

L.R. IMPERIAL, INC.,
Opposer,

-versus-

AMBICA INTERNATIONAL CORP.,
Respondent- Applicant.

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}
} **IPC No. 14-2015-00484**
} Opposition to:
} Appln. Serial No. 4-2015-008391
} Date Filed: 28 July 2015
} **TM: "ROSUVIN"**

NOTICE OF DECISION

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AMBICA INTERNATIONAL CORPORATION
Respondent-Applicant
#9 Amsterdam Extension
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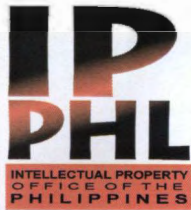
GREETINGS:

Please be informed that Decision No. 2016 - 165 dated June 02, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 02, 2016.

For the Director:

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



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TM: "ROSUVIN"

DECISION NO. 2016- 165

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DECISION

L.R. IMPERIAL, INC. ("Opposer"),¹ filed an opposition to the Trademark Application Serial No. 4-2015-008391. The application filed by AMBICA INTERNATIONAL CORP. ("Respondent-Applicant")², covers the mark "ROSUVIN" for use on "*pharmaceutical preparations namely anticholesterolemia/antidyslipidaemia*" under Class 05 of the International Classification of Goods.³

The Opposer alleges that the mark ROSUVIN filed by Respondent-Applicant so resembles the trademark ROSWIN owned by Opposer and duly registered with IPO prior to the publication for opposition of the mark ROSUVIN. Opposer also claims that the mark ROSUVIN will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark ROSUVIN is applied for the same class and goods as that of Opposer's trademark ROSWIN, i.e., for Antihyperlipidemic pharmaceutical preparations. As such, its registration will violated Section 123.1 (d) of the IP Code.

Opposer's evidence consists of the following:

1. Exhibit "A" - Copy of the pertinent page of IPO e-Gazette dated 14 September 2015;
2. Exhibit "B" - certified copy of the Trademark Registration No. 4-2010-009015 for the mark ROSWIN;
3. Exhibits "C"- copy of the Declaration of Actual Use filed on 02 August 2013;
4. Exhibit "D" - sample product packaging label bearing the trademark ROSWIN actually used in commerce;
5. Exhibit "E" - Certification of sales performance of ROSWIN; and
6. Exhibit "F" -Certificate of Listing of Identical Product issued by the FDA (previously BFAD).

This Bureau issued on 22 October 2015 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant on 04 November 2015. The Respondent-Applicant, however, did not file the Answer. On 20 May 2016, this Bureau declared Respondent-Applicant in default. Accordingly, pursuant to Rule 2 Section 10

¹ A domestic corporation with principal office address at 2nd Floor Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.
² A domestic corporation with address at #9 Amsterdam Extension, Merville Park Subdivision, Parañaque City.
³The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark **ROSUVIN**?

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. Thus, Sec. 123.1 (d) of the IP Code 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 or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its application for the mark ROSUVIN on 28 July 2015, the Opposer has already been issued a registration for its trademark ROSWIN on 13 January 2011 covering goods under Class 05. Respondent-Applicant's mark will be used also on goods under Class 5.

But, are the competing marks identical or confusingly similar and used on the same or closely related goods as to likely deceive or cause confusion?

The marks are reproduced below for comparison:

ROSWIN

Opposer's Mark

ROSUVIN

Respondent-Applicant's Mark

A comparison of the above competing trademarks show that they contain the same first three letters "**ROS**" and the last two letters "**IN**". The font used also appears similar. The marks differ only in the letter "**W**" in Opposer's which was changed to "**UV**" in Respondent-Applicant's mark to produce the mark ROSUVIN. This difference, however, pales into insignificance because of the close resemblance between the two marks. Also, when pronounced, Respondent-Applicant's mark produces the same sound as that of Opposer's mark. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark. Similarity of sound is sufficient ground to rule that two marks are confusingly similar when applied to merchandise of same descriptive properties. In fact, the Supreme Court has in many cases took into account the aural effects of the words and letters contained in the

marks in determining the issue of confusing similarity. In *Marvex Commercial Co., Inc. v Petra Hawpia & Co., et al.*⁴, the Court held:

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Marks*, 1947, Vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jass-Sea"; "Silver Flash" and "Supper Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo." Leon Amdur, in his book "Trade-Mark Law and Practice," pp. 419-421, cites [sic], as coming within the purview of the idem sonans rule, "Yusea" and "U-C-A," "Steinway Pianos" and "Steinberg Pianos," and "Seven-Up" and "Lemon-Up." In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Condura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin," as the sound of the two names is almost the same.

The likelihood of confusing similarity between the marks of the parties are made more evident because they are used on similar goods. Respondent-Applicant's mark is being applied for use on pharmaceutical preparations namely anti-cholesterolemia /anti-dyslipidaemia. "*Cholesterolemia*" means "*the abnormal condition of the presence of excessive amounts of cholesterol in the blood.*"⁵ On the other hand, the approved indication of Opposer's ROSWIN (generic name *Rosuvastatin*) is "an adjunct to diet to reduce elevated total cholesterol, low density lipoprotein cholesterol, apolipoprotein B, non-high density lipoprotein cholesterol and triglycerides levels and to increase HDL-C in patients with primary hypercholesterolaemia." Considering that the goods of the parties are similar or closely related there is likelihood that any impression, perception or information about the goods advertised under the mark ROSUVIN may be unfairly attributed or confused with Opposer's ROSWIN, and vice versa.

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 other⁶. Colorable imitation does not mean such similitude as amounts 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 trade name with that of the other mark or trade name 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 article⁷.

It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favor with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.⁸

⁴ G.R. No. L-19297. December 22, 1966 cited in *McDonald's Corporation v. L.C. Big Mak Burger, Inc.*, G.R. No. 143993. August 18, 2004.

⁵ <http://medical-dictionary.thefreedictionary.com/cholesterolemia>, accessed on 24 May 2016.

⁶ See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁷ See *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

⁸ See *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990

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. 4-2015-008391, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 JUN 2016


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