

PEDIATRICA, INC.,

Opposer,

-versus-

AMBICA INTERNATIONAL TRADING CORPORATION,

Respondent-Applicant.

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IPC No. 14-2014-00491

Opposition to :

Appln. No. 4-2014-004596

Date Filed: 11 April 2014

TM : "CELESTAL"

X-----X

NOTICE OF DECISION

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GREETINGS:

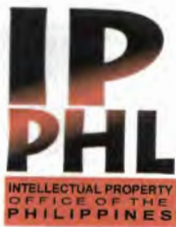
Please be informed that Decision No. 2016 - 358 dated October 05, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 05, 2016.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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Opposer,
 -versus-
 AMBICA INTERNATIONAL TRADING CORPORATION,
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IPC No. 14-2014-00491
 Opposition to:
 Application No. 4-2014-004596
 Date Filed: 11 April 2014
 Trademark: "CELESTAL"
 Decision No. 2016- 358

DECISION

PEDIATRICA, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-004596. The application, filed by Ambica International Trading Corporation² ("Respondent-Applicant"), covers the mark "CELESTAL" for use on "pharmaceutical preparations namely NSAID" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
"GROUNDS FOR OPPOSITION"

"The grounds for this Verified Notice of Opposition are as follows:

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

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

"9. The registration of the mark 'CELESTAL' in the name of the Respondent-Applicant will violate Sec. 123.1 (d) of the IP Code, which provides, in part, that a mark cannot be registered if it:

x x x

¹A domestic corporation duly organized and existing under the laws of the Philippines with office address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Metro Manila, Philippines.
² With address at #9 Amsterdam Extension, Merville Park Subdivision, Paranaque City, Metro Manila, Philippines.
³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the 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 'CELESTAL' will diminish the distinctiveness of Opposer's trademark 'RELESTAL'.

"ALLEGATIONS IN SUPPORT OF THE OPPOSITION

"In support of this Verified Notice of Opposition, Opposer will rely upon and prove the following facts:

"12. Opposer is the registered owner of the trademark 'RELESTAL'. It is engaged in the marketing and sale of a wide range of pharmaceutical products.

"12.1. The trademark application for the trademark 'RELESTAL' was originally filed with the Philippines Patent Office on 22 January 1975 by Opposer and was approved for registration on 5 December 1977 to be valid for a period of twenty (20) years, or until 5 December 1997. A certified true copy of the Certificate of Registration No. 25303 for the trademark 'RELESTAL' is attached hereto as Exhibit 'B' and made an integral part hereof.

"12.2. Before the expiration of the registration, Opposer filed an application for renewal of registration of the trademark 'RELESTAL' with the IPO, which was accordingly granted to be valid for another twenty (20) years from 5 December 1997 or until 5 December 2017. A certified true copy of the Certificate of RENEWAL of Registration No. 25303 is attached hereto as Exhibit 'C' and made an integral part hereof.

"12.3. Thus, the registration of the trademark 'RELESTAL' subsists and remains valid to date.

"13. The trademark 'RELESTAL' has been extensively used in commerce in the Philippines.

"13.1. Opposer has dutifully filed Affidavits of Use pursuant to the requirement of the law. Certified true copies of Affidavits of Use are attached hereto as Exhibit 'D', 'E', 'F', 'G', 'H' and 'I' and are made integral parts hereof.

"13.2. A sample product label bearing the trademark 'RELESTAL' actually used in commerce is hereto attached as 'Exhibit 'J' and made an integral part hereof.

"13.3. No less than the Intercontinental Marketing Services ('IMS') itself, the world's leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than one hundred (100) countries, acknowledged and listed the brand 'RELESTAL' as one of the leading brands in the Philippines in the category of 'A03A-Anti-spasmodic & Anti-cholinergic Plain' in terms of market share and sales performance. The original copy of the Certification and sales

performance issued by the IMS is attached hereto as Exhibit 'K' and made an integral part hereof.

