



THERAPHARMA, INC.,
Opposer,

-versus-

ALKEM LABORATORIES, LTD.,
Respondent-Applicant.

}
} **IPC No. 14-2009-00252**
} Opposition to:
} Appln. Serial No. 4-2009-001548
} Date Filed: 13 February 2009
} **TM: "ATVAS"**
}

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NOTICE OF DECISION

OCHAVE & ESCALONA
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GREETINGS:

Please be informed that Decision No. 2015 - 117 dated June 23, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 23, 2015.

For the Director:


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



THERAPHARMA, INC.,

Opposer,

-versus-

ALKEM LABORATORIES, LTD.

Respondent-Applicant.

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IPC No. 14-2009-00252

Opposition to:

Application No. 4-2009-001548

Date Filed: 13 February 2009

Trademark: "ATVAS"

Decision No. 2015- 117

DECISION

THERAPHARMA, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2009-001548. The application, filed by ALKEM LABORATORIES, LTD.² ("Respondent-Applicant"), covers the mark "ATVAS" for use as "pharmaceutical products namely, cholesterol management drugs" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"GROUNDS FOR OPPOSITION"

"The grounds for this Verified Opposition are as follows:

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

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

"9. The registration of the mark 'ATVAS' in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides, in part, that a mark cannot be registered if it:

xxx

¹A domestic corporation organized and existing under the laws of the Philippines with principal business address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

²A foreign corporation with principal business address at Devashish, Alkem House, Senapati Bapat Marg, Lower Parel, Mumbai India.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"10. 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.

"ALLEGATIONS IN SUPPORT OF THE OPPOSITION

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

"11. Opposer is the registered owner of the trademark 'AMVASC'. It is engaged in the marketing and sale of a wide range of pharmaceutical products.

"12. The trademark application for the trademark 'AMVASC' was filed with the Intellectual Property Office on 16 January 2006 by Opposer and was approved for registration on 19 March 2007 to be valid for a period of ten (10) years, or until 19 March 2017. Thus, the registration of the trademark 'AMVASC' subsists and remains valid to date. x x x

"13. The trademark 'AMVASC' has been extensively used in commerce in the Philippines.

"13.1. Opposer has dutifully filed a Declaration of Actual Use pursuant to the requirement of the IP Code. A copy of the Declaration of Actual Use filed by Opposer is hereto attached x x x.

"13.2. A sample product label bearing the trademark 'AMVASC' actually used in commerce is hereto attached x x x.

"13.3. 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 'AMVASC' as one of the leading brands in the Philippines in the category of 'CO8A Calcium Antagonists Plain' in terms of market share and sales performance. x x x

"13.4. In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, Opposer registered the product with the Bureau of Food and Drugs ('BFAD'). A copy of the Certificate of Product Registration issued by the BFAD for the trademark 'AMVASC' is hereto attached x x x

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

"13.6. 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.'

"14. The registration of Respondent-Applicant's 'ATVAS' will be contrary to Section 123.1 (d) of the IP Code. 'ATVAS' is confusingly similar to 'AMVASC'.

"14.1. There are no set rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or is a colorable imitation of, another. Nonetheless, jurisprudence provides enough guidelines and tests to determine the same.

"14.1.1. In fact, in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* (356 SCRA 207, 216 [2001]), the Supreme Court, citing *Ethepa v. Director of Patents* (16 SCRA 495, 497-498 [1966]), held "[i]n determining if colorable imitation exists, jurisprudence has developed two kinds of tests - the Dominancy Test and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitute infringement. On the other side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity."

"14.1.2. It is worthy to note at this point that in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* (supra, p. 221) the Supreme Court held "[T]he totality or holistic test only relies on visual comparison between two trademarks whereas the dominancy test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks."

"14.1.3. Relative thereto, the Supreme Court in *McDonalds' Corporation vs. L.C. Big Mak Burger, Inc.* (437 SCRA 10, 32-33 [2004]) held:

"14.1.4. This was affirmed in *McDonald's Corporation vs. MacJoy Fastfood Corporation* (514 SCRA 95, 109 [2007]), which held that, '[t]he Court has consistently used and applied the dominancy test in determining, confusing similarity or likelihood of confusion between competing trademarks.'

