

GRUNENTIAL GMBH,
Opposer,

-versus-

AMBICA INTERNATIONAL TRADING CORP.,
Respondent-Applicant.

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IPC No. 14-2012-00464

Opposition to:

Appln. Serial No. 4-2012-006962

Date Filed: 11 June 2012

TM: TRAMXL

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 405 dated 10 November 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 10 November 2016.

MARILYN F. RETUAL

IPRS IV

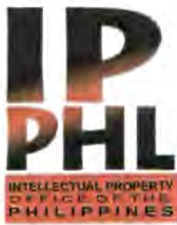
Bureau of Legal Affairs

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IPC No. 14-2012-00464

Opposition to:
 Application No. 4-2012-006962
 Date Filed: 11 June 2012
 Trademark: "TRAMXL"

Decision No. 2016- 405

DECISION

GRUNENTIAL GMBH¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-006962. The application, filed by Ambica International Trading Corporation.² ("Respondent-Applicant"), covers the mark "TRAMXL" for use on "pharmaceutical products namely analgesic" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

"The Opposition is based on the following grounds:

"1. Respondent-Applicant's trademark TRAMXL nearly resembles Opposer's trademark TRAMAL which was registered under Philippine Trademark Registration No. 042630 on January 19, 1989 for goods in class 05 namely, 'pharmaceutical products, viz. medicaments sold only on prescription which have an effect on the central nervous system', as likely to deceive or to cause confusion.

"1.1 Opposer's trademark TRAMAL with Philippine Trademark Registration No. 042630 enjoys about twenty three (23) years of priority and seniority over Respondent-Applicant's Philippine Trademark Application No. 4-2012-006962 for TRAMXL, which was filed only on June 11, 2012.

"1.2 Respondent-Applicant's trademark application for TRAMXL also designates goods in the same class 05, which is likely to cause confusion. While TRAMXL is used for 'pharmaceutical products namely analgesic', Opposer's trademark TRAMAL is used for 'pharmaceutical products, viz. medicaments sold only on prescription which have an effect on the central nervous system'.

¹A foreign corporation organized and existing under and by virtue of the laws of Germany, with business address at Zieglerstrasse 6, 52078 Aachen, Germany.

²With 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.

"1.3 Further, Respondent-Applicant's trademark TRAMXL is visually similar to Opposer's trademark TRAMAL. In fact, TRAMXL is similar to TRAMAL in overall impression which is likely to deceive or to cause confusion.

"1.3.1 Both the trademarks TRAMAL and TRAMXL have the same prefix 'TRA' and the same suffix, which starts with the letter 'M' and ends with the letter 'L', and these are the dominant and distinctive features of the trademarks TRAMXL and TRAMAL.

"1.3.2 The two trademarks TRAMAL and TRAMXL only differ by a single letter. TRAMAL contains the letter 'A' in its suffix, while TRAMXL contains the letter 'X'.

"1.3.3 In comparing both marks, five out of the six letters comprising the marks TRAMAL and TRAMXL are identical. In addition, both Respondent-Applicant's trademark TRAMXL and Opposer's trademark TRAMAL consist of only two (2) syllables. Hence, both trademarks have the same overall visual impression as shown below.

x x x

"1.3.4 Finally, when handwritten, as in written prescriptions, the marks are undoubtedly confusingly similar because of the similarities in (a) the prefix 'TRA'; (b) the letters 'M' and 'L' in the suffix; and (c) in the letters 'A' and 'X', which look almost identical when handwritten as shown below:

x x x

"1.3.5 It is clear from the foregoing that the dominant similarities between Opposer's trademark TRAMAL and Respondent-Applicant's trademark TRAMXL and the goods for which these marks are used, are such that TRAMXL is likely to deceive or to cause confusion, more specifically, where the pharmaceutical products are marketed under marks which look alike.

"1.4 Due to the resemblance to Opposer's trademark TRAMAL of Respondent-Applicant's trademark TRAMXL, the public is likely to think that Respondent-Applicant's goods originate from Opposer, Respondent-Applicant's use of the trademark TRAMXL may falsely and misleadingly suggest a connection between TRAMXL and Opposer on the one hand, or Respondent-Applicant and Opposer's goods bearing the trademark TRAMAL on the other hand.

"1.5 Thus, under 123.1 (d) subsection (iii) of R.A. 8293, the registration of trademark 'TRAMXL' should be proscribed. Pursuant to Section 123.1 (d) of the Intellectual Property Code or R.A. 8293, a mark cannot be registered if it nearly resembles a registered mark or a mark with an earlier filing date belonging to a different proprietor. Section 123.1 (d) states, to wit:

x x x

"2. Moreover, it is well settled that if the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place.

