

GRUNENTHAL GMBH,

Opposer,

-versus-

AMBICA INTERNATIONAL TRADING
CORP.,

Respondent-Applicant.

IPC No. 14-2015-00024

Opposition to:

Application No. 4-2014-007376

Date Filed: 11 June 2014

Trademark: TRAMALION

X-----X

NOTICE OF DECISION

ORTEGA BACORRO ODULIO CALMA & CARBONELL

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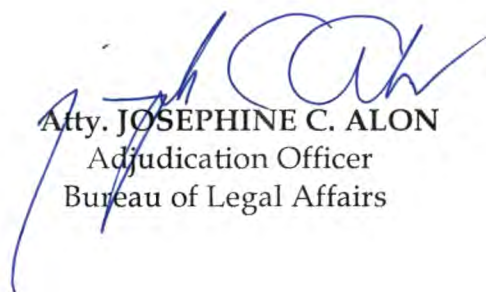
GENER C. SANSAET

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GREETINGS:

Please be informed that Decision No. 2016- 294 dated 25 August 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 25 August 2016.


Atty. JOSEPHINE C. ALON
Adjudication Officer
Bureau of Legal Affairs

"2. On the other hand, Respondent-Applicant filed its application to register its mark TRAMALION only on June 11, 2014 – or twenty seven (27) years after Opposer's trademark TRAMAL was first used in the Philippines, and twenty (25) years after it was registered locally.

"2.1. Respondent-Applicant seeks to register its trademark for TRAMALION in respect of goods in class 5, which is the same class covered by the Opposer's trademark registration for TRAMAL.

"2.2. Evidently, both trademarks are destined for use as brand names for pharmaceutical products which flow in the same channels of trade.

"3. Opposer's mark TRAMAL and Respondent-Applicant's mark TRAMALION are unmistakably aurally and visually similar, likely to deceive or to cause confusion:

"3.1. Respondent-Applicant's TRAMALION incorporates in its entirety Opposer's mark TRAMAL, which circumstance is likely to create confusion to the public. Hence, the trademarks have the same overall impression as shown below:

x x x

"3.2. Because Opposer's TRAMAL is in Respondent-Applicant's TRAMALION, the trademarks are not very different as a whole. The aural and visual similarities between the marks are strong and likely to make a lasting impression.

"3.3. In addition, the fact that Respondent-Applicant cunningly added '-ION' at the end of its mark TRAMALION does not make any substantial difference from Opposer's mark TRAMAL, especially since it dilutes the distinctiveness of Opposer's mark to the detriment of Opposer.

"3.4. Finally, when handwritten, as in written prescriptions, the marks are potentially confusingly similar as illustrated below:

x x x

"3.5. Therefore, the resemblance and similarities between Opposer's TRAMAL and the subject trademark TRAMALION are such that they will likely deceive or cause confusion to the public. This confusion should, of course, be avoided for the protection of the public.

"4. From the foregoing, it is reasonably clear that the registration of the trademark 'TRAMALION' should be proscribed under Section 123.1(d) of the Intellectual Property Code:

x x x

"5. In addition, trademark infringement is evident in Respondent-Applicant's adoption of the dominant features of TRAMAL in its use of the deception is likely to result, infringement takes place', as in the present case.

x x x



"5.3. Considering the close resemblance of Respondent-Applicant's trademark TRAMALION to Opposer's trademark TRAMAL and the same class of goods for which these marks are used, the public is likely to think that Respondent-Applicant's goods originate from Opposer or are sponsored by the Opposer. Thus, the similarity between the parties' marks falsely and misleadingly suggests a connection between TRAMALION and Opposer on the one hand, or between Respondent-Applicant and Opposer's goods bearing the trademark TRAMAL on the other hand.

"5.4. Thus, any use of the mark TRAMALION, which is a colorable imitation of the registered mark TRAMAL or, which contains the dominant features of the registered mark, constitutes trademark infringement under Sec. 155 of R.A. No. 8293, to wit:

x x x

"5.5. Therefore, Respondent-Applicant should be liable for trademark infringement, and the present application for registration of TRAMALION should be disallowed.