"14.1.5. In fact, the dominancy test is 'now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the colorable imitation of a registered mark x x x or a dominant feature thereof.'

"14.1.6. Thus, applying the dominancy test in the instant case, it can be readily concluded that the mark 'ATVAS', owned by Respondent-Applicant, so resembles Opposer's trademark 'AMVASC', that it will likely cause confusion, mistake and deception on the part of the purchasing public.

"14.1.6.1. First, Respondent-Applicant's mark 'ATVAS' appears and sounds almost the same as Opposer's trademark 'AMVASC'.

"14.1.6.2. Second, both marks starts with the letter 'A'.

"14.1.6.3. Third, both marks are composed of two syllables '/AT/-/VAS/' and '/AM/-/VASC/'.

"14.1.6.4. Fourth, the last syllable of both marks '/VAS/' and '/VASC/' sounds exactly the same as the letter 'C' in Opposer's trademark 'AMVASC' is pronounced silently.

"14.1.6.5. Fifth, Respondent-Applicant merely changed the second letter of Opposer's trademark 'AMVASC' from 'M' to letter 'T' and removed the last letter 'C' of Opposer's trademark 'AMVASC' (which is pronounced silently as shown in the preceding paragraph) in arriving at the mark 'ATVAS'.

"14.1.7. Clearly, the Respondent-Applicant's mark 'ATVAS' adopted the dominant features of the Opposer's trademark 'AMVASC'.

"14.1.8. As further ruled by the High Court in the McDonald's Corporation case (supra p. 33-34 [2004]):

"14.1.9. In American Wire & Cable Co., vs. Director of Patents (31 SCRA 544, 547-548 [1970]), the Supreme Court explained:

x x x

"14.2. Opposer's trademark 'AMVASC' and Respondent-Applicant's mark 'ATVAS' are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

"14.3. Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed mark 'ATVAS' is applied for the same class and goods as that of trademark 'AMVASC' under Class 05 of the International Classification of Goods for treatment of hypertension.

"14.4. Yet, Respondent-Applicant still filed a trademark application for 'ATVAS' despite its knowledge of the existing trademark registration of 'AMVASC', which is confusingly similar thereto in both its sound and appearance to the extreme damage and prejudice of Opposer.

"14.5. Opposer's intellectual property right over its trademark is protected under Section 147 of the IP Code, which states:

x x x

"14.6. 'When, as in the present case, one applied for the registration of at trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill.' x x x

"15. To allow Respondent-Applicant to continue to market its products bearing the mark 'ATVAS' undermines Opposer's right to its trademark. As the lawful owner of the trademark 'AMVASC', 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.

"15.1. Being the lawful owner of the trademark 'AMVASC', Opposer has the exclusive right to use and/or appropriate the said marks and prevent all third parties not having its consent from using in the course of trade identical or similar marks, where such would result in a likelihood of confusion.

"15.2. By reason of Opposer's ownership of the trademark 'AMVASC', it also has the right to prevent third parties, such as Respondent-Applicant, from claiming ownership over Opposer's marks or any depiction similar thereto, without its authority or consent.

"15.3. Moreover, following the illustrative list of confusingly similar sounds in trademarks cited in McDonald's Corporation case (supra, p. 34), it is evident that the Respondent-Registrant's mark 'ATVAS' is aurally confusingly similar to Opposer's trademark 'AMVASC':

x x x

"15.4. Further, the fact that Respondent-Applicant seeks to have its mark 'ATVAS' registered in the same class (Nice Classification 05) as Opposer's trademark 'AMVASC', coupled by the fact that both are for treatment of hypertension, will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

"16. By virtue of Opposer's prior and continued use of the trademark 'AMVASC', the same has become well-known and established valuable goodwill to the consumers and the general public as well. The registration and use of Respondent-Applicant's confusingly similar mark 'ATVAS' on its goods 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-Applicant is in any way connected with Opposer.

"16.1. As held in *Sterling Products International, Inc. vs. Farbenfabriken Bayer Aktiengesellschaft, et. al.* (27 SCRA 1214, 1227 [1968]) there are two types of confusion in trademark infringement. 'The first is the confusion of goods' in which event the ordinarily prudent purchaser would be induced to purchase one 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 former reflects adversely on the plaintiff's reputation.' The other is the confusion of business: 'Here 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 be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist.'

