

NOVARTIS AG,

Opposers,

- versus -

GENPHARM, INC.,

Respondent-Applicant.

X-----X

IPC NO. 14-2009-00161

Appln. No. 4-2008-010658

Date Filed: 03 September 2008

TM – “OROFER AND DEVICE”

NOTICE OF DECISION

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GREETINGS:

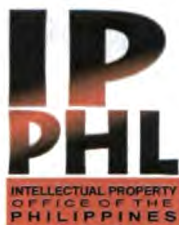
Please be informed that Decision No. 2016 - 367 dated October 11, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 11, 2016.

MARILYN F. RETUAL
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Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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NOVARTIS AG,
Opposer,
 -versus-
 GENPHARM, INC.,
Respondent-Applicant.
 -----x

IPC No. 14-2009-00161
 Opposition to:
 Application No. 4-2008-010658
 Date Filed: 03 September 2008
 Trademark: "OROFER
 AND DEVICE"
 Decision No. 2016- 367

DECISION

NOVARTIS AG¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2008-010658. The application, filed by GENPHARM, INC.² ("Respondent-Applicant"), covers the mark "OROFER AND DEVICE" for use as "vitamin/iron supplement" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
"LEGAL GROUNDS FOR THE OPPOSITION"

"1. The trademark OROFER and Device being applied for by respondent-applicant is confusingly similar to opposer's trademark OROFAR, as to be likely, when applied to or used in connection with the goods of respondent-applicant, to cause confusion, mistake and deception on the part of the purchasing public.

"2. The registration of the trademark OROFER and Device in the name of respondent-applicant will violate Section 123.1, subparagraph (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, to wit:
 x x x

"3. The registration and use by respondent-applicant of the trademark OROFER will diminish the distinctiveness and dilute the goodwill of opposer's trademark OROFAR.

¹ A foreign corporation duly organized and existing under and by virtue of the laws of Switzerland with business address at 4002 Basel, Switzerland.
² With address at Suite 303 SRI Building, 2444 F.B. Harrison St., Pasay City 1300.
³ The 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.

"4. The registration of the trademark OROFER in the name of respondent-applicant is contrary to other provisions of the Intellectual Property Code of the Philippines.

"FACTS AND CIRCUMSTANCES
IN SUPPORT OF THE OPPOSITION

x x x

"1. In the Philippines, opposer is the owner of the trademark OROFAR, as follows: x x x

"2. Opposer has also caused the registration of its products in the Bureau of Food and Drugs (BFAD) of the Department of Health. x x x

"3. Opposer has likewise caused the extensive promotion, advertising, sale and marketing of its products bearing the mark OROFAR in the Philippines. x x x

"4. By virtue of Certificate of Registration No. 44730 of the mark OROFAR in the Philippines and its continuous use since the year 1987, opposer has acquired a vested right over the mark in accordance with Section 122 of the Intellectual Property Code of the Philippines, as follows: x x x

"5. Being the registered owner, opposer holds the exclusive right to use the mark OROFAR in the Philippines. Section 138 of the Intellectual Property Code of the Philippines provides that: x x x

"6. Section 147.1 of the Intellectual Property Code of the Philippines clearly confers on herein opposer Novartis AG 'the exclusive right to prevent' herein respondent-applicant Genpharm Inc., which does not have the consent of Novartis AG, from using, much less registering the confusingly similar mark OROFER & Device, to wit: x x x

"7. More importantly, Section 123.1 (d) of the same law prohibits the registration of a mark which is identical or confusingly similar with a registered mark of another entity, to wit: x x x

"8. Indeed, in view of the foregoing, the registration and use by respondent-applicant of the trademark, which is confusingly similar with opposer's registered mark OROFAR is proscribed by law.

