BIOFEMME, INC., Opposer, **-versus-** **SUN PHARMA PHILIPPINES, INC.,** Respondent-Applicant.	}	**IPC No. 14-2014-00440** Opposition to: Application No. 4-2014-003137 Date filed: 13 March 2014 **TM: "DUZELA"**

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NOTICE OF DECISION

OCHAVE & ESCALONA
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Mandaluyong City

SUN PHARMA PHILIPPINES, INC.
Respondent-Applicant
Unit 604, 6th Floor, Liberty Center Building
140 H.V. dela Costa Street
Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 209 dated September 30, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 30, 2015.

For the Director:

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

BIOFEMME, INC.,
Opposer,

- versus -

SUN PHARMA PHILIPPINES, INC.,
Respondent-Applicant.
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IPC No. 14-2014-00440
Opposition to:

Appln. No. 4-2014-003137
Date Filed: 13 March 2014
Trademark: **"DUZELA"**

Decision No. 2015 - 209

D E C I S I O N

BIOFEMME, INC., ("Opposer"),[1] filed an opposition to Trademark Application Serial No. 4-2014-003137. The application, filed by SUN PHARMA PHILIPPINES, INC., ("Respondent-Applicant")[2], covers the mark "DUZELA" for use on goods under class[3] 05 namely: *pharmaceutical preparation.*

The Opposer alleges the following grounds for opposition:

"7. The mark 'DUZELA' filed by Respondent-Applicant so resembles the trademark 'FUNZELA' owned by Opposer and duly registered with the IPO prior to the publication for opposition of the mark 'DUZELA'.

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

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

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's evidence consists of the following:

1. Trademark Lists;
2. Certified true copy of Registration No. 4-2003-010821 for FUNZELA;
3. Certified true copies of the Declaration of Actual Use and Affidavit of Use;
4. Sample product packaging label bearing the trademark FUNZELA;

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1 A domestic corporation duly organized and existing under the laws of the Philippines, with office at 2nd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

2 A domestic corporation, with address at Unit 604, 6th Floor, Liberty Center Building, 104 H.V. dela Costa St., Salcedo Village, Makati City, Philippines.

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.

5. Certification and sales performance of FUNZELA; and,
6. Certificate of Product Registration.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 23 October 2014. Respondent-Applicant however, did not file an answer. Thus, in Order No. 2015-259 dated 20 February 2015, Respondent-Applicant is declared in default and this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark **DUZELA**?

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services if it nearly resembles such 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 on 13 March 2014[4], the Opposer has already an existing trademark registration for the mark FUNZELA bearing Registration No. 4-2003-010821 issued on 24 September 2005 in the Philippines., which was filed on 25 November 2003[5]. Unquestionably, the Opposer's application and registration preceded that of Respondent-Applicant's.

A comparison of the Opposer's mark with the Respondent-Applicant's is depicted below:

Funzela	DUZELA
Opposer's Trademark	Respondent-Applicant's Trademark

The foregoing marks contain the prominent middle and ending letters ***U, Z, E, L*** and ***A***. They only differ in their beginning letter ***F*** and the middle letter ***N*** in Opposer's FUNZELA, as against the beginning letter ***D*** in Respondent-Applicant's DUZELA.

Further, a scrutiny of the goods covered by the mentioned marks show the similarity and relatedness of the pharmaceutical products covered by the marks in class 05. Opposer's FUNZELA covers antifungal pharmaceutical preparation. On the other hand Respondent-Applicant's DUZELA likewise covers pharmaceutical preparations. They are intended for the same or related illness, thus, it may happen that these medicines are disposed by the pharmacist by mistake committed either in reading the prescription, or simply by disposing because these are over-the-counter type of medicine.

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.[6] Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied.

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4 Filewrapper records.
5 Exhibit "B" of Opposer.
6 Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

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.[7]

Succinctly, because the coverage of the Respondent-Applicant's trademark application would allow using the mark DUZELA on pharmaceutical products that are already dealt in by the Opposer using the mark FUNZELA, the changes in spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. The marks 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. Moreover, the contending pharmaceutical products are used for the same Classification 05 of goods for pharmaceutical preparation which Respondent-Applicant's product may also cover the illness intended to be treated by that of the Opposer.

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.[8] 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:[9]

> 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.

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. 4-2014-003137 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 30 September 2015.

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

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7 Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.
8 American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.
9 Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.