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

"10. Respondent-Applicant's use and registration of the mark "ROSUTIN" will diminish the distinctiveness of Opposer's trademark "ROSWIN"."

The Opposer's evidence consists of the following:

1. Copy of the pertinent page of the IPOPHL E-Gazette bearing publication date of 16 December 2013 (*Exhibit "A"*);
2. Certified true copy of the Certificate of Registration No. 4-2010-009015 for the trademark "ROSWIN" (*Exhibit "B"*);
3. Certified true copy of the Certificate of Listing of Identical Drug Product No. DRP-2065-01 (*Exhibit "C"*);
4. Certified true copy of the Declaration of Actual Use (*Exhibit "D"*);
5. Sample product label bearing the trademark "ROSWIN" actually used in commerce (*Exhibit "E"*); and
6. Certification and sales performance issued by the IMS Health Philippines, Inc. (*Exhibit "F"*).

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 03 February 2014. The Respondent-Applicant, however, did not file its Verified Answer. Thus, this Bureau issued Order No. 2014-683 dated 28 May 2014 declaring the Respondent-Applicant in default and submitting the case for decision on the basis of the opposition, affidavit of witness and documentary or object evidence submitted by the Opposer.

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

The Opposer anchored its opposition on Sec. 123.1 (d) of the Intellectual Property Code ("IP Code"), which 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 of:

- (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.

In this regard, records and evidence show that at the time the Respondent-Applicant filed its trademark application on 26 September 2013, the Opposer already has an existing trademark registration (No. 4-2010-009015) for ROSWIN issued on 13 January 2011 for use on "antihyperlipidemic" under Class 05. But while both marks are used for goods under

Class 05, the goods are not similar. The Opposer's ROSWIN is used as an "antihyperlipidemic" while the Respondent-Applicant's ROSUTIN is for "antibacterial".

Under this factual backdrop, a comparison of the competing marks, as shown below shows that confusion, much less deception, is not likely:

ROSWIN

Opposer's Mark

ROSUTIN

Respondent-Applicant's Mark

The number of letters and syllables comprising the marks makes a fine distinction between the Opposer's and Respondent-Applicant's marks. The Opposer's ROSWIN has six (6) letters and two (2) syllables while the Respondent-Applicant's ROSUTIN has seven (7) letters and three (3) syllables. The Opposer's mark is printed in bold block letters as compared to the Respondent-Applicant's mark. These variations in the number of letters and syllables as well as the appearance of the marks make the Respondent-Applicant's mark distinguishable from the Opposer's in terms of visual and aural effects. The configuration of the letter "T" in ROSUTIN creates a visual effect that one can easily see that it differs from the Opposer's mark. And when one pronounces the Opposer's mark, the sound produced ROS-WIN, is clearly distinguishable from RO-SU-TIN.

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.⁴

Clearly, the Respondent-Applicant satisfied this function test.

WHEREFORE, premises considered, the opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-00011620 be returned, together with a copy of this Decision, to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 22 December 2014.


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

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, November 19, 1999.