

THERAPHARMA, INC.,
Opposer,

-versus-

EON PHARMATEK INC.,
Respondent- Applicant.

X-----X

} **IPC No. 14-2015-00309**
}
} Opposition to:
} Appln. Serial No. 4-2015-001873
} Date Filed: 20 February 2015
} **TM: "HISTAFEX"**
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}
}
}
}

NOTICE OF DECISION

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

EON PHARMATEK, INC.
Respondent-Applicant
No. 17, 3rd Street, Brgy. Kapitolyo
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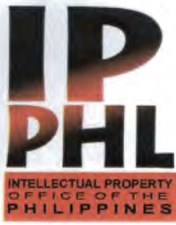
GREETINGS:

Please be informed that Decision No. 2016 - 244 dated July 12, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 12, 2016.

For the Director:

Edwin O. Daring
Atty. EDWIN DANILO A. DARING
Director III
Bureau of Legal Affairs



THERAPHARMA, INC.,

Opposer,

-versus-

EON PHARMATEK INC.,

Respondent-Applicant.

IPC No. 14-2015-00309

Opposition to Trademark

Application No. 4-2015-001873

Date Filed: 20 February 2015

Trademark: "HISTAFEX"

x ----- x Decision No. 2016- 244

DECISION

Therapharma, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2015-001873. The contested application, filed by EON Pharmatek Inc.² ("Respondent-Applicant"), covers the mark "HISTAFEX" for use on "anti-allergic drug" under Class 05 of the International Classification of Goods³.

The Opposer anchors its opposition on the provision of Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It alleges, among others, that it is engaged in the marketing and sale of a wide range of pharmaceutical products. The trademark application for the mark "HISTACORT" was filed with the then Philippine Patent Office ("PPO") on 09 November 1982 and was approved for registration on 09 February 1987. Before expiration thereof, it filed for a petition for renewal of registration, which was granted accordingly. It has also registered the mark with the Bureau of Food and Drugs, now Food and Drug Administration ("FDA"). It contends that the mark "HISTAFEX" is confusingly similar to its registered mark "HISTACORT". In support of its Opposition, the Opposer submitted the following as evidence:⁴

1. copy of Respondent-Applicant's trademark application as published in the IPO E-Gazette;
2. certified true copy of Certificate of Registration No. 36642;
3. certified true copy of Certificate of Renewal Registration no. 36642;
4. certified true copies of the Affidavits of Use and Declaration of Actual Use ("DAU") for the mark "HISTACORT";
5. sample product packaging of "HISTACORT"; and

¹ A corporation duly organized and existing under and by virtue of the laws of the Philippines with office address at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

² A corporation organized and existing under and by virtue of the laws of the Philippines with address at #17, 3rd Street, Brgy. Kapitolyo, Pasig City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

⁴ Exhibits "A" to "D".

6. certified true copy of the Certificate of Product Registration for "HISTACORT".

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant. The Respondent-Applicant filed its Answer on 10 July 2015 without the required Verification, Special Power of Attorney ("SPA") or any proof of authority of the person who executed the Verification and proof that it has furnished the Opposer a copy of the Answer. Thus, this Bureau issued Order No. 2015-1124 on 04 August 2015 directing the Respondent-Applicant to submit the said documents. The Respondent-Applicant, however, did not comply. Accordingly, the Hearing Officer issued on 03 March 2016 Order No. 2016-394 declaring the Respondent-Registrant in default and the case submitted for decision.

The issue in this case is whether the Respondent-Applicant's trademark application for the mark "HISTAFEX" should be allowed registration.

Records reveal that at the time the Respondent-Applicant filed an application for its mark "HISTAFEX" on 20 February 2015, the Opposer has a valid and existing registration of the mark "HISTACORT" issued as early as 09 February 1987.

Section 123.1(d) of the IP Code, relied upon by Opposer, provides that:

"Section 123.1. A mark cannot be registered if it:

(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"***

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown hereafter for comparison:

Histacort

Opposer's mark

HISTAFEX

Respondent-Applicant's mark


The marks are apparently similar with respect to its first syllable "HISTA". The term *hista*, however comes from the generic term antihistamine. Noteworthy, the Opposer's certificate of registration specifically states that the mark "HISTACORT" pertains to "*anti-allergic drug*". A mark or brand name itself gives away or tells the consumers the goods or service and/or the kind, nature, use or purpose thereof. Succinctly, what easily comes to the mind one when one sees or hears a mark or brand name of antihistamines of which the "hista" is a part of is the very concept or idea of the goods. As such, the Opposer cannot claim exclusive use or protection on the mere fact that another trademark appropriates "hista".

What will set apart or distinguish such mark from another which also includes the term "hista" is the letters, syllable or words that come before or after the generic name. In this case, the syllable "CORT" follows "HISTA" in the Opposer's mark, which is easily distinguishable from "FEX" in the Respondent-Applicant's. Clearly, they are not confusingly similar whether visually and aurally. In fact, the Trademark Registry, which this Bureau may take judicial notice, shows other registered marks belonging to different proprietors that similarly appropriate "HIST" or "HISTA", also for goods under Class 05, to wit: "HISTALORE" under Certificate of Registration No. 4-2005-007476, "ZYLOHIST" under Certificate of Registration No. 4-2012-002987 and "PREVAHIST" under Certificate of Registration No. 4-2007-003483.

Finally, it is emphasized that 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 This Bureau finds that the Respondent-Applicant's trademark is consistent with this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2015-001873 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 


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

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November, 1999.