"9. The mark OROFER of respondent-applicant is confusingly similar with the trademark OROFAR of opposer Novartis AG:

- a. "Both marks consist of six (6) letters and three (3) syllables.
- b. "Five (5) out of six (6) letters in both marks are identical. Hence, when viewed from a distance, both marks look the same.
- c. "The marks consist of three (3) syllables each with each syllable are also almost alike. The first syllable 'O' in opposer's mark is exactly the same as the first syllable 'O' in respondent-applicant's mark. The second syllable of both marks, i.e. 'RO', are identical. Moreover, the third syllables of both marks are almost the same too, i.e., 'FAR' in

opposer's mark and 'FER' in respondent-applicant's mark. The potential confusion is therefore real.

- d. "Because of the near unanimity in the letters and syllables of the two (2) marks, the syntax, the sound and the pronunciation of the marks are the same. Phonetically therefore, the two(2) marks are practically identical and confusingly similar. .

"10. It is settled jurisprudence that identity or similarity in the dominant features of two (2) competing marks will cause mistake or confusion in the minds of the purchasing public. The case of *Co Tiong Sa vs. Director of Patents* (95 Phil. 1 [1954]) categorically held, as follows: x x x

"11. It has also been held in the case of *Phil. Nut Industry, Inc. vs. Standard Brands, Inc.* (G.R. No. L-23035, 31 July 1975, 65 SCRA 575) that: x x x

"12. The dominance test was applied by the Supreme Court in many other cases including *Lim Hoa vs. Director of Patents* (100 Phil 214 [1956]), *Converse Rubber Corporation vs. Universal Rubber Products, Inc.* (G.R. No. L-27906, 08 January 1987, 147 SCRA 154) and *Asia Brewery, Inc. vs. Court of Appeals* (G.R. No. 103543, 05 July 1993, 224 SCRA 437).

"13. In the recent case of *McDonald's Corporation, et. al. vs. L.C. Big Mak Burger, et. al.* (G.R. No. 143993, August 18, 2004), the Supreme Court likewise applied the test of dominance in determining that the mark BIG MAC of McDonald's Corporation and the mark BIG MAK of L.C. Big Mak Burger are confusingly similar. The Court ruled, as follows: x x x

"that was further affirmed in the 2007 case of *McDonald's Corporation vs. Macjoy Fastfood Corporation* (G.R. No. 166115, February 2, 2007) where the Supreme Court again applied the test of dominance and ruled that there is confusing similarity between the McDonald's marks and the mark MACJOY & Device.

"14. The reasoning in the McDonald's case (supra) applying the Dominance Test is relevant in the instant case. The dominant feature in opposer's mark OROFAR is the mark itself, and it is practically identical with respondent-applicant's mark OROFER & Device. The difference in the fifth (5th) letters of both marks do not sufficiently distinguish the two marks from each other as they are similar in appearance. As such, the two (2) marks are ,for all intents and purposes, practically identical and confusingly similar. The purchasing public will easily recognize and remember the letters O,R, O, F, and R, and hence, it is very easy to mistake respondent-applicant's products bearing the mark OROFER for opposer's goods bearing the mark OROFAR. Hence, the use and registration of the mark OROFER and Device will create confusion, mistake and deception in the minds of the purchasing public.

x x x

"15. Moreover, both trademarks cover similar goods under International Class 5.

"Opposer's mark OROFAR covers:

"pharmaceutical products"

"while respondent-applicant's mark OROFER and Device covers:

"vitamin/iron supplement"



"16. Also, the goods being similar, they are sold, marketed and/or found in the same channels of business and trade, thus compounding the chance of confusion. Opposer's product OROFAR and respondent-applicant's mark OROFER & Device are both sold in pharmacies and hospitals. Hence, when placed side-by-side in the sales counters, display cabinets and racks along the aisle in pharmacies where they are sold, buyers and consumers will definitely be confused to find the two almost identical products, with the same brand and for the same goods.

"17. Moreover, both products possess the same characteristics and properties and serve the same purpose. They are both health-related products. Considering all these, the likelihood of confusion between the marks of opposer and respondent-applicant is enhanced.

"18. A boundless choice of words, phrases and symbols are available to a person who wishes to have a trademark sufficient unto itself to distinguish its products from those of others. There is no reasonable explanation therefore for respondent-applicant to use the word OROFER in its mark when the field for its selection is so broad. Respondent-applicant obviously intends to bank on the goodwill of opposer and pass off its products as those of opposer.

