



**GLAXOSMITHKLINE TRADING
SERVICES LIMITED,**
Opposer,

-versus-

**THE CATHAY YSS DISTRIBUTORS
CO., INC.,**
Respondent-Applicant.

X-----X

IPC No. 14-2012-00257
Opposition to:
Appln. Serial No. 4-2012-000220
Date Filed: 06 January 2012
TM: "ATHERIX"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 228 dated October 22, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 22, 2015.

For the Director:

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



GLAXOSMITHKLINE TRADING SERVICES LIMITED	} IPC NO. 14-2012-00257
	}
<i>Opposer,</i>	} Opposition to:
-versus-	} Appln. Ser. No. 4-2012-000220
	} Date Filed: 06 January 2012
	} Trademark: "ATHERIX"
THE CATHAY YSS DISTRIBUTORS CO., INC.,	}
	}
<i>Respondent-Applicant.</i>	} Decision No. 2015- <u>228</u>
x-----x	

DECISION

GLAXOSMITHKLINE TRADING SERVICES LIMITED¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-000220. The application, filed by The Cathay YSS Distributors Co., Inc.² ("Respondent-Applicant"), covers the mark "ATHERIX" for use on "pharmaceutical-antiplatelet" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"The Opposition is based on the following grounds:

"1. Respondent-Applicant's trademark AATHERIX nearly resembles Opposer's trademark ITERAX, which was registered under Philippine Trademark Registration No. 4-2000-004633 on February 10, 2005 for goods in Class 05 namely, 'pharmaceutical products and specialities namely tranquilizing products', as likely to deceive or to cause confusion.

"1.1. Respondent-Applicant's trademark application for AATHERIX was filed only last January 6, 2012, or approximately seven (7) years after the trademark ITERAX was registered.

"1.2 Respondent-Applicant's trademark application for AATHERIX also designates related goods in the same Class 5. While AATHERIX is used for 'pharmaceutical-antiplatelet' in class 5, Opposer's trademark ITERAX is also used for 'pharmaceutical products and specialities namely tranquilizing products' in class 5.

¹A foreign corporation organized and existing under the laws of Ireland, with business address at 6900 Cork Airport Business Park, Kinsale Road, Cork, Ireland.

²With address at 2nd Floor Vernida I, Amoroso St., Legaspi Village, Makati City, Metro Manila.

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

"1.3 Respondent-Applicant's trademark ATHERIX is visually, aurally and phonetically similar to Opposer's trademark ITERAX. In fact, ATHERIX is similar to ITERAX in overall impression, which is likely to deceive or cause confusion.

"1.3.1 In comparing both marks, it must be noted that all six letters comprising the mark ITERAX is ingeniously incorporated in the mark ATHERIX. One could easily notice that the letters of the two trademarks ITERAX and ATHERIX were rearranged in the sense that the position of the letters 'I' and 'A' were simply interchanged.

"1.3.2 Moreover, the mark ATHERIX merely added the letter 'H' in between 'T' and 'E' while retaining the same letters comprising the mark ITERAX. Hence, both trademarks have the same overall impression as shown below

"1.3.3 The two trademarks ITERAX and ATHERIX have confusingly similar suffixes and prefixes which are the dominant and distinctive phonetic features of the trademarks ITERAX and ATHERIX.

"1.3.4 Both Respondent-Applicant's trademark ATHERIX and Opposer's trademark ITERAX consist of three (3) syllables. The first two syllables 'ITE' of ITERAX, which are pronounced as i-te, are very similar in sound, if not almost the same with 'ATHE', the first two syllables of ATHERIX, which are pronounced as a-te, with a short a. Likewise, the last syllable 'RAX' of ITERAX and 'RIX' of ATHERIX are also phonetically related. The trademarks ATHERIX and ITERAX, when spoken, could therefore sound very much alike.

"1.3.5 The trademarks ATHERIX and ITERAX come within the purview of the idem sonans rule. According to such rule, two names are said to be 'idem sonantes', if the attentive ear finds difficulty in distinguishing them when pronounced.

"1.3.6 Finally, when written as in hand written prescription, ITERAX could easily be mistaken as ATHERIX, or vice versa, as shown below:

x x x

"1.4 It is clear from the foregoing that the resemblance and similarities between Opposer's trademark ITERAX and Respondent-Applicant's trademark ATHERIX, and the goods for which these marks are used, are such that ATHERIX is likely to deceive or to cause confusion on the part of the medical professionals, pharmacists, or the public, more specifically, where the pharmaceutical products are marketed under the marks which look and sound alike.

