



WESTMONT PHARMACEUTICALS INC.,
 Opposer,

 -versus-

 HERBANEXT, INC.,
 Respondent-Applicant.
 -----X

IPC No. 14-2010-00066
 Opposition to:
 Appln No. 4-2009-007994
 Date Filed: 11 August 2009
 TM: "IMMUNOFLU"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 10 dated February 03, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 03, 2015.

For the Director:

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



WESTMONT PHARMACEUTICALS, INC.,	}	IPC No. 14-2010-00066
	}	Opposition to:
Opposer,	}	
	}	Application No. 4-2009-007994
- versus -	}	Date Filed: 11 August 2009
	}	
HERBANEXT, INC.,	}	Trademark: IMMUNOFLU
Respondent-Applicant.	}	
x-----x		Decision No. 2015 - <u>10</u>

DECISION

WESTMONT PHARMACEUTICALS, INC.¹ ("Opposer") filed on 12 March 2010 a Verified Notice of Opposition to Trademark Application No. 4-2009-007994. The contested application, filed by HERBANEXT, INC.² ("Respondent-Applicant"), covers the mark IMMUNOFLU for use on "food supplement" under Class 05 of the International Classification of goods³.

The Opposer anchors its opposition on Sec. 123.1 (d) of Republic Act No. 8293 or the Intellectual Property Code of the Philippines ("IP Code"). The Opposer alleges that the Respondent-Applicant's IMMUNOFLU so resembles the Opposer's registered mark IMMUNOSIN as will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark is applied for the same class of goods as that of the Opposer's.

The Opposer's evidence consists of the following:

1. Page 3 of the IPO e-Gazette which was officially released on 11 January 2010;
2. Copies of Certificate of Registration No. 46980, Certificate of Renewal of Registration and Assignment of Registered Trademark;
3. Affidavits of Use filed by GenDrug and Opposer;
4. Sample of product label bearing the trademark IMMUNOFLU; and
5. Copy of the Certificate of Product Registration issued by the BFAD for the mark IMMUNOSIN.⁴

The Respondent-Applicant filed its Verified Answer on 26 July 2010, specifically denying the allegations stated in paragraphs 1 to 7 of the opposition and averring, among other things, the following defenses:

"8. In the trademark application of Respondent, the mark applied for is a food supplement. x x x

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

2 A domestic corporation with principal office address at Room 8, DC Building, Magsaysay Avenue, Bacolod City.

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.

4 Marked as Exhibits "A" to "I".

"9. Whereas that of the Opposer is for medicinal preparation useful as immunopotentiator, as shown in its Principal Register;

"10. Highlighting the differences of the two marks, "IMMUNOFLU" and "IMMUNOSIN" are the following:

"10.1. "IMMUNOFLU" is sold as a food supplement, whereas "IMMUNOSIN" is sold as a medicinal preparation;

"10.2. "IMMUNOFLU" is sold in capsule form, whereas "IMMUNOSIN" is being sold either as a syrup or in tablet form;

"10.3. "IMMUNOFLU" is not required to be sold in a pharmacy and if sold through one it is an over the counter good, whereas "IMMUNOSIN" is sold as a prescription drug.

"11. Thus, there can be no confusion or deception that will likely result in the mind of the purchaser since these goods are not similar or are not related to each other.

x x x

"17. Thus we reiterate that both marks are dissimilar to each other to cause confusion or cause the public to be deceived into believing that one product will pass off as the other.

"18. Taking every element of the case into consideration, it is Respondent's humble position that whether the dominancy test or holistic test is applied still there can be no confusion or deception since both marks are strikingly dissimilar to each other.

"19. From the appearance of the label of the product it can be gleaned that the mark "IMMUNOFLU" is entirely distinct from the mark "IMMUNOSIN" as to cause confusion in the mind of the purchase. x x x

"20. Aside from such differences there are other differences that would set the two marks apart as to prevent confusion in the minds of the purchaser.

"21. "IMMUNOFLU" is a food supplement.

"22. "IMMUNOSIN" is a medicinal preparation.

"23. "IMMUNOFLU" is sold in capsule form.

"24. "IMMUNOSIN" is sold either as a syrup or in tablet form.

"25. "IMMUNOFLU" is bought off the shelf or over the counter.

"26. "IMMUNOSIN" can only be bought with a prescription.

