



UNITED LABORATORIES, INC.,
Opposer,

-versus-

CHUGAI SEIYAKU KABUSHIKO KAISHA
(CHUGAI PHARMACEUTICAL CO., LTD.)
Respondent-Applicant.

}
} IPC No. 14-2010-000012
} Opposition to:
} Appln No. 4-2009-500104
} Filing Date: 15 March 2009
} TM: "RENAGEL"
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 05 dated January 21, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 21, 2015.

For the Director:


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



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} Decision No. 2015- 05

DECISION

UNITED LABORATORIES, INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2009-500104. The application, filed by CHUGAI SEIYAKU KABUSHIKO KAISHA (CHUGAI PHARMACEUTICAL CO., LTD.) ("Respondent-Applicant")², covers the mark "RENAGEL" for use of goods under class 05³ namely: "pharmaceutical preparations for hyperphosphatemia and other disorders namely in the treatment of renal failure."

The Opposer alleges the following:

"1. The trademark 'RENOGEN' so resembles 'RENAGEL' trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark 'RENAGEL'. The trademark 'RENAGEL', 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 'RENAGEL' is applied for the same class of goods as that of trademark 'RENOGEN', i.e. Class (5); for treatment of kidney disorder.

"2. The registration of the trademark 'RENAGEL' 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', 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.

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at No. 66 United Street Mandaluyong City.
² A foreign corporation with principal office address at 5-1 Ukima 5-Chome, Kita-ku, Tokyo, Japan.
³ The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

"3. The Respondent's use and registration of the trademark 'RENAGEL' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'RENOGEN'.

"4. Opposer, the registered owner of the trademark 'RENOGEN', is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'RENOGEN' was originally filed with the Intellectual Property Office on 19 February 2004 by Opposer's sister company, Unam Brands Limited ('Unam') which was approved for registration on 30 July 2006 and valid for a period of ten (10) years. On 24 October 2007, Unam transferred the ownership of the mark RENOGEN to the herein Opposer. Hence, Opposer's registration of the "RENOGEN" trademark subsists and remains valid to date. x x x

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

x x x

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

"7. 'RENAGEL' is confusingly similar to 'RENOGEN'.

x x x

"8. Moreover, Opposer's intellectual property right over its trademark is protected under Section 147 of the Republic Act No. 8293, otherwise known as the Philippine Intellectual Property Code ("IP Code"), which states:

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

"10. By virtue of Opposer's prior and continued use of the trademark 'RENOGEN', the same have become well-known and established valuable goodwill to the consumer and the general public as well. The registration and use of the respondent's confusingly similar trademark on its good 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 seeks to have its mark "RENAGEL" registered in the same class (Nice Classification 5) as the trademark 'RENOGEN' of Opposer plus the fact that both are for treatment for kidney

disorder, will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

“12. Finally, allowing the Respondent to use the mark ‘RENAGEL’ shall result to confusion of business or confusion of origin.”

The Opposer’s evidence consists of the following:

1. Exhibit “A” - List of Trademarks published for opposition released on 12 October 2009;
2. Exhibit “B” - Certificate of Registration No. 4-2004-001545 mark RENOGEN;
3. Exhibit “C” - Assignment of Registered Trademark RENOGEN;
4. Exhibit “D” - Declaration of Actual Use within three (3) years from filing;
5. Exhibit “F” - Sample of Actual Packaging of RENOGEN; and,
6. Exhibit “F” - Certificate of Product Registration issued by the Bureau of Food and Drugs.

On 07 June 2010, the Respondent-Applicant filed its Answer containing among others the following allegations:

“RESPONDENT-APPLICANTS “RENAGEL” IS NOT CONFUSINGLY SIMILAR TO OPPOSER’S “RENOGEN”

“3.1 Opposer attempts to impress upon this Honorable Office that Respondent-Applicant’s ‘RENAGEL’ mark is confusingly similar to its ‘RENOGEN’ mark, even going so far as to allege that said marks are ‘practically identical marks in sound and appearance’, when such an allegation is clearly false and misleading.

