



WESTMONT PHARMACUETICALS, INC.,
Opposer,

-versus-

I. P.S. PHARMACEUTICALS, INC.,
Respondent-Applicant.

} **IPC No. 14-2010-00323**
} Opposition to:
} Application No. 4-2009-011762
} Date filed: 17 November 2009
} **TM: "CALCITECT"**
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NOTICE OF DECISION

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Mandaluyong City

ANGELES & CANLAS LAW OFFICES
Counsel for Respondent-Applicant
256 Sto. Rosario Street, cor. St. Catherine Street
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GREETINGS:

Please be informed that Decision No. 2015 - 164 dated May 25, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 25, 2015.

For the Director:

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



WESTMONT PHARMACEUTICALS, INC.,	} IPC NO. 14-2010-00323
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2009-011762
	} Date Filed: 17 November 2009
	}
I.P.S. PHARMACEUTICALS, INC.,	} Trademark: "CALCITECT"
Respondent-Applicant.	}
x-----x	} Decision No. 2015- 104

DECISION

WESTMONT PHARMACEUTICALS, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2009-011762. The application, filed by I.P.S. PHARMACEUTICALS, INC. Respondent-Applicant)², covers the mark "CALCITECT", for use on "anti-thrombotic agent (tablets)" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The mark 'CALCITECT' so resembles the trademark 'CALCIBLOC' owned by Opposer, and duly registered with this Honorable Bureau prior to the publication for opposition of the mark 'CALCITECT'.

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

"9. The registration of the trademark 'CALCITECT' in the name of the Respondent-Applicant will violate Sec. 123 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, which provides, in part, that a mark cannot be registered if it:

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

² A domestic corporation with address at Unit F 16th Floor One Joroma Place, San Beda Street, Congressional Avenue, Quezon City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

(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;

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.

The Opposer also alleges, among others, the following facts:

“10. Opposer is the registered owner of the trademark ‘CALCIBLOC’.

“10.1. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. The trademark application for the trademark ‘CALCIBLOC’ was filed with the Bureau of Patents, Trademark and Technology Transfer on 26 May 1989 by Opposer’s sister company, Therapharma, Inc. and was approved for registration on 3 August 1990 to be valid for a period of twenty (20) years, or until 3 August 2010.

“10.2. In the meantime, on 4 March 2009. Therapharma Inc. assigned the trademark to herein Opposer.

“10.3. Before the expiration of the registration, on 30 July 2010, Opposer filed an application for renewal of the registration of the trademark ‘CALCIBLOC’ with the IPO.

“11. The trademark ‘CALCIBLOC’ has been extensively used in commerce in the Philippines.

xxx

“11.3. No less than the Intercontinental Marketing Services (‘IMS’) itself, the world’s leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand ‘CALCIBLOC’ as one of the leading brands in the Philippines in the category of ‘COBA- Calcium Antagonist Plain Market’ in terms of market share and performance.

“11.4. 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’).

“11.5. By virtue of the foregoing, there is no doubt that the Opposer has acquired an exclusive ownership over the trademark ‘CALCIBLOC’ to the exclusion of all others. xxx”

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of relevant page of Intellectual Property Office (“IPO”) E-Gazette;
2. Copy of Registration No.4881, registered on 3 August 1990 for the mark "CALCIBLOC" covering goods under class 5, namely: "medicinal preparations indicated for prophylaxis and treatment of angina, myocardial infarction and all forms of hypertension";
3. Copy of Assignment of Registered Trademark recorded on 4 March 2009;
4. Copy of Renewal of Registration dated 30 July 2010;
5. Copy of Affidavits 4 August 1995, 9 August 2000 and 14 September 2005;
6. Sample packaging for the pharmaceutical product "CALCIBLOC";
7. Certification from Intercontinental Marketing Services dated 11 October 2010; and
8. Copy of Certificate of Product Registration from the Bureau of Food and Drugs (BFAD) dated 1 June 2014.

This Bureau served upon the Respondent-Applicant a “Notice to Answer” dated 23 February 2011 which was received on 15 March 2011. The Respondent-Applicant however did not file an Answer.

Records show that at the time Respondent-Applicant applied for registration of the mark “CALCITECT” the Opposer already registered the mark “CALCOBLOC” under of Registration No. 48810. The goods covered by the Opposer’s trademark registration are also under Class 05, namely: “medicinal preparations indicated for prophylaxis and treatment of angina, myocardial infarction and all forms of hypertension”, while the Respondent-Applicant’s trademark application indicates use as “supplement/multivitamins”.

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

The competing marks are reproduced below:

Calcibloc

Opposer’s mark

Calcitect

Respondent-Applicant’s mark

The marks are similar with respect to the prefix, (“CALCI”). Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur.

"CALCI" as an affix or component of trademarks for use on goods under class 5 is not unique to the Opposer. The Trademarks Registry, the contents of which this Bureau can take cognizance of via judicial notice, shows registered marks, with the affix "CALCI", belonging to different proprietors. Also, there is a reason to infer that the "CALCI" in "CALCIBLOC" was derived from the word "CALCIUM". The Opposer itself, made reference in its Verified Opposition to "CALCIBLOC" as "one of the leading brands in the Philippines in the category of 'COPA-Calcium Antagonists Plain Market' in terms of market share and sales performance. Thus, "CALCIBLOC" as a trademark can be classified as a suggestive mark, which is a weak mark. To sustain the opposition on the ground of the commonality between the marks as to the affix "CALCI" would have the effect of giving the Opposer exclusive use of the affix as a mark and/or as part thereof for use on "calcium antagonists" and related products.

Thus, determining whether the competing marks are confusingly similar is to look for the letters or syllables appended to affix "CALCI". In this regard, the suffixes of the marks, "BLOC" and "TECT" are very phonetically dissimilar. When pronounced, the resultant words have a different sound. Visually and aurally the marks are not the same.

It is noteworthy that the products involved in this case are pharmaceutical products, where the purchaser will be more wary and exercise precaution in buying these. The Supreme Court in *Etepha A. G v. Director of Patents*⁴ is relevant to this case, to wit:

In the solution of a trademark infringement problem, regard too should be given to the *class* of persons who buy the particular product and the circumstances ordinarily attendant to its acquisition.¹⁶ The medicinal preparation clothed with the trademarks in question, are unlike articles of everyday use such as candies, ice cream, milk, soft drinks and the like which may be freely obtained by anyone, anytime, anywhere. Petitioner's and respondent's products are to be dispensed upon medical prescription. The respective labels say so. An intending buyer must have to go first to a licensed doctor of medicine; he receives instructions as to what to purchase; he reads the doctor's prescription; he knows what he is to buy. He is not of the incautious, unwary, unobservant or unsuspecting type; he examines the product sold to him; he checks to find out whether it conforms to the medical prescription. The common trade channel is the pharmacy or the drugstore. Similarly, the pharmacist or druggist verifies the medicine sold. The margin of error in the acquisition of one for the other is quite remote.

We concede the possibility that buyers might be able to obtain Pertussin or Attusin without prescription. When this happens, then the buyer must be one thoroughly familiar with what he intends to get, else he would not have the temerity to ask for a medicine — specifically needed to cure a given ailment. In which case, the more improbable it will be to palm off one for the other. For a person who purchases with open eyes is hardly the man to be deceived.


WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-011762 is hereby **DISMISSED**. Let the filewrapper of the

⁴ G.R. L. No. 20635, 31 March 1996

subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 25 May 2015.


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