

MEDICHEM PHARMACEUTICALS,
Opposer,

-versus-

**BOEHRINGER INGELHEIM
INTERNATIONAL GMBH,**
Respondent-Applicant.

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IPC No. 14-2010-00316
Opposition to:
Appln No. 4-2010-006196
Date Filed: 09 June 2010
TM: "ZELOTEP"

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NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for the Opposer
66 United Street
Mandaluyong City

**CASTILLO LAMAN TAN
PANTALEON & SAN JOSE**
Counsel for Respondent-Applicant
2nd, 3rd, & 4th Floors, The Valero Tower
122 Valero Street, Salcedo Village
Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 12 dated January 14, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 14, 2016.

For the Director:


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

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 Application No. 4-2010-006196
 Date Filed: 09 June 2010
 Trademark: "ZELOTEP"
 Decision No. 2016- 12

DECISION

MEDICHEM PHARMACEUTICALS, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-006196. The application, filed by BOEHRINGER INGELHEIM INTERNATIONAL GMBH² ("Respondent-Applicant"), covers the mark "ZELOTEP" for use as "*pharmaceutical preparations for the alimentary tract and metabolism, pharmaceutical preparations for blood and blood forming organs, pharmaceutical preparations for the cardiovascular system, pharmaceutical preparations for the the musculoskeletal system, pharmaceutical preparations for the central nervous system, pharmaceutical preparations for the peripheral nervous system, pharmaceutical preparations for the genitourinary system, pharmaceutical preparations for the respiratory system, epidermal medicines, hormones, anti-infective preparations, cytostatics, allergy medication*" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"GROUNDS FOR OPPOSITION

"The grounds for this opposition are as follows:

"1. The trademark 'ZELOTEP' so resembles 'ZEROLEP' trademark owned by Opposer, which was applied for registration with this Honorable Office prior to the application of the mark 'ZELOTEP'. The trademark 'ZELOTEP', which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'ZELOTEP' is applied for the same class of goods as that of trademark 'ZEROLEP', i.e. Class (5).

¹A domestic corporation organized and existing under the laws of the Philippines with principal office address at LVP Compound, Pioneer St., Mandaluyong City, Philippines.

²A foreign corporation with principal office address at 55216 Ingelheim, Germany.

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.

"2. The registration of the trademark 'ZELOTEP' in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the 'Intellectual Property Code of the Philippines', which provides, in part, that a mark cannot be registered if it:

xxx

Under the above-quoted provision, any mark, which is similar to a mark with an earlier filing 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.

"3. Respondent's use and registration of the trademark 'ZELOTEP' will diminish the distinctiveness of Opposer's trademark 'ZEROLEP'.

"ALLEGATIONS IN SUPPORT OF THE OPPOSITION

"In support of this Opposition, Opposer will rely upon and prove the following facts:

"4. Opposer, the owner of the trademark 'ZEROLEP', is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'ZELOTEP' was filed with the Intellectual Property Office on 19 June 2009 by Opposer and was approved for registration on 12 November 2009 and valid for a period of ten (10) years. x x x

"5. There is no doubt that by virtue of its prior registration, the Opposer has acquired an exclusive ownership over 'ZEROLEP' mark to the exclusion of all others.

"6. 'ZELOTEP' is confusingly similar to 'ZEROLEP'.

"6.1 There are no set rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or is a colorable imitation of, another. Nonetheless, jurisprudence provides enough guidelines and tests to determine the same.

"6.1.1 In fact, in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* [356 SCRA 207, 216,] the Supreme Court, citing *Ethepa v. Director of Patents*, held "[i]n determining if colorable imitation exists, jurisprudence has developed two kinds of tests - the Dominancy Test and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitute infringement. On the side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity."

"6.1.2 It is worthy to note at this point that in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* (Supra, p. 221) the Supreme Court held "[T]he totality or holistic test only relies on visual comparison between two trademarks whereas the dominancy test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks."

