



WESTMONT PHARMACEUTICALS INC.,
Opposer,

-versus-

XL LABORATORIES PVT. LTD.,
Respondent-Applicant.

} **IPC No. 14-2011-00019**
} Opposition to:
} Application No.4-2010-008323
} Date filed: 30 July 2010
} **TM: "HAYOSPAN"**
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NOTICE OF DECISION

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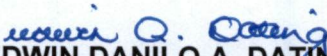
ANTONIO B. ROBLES
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Dita, Sta. Rosa Laguna

GREETINGS:

Please be informed that Decision No. 2015 - 47 dated April 06, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 06, 2015.

For the Director:


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



WESTMONT PHARMACEUTICALS INC.,
Opposer,

- versus -

XL LABORATORIES PVT. LTD.,
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IPC No. 14-2011-00019
Opposition to:

Appln. No. 4-2010-008323

Date Filed: 30 July 2010

Trademark : "**HAYOSPAN**"

Decision No. 2015 - 47

DECISION

WESTMONT PHARMACEUTICALS INC. ("Opposer")¹ filed on 01 February 2011 a verified opposition to Trademark Application Serial No. 4-2010-008323. The application, filed by XL LABORATORIES PVT. LTD., ("Respondent-Applicant")², covers the mark "HAYOSPAN" for use of goods under class 5³ on pharmaceutical product namely anticholinergic..

The Opposer alleges the following grounds for opposition:

"7. The mark 'HAYOSPAN' owned by Respondent-Applicant so resembles the trademark 'HYOS' owned by Opposer and duly registered with this Honorable Office prior to the publication for opposition of the mark 'HAYOSPAN'.

"8. The mark 'HAYOSPAN' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'HAYOSPAN' is applied for the same class and goods as that of Opposer's trademark 'HYOS', i.e. Class 05 of the International Classification of Goods as anticholinergic pharmaceutical preparation.

"9. The registration of the mark 'HAYOSPAN' in the name of the Respondent-Registrant will violate Sec. 123 of the IP Code.

In support of this Verified Opposition, Opposer will rely upon and prove the following facts:

"10. Opposer is the registered owner of the trademark 'HYOS'.

10.1. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. The trademark application for the trademark 'HYOS' was filed with the IPO on 13 November 2009 by Opposer and was approved for registration on 1 October 2020. Thus, the registration of the trademark 'HYOS' subsists and remains valid to date.

10.2. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, Opposer registered the product with the Bureau of Food and Drugs (BFAD).

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

² A foreign corporation with principal business address at 1-14, Shivlok House-1, Karampura Commercial Complex, Shivaji Marg, New Delhi, 110015, India.

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.

10.3. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark 'HYOS' to the exclusion of all others.

"11. As provided in Section 138 of the IP Code, 'A certificate of registration of a mark shall be 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.

"12. The registration of Respondent-Applicant's mark 'HYOS' will be contrary to Section 123.1 (d) of the IP Code. 'HYOS' is confusingly similar to Opposer's trademark 'HAYOSPAN'.

"13. To allow Respondent-Applicant to continue to market its products bearing the mark 'HAYOSPAN' undermines Opposer's right to its trademark 'HYOS'. As the lawful owner of the trademark 'HYOS' Opposer is entitled to prevent the Respondent-Applicant from using a confusingly similar mark in the course of trade where such would likely mislead the public.

"14. The registration and use of Respondent-Applicant's confusingly similar mark 'HAYOSPAN' on its goods will enable the latter to obtain benefit from Opposer's reputation and goodwill and will tend to deceive and/or confuse the public into believing that Respondent-Applicant is in any way connected with Opposer."

The Opposer's evidence consists of the following:

1. Exhibit "A" -"A-1" - Pertinent pages of the IPO E-Gazette;
2. Exhibit "B" - Certificate of Registration No. 4-2009-011648 for HYOS; and,
3. Exhibit "C" - Certificate of Product Registration by BFAD for HYOS.

This Bureau issued and served upon the Respondent-Registrant a Notice to Answer on 08 April 2011. Respondent-Registrant however, did not file an answer. Thus, he is declared in default and this case is deemed submitted for decision.

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

Sec. 123.1 (d) R.A. No. 8293, otherwise known as the Intellectual Property Code ("IP Code") provides:

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

The records and evidence show that at the time the Respondent-Applicant filed its trademark application for HAYOSPAN on 30 July 2010,⁴ the Opposer has already an existing trademark registration for the mark HYOS bearing Registration No. 4-2009-011648 issued on 01 October 2010, which was filed

⁴ Filewrapper records.

on 13 November 2009⁵. Unquestionably, the Opposer's application preceded that of Respondent-Applicant's.

Nevertheless, the competing marks are hereby reproduced for comparison:

Hyos

Opposer's Trademark

HAYOSPAN

Respondent-Applicant's Trademark

The HAYOSPAN trademark of the Respondent-Applicant contain all the letters in the Opposer's HYOS trademark. Such that, if either of the marks are spoken, they create an apparent aural similarity creating the likelihood of confusion of one mark as against the other.

Further, a scrutiny of the goods covered by the mentioned marks show the relatedness of the pharmaceutical products covered by the marks in classification no. 5. Opposer's HYOS particularly covers pharmaceutical preparation for the symptomatic relief of **gastrointestinal and genitourinary disorders characterized by smooth muscle spasms** and spasms and dyskinesia of the biliary system; whereas the Respondent-Applicant's HAYOSPAN covers pharmaceutical product namely **anticholinergic**. It appears that the illness treated by both drugs are related. Anticholinergics are a class of drugs that block the action of the neurotransmitter acetylcholine in the brain. They are used to treat diseases like asthma, incontinence, **gastrointestinal cramps, and muscular spasms**. They are also prescribed for depression and sleep disorders. The drugs help to block involuntary movements of the muscles associated with these diseases. They also balance the production of dopamine and acetylcholine in the body.⁶

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.⁷ Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.⁸

Succinctly, because the coverage of the Respondent-Applicant's trademark application would allow using the mark HAYOSPAN on goods or pharmaceutical products that are already dealt in by the Opposer using the mark HYOS, the changes in spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. HAYOSPAN and HYOS have identical sounds which make it not easy for one to distinguish one mark from the other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus,

⁵ Exhibit "B" of Opposer.

⁶ Anticholinergics available at <http://www.healthline.com/health/anticholinergics#Overview1> (last accessed 06 April 2015).

⁷ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

⁸ Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.

when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound, however, is practically replicated when one pronounces the Respondent-Applicant's mark.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁹ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court.¹⁰


Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase on product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

It must be emphasized that the Respondent-Applicant was given opportunity to defend its trademark application. It, however, failed to do so. Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-008323 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 06 April 2015.


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

⁹ American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.
¹⁰ Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.