

WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

NINA S. CAMPOS,
Respondent -Applicant.

X-----X

}
} IPC No. 14-2015-00469
} Opposition to:
} Appln. Serial No. 4-2015-503025
} Date Filed: 03 June 2015
} TM: "IMUCIN"
}
}
}
}

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for Opposer
No. 66 United Street
Mandaluyong City

NINA S. CAMPOS
Respondent-Applicant
House No. 12, South City Homes Subdivision
Uldog St. Consojong
Talisay City, Cebu 6045

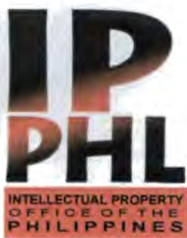
GREETINGS:

Please be informed that Decision No. 2016 - 153 dated May 31, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 31, 2016.

For the Director:

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



WESTMONT PHARMACEUTICALS, INC., }
Opposer, }
 -versus- }
 NINA S. CAMPOS, }
Respondent-Applicant. }
 x-----x

IPC No. 14-2015-00469
 Case Filed: 07 October 2015
 Opposition to:
 Application No. 4-2015-503025
 Date Filed: 03 June 2015
 Trademark: "IMUCIN"
 Decision No. 2016- 153

DECISION

WESTMONT PHARMACEUTICALS, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2015-503025. The application, filed by Nina S. Campos² ("Respondent-Applicant"), covers the mark "IMUCIN" for use as "dietary/food supplement" 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 Verified Notice of Opposition are as follows:

"7. The mark 'IMUCIN' applied for by Respondent-Applicant so so resembles the trademark 'IMMUNOSIN' owned by Opposer and duly registered with this Honorable Bureau prior to the publication of the application for the mark 'IMUCIN'.

"8. The mark 'IMUCIN' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'IMUCIN' is applied for the same class as that of Opposer's trademark 'IMMUNOSIN', i.e., Class 05 of the International Classification of Goods.

"9. The registration of the mark 'IMUCIN' in the name of Respondent-Applicant will violate Sec. 123.1 (d) of the IP Code, which provides, in part, that a mark cannot be registered if it: x x x

"10. Under the above-quoted provision, any mark, which is similar to a registered mark, 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.

¹A corporation duly organized and existing under the laws of the Philippines with principal office located at Bonaventure Building, Greenhills, San Juan, Metro Manila, Philippines.
²With address at House No. 12, South City Homes Subdivision, Uldog St., Cansojong, Talisay City, Cebu, 6045, Philippines.
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.

"11. Respondent-Applicant's use and registration of the mark 'IMUCIN' will diminish the distinctiveness of Opposer's trademark 'IMMUNOSIN'

"ALLEGATIONS IN SUPPORT OF THE OPPOSITION

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

"12. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products and is the registered owner of the trademark 'IMMUNOSIN'.

"12.1. The Trademark Application for the trademark 'IMMUNOSIN' was filed with the Bureau of Patents, Trademarks and Technology Transfer on 2 August 1988 by General Drug & Chemical Company, Inc. ('GDCCI') and was approved for registration on 23 November 1989 to be valid for a period of twenty (20) years, or until 23 November 2009. A certified true copy of Principal Register No. 46980 for the trademark 'IMMUNOSIN' is attached hereto x x x

"12.2. Subsequently, on 18 September 1999, GDCCI assigned the trademark 'IMMUNOSIN' to herein Opposer. A certified true copy of the Assignment of Registered Trademark dated 18 September 1999 duly filed with the IPO on 22 September 1999 is attached hereto x x x

"12.3. Before the expiration of the registration, Opposer timely filed a petition for renewal of registration, which was accordingly granted and valid for another period of ten (10) years, or until 23 November 2019. A certified true copy of Certificate of RENEWAL of Registration No. 046980 is attached hereto x x x

"12.4. Thus, the registration of the trademark 'IMMUNOSIN' subsists and remains to be valid to date.

"13. The trademark 'IMMUNOSIN' has been extensively used in commerce in the Philippines.