"16.2. The doctrine of confusion of business or origin is based on cogent reasons of equity and fair dealing. It has to be realized that there can be

unfair dealing by having one's business reputation confused with another. 'The owner of a trademark or trade name has a property right in which he is entitled to protection, since there is damage to him from confusion of reputation or goodwill in the mind of the public as well as from confusion of goods.' (*Ang vs. Teodoro*, 74 Phil 50, 55-56 [1942]).

"16.3. Applying the foregoing to the instant case, to allow Respondent-Applicant to use its mark 'ATVAS' on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the product of Respondent-Applicant originate from or is being manufactured by Opposer, or at the very least, is connected or associated with the 'AMVASC' product of Opposer, when such connection does not exist.

"16.4. In *Canon Kabushiki Kaisha vs. Court of Appeals* (336 SCRA 266, 275 [2000]), the Supreme Court explained that:

x x x

"16.5. Clearly, the scope of protection accorded to trademark owners includes not only confusion of goods but also confusion of origin. As in this case, besides from the confusion of goods already discussed, there is undoubtedly also a confusion of the origin of the goods covered by the marks of Respondent-Applicant and the Opposer, which should not be allowed.

"17. In case of grave doubt, the rule is that, '[a]s between a newcomer [Respondent-Applicant] who by confusion has nothing to lose and everything to gain and one [Opposer] who by honest dealing has already achieved favor with the public, any doubt should be resolved against the newcomer [Respondent-Applicant] inasmuch as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.' [Bracketed supplied] (*Del Monte Corporation, et. al. vs. Court of Appeals*, 181 SCRA 410, 420 [1990])

"17.1. In *American Wire & Cable Co., vs. Director of Patents* (*supra*, p. 551), it was observed that:

x x x

"17.2. When, as in the instant case, Respondent-Applicant used, without a reasonable explanation, a confusingly similar, if not at all identical, trademark as that of Opposer 'though the field of its selection was so broad, the inevitable conclusion is that it was done deliberately to deceive.' (*Del Monte Corporation, et. al. vs. Court of Appeals*, *supra*, p. 419-420).

"18. Respondent-Applicant's use of the mark 'ATVAS' in relation to any of the goods covered by opposed application, if these goods are considered not similar or closely related to the goods covered by Opposer's trademark 'AMVASC', will take unfair advantage of, dilute and diminish the distinctive character or reputation of the latter mark. Potential damage to Opposer will be caused as a result of its inability to control the quality of the products put on the market by Respondent-Applicant under the mark 'ATVAS'.

"19. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent-Applicant of the mark 'ATVAS'. The denial of the application subject of this Opposition is authorized under the IP Code.

"20. In support of the foregoing, the instant Opposition is herein verified by Mr. John E. Dumpit, which likewise serves as his affidavit (Nasser v. Court of Appeals, 191 SCRA 783 [1990]).

The Opposer's evidence consists of copies of pertinent pages of the IPO E-Gazette released on 27 July 2009; a copy of the certificate of registration No. 4-2006-000470 for the trademark AMVASC with filing date on 16 January 2006; a copy of Declaration of Actual Use for the trademark AMVASC; a sample product label bearing the trademark AMVASC; a copy of the certification and sales performance for the trademark AMVASC issued by the Intercontinental Marketing Services ("IMS"); and, a copy of the certification of product registration issued by BFAD for the trademark AMVASC.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 24 November 2009. The Respondent-Applicant filed its Answer on 24 March 2010 alleging among other things:

xxx

"Affirmative Allegations and Specific Defenses

"5. The foregoing allegations are reproduced and repleaded herein by way of reference.

"6. Respondent-Applicant disagrees with the theory of Opposer that the registration of the mark 'ATVAS' will likely cause confusion and mistake on the part of the general consuming public.

"7. Much is made of the argument that visually and aurally, the marks are confusingly similar. Opposer also makes much of the fact that both marks fall under Class 05 - which Opposer mistakenly limits to 'treatment of hypertension'.

"8. As will be shown hereunder, the grounds set forth in the Opposition have no basis, and necessarily, the same must be denied.

