



GLAXO GROUP LIMITED,  
Opposer,

-versus-

KOREA UNITED PHARM. INC.,  
Respondent-Applicant.

}  
} IPC No. 14-2014-00517  
} Opposition to:  
} Appln. Serial No. 4-2014-0009128  
} Date Filed: 23 July 2014  
} TM: "HEPSA"  
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**NOTICE OF DECISION**

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**UNITED DOUGLAS PHARM PHILIPPINES, INC.**


Respondent-Applicant's Representative  
Unit 2502 -B East Tower, Philippine Stock Exchange Bldg.  
Exchange Road, Ortigas Center  
Pasig City

**GREETINGS:**

Please be informed that Decision No. 2015 - 132 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. DATING**  
Director III  
Bureau of Legal Affairs



GLAXO GROUP LIMITED, } IPC NO. 14-2014-00517  
Opposer, } Opposition to:  
-versus- }  
} Appln. Ser. No. 4-2014-0009128  
} Date Filed: 23 July 2014  
} Trademark: "HEPSA"  
KOREA UNITED PHARMA INC., }  
Respondent-Applicant. }  
x-----x } Decision No. 2015- 132

### DECISION

GLAXO GROUP LIMITED, (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2014-0009128. The application, filed by KOREA UNITED PHARMA INC. (Respondent-Applicant)<sup>2</sup>, covers the mark "HEPSA", for use on "pharmaceutical preparations" under Class 5 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the following grounds:

"1. Sections 123.1 (d), of R.A. 8293, otherwise known as the Intellectual Property Code (hereinafter 'the Code') proscribes the registration of the mark HEPSA.

Section 123.1 (d) of the Code reads as follows:

Section 123. Registrability.-123.1. 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:
  - (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;

<sup>1</sup> A corporation duly organized and existing under the laws of England and Wales with address at 980 Great West Road, Brentford, Middlesex, TWG 9GS, England

<sup>2</sup> A foreign corporation with address at 154-8 Nonhyun-Dong Kangnam-Gu Seoul, Korea

<sup>3</sup> 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.

"2. Opposer, as registrant of the trademark HEPSERA, has an exclusive right to use the said trademark in connection with the pharmaceutical products covered by Trademark Registration No. 4-2002-010730. Section 138 and 147 of the Code provides: xxx

"3. Respondent-Applicant's HEPSERA trademark is identical, or at the very least, confusingly similar to Opposer's HEPSERA trademark as may be observed hereunder: xxx

- a. HEPSERA and HEPSE have the same first four (4) letters 'HEPS' and the same last letter 'A'.
- b. The two trademarks are also spelled almost exactly the same, the only difference being the two additional letters 'ER' sandwiched between 'HEPS' and 'A' in 'HEPSE'.
- c. Thus, the two trademarks have approximately the same starting sounds, making them aurally similar.
- d. HEPSE viewed as a whole is not very different or distinctive from HEPSE.
- e. Evidently, the resemblance and similarities between Opposer's trademark HEPSE and the subject trademark HEPSE are such that they are likely to deceive or cause confusion to the public that pharmaceutical preparations bearing the mark HEPSE are variations of Opposer's goods bearing the HEPSE mark.
- f. Opposer's trademark HEPSE was registered with the Honorable Office in respect of pharmaceutical preparations and substances used for the treatment of viral conditions, namely, Human Immunodeficiency Virus (HIV), Hepatitis, Herpes Genitalis, Herpes labialis, Herpes Simplex Virus, Varicella-Zoster Virus, Epstein-Barr Virus and Cytomegalovirus' in class 5 on 30 July 2006, or almost eight (8) years before Respondent-Applicant filed the subject Trademark Application No. 4-2014-009128 for HEPSE in respect of '[p]harmaceutical preparations' also in class 5 on 23 July 2014.