"13.1. GDCCI and Opposer have dutifully filed Affidavits of Use and Declarations of Actual Use pursuant to the requirement of the law. Certified true copies of the Affidavits of Actual Use and Declarations of Actual Use are attached hereto x x x

"13.2. A sample product label bearing the trademark 'IMMUNOSIN' actually used in commerce is hereto attached x x x

"13.3. No less than the International Marketing Services ('IMS') itself, the world's leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than one hundred (100) countries, acknowledged and listed the brand 'IMMUNOSIN' as one of the leading brands in the Philippines in the category of 'J05B- AntiVirals Excl. Anti-HIV' in terms of market share and sales performance. The Certification and sales performance issued by the IMS is attached hereto x x

"13.4. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, the product has been registered with the Bureau of Food and Drugs (now Food and Drug Administration). As evidence of such registration a certified true copy of the Certificate of Product Registration No. DR-XY4759 is attached hereto x x x

"14. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark, 'IMMUNOSIN' to the exclusion of all others.

"15. As provided in Section 138 of the IP Code, '[a] certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.'

"16. The registration of Respondent-Applicant's mark 'IMUCIN' will be contrary to Section 123.1 (d) of the IP Code. 'IMUCIN' is confusingly similar to Opposer's trademark 'IMMUNOSIN'.

"16.1. 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.

"16.1.1. In *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* [356 SCRA 207, 216 [2001]], the Supreme Court, citing *Ethepa v. Director of Patents* (16 SCRA 495, 497-498 [1966]), 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."

"16.1.2. 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."

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

"16.1.4. This was affirmed in *McDonald's Corporation vs. Macjoy Fastfood Corporation* (514 SCRA 95, 107-108 [2007]), which held that, '[t]he Court has consistently used and applied the dominancy test in determining confusing similarity or likelihood of confusion between competing trademarks.

"16.1.5. In fact, the dominance test is 'now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code, which defines infringement as the colorable imitation of a registered mark x x x or a dominant feature thereof' x x x

"16.1.6 Thus, applying the dominance test in the instant case, it can be readily concluded that the mark 'IMUCIN', owned by Respondent-Applicant, so resembles Opposer's trademark 'IMMUNOSIN', that it will likely cause confusion, mistake and deception on the part of the purchasing public.

"16.1.6.1. Respondent-Applicant's mark 'IMUCIN' appears and sounds almost the same as Opposer's trademark 'IMMUNOSIN'.

"16.1.6.2. The first three (3) and last two (2) letters of Respondent-Applicant's mark 'I-M-U-C-I-N' are exactly the same as the first two (2), fourth and last two (2) letters of Opposer's trademark 'I-M-M-U-N-O-S-I-N'.

"16.1.6.3. Both marks are pronounced with the same intonation.

"16.1.7. Clearly, Respondent-Applicant's mark 'IMUCIN' adopted the dominant features of the Opposer's trademark 'IMMUNOSIN'.

"16.1.8 As further ruled by the High Court in the McDonald's Corporation case (supra, p. 33-34 [2004]):

x x x

"16.1.9. In American Wire & Cable Co., vs. Director of Patents (31 SCRA 544, 547-548 [1970]), the Supreme Court explained:

x x x

"16.2. Opposer's trademark 'IMMUNOSIN' and Respondent-Applicant's mark 'IMUCIN' are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

"16.3. Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed mark 'IMUCIN' is applied for the same class as that of Opposer's trademark 'IMMUNOSIN' under Class 05 of the International Classification of Goods.

"16.4. Nevertheless, Respondent-Applicant still filed a trademark application for 'IMUCIN' despite its knowledge of the existing trademark registration of 'IMMUNOSIN', which is confusingly similar thereto in both its sound and appearance, to the extreme damage and prejudice of Opposer.

"16.5. 'x x x When, as in the present case, one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to

avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill. x x x'

"16.6. Opposer's intellectual property right over its trademark is protected under Section 147.1 of the IP Code, which states: x x x

"17. To allow Respondent-Applicant to market its products bearing the mark 'IMUCIN' undermines Opposer's right to its trademark 'IMMUNOSIN'. As the lawful owner of the trademark 'IMMUNOSIN', Opposer is entitled to prevent the Respondent-Applicant from using a confusingly similar mark in the course of trade where such would likely mislead the public.

"17.1. Being the lawful owner of 'IMMUNOSIN', Opposer has the exclusive right to use and/or appropriate the said trademark 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.

