

WARNER-LAMBERT COMPANY LLC,  
Opposer,

-versus-

AMBICA INTERNATIONAL  
TRADING CORPORATION,  
Respondent - Applicant.

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IPC No. 14-2014-00453  
Opposition to:  
Appln. No. 4-2014-005480  
Date Filed: 06 May 2014  
TM: "GOPID"

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**NOTICE OF DECISION**

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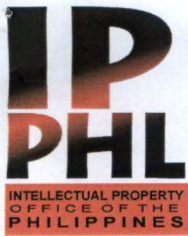
**GREETINGS:**

Please be informed that Decision No. 2016 - 121 dated April 20, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 20, 2016.

For the Director:

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



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IPC No. 14-2014-00453  
 Opposition to:  
 Application No. 4-2014-005480  
 Date Filed: 06 May 2014  
 Trademark: "GOPID"  
 Decision No. 2016- 121

**DECISION**

WARNER-LAMBERT COMPANY LLC<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-005480. The application, filed by Ambica International Trading Corporation<sup>2</sup> ("Respondent-Applicant"), covers the mark "GOPID" for use on "pharmaceutical preparations namely anti-thrombotic" under Class 05 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x x x

"4. GROUNDS FOR OPPOSITION

"The present Opposition rests on the following grounds:

"4.1. Opposer is the prior user and first registrant of the LOPID mark in the Philippines, well before the filing date of Respondent's GOPID trademark application. The registration details are as follows

x x x

"Opposer continuously used the LOPID mark in the Philippines and in numerous countries.

"4.2. Opposer, as the registered owner of the LOPID mark, enjoys the exclusive right to prevent all third parties not having its consent from using in the course of trade identical or similar signs for goods which are identical or similar to those in respect of which the trademark is registered (i.e., antibiotic preparations) where such use would result in a likelihood of confusion. In fact, there shall be a presumption that a likelihood of confusion will result if what is used is an identical sign for identical goods.

<sup>1</sup>A foreign corporation organized and existing under the laws of the state of Delaware, U.S.A.  
<sup>2</sup>A domestic corporation with address at #9 Amsterdam Extension, Merville Park Subdivision, Paranaque City, Metro Manila, Philippines.  
<sup>3</sup>The 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.

"4.3. Opposer's LOPID is a well-known mark, both internationally and in the Philippines. As such, Opposer is entitled to a wider scope of protection under Philippine law in that it is allowed to protect its LOPID mark against marks that are liable to create confusion in the minds of the public or used in bad faith.

"4.4. The registration of Respondent's mark will work to impede the natural expansion of Opposer's use of its LOPID mark in the Philippines.

"4.5. The registration and consequent use of the mark will result in a confusion of source of reputation, which is proscribed under the IP Code and applicable precedents.

"4.6. Other provisions of the IP Code and related international agreements or conventions on the subject of intellectual property rights warrant the denial by this Honorable Office of Respondent's trademark application.

#### "5. DISCUSSION

"5.1. Respondent's GOPID mark is identical and confusingly similar to LOPID, and thus runs contrary to Section 123 of the IP Code. Section 123 (d), (e), (f) and (g) of the IP Code provide:

x x x

"5.2. Except for the substitution of the letter 'L' with the letter 'G', Respondent's GOPID mark appropriates much of the elements of Opposer's LOPID trademark that would support a finding of sufficient similarity, if not identity, between the competing marks in terms of spelling, pronunciation and appearance. Replacing the letter 'L' by the letter 'G' does not add a distinguishing element that would sufficiently set the two competing marks apart. GOPID and LOPID, when read aloud, constitute idem sonans to a striking degree. It has been established that similarity of sound is a sufficient ground for the courts to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.

"5.3. In resolving the issue of confusing similarity, courts have resorted to the Dominancy Test which focuses on the similarity of the prevalent, essential or dominant features of the competing marks. In this case, the dominant feature of Opposer's mark are the syllables 'LO' and 'PID'. Respondent conveniently copied these elements and made the same the dominant element of its own 'GOPID' mark, with of course the convenient substitution of the letter 'L' with the letter 'G'. There is no doubt that 'LOPID' and 'GOPID' marks are confusingly similar in pronunciation and sound. These marks both consist of the sounds 'O' and 'PID'. Hence, applying the Dominancy Test to this case, it is clear that the sounds 'O' and 'PID', which are common to both marks, predominate both marks and attract attention of the ordinary purchaser. In other words, Respondent's 'GOPID' mark is but a slavish copy of Opposer's 'LOPID' trademark.