"2.1 Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. The ordinary customer does not scrutinize details of the label. He forgets and overlooks these, but retains a general impression, or a central figure, or a dominant characteristic.

"2.2 Moreover, the goods or services do not need to be identical or even competitive to justify a determination that there is a likelihood of confusion. It is sufficient that the goods or services of the applicant and the registrant are related in some manner, or that the circumstance surrounding their marketing are such that they are likely to be encountered by the same persons under the circumstances that would give rise, because of the marks used thereon, to the mistaken belief that they originate from or are in some way associated with the same producer.

"2.3 Thus, any use of the mark TRAMXL 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 the IP Code, which states:

x x x

"3. Opposer's trademark TRAMAL is well-known internationally and in the Philippines. Hence, the registration of a confusingly similar trademark TRAMXL in class 05 will dilute the distinctiveness of Opposer's mark, and will constitute a breach of the clear provisions of Article 6bis of the Paris Convention and Section 123.1 (e) and (f) of R.A. 8293 on well-known marks, to wit:

x x x

"3.1 Respondent-applicant's registration and use of the mark TRAMXL, which is confusingly similar to Opposer's well-known mark TRAMAL for the related goods in class 05, also constitute trademark dilution, regardless of the presence or absence of: (1) competition between the owner of the famous mark and other parties; or (2) likelihood of confusion, mistake or deception.

"3.2 It is apparent in Respondent-Applicant's attempted registration of the trademark TRAMXL that there is manifest intent to ride on the popularity and goodwill of the trademark TRAMAL.

"3.3 TRAMAL had been in use in the Philippines and known to the Philippine public as early as August 1, 1987 for Opposer's pharmaceutical products.

"3.4 As discussed above, the visual similarities and resemblance of the marks TRAMXL and TRAMAL are so glaring that it is hard to conceive that the Respondent-Applicant has not thought of Opposer's mark in contriving a confusing alike mark for its own pharmaceutical products.

"3.5 Out of the whole gamut of words and symbols that Respondent-Applicant could have used to create a trademark to designate its own

pharmaceutical products, it purposely used TRAMXL, which is obviously an approximation of Opposer's TRAMAL that has been in the market for more than twenty (20) years for use on similar goods.

"3.6 The adoption by the Respondent-Applicant of a mark, which is a lame variation of Opposer's mark is evident of the former's scheme to create confusion on the part of medical professionals and the purchasing public. With the close resemblance between two marks, it is not impossible that the products bearing the marks TRAMAL and TRAMXL may easily be mistaken for one another.

"Opposer will rely on the following facts to support its opposition:

"4. Opposer is the owner, first user, original adopter, and registrant of the trademark TRAMAL covered by Philippine Trademark Registration No. 042630 issued on January 19, 1989, renewed on January 19, 2009 and valid until January 19, 2019. The registration covers 'pharmaceutical products, viz. medicaments sold only on prescription which have an effect on the central nervous system' in class 05. A copy of Philippine Trademark Registration No. 042630 will form part of opposer's evidence.

"5. The first use internationally of the trademark TRAMAL occurred in Germany on or around January 1, 1977. In the Philippines, the mark TRAMAL was first used by the Opposer through its licensee, Rhone Poulenc Nattermann Pharma Inc., on August 1, 1987 and has been continuously used since then. Opposer's current licensee is Mundipharma Distribution GmbH (Philippine Branch).

"6. TRAMAL is also the subject of a valid and existing Certificate of Product Registration (CPR) issued by the Food and Drug Administration (FDA) of the Philippines on November 4, 2011 for the treatment of moderate to severe pain. A copy of CPR No. DR-XY4359 will form part of Opposer's evidence.

"7. Opposer has registered and/or applied for the registration of the trademark TRAMAL for pharmaceutical products in class 5 in more than one hundred (100) countries worldwide. Some certified true copies of the certificates of trademark registrations for TRAMAL will form part of the evidence in this case.

"8. The pharmaceutical products bearing the trademark TRAMAL are sold in various drugstores all over the country and worldwide. The TRAMAL brand of pharmaceutical product is sold in many parts of the world, such as, Singapore, Thailand, Indonesia, Germany, Portugal, Brazil, Australia, Japan, Kuwait, Austria, Greece, New Zealand, Chile, Panama, Colombia, China, Guatemala, Argentina, Pakistan, Malaysia, Taiwan, Switzerland, etc. Photos, packaging, package inserts and promotional material bearing the trademark TRAMAL will form part of Opposer's evidence.