"19. Opposer Novartis AG is a global pharmaceutical group engaged in the research, development, manufacture and marketing of pharmaceutical and healthcare products. Its businesses are divided into four (4) groups, namely, Pharmaceuticals, Vaccines and Diagnostics, Sandoz Generics, and Consumer Health.

"20. Novartis AG was formed following the merger of Ciba-Geigy and Sandoz in 1996. The merger was considered as one of the largest corporate mergers in history at the time. Presently, Novartis AG has 161 subsidiaries in 65 countries worldwide including Algeria, Argentina, Australia, Austria, Bangladesh, Belgium x x x

"21. Novartis AG is considered a world leader in providing medicines to protect health, prevent and treat diseases, and to improve well-being. In 2007, its group net sales amounted to US \$39,800,000,000. Its pharmaceutical business alone posted sales of US\$24,000,000,000.

"22. Furthermore, Novartis AG has invested vigorously in research and development to continue bringing new and innovative products to the market. As such, it invested a total of US\$6,430,000,000 in research and development in 2007. x x x

"23. In the case of American Wire & Cable Co. vs. Director of Patents (G.R. No. L-26557, February 18, 1970), the Supreme Court held that: x x x

"24. In view of the foregoing, the registration and use of the trademark OROFER and Device by respondent-applicant will deceive and/or confuse purchasers into believing that respondent-applicant's goods and/or products bearing the trademark OROFER and Device emanate from or are under the sponsorship of opposer Novartis AG, registered owner of the trademark OROFAR. This will therefore diminish the distinctiveness and dilute the goodwill of opposer's trademark.

The Opposer's evidence consists of a copy of Certificate of Trademark Registration No. 44750 issued by the Intellectual Property Office of the Philippines;

copies of the Certificate of Product Registration Nos. 000835 and 000841 issued by the Bureau of Food and Drugs of the Department of Health of the Philippine Government; Opposer's brochures and/or promotional materials bearing the mark OROFAR; copies of sales purchase orders and invoices of Opposer's product bearing the mark OROFAR; a copy of Opposer's Annual Report for the year 2007; and, Duly signed, notarized, and authenticated Affidavit-Testimony of witnesses Mary F. Leheny and Nazuki Hughes.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 17 August 2009. The Respondent-Applicant filed their Answer on 16 October 2009 and avers the following:

x x x

"ARGUMENTS

"57. Under Section 160, in relation to Section 3, of R.A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines, a foreign corporation may file a civil or administrative action, such as an opposition to the application for registration of a trademark. However, such right to sue is subject to the condition that the country of which it is national is a party to a convention or treaty, relating to intellectual property rights to which the Philippines is also a party, or extends reciprocal rights to Philippine nationals by law, to wit:

x x x

"58. Furthermore, such requisite is reiterated in Section 4 of Rule 2 of the Regulations on Inter Partes Proceedings, to wit:

x x x

59. In Philip Morris, Inc. vs. Fortune Tobacco Corp. (G.R. No. 158589. June 27, 2006), the Supreme Court held that a foreign corporation, though the registered owner of a trademark in the Philippines, must still meet the abovementioned condition, with respect to mutual treaty or reciprocity of rights, in order to avail of the rights granted under the Intellectual Property Code, such as the right to file a civil or administrative action in relation to intellectual property rights, to wit:

x x x

"60. In the case at bar, the Opposer has no legal capacity to file an opposition to the application for registration of respondent-applicant because it was never alleged nor proved in the Verified Opposition and the attached documents that the country of which it is a national is a party to any convention, treaty or agreement, relating to intellectual property rights to which the Philippines is also a party, or extends reciprocal rights to Philippine nationals by law. This Honorable Office cannot give judicial notice to such relevant convention or treaty and to such foreign law, if there are any, without such convention or foreign law being duly alleged and proved by the Opposer in its Verified Opposition.



⁴ Marked as Exhibits "A" to "I", inclusive.