"13.4. In order to legally market, distribute and sell this medicinal preparation in the Philippines, the product has been registered with the Bureau of Food and Drugs. As evidence of such registration a certified true copy of the Certificate of Product Registration No. DR-XY24410 for 'RELESTAL' is attached hereto as 'Exhibit L' and made an integral part hereof.

"14. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark 'RELESTAL' to the exclusion of all others.

"15. As provided in Section 138 of the IP Code, 'A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.'

"16. The registration of Respondent-Applicant's mark 'CELESTAL' will be contrary to Section 123.1 (d) of the IP Code. 'CELESTAL' is confusingly similar to Opposer's trademark 'RELESTAL'.

"16.1. There are no set rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or is a colorable imitation of, another. Nonetheless, jurisprudence provides enough guidelines and tests to determine the same.

"16.1.1. In *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* (356 SCRA 207, 216 [2001]), the Supreme Court, citing *Ethepa v. Director of Patents* (16 SCRA 495, 497-498 [1966]), held "[i]n determining if colorable imitation exists, jurisprudence has developed two kinds of tests - the Dominancy Test and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitute infringement. On the side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity."

"16.1.2. It is worthy to note at this point that in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* (Supra, p. 221) the Supreme Court held "[T]he totality or holistic test only relies on visual comparison between two trademarks whereas the dominancy test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks."

"16.1.3. Relative thereto, the Supreme Court in *McDonalds' Corporation vs. L.C. Big Mak Burger, Inc.* (437 SCRA 10, 32-33 [2004]) held:

x x x

"16.1.4. This was affirmed in *McDonald's Corporation vs. Macjoy Fastfood Corporation* (514 SCRA 95, 109 [2007]), which held

that, '[t]he Court has consistently used and applied the dominancy test in determining confusing similarity or likelihood of confusion between competing trademarks.'

"16.1.5. In fact, the dominancy test is 'now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code, which defines infringement as the colorable imitation of a registered mark xxx or a dominant feature thereof.' (MacDonald's Corporation, supra, p. 33 [2004])

"16.1.6. Thus, applying the dominancy test in the instant case, it can be readily concluded that the mark 'CELESTAL', owned by Respondent-Applicant, so resembles Opposer's trademark 'RELESTAL', that it will likely cause confusion, mistake and deception on the part of the purchasing public.

"16.1.6.1. Respondent-Applicant's mark 'CELESTAL' appears and sounds almost the same as Opposer's trademark 'RELESTAL'.

"16.1.6.2. The only difference between Opposer's trademark R-E-L-E-S-T-A-L, Respondent-Applicant's applied mark C-E-L-E-S-T-A-L is the first letter, which nevertheless is insufficient to eliminate the possibility of confusion.

"16.1.6.3. Both marks are composed of three (3) syllables, i.e., Respondent-Applicant's mark CE/LES/TAL and Opposer's mark RE/LES/TAL.

"16.1.6.4. Both marks are composed of eight (8) letters.

"16.1.6.5. Both marks are pronounced with the same intonation.

"16.1.7. Clearly, Respondent-Applicant's mark 'CELESTAL' adopted the dominant features of the Opposer's trademark 'RELESTAL'.

"16.1.8. As further ruled by the High Court in McDonald's Corporation case (supra p. 33-34 [2004]):

x x x

"16.1.9. In American Wire & Cable Co., vs. Director of Patents (31 SCRA 544, 547-548 [1970]), the Supreme Court explained:

x x x

"16.2. Opposer's trademark 'RELESTAL' and Respondent-Applicant's mark 'CELESTAL' are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

"16.3. Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed mark 'CELESTAL' is applied

for the same class and goods as that of Opposer's trademark 'RELESTAL' under Class 05 of the International Classification of Goods for pharmaceutical preparations.

"16.4. Opposer's intellectual property right over its trademark is protected under Section 147.1 of the IP Code, which states:

x x x

"17. To allow Respondent-Applicant to market its products bearing the mark 'CELESTAL' undermines Opposer's right to its trademark 'RELESTAL'. As the lawful owner of the trademark 'RELESTAL', Opposer is entitled to prevent the Respondent-Applicant from using a confusingly similar mark in the course of trade where such would likely mislead the public.