"17.2. By reason of Opposer's ownership of the trademark 'IMMUNOSIN', it also has the right to prevent third parties, such as Respondent-Applicant, from claiming ownership over Opposer's trademark or any depiction similar thereto, without its authority or consent.

"17.3. Moreover, following the illustrative list of confusingly similar sounds in trademarks cited in the McDonald's Corporation case (supra, p. 34 [2004]), it is evident that Respondent-Applicant's mark 'IMUCIN' is aurally confusingly similar to Opposer's trademark 'IMMUNOSIN':

x x x

"17.4. Further, the fact that Respondent-Applicant seeks to have its mark 'IMUCIN' registered in the same class (Nice Classification 05) as Opposer's trademark 'IMMUNOSIN' will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

"18. The registration and use of Respondent-Applicant's confusingly similar mark 'IMUCIN' on its goods will enable the latter to obtain benefit from Opposer's reputation and goodwill, and will tend to deceive and/or confuse the public into believing that Respondent-Applicant is in any way connected with the Opposer.

"18.1. As held in *Sterling Products International, Inc. vs. Farbenfabriken Bayer Aktiengesellschaft, et. al.* (27 SCRA 1214, 1227 [1968]) there are two types of confusion in trademark infringement. 'The first is the confusion of goods' in which event the ordinarily prudent purchaser would be induced to purchase one 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 former reflects adversely on the plaintiff's reputation.' The other is the confusion of business: 'Here 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 be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist.'

"18.2. The doctrine of confusion of business or origin is based on cogent reasons of equity and fair dealing. It has to be realized that there can be unfair dealing by having one's business reputation confused with another. 'The owner of a trademark or trade name has a property right in which he is entitled to protection, since there is damage to him from confusion of reputation or goodwill in the mind of the public as well as from confusion of goods.' (*Ang vs. Teodoro*, 74 Phil 50, 55-56 [1942]).

"18.3. Applying the foregoing to the instant case, to allow Respondent-Applicant to use its mark 'IMUCIN' on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the product of Respondent-Applicant with a mark 'IMUCIN' originated from or is being manufactured by Opposer, or at the very least, is connected or associated with the 'IMMUNOSIN' product of Opposer, when such connection does not exist.

"18.4. In *Canon Kabushiki Kaisha vs. Court of Appeals* (336 SCRA 266, 275 [2000]), the Supreme Court explained that:

x x x

"18.5. Clearly, the scope of protection accorded to trademark owners includes not only confusion of goods but also confusion of origin. As in this case, there is undoubtedly also a confusion of the origin of the goods covered by the mark of Respondent-Applicant and trademark of Opposer, which should not be allowed.

"19. Further, even assuming that Respondent-Applicant's mark is used on goods different from the Opposer's, still the application for registration of the mark 'IMUCIN' should be denied on the ground of trademark dilution.

"19.1. 'Trademark dilution is the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of: (1) competition between the owner of the famous mark and other parties; or (2) likelihood of confusion, mistake or deception.' (*Levi Strauss & Co. Clinton Apparelle, Inc.* 470 SCRA 236, 255 [2005]). The injury caused by the concurrent use of similar or identical marks is not consumer confusion but the gradual whittling away or dispersion of the identity and hold upon public mind of the mark or name by its use upon non-competition goods. (*Schechter, Frank I. Rational Basis of Trademark Protection*)

"19.2. The dilution injury stems from an unauthorized effort to market incompatible products or services by trading on another's trademark. The anti-dilution law is intended to prevent a defendant from using a trademark without permission in order to merchandise dissimilar products or services. It has been developed to combat an unauthorized and harmful appropriation of a trademark by another for the purpose of identifying, manufacturing, merchandising, or promoting dissimilar products or services. The harm occurs when a trademark's identity and integrity-its capacity to command respect in the market- is undermined due to its inappropriate and unauthorized use by other market sectors. (*Tiffany & Co. vs. Boston Club, Inc.* 231 F. Supp. 836, 844 (D. Mass. 1964)

"19.3. In the instant case, even assuming Respondent-Applicant's mark is to be used on goods different from those of the Opposer's it will inevitably result in the trademark dilution of Opposer's trademark 'IMMUNOSIN'.

"19.4. Likewise, the registration of Respondent-Applicant's mark 'IMUCIN' will unfairly limit the already established and protected rights of the Opposer over its trademark 'IMMUNOSIN'.