"61. Assuming without admitting that the Opposer has a legal capacity to sue this Honorable Office still must not give due course to and must dismiss the Verified Opposition for utter lack of merit as discussed in the following arguments.

"62. In the case at bar, the trademark 'OROFER' itself in fact, had already been registered by the Intellectual Property Office through the issuance of Certificate of Registration dated 17 November 2006 (ANNEX 'A') in the name of respondent-applicant, albeit without the partial underline like the trademark involved in the case at bar. It must be noted that the Opposer never opposed the application of such trademark.

"63. To reiterate, the BFAD required the respondent-applicant to register the trademark 'OROFER' together with the partial underline as the respondent-applicant used such trademark in its vitamin/iron supplement products with the additional partial underline. Consequently, the respondent-applicant was constrained to file again an application for registration of the same registered trademark 'OROFER' only to incorporate the additional partial underline as required by the BFAD. Hence, there is no basis for the Opposition because the trademark 'OROFER' itself had already been registered in the name of the respondent-applicant.

"64. Furthermore, Section 138 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippine, the Certificate of Registration of the trademark 'OROFER' is prima facie evidence of the validity of the registration, the registrant's ownership of the mark and of the exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate. Once registered, not only the mark's validity but also the registrant's ownership thereof is prima facie presumed.

"65. In the case at bar, the trademark 'OROFER' itself, without the partial underline, is valid and owned by respondent-applicant. As the registered owner, the respondent-applicant has the exclusive right to use trademark 'OROFER' itself in connection with the goods or services and those that are related thereto specified in the Certificate.

"66. There is no possibility of damage on the part of the Opposer because there is no likelihood of confusion as the trademarks pertain to totally and absolutely different products since there are fundamental differences between them as to their nature, generic name or component substances, purposes, contraindications or precautions, forms, and designs of the packages.

"67. The Dominancy Test focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception, and thus infringement.

"68. In the case at bar, the Opposer mainly uses the Dominancy test in asserting that there is likelihood of confusion, i.e. the public allegedly will likely confuse the Opposer's trademark 'OROFAR', referring to an oral antiseptic product used for the treatment of mouth and throat infections, with the Respondent-Applicant's trademark 'OROFER', pertaining to a vitamin/iron supplement used for the treatment of iron deficiency anemia. In its Verified

Opposition, the Opposer compares the trademarks simply with respect to the similarities of the letters found in such trademarks, thus, stating that both marks consist of six (6) letters and three (3) syllables, that five (5) out of six (6) letters in both marks are identical, and that the syntax, sound, and pronunciation are the same.

"69. Such comparison is too simplistic a determination of similarity or likelihood of confusion. The Opposer conveniently and grossly overlooks the fact that 'OROFAR' and 'OROFER' are not competing trademarks in the first place as they refer to totally and absolutely different products having different characteristics, properties, purposes. To reiterate, the Opposer's trademark 'OROFAR' refers to an oral antiseptic product composed of used for the treatment of mouth and throat infections, while the Respondent-Applicant's trademark 'OROFER', pertains to a vitamin/iron supplement used for the treatment of iron deficiency anemia.

"70. Simply put, there never will be a competition between an oral antiseptic used for the treatment of mouth and throat infections and a vitamin/iron supplement used for the treatment of iron deficiency anemia. There is no likelihood that the public will be deceived into buying a vitamin/iron supplement for the treatment of iron deficiency instead of buying an oral antiseptic for the treatment of mouth and throat infections.

"71. It is not likely that a person, in need of an oral antiseptic for the treatment of a mouth or oral infection, when confronted with two trademarks which are similar on their face but totally and absolutely different in all other respects, will be so confused or mistaken as to buy a vitamin/iron supplement for the treatment of iron deficiency anemia, and vice versa. A person buying a pharmaceutical product, such as an oral antiseptic or a vitamin/iron supplement that are obviously not competing products as they serve different functions, is more discerning and discriminating than the buyer of an ordinary product and will tend to examine more the products themselves rather than the trademark.