"5.4. Where a comparison between two competing marks shows such resemblance in general appearance or general features as would likely to deceive the ordinary purchaser exercising ordinary care, and to induce him to believe that the goods bearing the marks are products of one and the same enterprise, the junior mark is confusingly similar to the other. As held by the Supreme Court in *Societe des Produits Nestle v. Court of Appeals*, confusing similarity must be determined on the basis of

visual, aural, connotative comparisons and overall impressions engendered by the marks in controversy as they are encountered in the realities of the marketplace.

"5.5. Furthermore, the goods for which Respondent intends to use its GOPID mark are exactly the same, or are the very least closely related, to the goods currently being sold by Opposer in the Philippines market. This will confuse consumers by suggesting a connection, association or affiliation with Opposer, thereby causing substantial damage to the goodwill and reputation associated with the LOPID trademark, as well as Opposer's business reputation.

"5.6. Respondent's GOPID mark will be used in connection with an equivalent product, given that the scope of goods covered in said trademark application discloses that the mark will be used for 'anti-thrombotic' products. These products are likewise known to prevent the occurrence of heart strokes. An online search reveals that the mark is already being used for 'clopidogrel' products, marketed as follows:

x x x

"5.7. The generic name of LOPID is gemfibrozil, which helps reduce cholesterol and triglycerides (fatty acids) in the blood. Gemfibrozil is also used to lower the risk of stroke, heart attack, or other heart complications in people with high cholesterol and triglycerides who have not been helped by other treatment methods.

"5.8. Hence, it is clear that the pharmaceutical products covered by the competing marks are closely related, thereby aggravating the probability of public confusion as highly likely.

"5.9. In addition to being a well-known mark, both internationally and in the Philippines, Opposer's LOPID mark is likewise registered as a trademark in the Philippines. As such, Opposer is entitled to a wider scope of protection under Philippine law in that it is allowed to protect its LOPID mark against marks that are liable to create confusion in the minds of the public or used in bad faith under Article 6bis of the Paris Convention, thus:

x x x

"5.10. If allowed to proceed to registration, the consequent use of the GOPID mark by Respondent will amount to unfair competition with and dilution of Opposer's LOPID well-known mark, which has attained valuable goodwill and reputation through more than 35 years of extensive and exclusive use. This is prohibited under Section 168 of the IP Code.

"5.11. Opposer's goodwill is a property right separately protected under Philippine law, and a violation thereof amounts to downright unfair competition proscribed under Article 10bis of the Paris Convention, Article 28 of the Civil Code and Section 168 of the IP Code:

x x x

"5.12. On the other hand, Article 28 of the Civil Code and Section 168 of the IP Code provide:

x x x

"5.13. Opposer and/or its parent company, Pfizer Inc., their respective subsidiaries, joint ventures sister concerns, predecessors-in-title, licensees and assignees

in several other countries have extensively promoted the LOPID trademark worldwide, and have obtained significant exposure for the goods upon which the LOPID trademark is used in various media, including advertisements, internationally well-known print publications, and other promotional events.

"5.14. Opposer has not consented to Respondent's use and registration of the GOPID trademark, or any other mark identical or similar to the LOPID trademark. If Respondent uses the GOPID mark in class 5 for 'anti-thrombotic' preparations, which are similar, identical or closely related to the products that are produced by, originate from, or are under the sponsorship of Opposer, the purchasing public will be misled into believing that Respondent's goods are produced by, originate from, or are under the sponsorship of Opposer. This will result in potential damage to Opposer in light of its inability to control the quality of the products offered or put on the market by Respondent under the GOPID mark.

"5.15. It is apparent that Respondent's mark is calculated to ride on or cash in on the popularity of the LOPID mark, which undoubtedly has earned goodwill and reputation worldwide through Opposer's extensive use and promotion since 1979. Considering the substantial investment incurred by Opposer in promoting its goods and identifying itself throughout the world through the LOPID mark, it is clear that Respondent's deceitful conduct in securing the registration of a mark similar to Opposer's and in exploiting the same is aimed towards unduly enriching itself at the expense of Opposer.

"5.16. If Respondent were to be allowed to register and use its mark in connection with the advertisement, sale and distribution of its goods that are similar, identical, or closely related to Opposer's own goods, the consuming public would no doubt be misled into assuming or believing that Respondent's goods are delivered by, originate from, or are under the sponsorship of Opposer. Respondent's use of its mark would indicate a connection between Respondent's products and Opposer's, when in truth and in fact there is none.