"1.5 Respondent-Applicant's use of the trademark ATHERIX may also falsely and misleadingly suggest a connection between

ATHERIX and Opposer on the one hand, or Respondent-Applicant and Opposer's goods bearing the trademark ITERAX on the other hand. Hence, under Section 123.1 (d) of R.A. 8293, the registration of trademark ATHERIX should be proscribed.

"1.6 Pursuant to Section 123.1 (d) (iii) of the Intellectual Property Code or R.A. 8293, a mark cannot be registered if it nearly resembles a registered mark, or a mark with an earlier filing date belonging to a different proprietor which is likely to deceive or cause confusion. Section 123.1 (d) states, to wit:

x x x

"2. Further, it is well-settled that if the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place.

"2.1 Sufficient comparison and evaluation of the marks ATHERIX and ITERAX have been presented above in order to show that ATHERIX contains the main or essential or dominant features of ITERAX, and confusion and deception is likely to result. Out of the seven (7) letters that comprise the word ATHERIX, six letters are found in the registered mark ITERAX, namely, A, T, E, R, I and X, which therefore makes ATHERIX a colorable imitation of the registered mark ITERAX. In fact, there is a big possibility that the two marks may be mistaken for one another when written.

"2.2 Not only is it evident that Respondent-Applicant's trademark ATHERIX is visually similar to Opposer's trademark ITERAX, but ATHERIX also sounds very much like ITERAX.

"2.3 The goods or services need not be completely identical or even competitive to justify a determination that there is likelihood of confusion. It is sufficient that the goods of the applicant and the registrant are related in some manner, or that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under the circumstances that would give rise, because of the marks used thereon, to the mistaken belief that they originate from or are in some way associated with the same producer.

"2.4 Thus, any use of the mark ATHERIX, which is a colorable imitation of the registered mark ITERAX or, which contains the dominant features of the registered mark, also constitutes trademark infringement under Sec. 155 of the IP Code, which provides:

x x x

"The Opposition is also based on the following facts:

"3. The pharmaceutical products for which the trademark ITERAX is used are said in various drugstores all over the Philippines. It is known in the local market, which makes it a valuable product and trademark for the Opposer.

"3.1 Opposer's trademark ITERAX was first used by the Opposer and/or its predecessor-in-interest, UCB Pharma, in the Philippines since 1984 for 'pharmaceutical products and specialities namely tranquilizing products' in class 05. A copy of the Opposer's 3rd year Declaration of Actual Use for ITERAX is attached hereto as Exhibits 'A-2'. Samples of product packaging and package inserts used in the Philippines are Exhibits 'A-3'. This exhibit shows the use of ITERAX by UCB, the Opposer's predecessor-in-interest.

"3.2 ITERAX is the subject of two valid and existing Certificates of Product Registration (CPR) issued by the Food and Drug Administration (FDA) of the Philippines on 7th September 2010 for the indication used for symptomatic relief of anxiety and tension associated with psychoneurosis and as an adjunct in organic disease states in which anxiety is manifested. Effective in pruritus accompanying various dermatological conditions - atopic ezema, contact dermatitis, chronic urticarial, eczematous dermatitis, neurodermatitis, nummular dermatitis, miscellaneous disease. Copies of the CPR No. DJ-02953 and DE-002907 are attached hereto as Exhibits 'A-4'.

"3.3 The sales revenues in the Philippines of the product bearing the mark ITERAX in 2011 amounted to Php 170,500,000.00, and products bearing the mark ITERAX enjoy a significant market share.

"4. Opposer also invests heavily in advertising and publicizing the trademark ITERAX, thereby earning the trademark a reputable status. In 2011 alone, the advertising spent for the products bearing the mark ITERAX reached Php 4,363,000.00. Sample promotional materials are Exhibits 'A-5'.

"5. On the bases therefore of the facts and grounds relied upon by the Opposer, Respondent-Applicant's mark ATHERIX which has the same overall impression as that of the Opposer's trademark ITERAX, should not proceed to registration. As the creator and originator of the trademark ITERAX, Opposer's earlier adoption, registration and use thereof is entitled to protection.