"72. To reiterate, the Opposer's 'OROFAR' and the Respondent-Applicant's 'OROFER' are not competing trademarks. Hence, the dominancy test cannot be used in the first place in determining the existence of likelihood of confusion because the trademarks are not competing trademarks.

"73. The Holistic Test requires that the entirety of the marks in question be considered in resolving confusing similarity. Comparison of the words is not the only determining factor. The trademarks in their entirety as they appear in their respective labels or hang tags must also be considered in relation to the goods to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other. In comparing the resemblance or colorable imitation of marks, various factors have been considered, such as the dominant color, style, size, form, meaning of letters, words, designs, and emblems used, the likelihood of deception of the mark or name's tendency to confuse. In addition, the commercial impression likely to be conveyed by the trademarks if used in conjunction with the respective goods of the parties must also be considered.

"74. Contrary to the claims of Opposer that 'both products possess the same characteristics and properties and serve the same purpose, the products are totally and absolutely different and unrelated in all respects in truth and in fact.

"75. To reiterate, there are marked differences between the trademarks as the products they refer to are essentially different with respect to their nature, generic name, purpose, form and design of the package, to wit:

(a) With respect to the kind and nature of their products, the trademarks 'OROFAR' and 'OROFER' are inherently different. The Opposer's 'OROFAR' refers to an over-the-counter oral antiseptic, while the Respondent-Applicant's 'OROFER' pertains to a prescription vitamin/iron supplement.

(b) With respect to their generic name or the chemical substances that they are composed of, 'OROFAR' and 'OROFER' are intrinsically different. 'OROFAR' is composed of Benzoxonium Chloride and Lidocaine Chloride, which substances are prominently displayed in the packaging, whereas, 'OROFER' is composed of Iron (III) Hydroxide Polymaltose Complex.

(c) With respect to their purpose, 'OROFAR' and 'OROFER' are fundamentally different. 'OROFAR' is for the treatment of mouth and throat infections such as pharyngitis, laryngitis, tonsillitis, sore throat, stomatitis, aphthae, and gingivitis, while 'OROFER' is for the treatment of iron deficiency anemia, particularly during pregnancy, lactation, postpartum, childhood and post-surgical conditions.

(d) With respect to their precaution or contraindication, which is a condition or factor that increases the risk involved in using a particular drug, 'OROFAR' and 'OROFER' are effectively different. x x x

(e) With respect to their form by which they are manufactured, 'OROFAR' and 'OROFER' are basically different. 'OROFAR' is manufactured as a gargle solution or as lozenges, whereas, 'OROFER' is manufactured as syrup, capsule, oral drops, or chewable tablets.

(f) With respect to their packaging, 'OROFAR' and 'OROFER' are markedly different. x x x

(g) The above inherent and fundamental differences between 'OROFER' and 'OROFAR' are clearly shown by the sample packages of the products x x x

"78. As clearly shown from the immediately preceding paragraphs, the cases cited in the Verified Opposition have different factual milieus and, hence are not applicable to the case at bar. x x x

"79. In sum, all the cases cited by Novartis are not applicable. In those cases, the Supreme Court held that there can only be a case for infringement of trademark, that is, there is a possibility or likelihood of confusion or mistake to the general public, if the goods are the same or are similar, i.e. they have similar characteristics and serve similar purposes. Thus, the buyer of a product who wants or needs that product will likely confuse one trademark with that of the other as both trademarks refer to the same product with the same purpose. Hence, the Supreme Court used the Dominancy Test in such cases as the trademarks are considered as competing as they referred to the same or similar or related goods.