"20. Respondent-Applicant's use of the mark 'IMUCIN' in relation to any of the goods covered by the opposed application, if these goods are considered not similar or closely related to the goods covered by Opposer's trademark 'IMMUNOSIN', will undermine the distinctive character or reputation of the latter trademark. Potential damage to Opposer will be caused as a result of its inability to control the quality of the products put on the market by Respondent-Applicant under the mark 'IMUCIN'.

"21. In case of grave doubt, the rule is that, '[a]s 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 inasmuch as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.' (Del Monte Corporation, et. al. vs. Court of Appeals, 181 SCRA 410, 420 [1990])

"21.1. In American Wire & Cable Co., vs. Director of Patents (supra, p. 551), it was observed that: x x x

"21.2. When a newcomer used, without a reasonable explanation, a confusingly similar, if not at all identical, trademark as that of another 'though the field of its selection was so broad, the inevitable conclusion is that it was done deliberately to deceive.' (Del Monte Corporation, et. al. vs. Court of Appeals, supra, p. 419-420 [1990]).

"22. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent-Applicant of the mark 'IMUCIN'. The denial of the application subject of this opposition is authorized under the IP Code.

"23. In support of the foregoing, the instant Notice of Opposition is herein verified by Mr. Renato T. Castaneda, which will likewise serves as his affidavit (Nasser v. Court of Appeals, 191 SCRA 783 [1990]).

The Opposer's evidence consists of a copy of the pertinent page of the IPO E-Gazette officially released on 07 September 2015; a copy of Principal Register No. 46980 for the trademark IMMUNOSIN; a copy of the Assignment of Registered Trademark dated 18 September 1999 filed with the IPO on 22 September 1999; a copy of Certificate of Renewal of Registration No. 046980; copies of the Affidavits of Actual Use and Declarations of Actual Use; a sample product label bearing the trademark 'IMMUNOSIN' actually used in commerce; a copy of the Certification and Sales Performance issued by the IMS for the brand IMMUNOSIN; and a copy of the Certificate of Product Registration No. DR-XY4759.⁴

⁴Marked as Exhibits "A" to "K".

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 13 November 2015. Said Respondent-Applicant, however, did not file an Answer.

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

The Opposer anchors its opposition on Sections 123.1, paragraph (d) 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;"

Records show that at the time the Respondent-Applicant filed its trademark application on 06 March 2015, the Opposer has an existing trademark registration for the mark IMMUNOSIN (Reg. No. 046980) issued on 23 November 1989. The registration covers "medicinal preparation useful as immunopotentiator" under Class 05. The Respondent-Applicant's trademark application for the mark IMUCIN covers "dietary/food supplement" under Class 05.

Hence, the question, does IMUCIN resemble IMMUNOSIN such that confusion or deception is likely to occur? The marks are shown below:

Immunosin

Opposer's trademark

IMUCIN

Respondent-Applicant's mark

Although both have the same first two (2) syllables "IMMU" or "IMU", Opposer can not exclusively appropriate these two syllables. The term "IMMU" or "IMU" may be inferred as derived from "immune", immune system or immunology considering that the Opposer's mark is intended as medicinal preparation useful for immunopotentiator. The prefix "IMMUNO", therefore, is not considered unique if used

as a trademark or as part thereof for the subject goods. Indeed, "IMMUNO" when used as part of a trademark connotes or suggests the immune system.

Succinctly, an opposition cannot be sustained solely for the reason that the contending marks both contain the word IMMU or IMU. What makes the trademark distinctive are the suffixes and/or devices, if any, appended to the prefix "IMMU" or "IMU". Corollarily, the determination whether there is confusing similarity would depend on the evaluation of the other words, letters or features that are added to the word IMMU or IMU. Confusion is likely in this instance because of the close resemblance between the marks which used the first syllable "IMMU" or "IMU" and the last syllable SIN/CIN. Hence, a mistake in the dispensation of these drugs is possible. Likewise, 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"⁵, "SAPOLIN" and LUSOLIN"⁶, "CELDURA" and "CORDURA"⁷, "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.⁸

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. 4/2015/00503025 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, 31 MAY 2016


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

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

⁶ *Sapolin Co. v. Balmaceda and Germann & Co.*, 67 Phil. 705.

⁷ *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.)

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