"6. Opposer's trademark TRAMAL is also well-known internationally and in the Philippines. Thus, Respondent-Applicant's mark TRAMALION should be denied registration under Section 123.1(e) of the Intellectual Property Code, to wit:

x x x

"6.2. The trademark TRAMAL is registered and/or is being applied for registration by Opposer in over one hundred twelve (112) countries across almost all continents, including Algeria, Argentina, Armenia, Aruba, Australia, Austria, Bahrain, Bangladesh, Belarus, Benelux, Bolivia, Bosnia & Herzegovina, Botswana, Brazil, Bulgaria, Caribbean Netherlands, Chile, China, Colombia, Costa Rica, Croatia, Cuba, Curacao, Cyprus, Czech Republic, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Estonia, Finland, France, Gaza, Georgia, Germany, Ghana, Greece, Guatemala, Honduras, Hong Kong, India, Indonesia, Iran, Iraq, Israel, Italy, Jamaica, Japan, Jordan, Kazakhstan, Kenya, Korea (South), Kuwait, Kyrgyzstan, Latvia, Lebanon, Liechtenstein, Lithuania, Macedonia, Malawi, Malaysia, Malta, Mauritius, Moldova, Montenegro, Morocco, Namibia, New Zealand, Nicaragua, Nigeria, Norway, Oman, Pakistan, Panaman, Paraguay, Peru, Philippines, Poland, Portugal, Qatar, Romania, Russian Federation, Saudi Arabia, Serbia, Singapore, Slovakia, Slovenia, South Africa, Spain, Sri Lanka, St. Maarten, Sudan, Swaziland, Sweden, Switzerland, Syria, Taiwan, Tajikistan, Thailand, Trinidad & Tobago, Tunisia, Turkey, Uganda, Ukraine, United Arab Emirates, Uruguay, Uzbekistan, Venezuela, Vietnam, West Bank and Yemen.

"6.3. Some certified true copies of the certificates of trademark registrations for TRAMAL are also submitted herewith as follows:

x x x

"6.4. The earliest date of international trademark registration of TRAMAL is February 6, 1975 in Germany.

"6.5. The pharmaceutical products bearing the trademark TRAMAL are sold worldwide, and the mark TRAMAL is also widely used in the following

countries, to name a few: Argentina, Australia, Austria, Brazil, Chile, Colombia, Germany, Greece, Guatemala, India, Indonesia, Japan, Morocco New Zealand Nicaragua, Pakistan, Peru, Philippines, Panama, Portugal, Switzerland, Taiwan, and Thailand.

"6.6. As a consequence of such use of the mark TRAMAL, Opposer has successfully achieved substantial and extensive sales worldwide:

x x x

"6.7. In the Philippines, the sales figures of the TRAMAL product for the last five (5) years are as follows:

x x x

"7. Finally, it is apparent that Respondent-Applicant's use and attempted registration of the trademark TRAMALION is done in bad faith, with manifest intent to ride on the popularity and goodwill of the trademark TRAMAL:

"7.1. TRAMAL has been in use in the Philippines, and therefore has been known to the Philippine public, as early as August 1, 1987, or almost three (3) decades prior to Respondent-Applicant's application for TRAMALION.

"7.2. The pharmaceutical products for which the trademark TRAMAL is used, are sold in various drugstores all over the Philippines. It is well-known in the local market, which makes it a valuable product and trademark for Opposer.

"7.3. TRAMAL is the subject of Certificates of Product Registration (CPR) issued by the Food and Drug Administration (FDA) of the Philippines:

x x x

"7.4. Advertising and promotion of the TRAMAL trademark have been aggressive and have successfully placed the brand among the top brands in the market. There is also great effort through the worldwide web to give more information on TRAMAL. It is currently present in several websites, which can be accessed by people worldwide who wish to know more about the products. The following are the websites where the products bearing the mark TRAMAL are promoted and advertised:

x x x

"7.5. Thus, the adoption by Respondent-Applicant of the mark TRAMALION having the same overall impression as Opposer's mark TRAMAL will diminish and dilute the distinctiveness of Opposer's mark TRAMAL which has been used by Opposer in the Philippines as early as August 1, 1987.

"7.6. Finally, Respondent-Applicant's propensity to adopt the main or dominant features of Opposer's mark TRAMAL for its own advantage, and with manifest intention to ride on the popularity of the said mark, is obvious from Respondent-Applicant's following applications:

"i. Philippine Trademark Application No. 4-2012-006962 for TRAMXL filed on June 11, 2012. Opposer filed an opposition against the

said application before this Honorable Office on December 14, 2012, docketed as Inter Partes Case No. 14-2012-000464.