"6.1.3 Relative thereto, the Supreme Court in McDonalds' Corporation vs. L.C. Big Mak Burger, Inc. [437 SCRA 10] held:

xxx

"6.1.4 Applying the dominancy test, it can be readily concluded that the trademark 'ZELOTEP', owned by Respondent, so resembles the trademark 'ZEROLEP', that it will likely cause confusion, mistake and deception on the part of the purchasing public.

"6.1.4.1 First, 'ZELOTEP' appears and sounds almost the same as 'ZEROLEP';

"6.1.4.2 Second, both marks are composed of three (3) syllables;

"6.1.4.3 Third, the first two (2) and last two (2) letters of both marks are the same;

"6.1.5 Clearly, the Respondent adopted the dominant features of the Opposer's mark 'ZEROLEP';

"6.1.6 As further ruled by the High Court in McDonalds' case [p. 33]

x x x

"6.2 The trademark 'ZEROLEP' and Respondent's trademark 'ZELOTEP' are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

"6.2.1 Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed trademark 'ZELOTEP' is applied for the same class as that of trademark 'ZEROLEP', i.e. Class (5), to the Opposer's extreme damage and prejudice.

"7. To allow Respondent to continue to market its products bearing the 'ZELOTEP' mark undermines Opposer's right to its marks. As the lawful owner of the mark 'ZEROLEP', Opposer is entitled to prevent the Respondent from using a confusingly similar mark in the course of trade where such would likely mislead the public.

"7.1 Being the lawful owner of 'ZELOTEP', Opposer has the exclusive right to use and/or appropriate the said marks and prevent all third parties not having its consent from using in the course of trade identical or similar marks, where such would result in a likelihood of confusion.

"7.2 By virtue of Opposer's ownership of the trademark 'ZEROLEP', it also has the right to prevent third parties, such as Respondent, from claiming ownership over Opposer's marks or any depiction similar thereto, without its authority or consent.

"7.3 Moreover, following the illustrative list of confusingly similar sounds in trademarks which the Supreme Court in McDonald's Corporation, McGeorge Food Industries, Inc. vs. L.C. Big Mak Burger, Inc., 437 SCRA 268 (2004), it is evident that the mark 'ZELOTEP' is aurally confusingly similar to Opposer's mark 'ZEROLEP'.

"7.4 To allow Respondent to use its 'ZELOTEP' mark on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the 'ZELOTEP' product of Respondent originate from or is being manufactured by Opposer, or at the very least, is connected or associated with the 'ZEROLEP' product of Opposer, when such connection does not exist.

"8. Likewise, the fact that Respondent seeks to have its mark 'ZELOTEP' registered in the same class (Nice Classification 5) as the trademark 'ZEROLEP' of Opposer will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

"9. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent of the trademark 'ZELOTEP'. In support of the foregoing, the instant Opposition is herein verified by Ms. Merza Alejandrino which likewise serves as his affidavit (Nasser v. Court of Appeals, 191 SCRA 783 [1990]).

The Opposer's evidence consists of copies of pertinent pages of the IPO E-Gazette released on 18 October 2010; and, a copy of the certificate of registration No. 4-2009-006036 for the trademark ZEROLEP with filing date on 19 June 2009.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 18 February 2011. The Respondent-Applicant filed its Answer on 16 June 2011 alleging among other things:

xxx

"DISCUSSION

x x x

"10. Opposer alleges that 'ZELOTEP' is confusingly similar with its own registered trademark. Applying the dominance test, oppose argues that respondent-applicant adopted the dominant features of the former's mark merely on the basis of the following:

- a. First, 'ZELOTEP' appears and sounds almost the same as 'ZEROLEP';
- b. Second, both marks are composed of three (3) syllables; and
- c. Third, the first two letters and last two letters are the same.

⁴Marked as Annexes "A" and "B".

"11. However, opposer's conclusion, given the aforementioned observations of the two trademarks and applying the dominance test, is untenable.