"4. As stated above, the trademark HEPSE designates 'pharmaceutical preparations' in class 5 in the same way that Opposer's HEPSE trademark designates pharmaceutical preparations in the same class of goods. Stated otherwise, the parties respective pharmaceutical goods are used for the same purposes and necessarily flow through the same trade channels.

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

"1. Opposer is the owner and registrant of the trademark HEPSE covered by Registration No. 4-2002-010730 issued on 30 July 2006. The registration covers pharmaceutical preparations and substances used for the treatment of viral conditions, namely, Human Immunodeficiency Virus (HIV), Hepatitis, Herpes Genitalis, Herpes labialis, Herpes

Simplex Virus, Varicella-Zoster Virus, Epstein-Barr Virus and Cytomegalovirus' in class 5.

"2. Opposer has registered and/or applied for the registration of the trademark HEPSERA all over the world.

"3. Opposer's goods bearing the trademark HEPSERA are widely used worldwide, earning the trademark an international reputation in the pharmaceutical industry.xxx"

To support its opposition, the Opposer submitted as evidence, the authenticated and notarized Affidavit of Joanne B. Greene dated 15 January 2015<sup>4</sup>.

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 5 February 2015. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 24 June 2015 Order No. 2015-904 declaring the Respondent-Applicant to have waived its right to file an Answer.

Records show that at the time Respondent-Applicant applied for registration of the mark "HEPSA" the Opposer already registered the mark HEPSERA under Certificate of Registration No. 4-2002-010730 issued on 30 July 2006. The goods covered by the Opposer's trademark registration are also under Class 05, same as indicated in the Respondent-Applicant's trademark application.

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:

**HEPSERA**

Opposer's mark

**HEPSA**

Respondent-Applicant's mark

The marks are similar with respect to the four first letters, "H-E-P-S" and the last letter "A". The inclusion of the letters "ER" in the last syllable is inconsequential. The resultant marks when pronounced are *idem sonans* or phonetically similar. Visually and aurally the marks are confusingly similar. The Supreme Court held:

As to the syllabication and sound of the two trade-names "Sapolin" and "Lusolin" being used for paints, it seems plain that whoever hears or sees them cannot but think of paints of the same kind and make. In a case to determine whether the use of the trade-name "Stephens' Blue Black Ink" violated the trade-name "Steelpens Blue Black Ink", it was said and held that there was in fact a violation; and in other cases it was held that trade-names *idem sonans* constitute a violation in matters of patents and trade-marks and trade-names. (Nims on Unfair

<sup>4</sup> Exhibit "A" inclusive of submarkings

Competition and Trade-Mark, sec. 54, pp. 141-147; N. K. Fairbanks Co. vs. Ogden Packing and Provision Co., 220 Fed., 1002.)<sup>5</sup>

Likewise, the Supreme Court in the case of Marvex Commercial Co., Inv. V. Petra Hawpia & Co. and the Director of Patents<sup>6</sup> 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"; "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).

The Opposer submitted proof of its ownership of the "HEPSERA" mark, such as its Philippine registration of the mark "HEPSERA"<sup>7</sup> and registrations of the mark in other countries such as Peru, Singapore and Hongkong<sup>8</sup>. It also submitted representative sales invoices indicating the name "HEPSERA"<sup>9</sup> to prove commercial use in the Philippines.

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

<sup>5</sup> *Sapolin Co., Inc. v. Balmaceda*, G.R. No. L-45502, 2 May 1939

<sup>6</sup> G.R. No. L-19297, 22 December 1966

<sup>7</sup> Exhibit "A-1"

<sup>8</sup> Exhibits "A-3", "A-4" and "A-5"

<sup>9</sup> Exhibit "A-7" and "A-8"

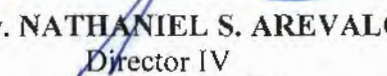
Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of 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 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.<sup>10</sup>

The public interest, therefore, 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.<sup>11</sup>

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2014-0009128 is hereby **SUSTAINED**. Let the filer wrapper 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

<sup>10</sup>*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

<sup>11</sup>*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).