The Opposer's evidence consists of the affidavit of Joanne Green, authorized attorney of Opposer; printout of Philippine Trademark Registration NO. 4-2000-004633; a copy of the 3rd year Declaration of Actual Use for ITERAX; photos of product packaging and package inserts used in the Philippines; copies of the CPI No. DJ-02953 and DE-002907; copies of sample promotional materials of ITERAX; and printout of Philippine Trademark Registration No. 4-2012-000220.⁴

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 23 August 2012. The Respondent-Applicant filed their Answer on 25 September 2012 and avers the following:

⁴ Marked as Exhibits "A" to "A-6".

x x x

"SPECIAL AND AFFIRMATIVE DEFENSES

"12. Respondent adopts and incorporates, by way of reference, all the material, pertinent, and relevant allegations contained in the preceding paragraphs;

"13. Opposer maintains that the mark 'ATHERIX' and ITERAX are confusingly similar. Evidence, however, will show that the marks are not confusingly similar and that there is actually no possibility of confusion.

"14. Opposer alleges that the mark 'ATHERIX' appears and sounds almost the same as Opposer's trademark ITERAX. This allegation, however, is not supported by evidence. By merely looking at, and pronouncing, the syllables of the marks, it cannot be gainsaid that the two marks give different visual and aural impressions. While Opposer maintains that the marks have confusingly similar suffixes and prefixes, and further posits that the marks have the same overall impression, Respondent-applicant avers that despite these similar letters, the other letters that make up the 'ATHERIX' mark give off an appearance and sound far removed from the ITERAX mark.

"15. Opposer goes to the extent of breaking down the marks into three syllables each and comparing them side-by-side to emphasize their similarities. Nonetheless, by doing so, Opposer only emphasized the apparent differences of the two marks. The pronunciation of the first syllable of the 'ATHERIX' mark, 'A', is the sound of a short a /æ/. The 'I' and the 'A' in the first syllable essentially distinguish it from the sound that there is indeed a difference in the aural impressions that the marks will create.

"16. Opposer seeks the application of the idem sonans rule in determining confusing similarity between the two marks. However, even if the idem sonans rule was to be applied, 'ATHERIX' is still not confusingly similar with ITERAX considering that 'ATHERIX' passed both the holistic and dominancy tests.

"17. If the holistic test were to be applied, this Honorable Office will readily see that 'ATHERIX' is not confusingly similar with ITERAX. As defined by jurisprudence, the holistic test entails a consideration of the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity. Hence, in the images below, this Honorable Office will immediately note the striking differences between 'ATHERIX' and ITERAX.

x x x

"18. The boxes of Opposer's ITERAX and Respondent-applicant's 'ATHERIX' employ different color scheme. Respondent-applicant's 'ATHERIX' employs a color scheme of purple (Pantone 683C) and beige (Pantone 136C). On the other hand, Opposer's ITERAX uses a color

scheme of white and black. Hence, pharmacists and ordinary purchasers will be immediately made aware of the specific pharmaceutical product they are holding.

"19. Aside from employing different color scheme on the respective product packaging, it is also noteworthy that the Respondent-applicant's 'CYDC' logo appears immediately above the 'ATHERIX' generic name Clopidogrel Bisulfate unlike Opposer's logo which appears at the lower portion of the ITERAX box. The presence of Respondent-applicant's 'CYDC' logo on the packaging would clearly convey to the purchasers that 'ATHERIX' is not a product of the Opposer.

"20. Moreover, in compliance with Republic Act NO. 6675 or the Generics Law of 1988 ('Generics Law' for brevity) and Department of Health Administrative Order No. 55 series of 1988, the label of 'ATHERIX' clearly indicates that 'ATHERIX' is manufactured by Lloyd Laboratories, Inc. for Respondent-applicant; that the product's generic name is Clopidogrel Bisulfate; its pharmacologic category is Antithrombotic; and the product is in 75 mg. film coated tablet. On the other hand, Opposer's label shows that ITERAX syrup is manufactured by NEXTPHARMA SAS Limay, France for UCB S.A. Pharma Sector Braine-L'Alleud, Belgium while ITERAX tablets are manufactured by UCB S.A. Pharma Sector Braine-L'Alleud, Belgium. Both ITERAX syrup and tablets are imported by GlaxoSmithKline Philippines, Inc., under its authority, the product's generic name is Hydroxyzine Dihydrachloride, its pharmacologic category is antihistamine/antiallergy in the packaging for its 60 ml syrup and antihistamine in the packaging for its 10 mg. tablets for its 100 tablets/box packaging. It is also noteworthy that on both labels, the generic names of the pharmaceutical products appear immediately above their respective brand names, they have the highest point size among the various printed elements on the labels and are enclosed exclusively by outline boxes.