"12. Section 123.1 of the Intellectual Property Code of the Philippines and Rule 101 of the Trademark Regulations provide:

x x x

"13. In determining whether the marks are identical or likely to deceive or lead to confusion, the courts have consistently employed the 'dominance test' where the dominant features in the competing marks are considered in determining whether they are confusingly similar. Under the 'dominance test,' courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. As stated by the Supreme Court in *Societe Des Produits Nestle v. Court of Appeals*, which is also cited by the Court in latter decisions, the test of dominance relies on the visual, the aural, the connotative comparisons and overall impressions between the two trademarks. The question is whether the use of the marks involved is likely to cause confusion or mistake in the mind of the public or deceive purchasers.

"14. Opposer's reliance on *Societe Des Produits Nestle, S.A. v. Court of Appeals* and *McDonald's Corporation v. L.C. Big Mak Burger, Inc.* are misplaced. In *Societe' Des Produits Nestle', S.A. v. Court of Appeals*, the Supreme Court held that, in trademark cases, likelihood of confusion is a relative concept and each case must be decided on its own merits, to wit:

x x x

"15. Opposer cannot find support in *Societe' Des Produits Nestle', S.A. v. Court of Appeals* because the case involves coffee, an ordinary household item, in which the Supreme Court held that:

x x x

"16. In contrast, the products covered by 'ZELOTEP' and 'Zerolep' are both prescription drugs, the relevant consumers of whom are discerning and cautious buyers and users. Besides, in the case of prescription drugs, while the patient is the end user, the prescribing medical specialist acts as filter before the drug reaches the patient. Thus, there is no way that a medical specialist, who would know the particular drug that he is prescribing, would be confused between 'ZELOTEP' and 'Zerolep.'

"17. Likewise, opposer's reliance on *McDonald's Corporation v. L.C. Big Mak Burger, Inc.* must fail. *McDonald's* involve trademarks covering both hamburgers and food business. Its products reach the consumers easily through its publicly-accessible restaurants and media placements. Not so in the case of prescription drugs which cannot be advertised or dispensed readily by drugstores.

"18. Foremost, oppose cannot find support under the Dominance Test when, in the first place, it failed to prove the dominant feature of its mark. The dominant feature of a mark is one which easily attracts the attention of a consumer and leads him to conclude the origin or manufacturer of the goods to which that is attached. The determination of the dominant element is more stringent than a mere comparison of the aural and visual similarities. It must be shown by a clear

and convincing evidence that the dominant element is that element of the mark which the consumers or public associates with the source or origin of the goods. Opposer failed to present evidence to prove the dominant feature of its mark, the distinctiveness of such dominant feature, if any, and its association with the source of its goods, because simply, the mark does not have any. Opposer, in invoking the Dominancy Test, raises the absurd proposition that since the first two letters, ZE-, and last two letters, -EP, of the subject marks are the same, then they are confusingly similar to each other.

"19. Assuming, arguendo, that the Opposition is anchored on opposer's aural and aural comparison of 'ZELOTEP' and 'Zerolep,' with emphasis on 'ZE;' and '-EP,' the same argument must fail. First, this Honorable Office's electronic library on trademarks reveals that there is another pending application for the mark 'ZENPEP' for goods under Class 5, against which opposer did not file any opposition.

"20. More, 'ZE' and 'EP' are syllables that are incapable of exclusive appropriation by anyone, including opposer. Otherwise, opposer can oppose any mark at all starting with 'ZE' and ending in 'EP,' such as, to name a few:

- (a) ZE-ze-EP;
- (b) ZE-la-kEP;
- (c) ZE-pa-dEP;
- (d) ZE-vo-vEP;
- (e) ZE-EP;
- (f) ZE-ep-EP;
- (g) ZE-ha-zEP;
- (h) ZE-ke-IEP; and
- (i) ZE-yi-zEP;