"80. Whereas, in the case at bar there can be no infringement of trademark, that is, there is no likelihood of confusion as the products are not similar in any way and, thus, there is no competing trademarks to speak of. x x x

"81. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone in determining general confusion made by the product upon the eye of the ordinary purchaser. x x x

"82. In the case at bar, the type of product involved, the market and the purchasers are all different. x x x

"83. Furthermore, there is no likelihood of confusion among the purchasing public because 'OROFER' is a prescription drug and, hence, cannot be bought over the counter, while 'OROFAR' is not a prescription drug and, hence, any person can buy it over the counter with or without prescription. x x x

"84. However, assuming without admitting that 'OROFER' is not a prescription drug, still the 'ordinary purchaser' will not likely confuse the vitamin/iron supplement 'OROFER' with the oral antiseptic 'OROFAR' as they are totally and absolutely different products as there are fundamental differences as to their nature, generic name or component substances, purposes, contraindications or precautions, forms, and designs of the packages.

"85. Hence, a person in need of an oral antiseptic for the treatment of mouth and throat infections will not likely confuse or mistake the Opposer's 'OROFAR', an oral antiseptic, with Respondent-Applicant's 'OROFER', a vitamin/iron supplement for the treatment iron deficiency anemia. x x x

"86. Therefore, there is no likelihood of confusion or mistake. In fact, there has been no actual confusion since the 'OROFER' products have been marketed, as affirmed by Mr. Arturo M. Tolentino, the Chief Executive Office of Alphamed Corporation, one of the corporations marketing the 'OROFER' products. x x x

"87. However, even if the dominancy test were to be used, as urged by the Opposer, the likelihood of confusion tantamount to infringement appears to be farfetched. It must be noted that a trademark serves as a toll to point out distinctly the origin or ownership of the goods to which it is affixed. The reason for the origin and/or ownership angle is that unless the words or devices do so point out the origin or ownership, the person who first adopted them cannot be injured by any appropriation or imitation of them by others, nor can the public be deceived.

"88. In the case at bar, the Opposer's trademark 'OROFAR' does not serve point out distinctly the origin or ownership of the goods to which it is affixed as it cannot be deduced that the trademark 'OROFAR' is in any way related to the Opposer 'Novartis'. Hence, there can be no damage on the part of the Opposer nor can the public be deceived.

x x x

"91. In the case at bar, the Opposer dwells on the argument that the trademarks are similar on their face, that is, that 'OROFAR' and 'OROFER' have the same five letters and have a similar sound when pronounced.

"92. However, this does not mean that there is likelihood of confusion. As held by the Supreme Court in the cases cited in the preceding paragraphs, there is no confusing similarity or likelihood of confusion and, thus, there is no trademark infringement despite the similarity of the trademarks and, in some cases such as Acoje Mining and Philippine Mining, despite the fact that the goods covered by the trademarks fall under the same class.

"93. The trademarks in the case at bar may have a similar spelling and pronunciation and may be both pharmaceutical products. However, their superficial similarities end there. To reiterate, the trademarks refer to totally and absolutely different products as they have fundamentally different nature, generic name or component substances, purposes, contraindications or precautions, forms and designs of the packages. x x x

"97. Moreover, as it has used such trademark for several years now in several countries, Respondent-Applicant could not have copied the Opposer's alleged trademark OROFAR, so as to allegedly ride on the goodwill of the Opposer, because Respondent-Applicant's trademark 'OROFER' has been so named since its inception and invention as such name refers to its meaning in relation to its function and main ingredient. To reiterate, the word 'OROFER' literally means 'golden iron' or 'oral iron' referring to an iron as its main ingredient, easily being identified as an iron supplementation to be taken orally, and connoting its function/purpose of treating iron deficiency conditions.

"98. The duly notarized Affidavit-Testimony of Mr. Prem Hemandes Sujanani is attached herewith x x x.