"ii. Philippine Trademark Application No. 4-2014-006090 for TRAMAZE filed on May 15, 2014. Opposer filed an opposition against the said application before this Honorable Office on October 10, 2014, docketed as Inter Partes Case No. 14-2014-00356.

"8. In view of the foregoing, Respondent-Applicant's application for registration of the mark TRAMALION must be rejected considering its striking similarities with Opposer's mark TRAMAL. More importantly, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.

The Opposer's evidence consists of the affidavit of Mr. Marcus Heppner; print-out from the IPOPHL database of Philippine Trademark Registration No. 042630 for the mark TRAMAL; samples of product packaging, package inserts, and promotional materials bearing the trademark TRAMAL; copies of Certificates of Product Registration for the brand name TRAMAL; print-outs from several websites where the products bearing the mark TRAMAL are promoted and advertised; and print-out from the IPOPHL database of Philippine Trademark Registration No. 4-2014-007376 for the mark TRAMALION.⁴

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 11 March 2015. The Respondent-Applicant filed their Answer on 09 June 2015 and avers the following:

x x x

"Special and Affirmative Defenses

"12. The trademark 'TRAMALION' is not identical to, nor does so resemble, the trademark 'TRAMAL' so as to cause confusion, mistake or deception on the part of the purchasing public. The marks 'TRAMALION' and 'TRAMAL' are clearly different in spelling and have distinctive pronunciations, fonts, colors and designs, nor do they nearly resemble or are confusingly similar to each other as to be likely to deceive or cause confusion.

"13. Importantly, there is no indication at all that the use of the mark 'TRAMALION' would likely cause confusion or mistake in the mind of or deceive the ordinary purchaser, or one who is accustomed to buy, and therefore to some extent familiar with, the mark 'TRAMAL'.

"14. Even assuming for argument that somehow 'TRAMALION' is confusingly similar to 'TRAMAL' (although as discussed above they are not), Opposer has no right to be protected and cannot bar Respondent-Applicant from

⁴Marked as Exhibits "A" and "B", inclusive.

using the mark 'TRAMALION' as it cannot possibly acquire an exclusive ownership of the mark 'TRAMAL' to the exclusion of others it being a direct derivative of its international non-proprietary name, the generic term 'TRAMADOL'. In *Philippine Refining Co., Inc. v. Ng Sam and Director of Patents*, the Supreme Court affirmed the Director of Patents' refusal to exclude other users of the mark 'CAMIA' it being a generic term, thus:

x x x

"15. If there is confusing similarity, trademark dilution and intent to ride on the popularity of another mark, Opposer is the guilty party, 'TRAMAL' being a what can be considered a 'lame variation' of the generic term 'TRAMADOL'. Significantly, all the letters in 'TRAMAL' are also in 'TRAMADOL'. Truth to tell, if Opposer's logic is followed to its logical conclusion, it is not farfetched to state that 'TRAMAL' has the 'general impression, or a central figure or a dominant characteristic' of 'TRAMADOL' which is its international non-proprietary name that is incapable of being exclusively appropriated.

"16. At the least, Opposer could not have acquired any right over the first Five (5) letters of its claimed mark 'TRAMAL' i.e. TRAMA-, considering that the same is directly derived from the generic term 'TRAMADOL' which has the same first Five (5) letters. In *Sanofi-Aventis v. Ver Heilen Pharmaceuticals*, citing IP Code, Section 121.1, the Director General of the Hon. Office, cancelled the registration of the marks 'XARTAN' and 'XARTAN+' for being directly derived from the generic and International Non-Proprietary Name 'Losartan' ratiocinating thus:

x x x

"17. Without any exclusive right over the term TRAMA- of its claimed mark 'TRAMAL', only the remainder of the letters of the marks should now be compared, i.e. -L vis a vis -LION. The striking and total dissimilarities are at once evident.

"18. Opposer seems to take issue with, and ignore at the same time, Respondent-Applicant's use of the suffix -LION. The use of the suffix -LION is not at all random as it is derived from STALLION, which is 'TRAMALION's manufacture in India.

"19. Anent Opposer's change of confusion, the Generics Act of 1988 (RA No. 6675) requires that 'the generic name shall appear prominently and immediately above the brand name in all product labels as well as in advertising and other promotional materials' obviating any risk of confusion. In fact, 'All medical, dental and veterinary practitioners, including private practitioners, shall write prescriptions using the generic name. The brand name may be included if so desired.'