“3.2 Opposer claims to have applied the Dominancy Test in finding that Respondent-Applicant’s mark ‘RENAGEL’ allegedly resembles its own ‘RENOGEN’ mark. However, Opposer made such a finding alleging that Respondent-Applicant ‘adopted the dominant features’ of the mark ‘RENOGEN’, without even pointing out especially which dominant features it is referring to. Surely, the Opposer doesn’t mean that the dominant features of its mark ‘RENOGEN’ are its first three letters: R, E and N. features that are dominant are those that are ‘commanding, controlling, or prevailing over all others.’ In the mark ‘RENOGEN’, its first three letters are certainly not any more essential or prevailing than the other letters in the same word. Opposer’s trademark consists of the word ‘RENOGEN’ in its entirety, and no of several components.

“3.3 Contrary to Opposer’s allegations, ‘RENAGEL’ does not sound like ‘RENOGEN’. The competing trademarks do not even rhyme or end with the same syllable.

"3.4 To claim that these words are similar on the basis of both having three (3) syllables and seven (7) letters is absurd, considering the number of existing words that also have the same number syllables and letters.

"3.5 Furthermore, Opposer has no proof that both marks are 'pronounced in the same intonation', having offered no explanation or description as to how its trademark 'RENOGEN' is pronounced in the first place.

"3.6 Contrary to Opposer's claim, Respondent-Applicant's 'RENAGEL' and Opposer's 'RENOGEN' look nothing alike. x x x

"3.7 Whether the Dominancy test or the Holistic test is applied, it is clear that 'RENAGEL' is not at all confusingly similar to Opposer's 'RENOGEN'. The Opposer's allegation that the competing marks are 'practically identical in sound and appearance is false and misleading, and to claim that the mark 'RENAGEL' 'so resembles' 'RENOGEN' so as to cause confusion, mistake or confusion is indeed reaching.

x x x

"3.10 In the case at bar, the goods covered by Respondent-Applicant's 'RENAGEL' and Opposer's 'RENOGEN' are medicinal or pharmaceutical products for treatment of kidney disorder, belonging to Class 05, specifically 'pharmaceutical preparations for hyperphosphatemia and other disorders namely in the treatment of renal failure', and "medicinal preparation for use as hemotopoietic agent", respectively. Since both products are for medicinal/pharmaceutical use, the buyer will, needless to say, be more wary of the nature of the product he is buying.

"3.12 In its Opposition, the Opposer alleged that the fact that the products of both its 'RENOGEN' and Respondent-Applicant's 'RENAGEL' belong to the same class (Class 05), and are for treatment of kidney disorder, will 'undoubtedly add to the likelihood of confusion amount the purchasers of these goods'. The Petitioner in the case of Cyanamid Company vs. The Director of Patents interposed a similar argument, asserting that the trademark, with which the Supreme Court did not agree. In answer, the court stated that no one can claim a monopoly in the preparation of a medical product for a particular use,

x x x

"3.13 In view of the visual and aural dissimilarity between Respondent-Applicant's 'RENAGEL' and Opposer's 'RENOGEN', and the nature of the products to which these competing marks are to be applied to, there can be no likelihood of confusion or mistake in the minds of the public.

"THE TRADEMARK 'RENAGEL' HAS
ALREADY BEEN REGISTERED IN THE
NAME OF THE RESPONDENT-APPLICANT,
TWO YEARS EARLIER THAN THE
OPPOSER'S APPLICATION OF THE MARK 'RENOGEN'

“3.14 In its Opposition, Opposer alleged that Respondent-Applicant ‘still filed a trademark application for ‘RENAGEL’ despite its knowledge of the existing trademark registration of ‘RENOGEN’, implying that Opposer had filed its application earlier than the Respondent-Applicant.

