

L.R. IMPERIAL, INC.,
Opposer,

-versus-

KUSUM HEALTHCARE PVT LTD.,
Respondent- Applicant.

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IPC No. 14-2015-00135
Opposition to:
Appln. Serial No. 4-2014-00015305
Date Filed: 15 December 2014
TM: "THROMBOSOLV"

NOTICE OF DECISION

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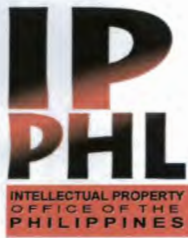
GREETINGS:

Please be informed that Decision No. 2016 - 207 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 30, 2016.

For the Director:

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



L.R. IMPERIAL, INC.,
Opposer,

- versus -

KUSUM HEALTHCARE PVT LTD.,
Respondent-Applicant.

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IPC No. 14-2015-00135

Opposition to:

Appln. No. 4-2014-00015305

Date Filed: 15 December 2014

Trademark : "THROMBOSOLV"

Decision No. 2016 - 207

DECISION

L.R. IMPERIAL, INC. ("Opposer"),¹ filed on 18 March 2015 a verified opposition to Trademark Application Serial No. 4-2014-00015305. The application, filed by KUSUM HEALTHCARE PVT LTD. ("Respondent-Applicant")², covers the mark "THROMBOSOLV" for use on goods under class 05³ namely: *pharmaceutical preparations*.

The Opposer alleges the following grounds for opposition:

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

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

"9. The registration of the mark 'THROMBOSOLV' in the name of the Respondent-Applicant will violate Sec. 123.1(d) of the IP Code.

" 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;

x x x (Emphasis supplied)

¹ A domestic corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines with office address at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, City of San Juan.
² Local agent's address at 831-A Eugenio Lopez St. corner EDSA, Quezon City.
³ The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

"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.

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

The Opposer's evidence consists of the following:

1. Respondent-Applicant's trademark application published for opposition in IPO E-Gazette;
2. Certified true copy (Ctc) of Certificate of Registration No. 4-2008-011456 for TROMBOCIL;
3. Ctc of Declarations of Actual Use;
4. Certificate of Product Registration No. DR-XY33394;
5. Sample product label bearing the trademark TROMBOCIL; and,
6. Certification and sales performance issued by the IMS.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer dated 27 March 2015 which was received by the Respondent-Applicant on 01 April 2015. However, this Bureau did not receive an answer and thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision.⁴

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

Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property Code ("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 if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 15 December 2014⁵, the Opposer has already an existing trademark registration for the mark TROMBOCIL bearing Registration No. 4-2008-0104556 dated 19 January 2009 in the Philippines falling under Class 05 for antiplatelet/peripheral vasodilator pharmaceutical preparations.⁶ It has also filed Declarations of Actual Use within 3 years from filing date⁷, and in the 5th year anniversary.⁸ Significantly, this Bureau noticed that the Respondent-Applicant's trademark application indicates that THROMBOSOLV is or will be used as "pharmaceutical preparations".

Nevertheless, it is unlikely that the co-existence of the marks will cause confusion, much less deception, among the public. The only similarities between the marks, as shown below,

Trombocil

Opposer's Trademark

THROMBOSOLV

Respondent-Applicant's Trademark

⁴ Order No. 2015-1107 dated 29 July 2015.

⁵ Filewrapper records.

⁶ Exhibit "B" of Opposer.

⁷ Exhibit "C" of Opposer.

⁸ Exhibit "D" of Opposer.

are the first and middle last syllables "TROM" or "THROM" and "BO".

In this regard, it appears that the abovementioned syllables are not accurate indicator of the existence of confusing similarity between the marks because the syllables are common in drugs or medicine, over which the Opposer cannot claim exclusive rights. "TROMBO" or "THROMBO" is obviously derived from the word "*thrombocyte*", which is the synonym of "*platelets*" or the large cells found in the bone marrow. The function of which is to contribute to chemical blood clotting and to other aspects of hemostasis.⁹ In fact, the Opposer's sample product packaging indicates TROMBOCIL as antiplatelet peripheral vasodilator.¹⁰ It is a fair inference that TROMBOCIL is derived from "THROMBOCYTES".

TROMBOCIL thus, is not highly distinctive as a trademark. At most, it is considered a suggestive mark, which is a weak mark. What will set apart or distinguish such mark from another mark which also includes the same or similar syllables, are the letters and/or syllable that precede "TOMBO" or "THROMBO". In this instant, it is very unlikely that a consumer will be misled or confused into believing that the Respondent-Applicant's goods came or originated from or connected to or associated with the Opposer's. The Respondent-Applicant's mark ends with "SOLV" which is so much different, visually and aurally, from "CIL" in the Opposer's mark.

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.¹¹ This Bureau finds the Respondent-Applicant's mark consistent with this function.

Moreover, taking into account that the similarity between the competing marks is "THROMBO" or "TROMBO", sustaining the instant opposition would have the unintended effect of giving the Opposer the exclusive rights to use the same.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2014-00015305 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 30 JUN 2016


Atty. NATHANIEL S. AREVALO
Director W, Bureau of Legal Affairs

⁹ Platelet, The Free Dictionary by Farlex, available at <http://medical-dictionary.thefreedictionary.com/Trombocytes> (last accessed 14 June 2016).

¹⁰ Exhibit "F" of Opposer.

¹¹ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.