"20. Moreover, Republic Act No. 5921, also known as Act Regulating the Practice of Pharmacy also requires that 'No medicine, pharmaceutical, or drug of whatever nature and kind or device shall be compounded, dispensed, sold or resold, or otherwise be made available to the consuming public except through a prescription drugstore or hospital pharmacy, duly established in accordance with the provisions of this Act and that 'Every pharmacy, drugstore or hospital pharmacy whether owned by the government or a private person or firm shall at

all times when open for business by under the personal and immediate supervision of a registered pharmacist. These legal provisions further insure against possible confusion that Opposer claim to be guarding against.

"21. Moreover, comparison of packaging for 'TRAMALION' and 'TRAMAL' shows great variance further lessening any chance of confusion between said marks in actual commerce. The test of similarity is to consider the two marks in their entirety, as they appear in their respective labels, in relation to the goods to which they are attached (Bristol Myers Company v. Director of Patents, et al., 17 SCRA 128, citing Mead Johnson & Co. v. NVJ Van Dorp, Ltd., et al., 7 SCRA 768). The mark must be considered as a whole and not as dissected. If the buyer is deceived, it is attributable to the marks as a totality, not usually to any part of it. (Del Monte Corp. v. CA, 181 SCRA 410).

"22. The mark 'TRAMALION' being distinct from or dissimilar to the generic name 'TRAMAL', the same cannot give rise to a cause of action in favor of Opposer much less to exclude Respondent-Applicant from the use of a separate and distinct mark 'TRAMALION'. Accordingly, Opposer cannot claim any damage by reason of Respondent-Applicant's continued use of the mark 'TRAMALION'.

"23. Respondent-Applicant's use of the mark 'TRAMALION' in commerce is shown by the Food and Drug Administration's issuance of a Certificate of Product Registration in its favor, a copy of which is attached as Exhibit 3.

"24. Lastly, Opposer is a foreign corporation but Opposer has not alleged much less presented any proof that its home country 'extends reciprocal rights to nationals of the Philippines by law as required by Rule 2, Section 4 of the Rules and Regulations on Inter Partes Proceedings.' Accordingly, Opposer may not be allowed to oppose Respondent-Applicant's application.

The Respondent-Applicant's evidence consists of a copy of the mark or label; sample label and/or product packaging bearing the mark TRAMALION and a copy of the Certificate of Product Registration for the brand name Tramalion-P.⁵

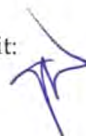
On 27 January 2016, the Preliminary Conference was terminated and the parties were directed to file their respective position papers. Thereafter, the case was deemed submitted for resolution.

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

Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

Sec. 123. Registrability. - 123.1. A mark cannot be registered if it:

x x x



⁵Marked as Exhibits "1" to "3".

- (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 11 June 2014, the Opposer already owns trademark registration for "TRAMAL" in different countries. In the Philippines, it registered the "TRAMAL" mark under Trademark Reg. No. 042630 issued on 19 January 1989. The "TRAMAL" registration covers "pharmaceutical products, viz. medicaments sold only on prescription which have an effect on the central nervous system in Class 05.

The competing marks, as shown below, are confusingly similar:

TRAMAL

Opposer's trademark

TRAMALION

Respondent-Applicant's mark

This Bureau finds that while the pharmaceutical products indicated in Respondent-Applicant's trademark application are not exactly similar to those covered by the Opposer's registration, confusion is still likely to occur in this instance because of the close resemblance between the marks and that the goods are for human consumption. Respondent-Applicant's mark TRAMALION adopted the dominant features of Opposer's mark TRAMAL. TRAMALION appears and sounds almost the same as Opposer's trademark TRAMAL. The first two (2) syllables and/or the first six (6) letters of both marks are the same. Respondent-Applicant merely added the letters I, O and N in coming up with the mark TRAMALION. 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"⁶, "SAPOLIN" and "LUSOLIN"⁷, "CELDURA" and "CORDURA"⁸, "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:

⁶ *MacDonalds Corp, et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

⁷ *Sapolin Co. v. Balmaceda and Germann & Co.*, 67 Phil, 705.

⁸ *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.)

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.⁹


While it may be true that "TRAMAL" was derived from the generic name "TRAMADOL", "TRAMAL" is sufficiently distinctive to be registered as a mark. It is considered a suggestive mark, which is a weak mark.

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1 par. (d) (iii) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-007376 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, 25 AUG 2016.


Atty. JOSEPHINE C. ALON
Adjudication Officer
Bureau of Legal Affairs

⁹ *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297, 22 Dec. 1966.