



**MEDICHEM PHARMACEUTICALS, INC.,**  
Opposer,

**-versus-**

**ZYDUS PHILIPPINES, INC.,**  
Respondent-Applicant.

}  
} **IPC No. 14-2013-00269**  
} Opposition to:  
} Application No.4-2013-002315  
} Date filed: 01 March 2013  
} **TM: "DONPEZ"**  
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### NOTICE OF DECISION

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

**ZYDUS PHILIPPINES, INC.,**  
Respondent-Applicant  
Unit Penthouse 1, 19<sup>th</sup> Floor  
Gold Loop Tower A.Escriba Drive  
Barangay San Antonio, Ortigas Center  
Pasig City

#### GREETINGS:

Please be informed that Decision No. 2015 - 17 dated February 18, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 18, 2015.

For the Director:

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



**MEDICHEM PHARMACEUTICALS, INC.,**

Opposer,

-versus

**ZYDUS PHILIPPINES, INC.,**

Respondent-Applicant.

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IPC No. 14-2013-00269

Opposition to Trademark

Application No. 4-2013-002315

Date Filed: 01 March 2013

Trademark: **"DONPEZ"**

Decision No. 2015- 17

**DECISION**

Medichem Pharmaceuticals, Inc.<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-002315. The contested application, filed by Zydus Philippines, Inc.<sup>2</sup> ("Respondent-Applicant"), covers the mark "DONPEZ" for use on *"donepezil hydrochloride (pharmaceutical product: anti-dementia)* under Class 05 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the provision of Section 123.1 (d) of the Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). It contends that the Respondent-Applicant's mark "DONPEZ" is confusingly similar to its registered mark "DOPEZIL" alleging that the two appear and sound similar. It avers that it has extensively used "DOPEZIL" in commerce in the Philippines and that it has dutifully filed the pertinent Declaration of Actual Use (DAU). It also maintains that the International Marketing Services ("IMS") acknowledged and listed the brand as one of the leading brands in the Philippines in the category of *"N07D-Anti-Alzheimer"* in terms of market share and sales performance. It further states that it registered its product with the Food and Drug Administration ("FDA") in order to legally market, distribute and sell the same.

In support of its Opposition, the Opposer submitted the following as evidence:<sup>4</sup>

1. copy of the IPO E-Gazette showing the publication of the Respondent-Applicant's trademark application;
2. certified true copy of Certificate of Registration No. 4-2009-007688;
3. certified true copy of the DAU;

<sup>1</sup> A domestic corporation, duly organized and existing under the laws of the Philippines with office address at No. 132 Pioneer Street, Mandaluyong City, Metro Manila, Philippines.

<sup>2</sup> With office address at Unit Penthouse 1, 19<sup>th</sup> Floor, Gold Loop Tower A, Escriva Drive, Barangay San Antonio, Ortigas Center, Pasig City, Metro Manila, Philippines.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the 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 Purpose of the Registration of Marks concluded in 1957.

<sup>4</sup> Marked as Exhibits "A" to "F".



4. sample product label bearing the mark "DOPEZIL";
5. copy of the certification by IMS and sales performance; and,
6. certified copy of the Certificate of Product Registration issued by the FDA.

On 03 July 2013, a Notice to Answer was served to the Respondent-Applicant. The latter, however, failed to comply. Thus, the Hearing Officer issued Order No. 2013-1551 on 30 October 2013 declaring the Respondent-Applicant in default and submitting the case for resolution.

The issue to be resolved is whether the Respondent-Applicant's mark "DONPEZ" should be allowed registration.

Records reveal that the Opposer was issued registration for its mark "DOPEZIL" on 17 December 2009 under Certificate of Registration No. 4-2009-007688. The Respondent-Applicant, on the other hand, filed the contested application only on 01 March 2013.

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are reproduced below for comparison:

**Dopezil**

**DONPEZ**

*Opposer's mark*

*Respondent-Applicant's mark*

The competing marks are similar with respect to its first two letter "DO" and their common appropriation of the syllable "PEZ". The plausible explanation for these resemblances is because both the Opposer and the Respondent-Applicant derived their respective marks from the generic name of the pharmaceutical product they both pertain which is *donepezil hydrochloride*. Both the Opposer and the Respondent-Applicant merely omitted some of the letter from the word *donepezil* in arriving at their trademarks. As such, the competing marks are therefore suggestive marks. Although registrable, they are considered weak marks as far as distinctiveness is concerned. The mark or brand name itself gives away or tells the consumers the goods and/or the kind, nature, use or purpose thereof.

Taken in their entirety, the marks exude differences in sound and appearance. For one, the Opposer's mark consists of only two syllables while that of

the Respondent-Applicant's has three. Also, the third letter "N" between "DO" and "PEZ" in the Opposer's mark and the ending letters "IL" in the Respondent-Applicant's create the distinction in the marks.

Furthermore, it is doubtful if the consumers in encountering the mark "DONPEZ" will have in mind or be reminded of the trademark "DOPEZIL", and vice-versa. The Opposer has not established that "DOPEZIL" is a well-known mark nor that its mark's fame could support the claim that Respondent-Applicant's trademark application and use of the mark "DONPEZ" manifest the latter's intent of riding in on the goodwill supposedly earned and enjoyed by the former.

Finally, it is emphasized that 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.<sup>5</sup> The Respondent-Applicant's trademark sufficiently met this requirement.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-002315 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 18 February 2015.

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

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<sup>5</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.