"21. Clearly, the different product information conveyed and the manner they are displayed on the respective labels of the pharmaceutical products negate any possibility that physicians, pharmacists and ordinary purchasers will confuse 'ATHERIX' as ITERAX.

"22. Further, when written, the marks also bear no confusing similarity. The disparity in spelling will surely give different visual impressions. Hence, these differences in aural and visual impressions together with the presence of physicians and pharmacists in the dispensation of these prescription drugs nullify the likelihood of confusion.

"23. This Honorable Office should also note that the form and style of letters employed by the Respondent-applicant in its mark or brand name 'ATHERIX' are completely different from the Opposer's ITERAX. The Respondent-applicant will use the font Univers for its 75 mg film coated 'ATHERIX' tablet. On the other hand, Opposer consistently uses Century Gothic in bold format for its ITERAX. Further, the mark 'ATHERIX' is in all capital letters, whereas in ITERAX mark, only the first letter is capitalized. Again, these striking dissimilarities in the appearance

of the marks or brand names will not cause any confusion to the purchasers.

"24. Even if the dominancy test is to be applied, it cannot be gainsaid that 'ATHERIX' is not confusingly similar to ITERAX. As stated in Philip Morris, Inc. v. Fortune Tobacco Corporation:

x x x

"25. Regrettably, other than showing that there are some letters common to both marks, the Opposer failed to show that such similitude is substantial enough that the consumers will be likely confused or deceived into purchasing Respondent-applicant's 'ATHERIX' supposing it to be the Opposer's ITERAX or vice-versa. On the contrary, Respondent-applicant's mark 'ATHERIX' is aurally and phonetically distinguishable from ITERAX even to those who are unfamiliar with or have heard the marks or brand names for the first time.

"26. The Respondent-applicant submits that the similarity of some of the letters appearing in both marks is insufficient to make the marks confusingly similar especially when the combination of all the letters in both marks produce distinct and distinguishable sounds. This Honorable Office is not unmindful of the Supreme Court's pronouncement that there is no confusing similarity between the following marks: 'Bufferin' and 'Bioferin' and 'Attusin' and 'Pertussin'.

"27. The Opposer would like to impress upon this Honorable Office that the case of McDonald's Corporation vs. L.C. Big Mak Burger, Inc. wherein the Supreme Court ruled that the marks are confusingly similar and there is likelihood of confusion to the public should be applied to the present case. This Honorable Office however, should be cautious in applying the McDonald's ruling. In the McDonald's case, the marks involved are 'Big Mac' and 'Big Mak' both for hamburger, a common food item. Further, the marks 'Big Mac' and 'Big Mak' are obviously aurally and phonetically identical. In contrast, the present case involves the marks 'ATHERIX' which is for antithrombotic drug and ITERAX which is for anxiolytic/antihistamine/antipuritic drug, both products are prescription drugs that are easily accessible to the public. The marks 'ATHERIX' and ITERAX are not even aurally and phonetically similar. Clearly, there is no iota of similitude in factual milieu between the present case and the McDonald's case that would warrant the application of the ruling in the latter case.

"28. Further, the Supreme Court's ruling in the Philip Morris case on the application of the test of dominancy is instructive:

x x x

"29. Hence, following the Philip Morris ruling, if 'ATHERIX' is to be considered confusingly similar to ITERAX, the mark 'ATHERIX' should point out that it is owned by the Opposer or that the goods bearing the 'ATHERIX' mark is manufactured by the Opposer. However, in the present case, the use by the Respondent-Applicant of the mark 'ATHERIX' for its pharmaceutical product will not in any way be associated to the

Opposer or to any of the latter's pharmaceutical products simply because 'ATHERIX' is a unique term coined by Respondent-applicant.

"30. As earlier pointed out, there is no similarity in the 'prevalent features of the competing trademarks'. The two marks do not appear and sound the same. The use of the marks will not likely cause confusion or mistake in the mind of the public or deceive purchasers, nor will the use of the 'ATHERIX' mark point to the Opposer as its origin or owner.

"31. The generic term of ITERAX is 'Hydroxyzine Dihydrochloride', while ATHERIX's generic name is 'Clopidogrel Bisulfate'. Clearly, Respondent-applicant did not adopt, as otherwise pointed out by Opposer, the dominant features of Opposer's trademark. The two marks, having varying generic names, evidently refer to varying medical formulations, and are ultimately used for the treatment of different illnesses.

