

GLAXO GROUP LIMITED,
Opposer,

-versus-

AMBICA INTERNATIONAL
TRADING CORPORATION,
Respondent- Applicant.

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IPC No. 14-2014-00354
Opposition to:
Appln. Serial No. 4-2014-005300
Date Filed: 02 May 2014
TM: "ZYVIRAX"

X-----X

NOTICE OF DECISION

BARANDA & ASSOCIATES
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GREETINGS:

Please be informed that Decision No. 2016 - 447 dated December 06, 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, December 13, 2016.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

GLAXO GROUP LIMITED
Opposer,

- versus -

**AMBICA INTERNATIONAL
TRADING CORPORATION,**
Respondent-Applicant.

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IPC No. 14-2014-00354
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Date Filed: 02 May 2014
Trademark: "ZYVIRAX"

Decision No. 2016 - 447

DECISION

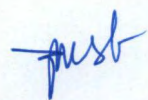
GLAXO GROUP LIMITED ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2014-005300. The application, filed by AMBICA INTERNATIONAL TRADING CORPORATION ("Respondent-Applicant")², covers the mark "ZYVIRAX" for use on goods under class 05³ namely: "*pharmaceutical preparations namely anti-viral*".

The Opposer alleges that GlaxoSmithKline group of companies has its roots way back in 1715. It is one of the world's leading research-based pharmaceutical and healthcare companies which employs around 99,000 people across 115 countries, with more than 12,500 people charged with the research and development of new medicines, vaccines and consumer health products, and carries out operations in 86 manufacturing sites in 36 countries.

It was mentioned that the Opposer's products are marketed and sold worldwide, including the Philippines, Australia, the European Union, India, Japan, New Zealand, South America, South East Asia, UK and USA. Among its famous consumer healthcare brands is ZOVIRAX, a known acyclovir brand, which is an anti-viral preparation used to ease the pain and speed the healing of sores and blisters. ZOVIRAX, an invented word and has no dictionary meaning was first to introduced in the market in 1977 by the Opposer's predecessor-in-interest, The Wellcome Foundation Limited, which is also part of the GlaxoSmithKline group of companies. It was first used commercially in 1982. The mark was subsequently assigned to the Opposer in 17 October 2007 via a Deed of Assignment. Currently, ZOVIRAX is available in many jurisdictions worldwide, including the Philippines. Due to 30 years worth of product effectivity, constant innovation, strong branding and extensive promotions and marketing strategies, ZOVIRAX has achieved the highly remarkable status today.

Moreover, the ZOVIRAX mark has been used and has extensively been promoted around the globe. The mark has attained substantial goodwill and esteemed reputation worldwide through strong branding programs and intensive marketing strategies. The Opposer likewise owns and maintains several

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- ¹ A corporation duly existing and registered under the laws of England and Wales, with address at 980 Great West Road, Brentford, Middlesex, TW8 9GS, England.
 - ² A domestic corporation with office address at #9 Amsterdam Extension, Merville Park Subdivision, Paranaque City, Metro Manila.
 - ³ The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.



ZOVIRAX domain registrations. As a result of the extensive promotions carried out worldwide, the total sales of ZOVIRAX products are very high.

The ZOVIRAX mark was first registered on 19 July 1977 in the United Kingdom. Today, almost 300 ZOVIRAX marks are the subject of registrations and applications in countries around the world. In the Philippines, the Opposer owns the registration for ZOVIRAX. In the Philippines, ZOVIRAX is one of the most reputable brands in its category. The ZOVIRAX mark has been used in the Philippines since 01 November 1984 and distributed in different outlets including Oro Wonder Drug, Rose Phar Inc., Jhime Drugstore and La Nueva Pharmacy, Medicam Drugstore, Friendship Drug and MRR Pharmacy.

The Opposer's evidence consists of the following:

1. Verified Notice of Opposition;
2. Special Power of Attorney in favor of Baranda & Associates;
3. Affidavit of Terence A. Dixon, Opposer's authorized attorney;
4. Copy of the Deed of Assignment of the mark from The Wellcome Foundation Limited to the Opposer;
5. Copy of sample promotional materials;
6. Copy of document reflecting recent sales figures of ZOVIRAX products;
7. Copy of 3rd and 5th years Declaration of Actual Use for trademark ZOVIRAX;
8. Printout of UK Registration No. 00001081183 by the UK IPO Trademark Database;
9. List of ZOVIRAX applications and registrations worldwide;
10. Copies of Australian Registration Nos. 310719,332308, 377748 and 777641 for the trademark ZOVIRAX in Class 5;
11. Copy of Australian Registration No. 383587 for the trademark ZOVIRAX STRIPE, WAVY FORMING CIRCLE, IRREGULAR in Class 5;
12. Copy of Australian Registration No. 1111498 for the trademark ZOVIRAX in Class 10;
13. Copy of Australian Registration No. 1106729 for the trademark ZOVIRAX SPEEDS HEALING TO GET RID OF COLD SORES MAC-P PENETRATING FORMULA AT BLISTER OR TINGLE ANTI-VIRAL TREATMENT in Class 5;
14. Copies of UK Registration Nos. UK00001182433, UK00002042748, EU003431798, UK00002400089, WE00000880836, EU006642375 for the trademark ZOVIRAX;
15. Copy of UK Registration No. EU005115217 for the trademark ZOVIRAX SHIELD & HEAL;
16. Copy of U.S.A. Registration No. 73203076 for the trademark ZOVIRAZ in Class 5;
17. Copy of Philippine Registration No. 4-1999-06368 for the trademark ZOVIRAX in Class 5; and,
18. Images showing use of the mark ZOVIRAX in Greece,