"9. Class 05 of the International Classification of Goods is not limited to 'treatment of hypertension.' The Opposer misleads when it argues that the competing marks 'ATVAS' and 'AMVASC' fall under the 'Class 05 of the International Classification of Goods for treatment of hypertension.' Truly, goods intended for the treatment of hypertension do not belong to a class of their own.

"10. Under the Nice International Classification of Goods and Services, Class 05 includes the following products:

x x x

"11. While it may be that both goods are sought to be registered under Class 05 of the International Classification of Goods, Respondent-Applicant respectfully submits that

⁴Marked as Exhibits "A" and "F", inclusive.

the mark 'ATVAS' may validly be registered without creating a likelihood of confusion with the mark 'AMVASC.'

"12. Preliminarily, Respondent-Applicant wishes to highlight that the drug to be marketed and sold under the mark 'ATVAS' is not for treatment of hypertension. It falls under Class 05 for being a drug intended to control cholesterol.

"13. As will be shown hereunder, the attitude of the purchasers of these drugs, as well as the provisions of The Generics Act, as amended by the Universally Accessible Cheaper and Quality Medicines Act of 2008 not only reduce the likelihood of confusion, they negate it.

"14. No likelihood of confusion. Likelihood of confusion or deception is a relative concept, a determination of which can only be arrived at by taking into consideration the peculiar and distinct circumstances surrounding each case. It is respectfully submitted that, after a thorough examination of the circumstances of this case, the inevitable conclusion is that the registration of the mark 'ATVAS' will not result in a likelihood of confusion with the mark 'AMVASC'.

"15. In discussing whether the marks 'ATVAS' and 'AMVASC' are confusingly similar, a comparison of the drugs which are to be sold under these marks is also necessary.

"16. The products to be sold under the names 'ATVAS' and 'AMVASC' are not ordinary goods. The drugs 'ATVAS' and 'AMVASC' are prescription medication. They cannot ordinarily be obtained over the counter as with common everyday consumer goods.

"17. Jurisprudence teaches us that as a factor in determining whether there is likelihood of confusion, we must look into the nature of the goods bearing the marks. In the case of *Lim Hoa vs. Director of Patents* the general rule was laid that the risk of confusion is less where the items are of greater value:

x x x

"18. Respondent-Applicant respectfully submits that an equal, if not greater, degree of care and caution likewise permeates in the purchase of drugs and medicines. It bears stressing that in purchasing drugs and medicines, the primary concern of the purchaser is his health and well-being. A prudent individual will not obtain medication with wanton disregard or without first properly informed and advised as to the type of medication that he needs.

"19. Opposer's drug is used in the treatment of hypertension - high blood pressure. It is not ordinary painkiller or treatment for sore throat. Rather, the condition sought to be treated is a serious one. As such, one can be expected to approach the situation with even greater care.

"20. In the case of *Etepha vs. Director of Patents*, the Supreme Court opined that where the goods involved are prescription medication, the likelihood of confusion is minimal, if not absent:

x x x

"21. A similar conclusion was reached in the case of Bristol Myers Company vs. Director of Patents, to wit:

x x x

"22. Taking the above-cited cases into consideration, it is plain that the mere aural and visual similarities of the words as alleged by Opposer are not sufficient to warrant the denial of the application for the mark 'ATVAS.'

"23. Clearly, a mere side-by-side comparison of the words 'ATVAS' and 'AMVASC' will not do. The method employed by Opposer is extremely short-sighted.

"24. Different generic names. As has been stated above, the drugs involved in this case do not serve the same purpose. Proof of this can be found in the generic names of the respective drugs.

"25. The sample packaging of 'AMVASC' of the Opposer displays in bold characters that the drug has the generic name amlodipine besilate. By its own statements, we likewise know that the purpose of the drug is to treat hypertension.

"26. The drug 'ATVAS' will be made up of atorvastatin. It is a drug to be used for the control of cholesterol. Clearly, although both products fall under Class 05, they are different products for different ailments. They cannot be interchanged.

"27. Moreover, due to the passage of The Universally Accessible Cheaper and Quality Medicines Act, the following amendment to Section 6 of the Generics Act of 1988 was made:

x x x

"28. With the heightened awareness and emphasis placed on the generic names of drugs, the likelihood of confusion between 'ATVAS' (atorvastatin) and 'AMVASC' (amlodipine), is reduced to nil. Clearly, the 'word-centered' approach adopted by the Opposer has been rendered meaningless by the passage of the new law.