"32. The nature of the goods and the circumstances under which the Respondent-Applicant's and the Opposer's product are sold all the more negates the likelihood of confusion alleged by the Opposer.

"33. This Honorable Office will note that while both marks are under Class 5, this should not dictate the possibility of confusing similarity of the goods. In *Philippine Refining Co., Inc. v. Ng Sam and the Director of Patents*, the Supreme Court ruled thus:

x x x

"34. Applying the above legal precept to the instant case, this Honorable Office must consider that although the goods covered by both marks fall under the same classification of goods, the goods are non-competitive, that is, the pharmaceutical products of the Respondent-applicant and the Opposer do not have the same indications or do not treat the same ailments. It bears stressing that 'ATHERIX' (generic name: Clopidogrel Bisulfate) is given as prophylaxis for thromboembolic events. Treatment of acute coronary syndromes, including unstable angina and non-Q wave myocardial infarction. On the other hand, the Indications in the physician's package insert of ITERAX (generic name: Hydroxyzine Dihydrochloride) states:

x x x

"35. It is noteworthy that 'ATHERIX' and ITERAX are prescription drugs that are not directly taken off the rack by the purchasers. For both pharmaceutical products to pass on to the buyers, the latter must present a licensed physician's prescription to a pharmacist, who will dispense the pharmaceutical product.

"36. Clearly, the dispensation of prescription drugs calls for the intervention of highly literate, trained and cautious individuals such as physicians and pharmacists. Surely, none of them will be confused in prescribing and dispensing 'ATHERIX' supposing it to be ITERAX or other pharmaceutical product.

"37. It bears stressing that Respondent-applicant's 'ATHERIX' and Opposer's ITERAX have different indications and generic names. As previously mentioned, 'ATHERIX' is an antithrombotic drug with the generic name Clopidogrel Bisulfate while ITERAX is an anxiolytic/antihistamine/antipuritic drug with the generic name Hydroxyzine Dihydrochloride. Significantly, physicians are mandated by law to write the generic names of the medicines they are prescribing. Section 6 of the Generics Law as amended provides:

x x x

"38. The requirement of using the generic names in prescribing and dispensing drugs nullifies any possibility of confusion. Judicial notice must be had of the fact that physicians and pharmacists are trained to distinguish one medicine from another. This means that it would be much easier for them to differentiate drugs that have varying generic names and indications. A physician will prescribe 'ATHERIX' not because he mistook it for ITERAX but because after careful examination of his patient's condition, the proper medication for him is 'ATHERIX'. Similarly, the pharmacist will dispense 'ATHERIX' not because he mistook it for ITERAX but because 'ATHERIX' is clearly written on the physician's prescription.

"39. In the case of Bristol Myers Co. vs. Director of Patents, where the Supreme Court allowed the separate registration of the trademarks 'BUFFERIN' and 'BIOFERIN,' it was ruled that with regard to medicines, the requirement for prescription makes 'the chances of being confused into purchasing one for the other are therefore all the more rendered negligible.'

"40. Further, given that the products involved are prescription drugs, purchasing this type of goods will entail more vigilance from the buying public, who are more likely to be cautious and less likely to be confused in purchasing the pharmaceutical products. Any likelihood of confusion is belied by the fact that an 'ordinary purchaser' of pharmaceutical product would necessarily be one who is discerning and familiar with their nuances and individual markings, considering the type and nature of the products involved. As held by the Supreme Court in the Philip Morris case:

x x x

"41. It is worthy to note that the products or medicines involved in this case are not common consumer goods, like the products involved in the following cases cited by the Opposer: McDonald's Corporation vs. L.C. Big Mak Burger, Inc., American Wire and Cable Company v. Director of Patents, Chuachow Soy & Canning Co., vs. Director of Patents, and Canon Kabushiki Kaisha vs. Court of Appeals. To be sure, the McDonald's Corporation case involved food products, the American Wire case involved electric wires, apparatus, machines and supplies, the Chuachow Soy & Canning Co. case concerned marks used for the manufacture of soy sauce, and the Canon Kabushiki Kaisha case involved paints, chemical products, toner, dyestuff, and sandals. These are not the types of products

involved in this case. Hence, the cited rulings are not on all fours with this case.