"21. Moreover, the likelihood of confusion is not affected by the fact that the marks are used for closely related goods. As stated in *Mighty Corp. vs. E & J. Gallo Winery*, which enumerated the factors that come into play in resolving whether goods are related:

x x x

"22. In the meantime, while both trademarks are registered or sought to be registered under Nice Classification 5, which generally pertains to pharmaceutical products, both opposer's and Boehringer's application are more specific. Respondent's application is intended to cover pharmaceutical preparations for the alimentary tract and metabolism, pharmaceutical preparations for blood and blood forming organs, pharmaceutical preparations for the cardiovascular system, pharmaceutical preparations for the central nervous system, pharmaceutical preparations for the peripheral nervous system, pharmaceutical preparations for the genitourinary system, pharmaceutical preparations for the respiratory system, epidermal medicines, hormones, anti-infective preparations, cytostatics, allergy medication, specifically an oncologic pharmaceutical drug. On the other hand, opposer obtained the registration for 'Zerolep' specifically for anti-epileptic pharmaceutical preparation.

"23. Simply put, respondent's 'ZELOTEP' is an anti-cancer drug, while opposer's 'Zerolep' is anti-epileptic drug. Both are prescription drugs intended for

two different disease conditions and prescribed by two different kinds of medical specialty professionals. Opposer could not even claim that doctors could be confused between the two marks inasmuch as the marks serve to identify two different pharmaceutical products, one intended to treat cancer and the other an anti-epileptic. Further, 'ZELOTEP' is prescribed by an oncologist intended for patient who has cancer, while 'Zerolep' is prescribed by a neurologist for a patient who has epilepsy. Clearly, the goods of opposer and respondent are so unrelated that consumers and doctors, would not, in any probability, mistake one as the source of origin of the product of the other. Even if one of these drugs is an over-the-counter drug and the other a prescription drug, the stark difference would be obvious. In *Bristol Myers Company v. Director of Patents, et al.*, the Supreme Court held:

x x x

"24. Because of the Rx status of the products covered by the marks, opposer is greatly mistaken to allege that 'ZELOTEP' 'will likely cause confusion, mistake and deception on the part of the purchasing public.' In assessing whether the degree of similarity between the respective marks is sufficient to give rise to a likelihood of confusion, it is necessary to consider who the average consumer is and to make an allowance for the defective recollection. In assessing the likelihood of confusion in this case, the views of qualified professionals such as pharmacists and doctors should be considered since opposer's and respondent's products are prescription drugs. The involvement of a medical professional is at least sufficient to avoid any greater likelihood of confusion.

"25. Even if the average consumer is said to be the 'purchasing public' and he does not have any specialized knowledge in the field of medicine, he is particularly cautious regarding the nature of those products, as they involve health.

x x x

"26. In its Opposition, opposer attached a copy of its purported Certificate of Registration which it claims to be certified. An inspection of the attached certificate will show that it has been stamped 'Certified True and Copy of the Original' by a certain Glenn Q. Albano, a notary public.

"27. This fall short of the requirement for a certified true copy of a certificate of trademark registration, which is a public document. Regarding the authentication of public documents, the Rules on Evidence provide that the record of public documents, when admissible for any purpose, may be evidenced by an official publication thereof or by a copy attested by the officer having legal custody of the record, or by his deputy. The attestation of the certifying officer must state, in substance, that the copy is a correct copy of the original, or a specific part thereof, as the case may be.

"28. In this case, opposer presented neither an official publication nor a certified true copy of its certificate of registration issued by the officer having legal custody thereof or this Honorable Court.

"29. By failure to present a valid certified true copy of the certificate of trademark registration, opposer fails to establish its legal right. In Bank of America NT & SA v. Court of Appeals, et al., the Supreme Court held that:

x x x

"30. For failure to establish its legal right, opposer fails to state its cause of action. Hence, this Opposition must be dismissed outright.

x x x

"31. Section 3, Rule VII of the 2004 Rules on Notarial Practice provides that the notary public should affix a single, clear, legible, permanent, and photographically reproducible mark, image or impression of the official seal beside his signature on the notarial certificate of a paper instrument of document. Moreover, the Notarial Rules also requires the notary public to indicate his office address, roll of attorney's number and IBP number in the notarial certificate. In this case, not only was there no clear image or impression of the seal beside the notary public's signature; the notary public did not also indicate his office address.