"29. Taking into account the doctrine in the Etepha case above and the provisions of the Generics Act of 1988 a typical transaction for the purchase of these drugs is as follows:

x x x

"30. Distinct packaging negates possibility of confusion; no visual similarity. To further show that the possibility of confusion arising from the registration of the mark 'ATVAS' is nil, Respondent-Applicant attaches hereto a photograph of the packaging of the product.

"31. A simple visual comparison between the product packaging will suffice to erase the apprehensions and fears of Opposer. The likelihood of confusion of origin is negated by the fact that the name and logo of the manufacturer is boldly indicated on the box. Additionally, the large font indicating the generic name of the drug, as required by law, clearly distinguishes ATVAS from AMVASC.

"32. The possibility of confusing the consumer is likewise negated by the label stating that a prescription is required.

x x x

"33. Respondent-Applicant did not adopt the dominant features of the mark 'AMVASC'. Opposer accuses the Respondent-Applicant of deliberately using a confusingly similar brand name without reasonable explanation. The allegation is simply untrue. Alken Laboratories, Limited is one of the largest manufacturers of pharmaceutical products in India. It has made its mark in other countries as well, and is now expanding its reach in the Philippines.

"34. The mark 'ATVAS' has been previously used by Alkem to market its drug with the chemical composition atorvastatin in India. By no stretch of the imagination can it be gainsaid that the application for registration of the mark 'ATVAS' is intended solely to ride off of the goodwill generated by the mark 'AMVASC'.

"35. All told, the fears of Opposer that the allowance of the registration of the mark 'AMVASC' will damage its reputation, destroy its goodwill, and hamper its growth are more imagined than real. The mark 'ATVAS' does not infringe upon the mark 'AMVASC'. Based on the foregoing discussion, it is plain that there is no likelihood of confusion of goods or confusion of origin. The Opposition must be dismissed and Trademark Application No. 4-2009-001548, approved.

The Respondent-Applicant's evidence consists of a photograph of the packaging for the mark ATVAS highlighting the name of the manufacturer, Alkem Laboratories, Inc. and the label requiring a doctor's prescription.⁵

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

Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

Sec. 123. Registrability. - 123.1. 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;"

Records show that at the time the Respondent-Applicant filed its trademark application on 13 February 2009, the Opposer has an existing trademark registration for the mark AMVASC under Certificate of Registration No. 4-2006-000470 issued on 19 March 2007. The registration covers medicinal preparation for the treatment of hypertension, chronic stable angina and myocardial ischemia due to vasospastic angina under Class 05. This Bureau noticed that the goods indicated in the Respondent-

⁵Marked as Exhibit "1".

Applicant's trademark application, i.e. pharmaceutical products namely, cholesterol management drugs under Class 05, are closely-related to the Opposer's.

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

Amvasc

ATVAS

Opposer's trademark

Respondent-Applicant's mark

Confusion is likely in this instance because of the close resemblance between the marks. Both marks have the same number of syllables: /AM/VASC for Opposer's and /AT/VAS for Respondent-Applicant's. Both marks start with the letter "A" and end with the same sounding suffixes "VASC" and "VAS". It could result to mistake with respect to perception because the marks sound so similar. Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"⁶, "SAPOLIN" and LUSOLIN⁷, "CELDURA" and "CORDURA"⁸, "GOLD DUST" and "GOLD DROP". The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS": the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance...."SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.⁹

It is emphasized that 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

⁶ *MacDonalds Corp, et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

⁷ *Sapolin Co. v. Balmaceda and Germann & Co.*, 67 Phil, 705.

⁸ *Co Tiong SA v. Director of Patents*, G.R. No. L- 5378, 24 May 1954; *Celanes Corporation of America vs. E. I. Du Pont de Nemours & Co.* (1946), 154 F. 2d 146 148.)

⁹ *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297, 22 Dec. 1966.


sale of an inferior and different article as his product.¹⁰ This Bureau finds that the mark applied for registration by the Respondent-Applicant does not meet this function.

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1(d) (iii) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-001548 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 June 2015.


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

¹⁰ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Eihepa v. Director of Patents*, *supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).