"42. It is then only proper for this Honorable Court to consider the ruling in *Etepha v. Director of Patents*, a case which involved prescription drugs, in deciding the presence of confusing similarity. In *Etepha*, the Supreme Court ruled:

"43. Evidently, the Supreme Court has already ruled out the possibility of confusing medicines when physicians and pharmacists are involved. Given that this matter of confusing similarity of two pharmaceutical products is the main issue in this case, this Honorable Office has no reason to divert from the thrust of the rulings in the previously cited cases of *Etepha* and *Bristol Myers*: confusion in the dispensation of drugs is rendered impossible by the intervention of a physician and a pharmacist in the acquisition of the drugs.

"44. Further, the Cheaper Medicines Act amended Sec. 25 of the Pharmacy Law, thus:

x x x

"45. Given the foregoing, it bears stressing that these drugs are not the usual medicines consumed, like paracetamol for fever, or loperamide for diarrhea. The purchase of the products involved in this case entail more vigilance from the buying public, who are more likely to be cautious and less likely to be confused especially that the drugs are prescription drugs and cannot simply be purchased over-the-counter. On top of this, the drugs to which the marks pertain to do not even share a common generic name.

"46. Undeniably, the margin of error in the acquisition of one for the other is quite remote. When written, the marks also bear no confusing similarity. The disparity in spelling will surely give different visual impressions. These differences in aural and visual impressions together with the presence of physicians and pharmacists in the dispensation of these prescription drugs nullify the likelihood of confusion.

"47. At any rate, this Honorable Office will note that no less than the Intellectual Property Office through the Bureau of Trademarks affirmed the registrability of Responnet-applicant's mark 'ATHERIX' when the subject application was allowed after it had undergone merit examination without citing the Opposer's mark as an obstacle to the registration of the subject application.

The Respondent-Applicant's evidence consists of a copy of the Secretary Certificate issued by Ms. Nona F. Crisol, Corporate Secretary of the Respondent-Applicant appointing Ms. Crisol or any of the partners and/or associates of JG Law to be the attorneys-in-fact of Respondent-Applicant at any stage of the

proceedings in Inter-Partes Case No. 14-2012-00257; actual boxes of ITERAX; details of the proposed box of ATHERIX; and the affidavit of Ms. Nona F. Crisol.⁵

On 09 July 2013, the Preliminary Conference was terminated and the parties were directed to file their respective position papers. Thereafter, the case was deemed submitted for resolution.

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

The Opposer anchors its opposition on Sections 123.1 (d) (iii) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

Sec. 123.Registrability. – 123.1. A mark cannot be registered if it:

x xx

(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 at the time the Respondent-Applicant filed its trademark application on 06 January 2012, the Opposer has an existing trademark registration for the mark ITERAX (Reg. No. 420004633) issued on 10 February 2005. The registration covers "pharmaceutical products and specialities namely tranquilizing products" under Class 05. On the other hand, Respondent-Applicant's trademark application for the mark ATHERIX covers "pharmaceutical-antiplatelet" under Class 05.

The marks are shown below:

ITERAX

Opposer's trademark

ATHERIX

Respondent-Applicant's mark

This Bureau finds that confusion or deception is unlikely to occur in this instance. Although the contending marks contain the letters I, T, E, R, A, X, the

⁵ Marked as Exhibits "1" to "4", inclusive.

arrangement of the letters and insertion of the letter H in AATHERIX has rendered Respondent-Applicant's mark a character that is distinct from the Opposer's. The mark ITERAX in the actual box or packaging is written with only the letter I in upper case vis-à-vis the mark AATHERIX in the proposed packaging which has all the letters A, T, H, E, R, I, X in upper case. The Supreme Court has held:

It is true that between petitioner's trademark "ALACTA" and respondent's "ALASKA" there are similarities in spelling, appearance and sound for both are composed of six letters of three syllables each and each syllable has the same vowel, but in determining if they are confusingly similar a comparison of said words is not the only determining factor. The two marks in their entirety as they appear in the respective labels must also be considered in relation to the goods to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other. Having this view in mind, we believe that while there are similarities in the two marks there are also differences or dissimilarities which are glaring and striking to the eye as the former.⁶

Moreover, Respondent-Applicant's mark covers pharmaceutical products (antiplatelet) that are so different from Opposer's, i.e. tranquilizing products.

The essence of trademark registration is to give protection to the owners of trademarks. 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.⁷ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2012-000220 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 22 October 2015.



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

⁶*Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.

⁷*Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.