

GLAXO GROUP LIMITED,
Opposer,

-versus-

**AMBICA INTERNATIONAL
TRADING CORPORATION,**
Respondent-Applicant.

} **IPC No. 14-2014-00444**
}
} Opposition to:
} Appln. No. 4-2014-00007390
} Date Filed: 11 June 2014
} **TM: "CORTUM"**
}
}
}
}

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 263 dated November 11, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 11, 2015.

For the Director:


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

GLAXO GROUP LIMITED,
Opposer,

- versus -

**AMBICA INTERNATIONAL
TRADING CORPORATION,**
Respondent-Applicant.

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IPC No. 14-2014-00444
Opposition to:

Appln. No. 4-2014-00007390
Date Filed: 11 June 2014
Trademark : "CORTUM"

Decision No. 2015 - 263

DECISION

GLAXO GROUP LIMITED ("Opposer"),¹ filed a verified opposition to Trademark Application Serial No. 4-2014-00007390. The application, filed by AMBICA INTERNATIONAL TRADING CORPORATION ("Respondent-Applicant"),² covers the mark "CORTUM" for use on "*pharmaceutical preparations namely anti-bacterial*" under class 05 of the International Classification of Goods.³

The Opposer alleges the following grounds for opposition:

"1. Respondent-Applicant's CORTUM trademark is, at the very least, confusingly similar to Opposer's registered FORTUM trademark.

"2. The trademarks FORTUM and CORTUM are confusingly similar in many respects. Section 123.1 (f) of R.A. 8293 otherwise known as the Intellectual Property Code (hereinafter 'the Code') proscribes the registration of the trademark CORTUM.

"3. Opposer, as registrant of the trademark FORTUM, has an exclusive right to use the said trademark in connection with pharmaceutical products covered by Trademark Registration No. 4-2006-002535.

"4. As stated, the trademark CORTUM designates 'pharmaceutical preparations namely anti-bacterial' in class 5 in the same way that Opposer's FORTUM trademark designates antibiotics in the same class of goods. Therefore, the parties' respective pharmaceutical goods are used for the same purposes for having the same indication, and necessarily flow in the same trade channels, that is, drugstores.

"5. Due to the confusing similarity between the CORTUM trademark and the FORTUM trademark as well as the similarity of the goods that they respectively designate, the use by Respondent-Applicant of CORTUM will likely mislead the public into believing that Respondent-Applicant's goods originated from Opposer or is affiliated with Opposer's goods, or conversely, that Opposer's goods originated from Respondent-Applicant.

¹ A corporation duly organized under and by virtue of the laws of England and Wales, with address at 980 Great West Road, Brentford Middlesex TW8 9GS, England.

² With business address at #9 Amsterdam Extension, Merville Park subdivision, Paranaque City, Metro Manila.

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

"6. It is apparent that Respondent-Applicant's attempted registration of the trademark CORTUM is done in bad faith, with manifest intent to ride on the popularity and goodwill of the trademark FORTUM.

"7. The confusion that will result from Respondent-Applicant's use of CORTUM despite the prior presence and registration of FORTUM will most likely benefit Respondent-Applicant but will certainly prejudice Opposer, the owner of the registered trademark FORTUM, and one of the leading pharmaceutical companies worldwide."

The Opposer's evidence consists of the following:

1. Print-out of Trademark Registration No. 4-2006-002535 from IPOPHL trademark database;
2. List of worldwide registrations and application for FORTUM;
3. Certificates of Trademark Registration for FORTUM from various jurisdictions;
4. FORTUM sales figures;
5. Copy of invoices;
6. Photographs of product packaging used for FORTUM in the Philippines; and,
7. Sample promotional materials for FORTUM.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 16 December 2014. Respondent-Applicant however, in its Answer dated 09 February 2015, it failed to complete the requirements on time. Thus, Respondent-Applicant was declared in default and this instant case is deemed submitted for decision.⁴

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

It is emphasized that 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 out into the market a superior 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.⁵

Sec. 123.1 (d) R.A. No. 8293, also known as the Intellectual Property Code ("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;**
(Emphasis Supplied)

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 11 June 2014⁶, the Opposer has already an existing trademark registration for the mark

⁴ Order No. 2015-1196 dated 12 August 2015.

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

⁶ Filewrapper records.

FORTUM bearing Registration No. 4-2006-002535 issued on 16 July 2007⁷ in the Philippines. It remains active under the name of herein Opposer up to the present.⁸ The Opposer has also shown evidence of worldwide registrations and application for the registration of FORTUM.⁹ 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:

FORTUM **CORTUM**

Opposer's Trademark

Respondent-Applicant's Trademark

The only difference between the competing marks is the first letter of the marks which is the letter "R" in the Opposer's; and the letter "C" in the Respondent-Applicant's. The visual and aural similarities of the marks are very apparent. The font design depicts no significant individuality except that FORTUM is in bold font. The aural effect when the marks are pronounced creates perplexity because of the prevailing similarities in its letter component.

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 FORTUM covers antibiotic and antibacterial preparations and substances. On the other hand Respondent-Applicant's CORTUM likewise covers pharmaceutical preparations namely anti-bacterial. 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.¹⁰ Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. 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.¹¹

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

⁷ Exhibit "A-1" of Opposer.

⁸ Exhibits "A-7" of Opposer.

⁹ Exhibits "A-2" and "A-3" to "A-6" of Opposer.

¹⁰ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

¹¹ Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.

purchaser of the older brand mistaking the newer brand for it.¹² 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:¹³

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. 4-2014-00007390 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 11 November 2015.


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

¹² American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.

¹³ Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.