

**DRUG HOUSES OF AUSTRALIA
(OVERSEAS) LIMITED,**
Opposer,

-versus-

PETRA FOODS LIMITED,
Respondent- Applicant.

X-----X

} **IPC No. 14-2011-00218**
} Opposition to:
} Appln. Serial No. 4-2010-003311
} Date Filed: 26 March 2010
} **TM: "EUMENTHOL"**

NOTICE OF DECISION

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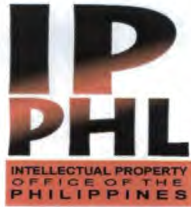
GREETINGS:

Please be informed that Decision No. 2016 - 171 dated June 13, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 13, 2016.

For the Director:

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



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IPC NO. 14-2011-00218

Opposition to:
Appln. Ser. No. 4-2010-003311
Filing Date: 26 March 2010
Trademark: **EUMENTHOL**

Decision No. 2016 - 171

DECISION

DRUG HOUSES OF AUSTRALIA (OVERSEAS) LIMITED¹ ("Opposer") filed a Verified Opposition to Trademark Application Serial No. 4-2011-003845. The application, filed by PETRA FOODS LIMITED² ("Respondent-Applicant") covers the mark **EUMENTHOL** for use on "*pharmaceutical substances being medicated candy, lozenges and medicated jujubes, dietetic foods adapted for medical use*" under Class 5 and "*confectionery, honey, glucose, flavourings other than essential oils and essences for foodstuffs, candy for food, sweetmeats [candy] sugar confectionery*" under Class 30 of the International Classification of goods³.

The Opposer alleges the following grounds:

"4.1. Opposer is the true, lawful owner of the well-known HUDSON'S EUMENTHOL Marks including the 'EUMENTHOL' Trademark.

"4.2. Respondent-Applicant's 'Eumenthol' mark is confusingly similar to Opposer's well-known HUDSON'S EUMENTHOL Marks and 'EUMENTHOL' Trademark, in violation of Section 123.1 (e) of the IP Code and international treaties.

"4.3. Respondent-Applicant's use and appropriation of the 'Eumenthol' mark misrepresents the true ownership of the said mark and sustains the belief that a connection or relationship between Opposer and Respondent-Applicant subsists, when there is none, to the detriment of the Opposer and the public."

The Opposer's evidence consists of the following:

1. Exhibit "A" - photograph of the back label of Hudson's Eumenthol Jujubes range of products first manufactured by Jack Chia Industries (Thailand) Public Co. Ltd in the

¹A corporation organized and existing under the laws of Hong Kong with address at Room 901 Yip Fung Building, 2-12 D'Aguiar Street, Central Hong Kong.

²A corporation organized and existing under the laws of Singapore with address at 111 Somerset Road, #16-01 Singapore Power Building, Singapore 238164.

³The 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.

- 1970's under license from Opposer ;
2. Exhibits "B" to "B-6" - photographs of other Hudson's Eumenthol Jujubes products produced under license from Opposer;
 3. Exhibit "C" - photos of Opposer's Hudson's Jujubes range bearing the mark "HUDSON'S EUMENTHOL" marks;
 4. Exhibits "D" and "E" - Hudson's Product Profile and brochures
 5. Exhibits "F" - copy of Invoice No. JCIT 02/99 dated 12 July 1999;
 6. Exhibits "G" - List showing the details of all of Opposer's worldwide registrations for HUDSON'S EUMENTHOL;
 7. Exhibits "H" to "J" - certified copies of registration certificates for the HUDSON'S EUMENTHOL issued in Australia and USA;
 8. Exhibits "K" and "L" - printout extracts from the IPOPHL's trademark online database of the marks HUDSON'S IN OVAL and HUDSON'S EUMENTHOL CHEMICAL COMPANY AND SNAKE & TREE DEVICE;
 9. Exhibit "M" - printout of the web listing in Pikaba.com;
 10. Exhibit "N" - printout of the web listing in www.bonanza.com; and
 11. Exhibit "O" - printout of the web listing in www.ioffer.com;

This Bureau issued on 27 June 2011 a Notice to Answer and personally served it to Respondent-Applicant's counsel. After several motions for extension of time, Respondent-Applicant filed the Verified Answer on 08 November 2011 alleging the following Special and Affirmative Defenses:

"I. PETRA FOODS is the lawful owner and prior user of the 'EUMENTHOL' word mark.