The Respondent-Applicant's evidence consists of a copy of the Certificate of Registration No. 4-2004-010001 registered on 17 November 2006; copies of Certificate of Registrations/Licenses of the trademark 'OROFER' from various countries; a copy of the Letter dated 03 March 2005 from the Intellectual Property Office to the Respondent-Applicant; a copy of the Letter dated 19 April 2005 from Respondent-Applicant to the Intellectual Property Office in response to the letter dated 03 March 2005; a copy of the Notice of Allowance dated 09 June 2006 issued by the Intellectual Property Office; a copy of Official Receipt NO. 094887; a copy of the Certificate of Product Registration dated 07 March 2008 and issued by the Bureau of Food and Drugs registering 'OROFER' Syrup; a copy of the Certificate of Product Registration dated 10 September 2008 and issued by BFAD; a copy of the Certificate of Product Registration dated 24 September 2008 and issued by BFAD with a validity period of five (5) years; a copy of the Certificate of Product Registration dated 24 September 2008 issued by BFAD with a validity of three (3) years; a copy of the Registrability Report dated 11 December 2008 to the registrability of the trademark 'OROFER'; a copy of the Letter of Respondent-Applicant in response to the registrability report dated 11 December 2008; the letter of Ms. Mahindra Sujanani, Genpharm's Product Manager; a copy of Notice of Allowance

dated 03 February 2009; a copy of Official Receipt No. 0228596 issued by the Intellectual Property Office; a copy of page 342 and of the first page of "Philippine Pharmaceutical Directory Review"; a sample package of "OROFER" Syrup in 150 ml; a sample package of "OROFER" Capsule; a sample package of "OROFER" Oral Drops; a sample package of "OROFER" Chewable Tablet; the letter of Mr. Arturo M. Tolentino dated 12 October 2009; and the affidavit-testimony of Mr. Prem Hemandas Sujanini, the President of Respondent-Applicant.⁵

On 03 November 2009, Opposer filed a Reply to Respondent-Applicant's Answer and on 16 November 2009, Respondent-Applicant filed a Rejoinder.

On 28 January 2010, the Preliminary Conference was terminated. Parties submitted their respective position papers. Thereafter, the case was deemed submitted for resolution.

Should the Respondent-Applicant be allowed to register the trademark OROFER AND DEVICE?

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. 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 the Opposer filed a trademark application for OROFAR on 28 April 1986. The application covers "pharmaceutical products" under Class 05. On the other hand, the Respondent-Applicant filed the trademark application subject of the opposition on 03 September 2008. Respondent-Applicant, however, has an existing trademark registration for the same mark OROFER issued on 03 September 2006 for pharmaceutical products, specifically anti-anemic under Class 05.

⁵Marked as Exhibits "1" to "19", inclusive.

Hence, the question, does OROFER AND DEVICE resemble OROFAR such that confusion or deception is likely to occur? The marks are shown below:

OROFAR

Orofer

Opposer's trademark

Respondent-Applicant's mark

This Bureau noticed that the products covered by the marks have different preparations. Designated as OROFER AND DEVICE, Respondent-Applicant's products are used as "vitamin/iron supplement". Opposer's products covered under OROFAR are "pharmaceutical products", specifically an oral antiseptic. However, confusion is likely in this instance because of the close resemblance between the marks and that the goods are both medicines and pharmaceutical preparations or for human consumption. There is no doubt that the first two syllables of the contending marks "ORO" is from the Latin word *ōs*, meaning "mouth". This Bureau cannot sustain the opposition solely on the ground that both marks contain or start with "ORO". To do so would have the unintended effect of giving the Opposer exclusive right over the prefix "ORO". To determine whether two marks that contain the prefix "ORO" are confusingly similar, there is a need to examine the other letters or components of the trademarks. In this regard, when the syllable "FER" is appended to "ORO", the resulting mark when pronounced can hardly be distinguished from OROFAR. Confusion is likely in this instance. Under the *idem sonans* rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"⁶, "SAPOLIN" and LUSOLIN⁷, "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

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.)

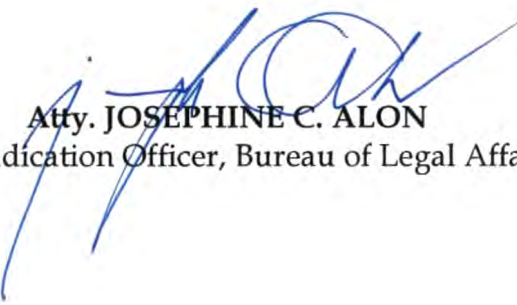
⁹ *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297, 22 Dec. 1966.

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. 4-2008-010658 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, 11 OCT 2016.


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