



F. HOFFMANN-LA ROCHE AG,
Opposer,

-versus-

OEP PHILIPPINES , INC.,
Respondent-Applicant.

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}
} **IPC No. 14-2012-00097**
} Opposition to:
} Appln. Serial No.4-2009-002652
} Date filed: 27 October 2011
} **TM: "KYTRON"**
}

NOTICE OF DECISION

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OEP PHILIPPINES, INC.
Respondent-Applicant
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Legaspi Village, Makati City

GREETINGS:

Please be informed that Decision No. 2015 - ____ dated June 29, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 29, 2015.

For the Director:

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



F. HOFFMANN-LA ROCHE AG,
Opposer,

-versus-

OEP PHILIPPINES, INC.,
Respondent-Applicant.

}IPC NO. 14-2012-00097
}Opposition to:
}
}Appln. Ser. No. 4-2011-012988
}Date Filed: 27 October 2011
}
}Trademark: "KYTRON"
}
}Decision No. 2015-

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DECISION

F. HOFFMANN-LA ROCHE AG ., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-012988. The application, filed by OEP PHILIPPINES, INC. (Respondent-Applicant)², covers the mark "KYTRON", for use on "pharmaceutical product taken intravenously for the prevention and treatment of chemotherapy induced nausea and vomiting and post-operative nausea and vomiting" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"1. Opposer is the first user and true owner of the trademark KYTRIL, being the successor-in-interest to the mark which was first registered in the Philippines under Reg. No. 58221 issued on June 2, 1994 in the name of Beecham Group, plc. And subsequently assigned to the Opposer which covers 'preparations for the treatment of nausea and vomiting induced by estostatic therapy for cancer patients' in class 5. Moreover, Opposer has been using the trademark KYTRIL specifically in respect of preparations for the 'management of nausea and vomiting induced by cytotoxic chemotherapy and radiotherapy and for the prevention and treatment of post-operative nausea and vomiting' since approval of its product launching by the then Bureau of Food and Drugs in 2000, long before the Applicant appropriated the mark KTRON for use on identical products. Opposer has been actively promoting and selling KYTRIL in the Philippines since its launching and to date, it remains to be one of the most recognized and accepted preparations for the

¹ A corporation duly organized and existing under the laws of Switzerland with principal address at F. Hoffmann-la Roche AG, Grenzacherstrasse 124, 4070 Basel, Switzerland

² A Philippine corporation with address at Unit 606 SEDCO Bldg I, cor Rada & Legaspi Sts., Legaspi Village, Makati 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.

treatment of chemotherapy-related nausea and vomiting by doctors and patients in the country.

"2. Applicant's trademark KYTRON, as used on pharmaceutical preparations for the treatment of chemotherapy induced nausea and vomitin, so closely, visually and aurally, resembles Opposer's trademark KYTRIL as also used on identical pharmaceutical preparations in class 5 as to be likely, when applied to or used in connection with the goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public. The registration and use of a confusingly similar trademark by the Applicant will tend to deceive and/or confuse purchasers into believing that Applicant's products emanate from or are under the sponsorship of Opposer, for the following reasons:

- i) The trademarks are closely or confusingly similar;
- ii) The trademarks are applied on identical goods;
- iii) The parties are engaged in competitive business; and
- iv) The goods on which the trademarks are used are bought by the same class of purchasers and flow through the same channels of trade.xxx"

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

1. Authenticated and notarized Affidavit of Tapio Blanc dated 3 April 2012;
2. Certified true copy of Certificate of Registration No. 58211 for the mark "KYTRIL" issued on 2 June 1994;
3. Certified true copy of Certificate of Product Registration DR-XY25012 dated 15 June 2010 issued by the Bureau of Food and Drugs;
4. Certified true copy of Certificate of Product Registration DR-XY15996 dated 17 August 2000 issued by the Bureau of Food and Drugs;
5. Customer list;
6. Sample label/package of "KYTRIL"; and
7. Medical Literature for "KYTRIL".⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 16 May 2012. The Respondent-Applicant, however, did not file an Answer. The Hearing Officer issued on 7 February 2013 Order No. 2013-219, declaring the Respondent-Applicant in default.

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

Sec. 123.1. Registrability. 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:

⁴ Exhibits "A" to "I"

- (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 show that when the Respondent-Applicant filed its application on 27 October 2011, the Opposer already has an existing registration for the trademark KYTRIL under Certificate of Registration No. 58211 for the mark "KYTRIL" issued on 2 June 1994⁵. The Opposer's trademark registration covers "Preparation for treatment of nausea and vomiting induced by cystostatic therapy for cancer patients". The Respondent-Applicant's trademark application therefore indicates goods that are similar to the Opposer's.

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

Opposer's mark

Respondent-Applicant's mark

The marks have the same first four (4) letters "K-Y-T-R". In this regard, this Bureau finds that the mark KYTRIL is unique and highly distinctive and used on the same goods and products. The entire mark or the first four letters "KYTR" thereof do not, correspond to the generic name of the pharmaceutical product on which it is used, that is, which generic name is "GRANISETRON".⁶ Neither does the mark, describes or suggests such pharmaceutical product. Thus, the adoption by Respondent-Applicant of a mark similar to the Opposer's arbitrary mark, KYTRIL, is likely to cause mistake, confusion and deception among the purchasing public. The Supreme Court in the case of Marvex Commercial Co., Inv. V. Petra Hawpia & Co. and the Director of Patents⁷ is instructive on the matter, 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 (Co Tiong Sa vs. Director of Patents, 95 Phil. 1 citing Nims, The Law of Unfair Competition and Trademarks, 4th ed., vol. 2, pp. 678-679). xxx

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jazz-Sea";

⁵ Exhibit "B"

⁶ Exhibit "G"

⁷ G.R. No. L-19297, 22 December 1966

"Silver Flash" and "Supper-Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "TradeMark Law and Practice", pp. 419-421, cites, as coming within the purview of the *idem sonans* rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.

In the case at bar, "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 (see *Celanese Corporation of America vs. E. I. Du Pont*, 154 F. 2d. 146, 148).

Succinctly, the public may also be misled into believing that one mark is just a variation of the other. Thus, the public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. 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 sale of an inferior and different article as his product.⁸

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-012988 is hereby **SUSTAINED**. Let the filewrapper of the 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, 29 June 2015.

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

⁸*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha 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).