"II. The registration of PETRA FOODS' 'EUMENTHOL' mark is not contrary to Section 123.1 (d) of R.A. No. 8293.

"III. PETRA FOODS' use of the 'EUMENTHOL' mark cannot suggest a connection between it and Opposer.

To support its contention, Respondent-Applicant submitted as its evidence the Responsive Action (To Official Action Paper No. 2)⁴ filed on 23 November 2010 with the Bureau of Trademarks. On 28 November 2011, Opposer filed a Reply attaching Exhibits "P", "Q" and "R".

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation. On 28 February 2012, the Bureau's ADR Services submitted a report that the parties failed to settle the dispute. On 18 June 2012, the preliminary conference was terminated and the parties were directed to submit position papers. On 28 June 2012, the parties submitted their respective Position Papers.

Should the Respondent-Applicant be allowed to register the mark "EUMENTHOL"?

⁴ See Annex "A" to the Verified Answer.

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.⁵ 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 marks of the parties are shown below:



EUMENTHOL

Opposer's Marks

EUMENTHOL

Respondent-Applicant's Mark

There is no doubt that Respondent-Applicant's mark is confusingly similar to the Opposer's. Confusion is likely in this instance because of the resemblance of the competing trademarks. The competing marks contain the word "EUMENTHOL" which constitute the marks of the parties. While Respondent-Applicant's mark consists of the word "EUMENTHOL" itself sans the "representation of a snake and a tree surrounded by the words 'Hudson's Eumenthol Chemical Company' inside a round device above the term EUMENTHOL", still there is a likelihood that consumers or the public will be confused, mistaken or deceived that the goods upon which the competing marks are used come from the same source or origin because of the presence of the word "EUMENTHOL". Also, the goods upon which the marks are used are similar which all the more makes the likelihood of confusion apparent.

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, patent and warrant a denial of an application for registration, 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 purchaser of the older brand mistaking the newer brand for it.⁶

⁵See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

⁶See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

But who between Opposer and Respondent-Applicant has a better right over the EUMENTHOL mark?

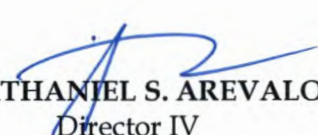
Records will show that when Respondent-Applicant filed its application for registration on 26 March 2010, Opposer already has earlier filed its own application for registration of its EUMENTHOL mark on 11 March 2010 under Trademark Application Serial No. 4-2010-002769. As between Opposer and Respondent-Applicant, it is the former who has priority right based on the filing dates Philippines. The Respondent-Applicant's trademark application is therefore proscribed under Sec. 123.1 (d) of the IP Code.

Records will also show that the mark EUMENTHOL was derived from the combination of the word "Eucalyptus" and "Menthol"⁷ which was registered since 1908 in Australia⁸ originally by Hudson Company for its "pastille" used in treatment of a range of oral problems. The mark was later on acquired by herein Opposer.⁹ Its registration in the United States of America dates back to 1949.¹⁰ On the other hand, Respondent-Applicant's claim of ownership over the mark EUMENTHOL is based on the assignment of the mark by Hudson Group Holdings (M) Sdn. Bhd. executed in 07 February 2006. However, Respondent-Applicant failed to show that the use by its predecessor of the mark EUMENTHOL was earlier than that of Opposer's. Thus, between Opposer and Respondent-Applicant, the former has a better right over the mark EUMENTHOL.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-003311, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **13 JUN 2018**


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

⁷ See Exhibit "P" of Opposer

⁸ Exhibit "H" of Opposer.

⁹ *Supra*, Note 6.

¹⁰ Exhibit "J" of Opposer.