"5.17. At the very least, the use by Respondent of the GOPID mark in relation to its goods, whether or not identical, similar or closely related to the Opposer's goods will take unfair advantage of, dilute and diminish the distinctive character or reputation of the LOPID trademark. Opposer will suffer grave and irreparable injury to its goodwill, reputation and business as a whole should the registration and consequent use of the subject mark be allowed by this Honorable Office.

"5.18. It may interest the Honorable Office to note that Respondent has previously attempted to register a trademark for 'LORID' (Application NO. 4-2007-014169 filed on 21 December 2007), which was opposed by Opposer and Pfizer Inc. under IPC No. 14-2008-00237. In a Decision rendered by this Honorable Office on 10 June 2009, the opposition was sustained. On 10 September 2010, said Decision became final and executory when the petition for review filed by Respondent before the Court of Appeals was denied. Attached as Annex 'E' hereof is a copy of this Honorable Office's Decision dated 10 June 2009 in said case, while Annex 'F' hereof are the Resolutions issued by the Court of Appeals.

"5.19. This being the second attempt of Respondent to register a mark with only a one-letter difference from Opposer's LOPID mark, with more reason should Respondent's trademark application before this Honorable Office be denied.

x x x

The Opposer's evidence consists of the Notice of Opposition; copies of the notarized Certificate of Authority and Special Power of Attorney dated 4 December 2014; various product packaging inserts of LOPID from several jurisdictions including the Philippines, Hong Kong, Taiwan, India, Ireland, the United States of America, Denmark, Mexico and Indonesia; copy of a table showing the details of applications and registrations for the LOPID mark worldwide; representative copies of registrations of the LOPID mark all over the world; copies of journal articles, studies, letters, and lists, showing that the LOPID mark has appeared and was described in major international publications worldwide dealing with pharmaceutical products.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 16 February 2015. Respondent-Applicant filed its Answer via registered mail. On 07 April 2015, this Bureau issued Order No. 2015-497 directing the Respondent-Applicant to submit the original Secretary's Certificate. The Respondent-Applicant, however, filed the Compliance beyond the period to submit, hence, Respondent-Applicant was declared in default.

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

The Opposer anchors its opposition on Sections 123.1, paragraphs (d) and (e), 147 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 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;"
  
- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

<sup>4</sup>Marked as Exhibits "A" and "G", inclusive.

- (f) Is Identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use.
- (g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services.

Records show that at the time the Respondent-Applicant filed its trademark application on 06 May 2014, the Opposer already has an existing trademark registration for the mark LOPID under Certificate of Registration No. 048682 issued on 18 July 1990. The registration covers lipoprotein reducing preparations that lower cholesterol and triglyceride levels in Class 05. This Bureau noticed that the products indicated in the Respondent-Applicant's trademark application, i.e. pharmaceutical preparations namely anti-thrombotic under Class 05, are closely-related to the Opposer's.

But, are the competing marks, as shown on the next page, resemble each other such that confusion, or even deception is likely to occur?

**Lopid**

Opposer's trademark

**GOPID**

Respondent-Applicant's mark

Confusion is likely in this instance because of the close resemblance between the marks and that the goods covered by the competing marks are closely-related as they are indications or treatment for heart diseases. Respondent-Applicant's mark GOPID adopted the dominant features of Opposer's mark LOPID. GOPID appears and sounds almost the same as Opposer's trademark LOPID. Both LOPID and GOPID marks contain the letters OPID. Respondent-Applicant merely changed the first letter "L" in Opposer's LOPID with the letter "G" to come up with the mark GOPID. 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"<sup>5</sup>, "SAPOLIN" and LUSOLIN"<sup>6</sup>, "CELDURA" and

<sup>5</sup> *MacDonalds Corp, et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

<sup>6</sup> *Sapolin Co. v. Balmaceda and Germann & Co*, 67 Phil, 705.

"CORDURA"<sup>7</sup>, "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 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.<sup>8</sup>


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>9</sup> This Bureau finds that the mark applied for registration by the Respondent-Applicant does not meet this function.

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

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-00005480 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, 20 APR 2016.

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

<sup>7</sup> *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.)

<sup>8</sup> *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297,22 Dec. 1966.

<sup>9</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepe 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).