"8.1 Worldwide sale figures of the TRAMAL product for the last three (3) years are as follows:

x x x

"8.2 In the Philippines, sales figures of the TRAMAL product for the last three (3) years are as follows:

x x x

"9. Opposer also invests heavily in advertising and publicizing the trademark TRAMAL worldwide, thereby earning the trademark on international reputation, and the product bearing the mark a significant market share in the pharmaceutical industry. There is great effort through the worldwide web to advertise and promote TRAMAL. It is currently present in several websites, which can be accessed by people worldwide to know about the products. Among these websites are:

x x x

"10. On the bases of the foregoing facts and arguments, it cannot be denied that Respondent-Applicant's appropriation of the confusingly similar mark TRAMXL, which has the same overall impression as that of the Opposer's trademark TRAMAL, is an act designed to dilute the distinctiveness and goodwill of the mark TRAMAL. As the creator and originator of the trademark TRAMAL, Opposer's earlier adoption and registration of this mark is entitled to protection.

The Opposer's evidence consists of the affidavit signed by Thomas Senderovitz and Marcus Heppner; a copy of the Certificate of Trademark Renewal Registration No. 0424630 for TRAMAL; a printout of Philippine Trademark Registration No. 0424630 for TRAMAL; a list of the worldwide trademark registrations and applications for TRAMAL; a copy of the certificate of OMPI trademark registration for TRAMAL covering 27 countries; a copy of the certificate of trademark registration for TRAMAL in Germany; a copy of the certificate of trademark registration for TRAMAL in Ecuador; a copy of the certificate of trademark registration for TRAMAL in Thailand; a copy of the certificate of trademark registration for TRAMAL in Taiwan; a copy of the certificate of trademark registration for TRAMAL in Chile; a copy of the certificate of trademark registration for TRAMAL in Malaysia; a copy of the certificate of trademark registration for TRAMAL in Brazil; a copy of the certificate of trademark registration for TRAMAL in Peru; a copy of the certificate of trademark registration for TRAMAL in Argentina; a copy of the certificate of trademark registration for TRAMAL in Indonesia; samples of product packaging and package inserts for TRAMAL used in the Philippines; copy of the 15th year Declaration of Actual Use for TRAMAL; copies of Certificates of Product Registration Nos. DR-XY4359 and DR-XY30207; a summary report of the global and Philippine net revenues for the sale of products bearing the mark TRAMAL for fiscal years 2009, 2010 and 2011; sample promotional materials for TRAMAL in the Philippines; printouts from the website <http://www.mydr.com.au/medicines/cmis/tramal-capsules>; printouts from the website <http://www.medicinanet.com.br/bula/5117/tramal.htm>; printouts from the website <http://www.mims.com/Philippines/drug/info/Tramal/>; printout from the website <http://www.drugs.com/drug-interactions/tramadol.tramal-sr.html>; printouts from the website <http://www.medsafe.govt.nz/consumers/cmi/t/tramal-sr.htm>; printouts from the website http://www.csl.com.au/s1/cs/auhq/1196562765747/WebProduct_C/1196562642959/ProductDetail.ht; printouts from the website <http://home.intekom.com/pharm/janssen/tramal-c.html>; samples of product

packaging and package inserts used in Germany; and promotional materials used in Panama.⁴

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 18 January 2013. The Respondent-Applicant filed their Answer on 04 April 2013 and avers the following:

x x x

"Denials

"1. Respondent-Applicant denies for being false paragraph 1 of the Verified Opposition dated November 16, 2012 (the 'Opposition') the truth being that the trademark 'TRAMXL' does not resemble and will not cause confusion, mistake or deception on the part of the purchasing public in relation to the trademark 'TRAMAL'.

"1.1 Respondent-Applicant denies paragraph 1.1 of the Opposition insofar as 'TRAMAL''s registration is concerned for lack of knowledge sufficient to form a belief as to the truth thereof.


"1.2 Respondent-Applicant denies paragraph 1.2 of the Opposition insofar as it alleges that 'TRAMXL' is likely to cause confusion for being false, the truth being that registration of 'TRAMXL' is not likely to cause confusion with 'TRAMAL'.

"1.3 Respondent-Applicant denies paragraph 1.3 and its sub-paragraphs of the Opposition for being false, the truth being that 'TRAMXL' is not identical nor visually similar to 'TRAMAL' even in overall impression as these marks 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. A side-by-side comparison of the two marks, attached as Annex 1, confirms this.

"1.4 Respondent-Applicant denies for being false and conclusionary paragraphs 1.4 and 1.5 of the Opposition.