"17.1. Being the lawful owner of 'RELESTAL', Opposer has the exclusive right to use and/or appropriate the said marks and prevent all third parties not having its consent from using in the course of trade identical or similar marks, where such would result in a likelihood of confusion.

"17.2. By reason of Opposer's ownership of the trademark 'RELESTAL', it also has the right to prevent third parties, such as Respondent-Applicant, from claiming ownership over Opposer's trademark or any depiction similar thereto, without its authority or consent.

"17.3. Moreover, following the illustrative list of confusingly similar sounds in trademarks cited in McDonald's Corporation case (supra, p. 34), it is evident that Respondent-Applicant's mark 'CELESTAL' is aurally confusingly similar to Opposer's trademark 'RELESTAL'.

x x x

"17.4. Further, the fact that Respondent-Applicant seeks to have its mark 'CELESTAL' registered in the same class (Nice Classification 05) as Opposer's trademark 'RELESTAL' will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

"18. The registration and use of Respondent-Applicant's confusingly similar mark 'CELESTAL' on its goods will enable the latter to obtain benefit from Opposer's reputation and goodwill, and will tend to deceive and/or confuse the public into believing that Respondent-Applicant is in any way connected with Opposer.

"18.1. As held in *Sterling Products International, Inc. vs. Farbenfabriken Bayer Aktiengesellschaft, et. al.* (27 SCRA 1214, 1227 [1968]) there are two types of confusion in trademark infringement. 'The first is the confusion of goods' in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other.' In which case, 'defendant's goods are then brought as the plain' The other is the confusion of business: 'Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist.'

"18.2. The doctrine of confusion of business or origin is based on cogent reasons of equity and fair dealing. It has to be realized that there can be unfair dealing by having one's business reputation confused with another. 'The owner of a trademark or trade name has a property right in which he is entitled to protection, since there is damage to him from confusion of reputation or goodwill in the mind of the public as well as from confusion of goods.' (Ang vs. Teodoro, 74 Phil 50, 55-56 [1942])

"18.3. Applying the foregoing to the instant case, to allow Respondent-Applicant to use its mark 'CELESTAL' on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the product of Respondent-Applicant with a mark 'CELESTAL' originated from or is being manufactured by Opposer, or at the very least, is connected or associated with the 'RELESTAL' product of Opposer, when such connection does not exist.

"18.4. In Canon Kabushiki Kaisha vs. Court of Appeals (336 SCRA 266, 275 [2000]), the Supreme Court explained that:

x x x

"18.5. Clearly, the scope of protection accorded to trademark owners includes not only confusion of goods but also confusion of origin. As in this case, besides from the confusion of goods already discussed, there is undoubtedly also a confusion of the origin of the goods covered by the marks of Respondent-Applicant and Opposer, which should not be allowed.

"19. In case of grave doubt, the rule is that, '[a]s between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favor with the public, any doubt should be resolved against the newcomer inasmuch as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.' (Del Monte Corporation, et. al. vs. Court of Appeals, 181 SCRA 410, 420 [1990])

"20. Respondent-Applicant's use of the mark 'CELESTAL' in relation to any of the goods covered by the opposed application, if these goods are considered not similar or closely related to the goods covered by Opposer's trademark 'RELESTAL', will undermine the distinctive character or reputation of the latter trademark. Potential damage to Opposer will be caused as a result of its inability to control the quality of the products put on the market by Respondent-Applicant under the mark 'CELESTAL'.

"21. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent-Applicant of the mark 'CELESTAL'. The denial of the application subject of this opposition is authorized under the IP Code.