This Bureau issued and served upon Respondent-Applicant a Notice to Answer.⁴ On 20 January 2015, Respondent-Applicant filed an Answer attached with a photocopy of Secretary's Certificate. Despite this Bureau's order to submit the original form within a reasonable period of time⁵, Respondent-Applicant failed to comply to the said order. Thus, Respondent-Applicant was declared in default⁶, and this case is deemed submitted for decision.

⁴ Dated 12 November 2014. Received on 20 November 2014.

⁵ Order No. 2015-335 dated 04 March 2015.

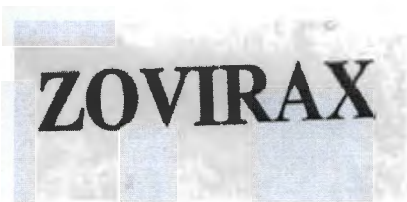
⁶ Rule 2, sec. 9 par (d) of the Amended Rules and Regulations on Inter Partes Proceedings (promulgated through office Order No. 99, s. 2011 as amended by office Order No. 14-068 s. 2014. Order No. 2015-1001 dated 08 July 2015.

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

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 02 May 2014⁷, the Opposer has already an existing trademark registration for the mark ZOVIRAX bearing Registration No. 4-1006-06368 issued on 05 September 2002⁸. The validity of this registration is maintained through the filing of the 3rd and 5th years Declaration of Actual Use⁹. It also has various registration of its ZOVIRAX mark and its variants in foreign countries such as the United Kingdom¹⁰, Australia¹¹ and the United States of America¹². Unquestionably, the Opposer's applications and registrations preceded that of Respondent-Applicant's.

A comparison of the Opposer's mark with the Respondent-Applicant's is depicted below:



Opposer's Trademark

ZYVIRAX

Respondent-Applicant's Trademark

The only difference between the marks is the second letter "O" in Opposer's ZOVIRAX, which is changed to letter "Y" in Respondent-Applicant's ZYVIRAX. Obviously, the marks appear visually and aurally similar.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.¹³ Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.¹⁴

⁷ Filewrapper records.

⁸ Exhibit "AA" of Opposer.

⁹ Exhibits "H" and "I" of Opposer.

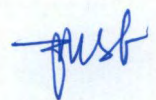
¹⁰ Exhibits "S" to "Y" of Opposer.

¹¹ Exhibits "L" to "R" of Opposer.

¹² Exhibit "Z" of Opposer.

¹³ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

¹⁴ Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.



This Bureau further underscores the fact that the competing marks cover goods which are similar and/or identical in its kind, use, purpose and nature. This determines the likelihood of confusion by reason of Opposer's ZOVIRAX registration which covers "*anti-viral pharmaceutical preparations and substances*"¹⁵, which is identical to the goods covered by that of Respondent-Applicant which as indicated in the application documents as "*pharmaceutical preparations namely anti-viral*".

Succinctly, because the coverage of the Respondent-Applicant's trademark registration would allow using the mark ZYVIRAX on goods or pharmaceutical products that are already dealt in by the Opposer using the mark ZOVIRAX, the minute changes in spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. ZYVIRAX and ZOVIRAX have similarity in sounds, both consisting of three syllables, which make it not easy for one to distinguish one mark from the other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Petitioner's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound, however, is practically replicated when one pronounces the Respondent-Registrant's mark.

Accordingly, this Bureau finds and concludes that the Respondent-Registrant's trademark application is proscribed by Sec. 123.1(d) of the IP Code, which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor with an earlier filing or priority date, with respect to the same or closely related goods or services, or has a near resemblance to such mark as to likely deceive or cause confusion.¹⁶

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-005300 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 06 DEC 2016



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

¹⁵ Exhibit "B" of Petitioner.

¹⁶ Great White Shark Enterprise vs. Danilo M. Caralde, Jr., G.R. No. 192294, 21 November 2012.