“3.15 The truth is that respondent-Applicant filed an application for the registration of its mark ‘RENAGEL’ several years before Opposer’s application for the registration of its mark ‘RENOGEN’. Opposer’s application for the mark ‘RENOGEN’ was originally filed with the IPOPhil on February 19, 2004, the registration of which was granted only on July 30, 2006. Respondent-Applicant hereby sub, its that it first filed an applicant for the trademark registration of the mark ‘RENAGEL’ as early as August 12, 1998, six (60 years earlier than Opposer’ application.

“3.16 Respondent-Applicant also filed subsequent applications for the registration of the same mark, x x x

“3.18 In fact, and more importantly, Respondent-Applicant is the owner of the registered trademark ‘RENAGEL’, covered by Registration No. 4-2002-001787, which was registered with IPOPhil on August 05, 2004, two (2) years before the registration of Opposer’s ‘RENOGEN’.

“3.19 Some of the other above-listed applicants were likewise allowed to mature into registration, specifically, Respondent-Applicant was grated Registration Nos. 42005008747 and 42005002020 cover the trademark ‘RENAGEL’ on September 18, 2007, respectively.

“3.21 Ergo, assuming arguendo that respondent-Applicant’s ‘RENAGEL’ is at all similar to Opposer’s ‘RENOGEN’, it is the Respondent-Applicant who has the better right between the parties, as it applied for and secured the registration of its ‘RENAGEL’ mark long before the registration of Opposer’s ‘RENOGEN’, thus negating Opposer’s claim that the registration and use of ‘RENAGEL’ will enable Respondent-Applicant to benefit from its alleged reputation and goodwill. More importantly, Opposer has never filed any opposition to any of the trademark applications of the Respondent-Applicant for its ‘RENAGEL’ trademark and its variant from 1988 to 2005. This can lead to the sole conclusion that Opposer has not found the mark ‘RENAGEL’ as confusingly similar to its ‘RENOGEN’ trademark.

“3.22 Furthermore, Respondent-Applicant has oriented has obtained registrations for the trademark ‘RENAGEL’ from intellectual property offices of various countries in Asia, some which date back to the late ‘90’s.

“OPPOSER’S ‘RENOGEN’ IS NOT A WELL-KNOWN MARK.

“3.23 Opposer claims, throughout its Opposition, that its mark ‘RENOGEN’ is a well-known mark, alleging that through its ‘prior and continued use of the trademark ‘RENOGEN’, the same has (sic) become well-known and established

valuable goodwill to the consumers and the general public as well’. However, without any evidence to support the foregoing, such statements by the Opposer remain empty and self-serving.

x x x

“3.25 Opposer has failed to allege and prove which of the above-cited criteria or any combination thereof, its mark ‘RENOGEN’ has met, if any.

“3.26 Furthermore, a well-known mark must be considered by the competent authority of the Philippines, taking into consideration the knowledge of the relevant sector of the public at large. 9Section 123.1 (e) Opposer has not shown that its mark ‘RENOGEN’ has been deemed or declared well-known by the component Philippine authority.

“3.27 Opposer has also failed to substantiate its claims of having ‘achieved favor with the public’ and possessing goodwill through ‘substantial investment of time and resources’; or its alleged ‘reputation, goodwill and advertising’, having offered no evidence of such by way of sales in the Philippines or amounts spent in the marketing or advertising of its product bearing the mark. ‘RENAGEL’.

The Respondent-Applicant’s evidence consists of the following:

1. Exhibit “1” - Authenticated copy of Secretary’s Certificate/Special Power of Attorney
2. Exhibit “2” - Authenticated copy of Affidavit issued by Masahisa Yamaguchi of Chugai Seiyaku Kabushiki Kaisha; and,
3. Exhibits “3-9” - Certified true copies of Application Nos. 41998006056, 41999001520, 42001005839, Reg. Nos. 4-2002-001787, 42005008747, 42005002020, and Application No. 42009500104 for the trademark RENAGEL.

In this connection, position paper was submitted by the Respondent-Applicant on 18 March 2011. On the other hand, this Bureau noticed that a company not involved in this case, BIOMEDIS, INC., filed a position paper as “Opposer”. No position paper was filed by the Opposer UNITED LABORATORIES, INC.

