

HOECHST GMBH,
Opposer,

-versus-

DAEWOONG PHARMA
PHILIPPINES, INC.,
Respondent- Applicant.

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IPC No. 14-2014-00188
Opposition to:
Application No. 4-2013-008773
Date Filed: 24 July 2013
Trademark: "OLASTAR"

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NOTICE OF DECISION


CESAR C. CRUZ PARTNERS LAW OFFICES
Counsel for the Opposer
30th Floor, Ayala Life-FGU Center
6811 Ayala Avenue, Makati City

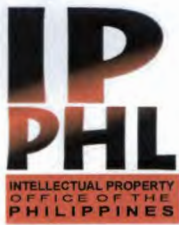
MINERVA A. LUCAS
Representative of Respondent-Applicant
Unit 2811, One Corporate Center
Julia Vargas corner Meralco Avenue
Ortigas Center, Pasig City

GREETINGS:

Please be informed that Decision No. 2016 - 374 dated October 13, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 13, 2016.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



HOECHST GMBH,
Opposer,

versus-

DAEWOONG PHARMA
PHILIPPINES, INC.
Respondent-Applicant.

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IPC NO. 14-2014-000188

Opposition to :
Appln. Ser. No. 4-2013-008773
Filing Date: 24 July 2013
Trademark: OLOSTAR

Decision No. 2016 - 374

DECISION

HOECHST GMBH,¹ ("Opposer") filed an Opposition to Trademark Application No. 4-2013-08773. The application, filed by DAEWOONG PHARMA PHILIPPINES, INC.² ("Respondent-Applicant"), covers the mark **OLOSTAR** for use on "*Dyslipidaemic/Angiotensin II antagonist pharmaceutical drug preparation*" under Class 05 of the International Classification of goods³.

Opposer alleges that the Respondent-Applicant's application for the registration of the mark OLOSTAR should not be given due course because it is contrary to Section 123.1 (d) of the Intellectual Property Code (IP Code). According to Opposer, the Respondent-Applicant's mark closely resembles and very similar to the Opposer's SOLOSTAR mark that was previously registered in the Philippines and in other countries involving similar goods covered under Class 5. As such, the registration and use of Respondent-Applicant's mark may cause confusion, mistake and deception to the public as to source of goods and will falsely suggest a connection between the Opposer and Respondent-Applicant.

The Opposer's evidence consists of the following:

1. Special Power of Attorney in favor of Cesar C. Cruz & Partners Law Offices;
2. Authenticated Affidavit of Dr. Derek Gribbin and Daniel Bendel;
3. List of countries where the mark is registered;
4. Representative samples of certificates of registration of the mark SOLOSTAR issued in Australia, Canada, China and OHIM;
5. Affidavit of Gloria Meñano;
6. Copies of marketing materials to promote the drug SOLOSTAR;
7. Copy of Certificate of Product Registration for the drug bearing the mark SOLOSTAR issued by the Food and Drug Administration;
8. Listing of hospitals, clinics, drugstores where SOLOSTAR was distributed; and
9. Copies of sample invoices for the drug SOLOSTAR issued to Metro Drug.

This Bureau issued on 05 August 2014 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant's representative on 12 August 2014. The Respondent-Applicant, however, did not file the Answer. On 24 June 2015, this Bureau declared Respondent-Applicant in

¹ A corporation duly organized and existing under the laws of Germany with principal address at Brunningstrasse 50, 65926 Frankfurt Am Main, Germany.

² A domestic corporation with office address at Unit 2811 One Corporate Center, Julia Vargas corner Meralco Avenue, Ortigas Center, Pasig City.

³ The 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.

Republic of the Philippines
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default. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark **OLOSTAR**?

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.⁴

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

Section 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;

The records will show that at the time the Respondent-Applicant filed its application for registration of the mark **OLOSTAR** on 24 July 2013, the Opposer already has an existing registration for the trademark **SOLOSTAR** issued way back in 08 October 2007. Thus, as between Opposer and Respondent-Applicant, the former has priority right as against the latter.

But are the competing marks, as shown below, identical or similar or resemble each other such that confusion, mistake or deception is likely to occur?

SOLOSTAR



Opposer's Marks

OLOSTAR

Respondent-Applicant's Mark

A perusal of the composition of the competing trademarks involved in this case show that

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.



both marks contain almost all the same letters. Opposer's mark consists of the letters "S-O-L-O-S-T-A-R" while Respondent-Applicant's consists of the letters "O-L-O-S-T-A-R". Respondent-Applicant merely dropped the first letter "S" in Opposer's mark to form its own mark OLOSTAR. Both marks are written in plain upper letters. Since the marks are mere word marks written in plain printed font and contains no other features, there is nothing that could help the consumers distinguish one from the other. Thus, the marks of the parties are confusingly similar as to likely cause confusion, mistake or deception on the part of the consumers as to the source of the goods and will falsely suggest a connection between Opposer and Respondent-Applicant.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other⁵. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁶.

A boundless choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his product from those of others. When, however, there is no reasonable explanation for the defendant's choice of such a mark though the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive.⁷

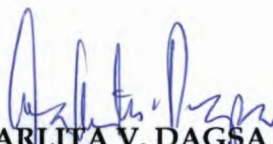
Adding up to the likelihood of confusion is the fact that both marks are used on goods belonging to Class 5 of the international classification of goods. Indeed, the determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two marks is such that there is possibility of the older brand mistaking the newer brand for it.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-008773, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **13 OCT 2016**


MARLITA V. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

⁵ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁶ *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

⁷ *Converse Rubber Corporation vs. Universal Rubber Products, Inc.*, G.R. No. L-27906. January 8, 1987.