"1.5 The marks do not involve either the same or closely related goods as 'TRAMXL' covers pharmaceutical products under the generic name Analgesic while 'TRAMAL' cover medication sold on prescription which have an effect on the central nervous system under the generic name Tramadol Hydrochloride.

"1.3 Doctors/physicians prescribe drugs and medicines in accordance with the Generics Act of 1988 (RA No. 6675) that requires prescriptions using generic names obviating any risk of confusion.

"2. Respondent-Applicant denies for being false and conclusionary paragraph 2 of the Opposition, including its sub-paragraphs. 

⁴ Marked as Exhibit "A", inclusive

"3. Respondent-Applicant denies for being conclusionary and speculative paragraphs 3 and 10 of the Opposition, including sub-paragraphs insofar as it alleges confusing similarity, trademark dilution and intent to ride on the popularity of another mark.

"4. Respondent-Applicant denies, for lack of knowledge sufficient to form a belief as to the truth of the statements contained therein, paragraphs 3 (insofar as it alleges international reknown), 4, 5, 6, 7, 8 and 9, including sub-paragraphs, fo the Opposition.

"5. Paragraphs 1 and 3 of the Opposition are also denied insofar as they imply that Opposer has acquired an exclusive ownership of the 'TRAMAL' on the ground that Opposer cannot possibly acquire an exclusive ownership of the mark 'TRAMAL' to the exclusion of others it being a direct derivative of the generic term 'TRAMADOL'. In *Philippine Refining Co., Inc. v. Ng Sam and Director of Patents*, G.R. No. L-26676, July 30, 1982, the Supreme Court affirmed the Director of Patents' refusal to exclude other users of the mark 'CAMIA' it being a generic term, thus:

'6. If there is confusing similarity, trademark dilution and intent to ride on the popularity of another mark, Opposer is guilty party, 'TRAMAL' being a, to use its own words, 'lame variation' of 'TRAMADOL'. Significantly, all the letters in 'TRAMAL' are also in 'TRAMADOL'. Truth to tell, it is not farfetched to state that 'TRAMAL' has the, to borrow its own words, 'general impression, or a central figure or a dominant characteristic' of 'TRAMADOL' an international non-proprietary name incapabile of being exclusively appropriated.

" Affirmative Defense

"7. The trademark 'TRAMAL' being directly derived from the generic and international Nonproprietary Name 'Tramadol', cannot be validly registered as a trademark. In *Sanofi-Aventis v. Ver Heilen Phamaceuticals*, Appeal No. 14-08-04, December 19, 2008, 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

"8. The mark 'TRAMAL' being incapable of appropriation by a single entity as a mark to the exclusion of all others, it 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 'TRAMXL' for distinct goods. Accordingly, Opposer cannot claim any damage by reason of Respondent-Applicant's continued use of the mark 'TRAMXL'.

The Respondent-Applicant's evidence consists of a side-by-side comparison of the two marks.⁵

⁵ Marked as Annex "1".

On 13 November 2013, the Preliminary Conference was conducted and terminated. Only the counsel of the Opposer appeared and Respondent-Applicant was declared to have waived its rights to submit position paper. Opposer submitted their position paper on 25 November 2013. Thereafter, the case was deemed submitted for resolution.

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

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

(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 2012, 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

TRAMXL

Respondent-Applicant's mark

It is obvious that the prefix TRAM in both marks is derived from the opioid pain medication used to treat moderate to moderately severe pain "tramadol".⁶ In order to render such a mark with the distinctive character to be eligible for registration, letters, words or features should be used in combination with the prefix TRAM. The determination, therefore, of whether there is confusing similarity would depend on the

⁶ <https://en.wikipedia.org/wiki/Tramadol>.

evaluation of the other words, letters or features that are added to the prefix TRAM. In this regard, this Bureau finds that the syllable "XL" in combination with the prefix TRAM closely resembles the syllable "AL" as a suffix to "TRAM". XL and AL are monosyllabic and visually similar. When pronounced TRAMXL sounds similar to TRAMAL, as it is probable for consumers to read "TRAMXL" as "TRAMAL". Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"⁷, "SAPOLIN" and LUSOLIN"⁸, "CELDURA" and "CORDURA"⁹, "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.¹⁰

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. 4-2012-006962 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, 10 NOV 2016.


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

⁷ *MacDonalds Corp. et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

⁸ *Sapolin Co. v. Balmaceda and Germann & Co.*, 67 Phil. 705.

⁹ *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.)

¹⁰ *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297, 22 Dec. 1966.