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

The instant opposition is anchored on Section 123.1 paragraph (d) of the IP Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records and evidence show that the Opposer filed the application for the registration of the mark "RENOGEN" on 19 February 2004. The application was allowed and the Opposer was issued Registration No. 4-2004-001545 on 30 July 2006.⁴ On the other hand, the Respondent-Applicant filed an application for the registration of the mark "RENAGEL" as early as 12 August 1998⁵, followed by a succession of filings on 04 March 1999⁶, 10 August 2001⁷, and 01 March 2002. These applications predate the Opposer's trademark application. Most of these applications were still subsisting when the Opposer filed its application in 2004. In fact, one matured into trademark registration (No. 4-2002-001787). The other applications though, including those filed on 05 September 2005⁸, and 02 March 2009⁹, were either refused registration for failure to file the required Declaration of Actual Use within three years from the filing date or were abandoned.

In this regard, a Certificate of Registration such as Registration No. 4-2002-001787 constitutes a prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.¹¹ On this score alone, the instant opposition has no leg to stand alone. While there were applications filed earlier than Application Serial No. 4-2009-500104, these applications, one of which matured into registration, in fact belong to the Respondent-Applicant.

On the issue that the marks are confusingly similar, the marks are reproduced below for comparison:

RENOGEN

Opposer's mark

Renagel

Respondent-Applicant's mark

The marks reveal disparity in both aural and visual appearance. The middle vowel letter "O" in RENOGEN and "E" in RENAGEL and the corresponding ending letters "N" and "L", respectively, create the distinction when the marks are entirely pronounced. The similarity in the beginning letters "R", "E" and "N" obviously came from the disorder treated by the said medicines, which is renal failure.

Further, a scrutiny of the goods covered by the contending marks show that while both fall under Class 5 goods, they are particularly addressed for the treatment of different illnesses. Opposer's RENOGEN is a medicinal preparation for use as hematopoietic agent.

4 Exhibits "B" and "C" of Opposer.
5 Exhibit "3" of Respondent-Applicant.
6 Exhibit "4" of Respondent-Applicant.
7 Exhibit "5" of Respondent-Applicant.
8 Exhibit "7" of Respondent-Applicant.
9 Exhibit "8" of Respondent-Applicant.
10 Exhibit "6" of Respondent-Applicant.
11 Sec. 138, IP Code.


This is an agent that promotes the formation of blood cells, which includes bone marrow, spleen, thymus, and lymph nodes.¹² On the other hand, Respondent-Applicant's RENAGEL is a preparation for hyperphosphatemia and for the treatment of renal failure. Hyperphosphatemia is a condition consisting of abnormal high serum phosphate intake and/or decreased phosphate excretion.¹³ Thus, the peculiarity of the goods and the illnesses these drugs treat will not cause confusion to patients who will definitely exercise discretion and intelligence in purchasing medicines for specific illness.

While there may be similarities between the marks, the differences as discussed above far outweigh the likelihood of confusion. It is doubtful if the consumers in encountering the mark RENAGEL will have in mind or be reminded of the mark RENOGEN. The Opposer has not established that RENOGEN is a well-known mark nor famous, so as to support a claim that the Respondent-Applicant's trademark application and use of the mark RENAGEL is intended to ride in on the goodwill supposedly earned by the Opposer's mark. The marks were both registered and have been co-existing for several years now. This debunks any assertion of the existence of the likelihood of confusion.

WHEREFORE, premises considered, the instant Opposition is hereby **DISMISSED**. Let the file wrapper of the Trademark Application Serial No. 4-2009-500104 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 21 January 2015.


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

¹² The Free Dictionary by Farlex, available at <http://dictionary.thefreedictionary.com/hematopoietic> (last accessed 18 December 2014).

¹³ Medscape, available at <http://emedicine.medscape.com/article/241185-overview> (last accessed 18 December 2014)