"27. They definitely do not refer to the same goods or services. They are not closely related. They do not resemble each other as to likely deceive or cause confusion. Much less are they connected in any way to each other.

"28. Simply put, Respondent-Applicant is in the general business of food supplement, while the Opposer is in the pharmaceutical business.

"29. Therefore, it is absurd to even think that there are any similarities, however slim, between and among the goods being produced and marketed by both parties. Any ordinary man of average and sufficient discernment on the street would be able to tell the difference of a food supplement from a medicine.

"30. Thus, having pointed out the intrinsic differences of both parties' goods, Respondent has unequivocally established that there can be no infringement with the registration of the Respondent's mark.

"31. Even if we are to apply the dominancy test and look into the aural effects of the marks, still there can be no confusion that could arise in the minds of the purchaser in that the last words after immuno are "FLU" and "SIN".

"32. Phonetically, both words are not similar. They do not sound the same and thus cannot be confused with the other. They cannot be aurally and confusingly similar.

"33. There can hardly be any dispute, therefore, that both marks are entirely distinct and dissimilar from each other to likely deceive purchasers and cause confusion in the mind of the public."

The Respondent-Applicant's evidence consists of a copy of its License to Operate issued by the Department of Health, Bureau of Food and Drugs, Trademark Application, and a copy of its label.⁵

Then after, the case was scheduled for mediation conference. After it was declared a failure of mediation, the preliminary conference of the case was set and terminated on 17 August 2011.

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

Sec. 123.1 (d) of R. A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines, relied upon by the Opposer, 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

⁵ Marked as Annexes "A" to "C".

- (ii) closely related goods or services, or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion; x x x

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 11 August 2009, the Opposer's sister company, General Drug and Chemical Company, Inc. ("GenDrug") has long been issued a certificate of registration (No. 46980) for the trademark IMMUNOSIN on 23 November 1989. Subsequently, GenDrug assigned the trademark IMMUNOSIN to herein Opposer by virtue of Assignment of Registered Trademark⁶. Prior to the expiration of the twenty year term, the Opposer cause the renewal of the mark starting 23 November 2009.

But do the marks, as shown below, resemble each other that confusion or even deception is likely to occur?

Immunosin

Opposer's Mark

IMMUNOFLU

Respondent-Applicant's Mark

Notwithstanding the similarity in the prefix "IMMUNO", it is unlikely that the co-existence of the marks will cause confusion, much less deception, among the public. The prefix "IMMUNO" may be inferred as derived from the term immune, immune system or immunology considering that the Opposer's IMMUNOSIN is intended as medicinal preparation useful as immunopotentiator. The prefix "IMMUNO", therefore, is not really unique if used as a trademark or as part thereof for the subject goods. Indeed, "IMMUNO" when used as part of a trademark merely connotes or suggests the immune system.

Succinctly, what would make such trademark distinctive are the suffixes or appendages to the prefix "IMMUNO" and/or the devices, if any. In this instance, the difference in the last syllable of the marks, namely, "SIN" for Opposer and "FLU" for Respondent-Applicant, makes a fine distinction between the competing marks as to sound and appearance such that confusion or deception is unlikely to occur. There is a remote possibility for a consumer to assume or conclude that there is a connection between the parties solely because both marks start with the word or syllable "IMMUNO".

Moreover, considering that the only similarity between the competing marks is the prefix "IMMUNO", sustaining the opposition would have the unintended effect of giving the Opposer the exclusive right to use "IMMUNO", which evidently describes the pharmaceutical goods involved. Taking judicial notice of the information in the Trademark Registry, it reveals that there are a number of registered marks with the prefix "IMMUNO" for use on goods under Class 05, to cite a few:

1. "IMMUNOCAL", Registration No. 4-2005-003442;
2. "IMMUNOCAP", Registration No. 4-2005-002542; and
3. "IMMUNOPROTEIN", Registration No. 4-2005-004614.

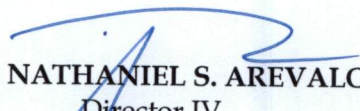
⁶ Exhibit "D".

The essence of trademark registration is to give protection to the owners of 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 product.⁷

WHEREFORE, premises considered, the opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2009-007994 be returned, together with a copy of this Decision, to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 03 February 2015.


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

⁷ See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.