

GALDERMA S.A.,

Opposer,

-versus-

THE GENERICS PHARMACY INC.,

Respondent-Applicant.

X-----X

IPC No. 14-2011-00288

Opposition to :

Appl. No. 4-2011-000690

Date Filed: 21 January 2011

TM : **"CETAPHEN"**

NOTICE OF DECISION

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Counsel for Respondent-Applicant

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GREETINGS:

Please be informed that Decision No. 2016 - 347 dated October 06, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 06, 2016.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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GALDERMA S.A.,
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THE GENERICS PHARMACY, INC.,
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IPC No. 14-2011-00288
Opposition to Trademark
Application No. 4-2011-00690
Date Filed: 21 January 2011
Trademark: **"CETAPHEN"**

Decision No. 2016- 347

DECISION

Galderma S.A.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-000690. The application, filed by The Generics Pharmacy, Inc.² ("Respondent-Applicant"), covers the mark "CETAPHEN" for use on "*pharmaceutical; product categorized as analgesic/antipyretic/decongestant*" under Class 05 of the International Classification of Goods³.

The Opposer maintains that the Respondent-Applicant's mark "CETAPHEN" is confusingly similar to its own registered "CETAPHIL" trademark. It explains that "CET" is derived from "cetyl alcohol" while "APHIL" is a creative and inventive addition. According to the Opposer, its company is one of the world's leading dermatology company founded in 1981 as a joint venture with Nestle and L'Oreal. In the Philippines, its mark was first used in 1983. In support of its allegations in the Opposition, the Opposer submitted the following as evidence:

1. notarized and legalized affidavit-testimony of Julie Bernard;
2. notarized picture of "CETAPHIL" packaging;
3. notarized list of "CETAPHIL" registrations by country;
4. certified true copies of Bangladesh Trademark Registration No. 74045; Finland Trademark Registration No. 116870, Hongkong Trademark Registratio No. 00850/1997, Iceland Trademark Registration No. 132629, Namibia Trademark Registration No. 2000/0547, New Zealand Trademark Registration No. 252273, Philippine Trademark Registration No. 4-2008-013581 and UAE Trademark Registration No. 11032;

¹ A corporation existing under the laws of Switzerland with principal office Zugertrasse 8, 6330 Cham, Switzerland.

² With office address at 459 Quezon Avenue, Quezon City, Metro Manila.

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.

5. notarized summary of sale of "CETAPHIL" products from 2000-2010 in different countries;
6. notarized copies of promotional, advertising and detail aids of its products;
7. notarized extracts of "CETPHIL" webpages in major countries; and
8. notarized magazine press releases and features of its products.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 17 August 2011. The latter, however, did not file it Answer. On 09 November 2011, the Opposer moved to declare the Respondent-Applicant in default. On 10 January 2012, the Hearing Officer issued Order No. 2012-104 granting the Opposer's motion to declare the Respondent Applicant in default and submitting the case for decision based on the opposition, affidavits of witnesses and documentary evidence submitted by the Opposer.

The issue to be resolved is whether or not the mark "CETAPHEN" should be registered in favour of Respondent-Applicant.

Section 123.1 (d) of RA 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

"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; xxx."

Records show that at the time the Respondent-Applicant filed the contested application, the Opposer has a valid and existing registration for the mark "CETAPHIL" under Certificate of Registration No. 4-2008-013581 issued on 10 December 2009 for goods under Classes 03 and 05.

But are the competing marks, as shown hereafter, confusingly similar?

⁴ Marked as Exhibits "D" to "S", inclusive.

CETAPHIL

Opposer's mark

CETAPHEN

Respondent-Applicant's mark

The competing marks both begin with the syllables "CETAPH". According to the Opposer, it derived the syllable "CET" from cetyl alcohol but the rest of the letters in its mark is coined by it. On the other hand, no explanation was proffered by the Respondent-Applicant on how it came up with a closely similar trademark. It appears that the Respondent-Applicant merely replaced the the last two letters in the Opposer's mark, "IL", for "EN". Despite the same, the two marks remain visually and phonetically similar. After all, 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 purchased as to cause him to purchase the one supposing it to be the other.⁵

It is highly probable that the purchasers will be led to believe that Respondent-Applicant's mark is a mere variation of Opposer's mark and that its goods are associated with the latter especially that both marks cover goods under Class 05. Succinctly, it is settled that the likelihood of confusion, mistake and/or deception will subsist not only as to the consumer's perception of the goods but also on the origins thereof. Callman notes two types of confusion. 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 bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." 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 then 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."⁶

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

⁵ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

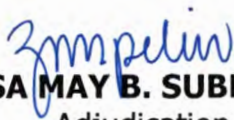
⁶ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

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.⁷ The Respondent-Applicant's mark fell short in meeting this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-000690 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 OCT 2016


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.