"22. In support of the foregoing, the instant Notice of Opposition is herein verified by Mr. Jose A. Peralta, which will likewise serves as his affidavit. (Nasser vs. Court of Appeals, 191 SCRA 783, 792-793 [1990])

The Opposer's evidence consists of a copy of the pertinent page of the IPO E-Gazette officially released on 7 October 2014; a copy of the Certificate of Registration No. 25303 for the trademark "RELESTAL"; a copy of the Certificate of RENEWAL of

Registration No. 25303; copies of the Affidavits of Use for the trademark "RELESTAL"; a sample product label bearing the trademark "RELESTAL"; a copy of the Certification and sales performance for A03A-Anti-spasmodic & Anti-cholinergic Plain; and a copy of Certificate of Product Registration No. DR-XY24410 for "RELESTAL".⁴

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 15 December 2014. The Respondent-Applicant filed their Answer on 02 February 2015 and avers the following:

x x x

"Special and Affirmative Defense

"11. The trademark 'CELESTAL' is not identical to, nor does so resemble, the trademark 'RELESTAL' so as to cause confusion, mistake or deception on the part of the purchasing public.

"12. The test of similarity is to consider the two marks in their entirety, as they appear in the 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).

"13. The generic name for the product 'CELESTAL' is 'Celecoxib' while 'RELESTAL' is 'Dicycloverine hydrochloride'. 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.' Due to the great disparity between 'Haloperidol' and 'Allopurinol', there is no basis for any charge of confusion between the two products.

"14. Moreover, Republic Act No. 5921, also known as an 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 be under the personal and immediate supervision of a registered pharmacist.' These pharmacists tasked to dispense medicine further insure against possible confusion that Opposer claim to be guarding against.

⁴Marked as Exhibits "A" to "L".

"15. 'CELESTAL' (s eh l - L EH S -tahl) and 'RELESTAL' (raeh- L EH S - tahl) greatly differ in pronunciation as the first syllable of each seems to be the dominant feature of each.

"16. Respondent-Applicant's use of the trademark 'CELESTAL' in commerce is shown by the Food and Drug Administration of a Certificate of Product Registration in its favor, a copy of which is attached as Annex 1.

The Respondent-Applicant's evidence consists of a copy of the Certificate of Product Registration for the Brand Name "Celestal-400" with the generic name "CELECOXIB 400 mg Capsule."⁵

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

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

Sec. 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;"

Sec. 138. *Certificates of Registration.* - A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.

Sec. 147.*Rights Conferred.* - 147.1. The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

Records show that at the time the Respondent-Applicant filed its trademark application on 11 April 2014, the Opposer has an existing trademark registration for the mark RELESTAL under Reg. No. 25303 issued on 5 December 1977. The registration covers "medicine (antispasmodic)" under Class 05. On the other hand, Respondent-

⁵ Marked as Exhibit "1".

Applicant's trademark application for the mark CELESTAL under Application Serial No. 4-2014-004596 covers "pharmaceutical preparations namely NSAID".

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

Relestal

CELESTAL

Opposer's trademark

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 CELESTAL adopted the dominant features of Opposer's mark RELESTAL. CELESTAL appears and sounds almost the same as Opposer's trademark RELESTAL. Both CELESTAL and RELESTAL marks have eight (8) letters. The seven (7) letters of both marks are the same. Both have three (3) syllables, "RE-LES-TAL" and "CE-LES-TAL". Respondent-Applicant merely changed the first letter "R" in Opposer's RELESTAL with the letter "C" to come up with the mark CELESTAL. 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:

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

It is emphasized that 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

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.)

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



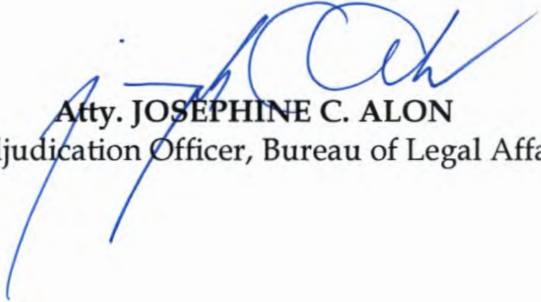
instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.¹⁰ This Bureau finds that the mark applied for registration by the Respondent-Applicant does not meet this function.

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

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-004596 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, 05 OCT 2016.


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

¹⁰ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepa v. Director of Patents, supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).