"32. Since the verification/certification of non-forum shopping was improperly notarized, opposer is deemed not to have complied with the requirements of Section 5, Rule 7 of the 1997 Rules of Civil Procedure, which applies in a suppletory manner to inter partes opposition proceedings. Section 5, Rule 7 of the 1997 Rules further provides that failure to comply with its requirements shall not be curable by mere amendment of the complaint but shall be a ground for the dismissal of the case without prejudice.

"33. All told, Respondent-applicant respectfully prays that this Honorable Office dismiss the unverified Opposition dated December 17, 2010 for failure to state a cause of action, which is likewise without any basis and merit, and allow the registration of the mark 'ZELOTEP' in Boehringer Ingelheim International GmbH's name.

"34. Attached to and in support of the Answer are the notarized and authenticated affidavit of Maximilian Kammler and notarized affidavit of Ms. Teresa Paz B. Grecia Pascual.

The Respondent-Applicant's evidence consists of copies of a copy of the power of attorney; a printed copy of the webpage www.boehringer-ingelheim.com/corporate-profile.html ; a print-out of the webpage www.boehringer-ingelheim.com/products.html; a print out of the webpage www.boehringer-ingelheim.com/research_development.html; list of countries where the mark 'ZELOTEP' has been registered and has pending applications; a print-out of the IPO trademark webpage <https://trademarks.ipophil.gov.ph/tmsearch> ; affidavit of Maximilian Kammer, the in-house lawyer for trademarks of the Boehringer Ingelheim Group of Companies; and, the notarized affidavit of Ms. Teresa Paz B. Grecia Pascual, the associate attorney of Castillo Laman Tan Pantaleon & San Jose Offices, appointed

attorneys-in-fact by Respondent-Applicant to represent the latter in this particular inter-partes case.⁵

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

This Bureau takes cognizance via judicial notice of the fact that, based on the records of the Intellectual Property Office of the Philippines, the Opposer filed a trademark application for "Zerolep" on 19 June 2009. The application covers antiepileptic pharmaceutical preparation. On the other hand, the Respondent-Applicant filed the trademark application subject of the opposition on 09 June 2010.

The competing marks, as shown below, are confusingly similar:

Zerolep

Opposer's trademark

ZELOTEP

Respondent-Applicant's mark

This Bureau finds that while the pharmaceutical products indicated in Respondent-Applicant's trademark application are not exactly similar to those covered by the Opposer's registration, confusion is still likely to occur in this instance because of the close resemblance between the marks and that the goods are for human consumption. Respondent-Applicant's mark ZELOTEP adopted the dominant features of Opposer's mark ZEROLEP. ZELOTEP appears and sounds almost the same as Opposer's trademark ZEROLEP. Both ZELOTEP and ZEROLEP marks have seven (7) letters. The six (6) letters of both marks are the same. Both have three (3) syllables, "ZE-RO-LEP" and "ZE-LO-TEP". Respondent-Applicant merely changed Opposer's letter L with the letter R and Opposer's letter T with the letter L in coming up with the mark ZELOTEP. It could result to mistake with respect to perception because the marks sound so similar. Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"⁶, "SAPOLIN" and LUSOLIN"⁷, "CELDURA" and "CORDURA"⁸, "GOLD DUST" and "GOLD DROP". The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, 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

⁵Marked as Exhibits "1" to "8", inclusive.

⁶ *MacDonalds Corp, et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

⁷ *Sapolin Co. v. Balmaceda and Germann & Co.* 67 Phil, 705.

⁸ *Co Tiong SA v. Director of Patents*, G.R. No. L- 5378, 24 May 1954; *Celanes Corporation of America vs. E. I. Du Pont de Nemours & Co.* (1946), 154 F. 2d 146 148.)

significance...."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.⁹

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1 par. (d) (iii) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-006196 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, January 14, 2016.



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

⁹ *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297,22 Dec. 1966.