

**TEVA PHARMACEUTICAL
INDUSTRIES, LTD.,**

Opposer,

-versus-

SRS PHARMACEUTICALS PHILS., INC.,

Respondent- Applicant.

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IPC No. 14-2013-00186

Opposition to:

Appln. Serial No. 4-2012-014289

Date Filed: 23 November 2012

TM: "AZIACT"

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NOTICE OF DECISION

CASTILLO LAMAN TAN PANTALEON & SAN JOSE

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SRS PHARMACEUTICALS PHILS., INC.

Respondent-Applicant
Unit 1903, Jollibee Plaza Condominium
F. Ortigas Road, Ortigas Center
Pasig City

GREETINGS:

Please be informed that Decision No. 2017 - 14 dated January 20, 2017 (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, January 23, 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

TEVA PHARMACEUTICAL INDUSTRIES
LIMITED,

Opposer,

versus-

SRS PHARMACEUTICALS PHILS.,INC.,

Respondent-Applicant.

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IPC NO. 14-2013-00186

Appln. Ser. No. 4-2012-014289

Filing Date: 23 November 2012

Trademark: AZIACT

Decision No. 2017 - 14

DECISION

TEVA PHARMACEUTICAL INDUSTRIES, INC.,¹ ("Opposer") filed on 05 July 2013 an Opposition to Trademark Application No. 4-2012-014289. The application, filed by SRS PHARMACEUTICALS PHILS,INC.² ("Respondent-Applicant") covers the mark AZIACT for use on "*pharmaceutical and medical preparations for the treatment of infections and diseases, illness and ailments, health, food and dietary supplements, home remedy and herbal preparations, food products, medical devices, sanitary preparations; dietetic substances adapted for medical use, food for babies*" under Class 05 of the International Classification of Goods³.

The Opposer alleges that the mark AZIACT applied for by Respondent-Applicant is confusingly similar to its own mark AZILECT covering the same or similar goods. Because of the confusing similarity between the opposing marks, Respondent's products may be assumed to originate from Teva Pharmaceuticals thereby deceiving the public into believing that there is some connection between the Respondent and the Opposer when in fact, it does not exist. Opposer also posits that the use of the AZIACT mark will blur the distinctiveness of the registered AZILECT trademark.

The Opposer's evidence consists of the following:

1. Legalized and authenticated Power of Attorney;
2. General Information Sheet of SRS Pharmaceuticals Phils., Inc.;
3. Printout of the Company Profile of Opposer downloaded from the website <http://www.teavpharm.com>;
4. Printout from the Opposer website about the product AZILECT;
5. Certified copy of Certificate of Registration No. 4-2012-000999 for the mark AZILECT granted on 3 May 2012;
6. Printout of Certificate of Registration No. 4-2009-001395 for the mark AZILECT granted on 27 April 2009;
7. Printout of the History of Opposer downloaded from the website <http://www.teavpharm.com>;
8. Printout of information about the drug AZILECT from the website <http://drugs-about.com>;

¹ A corporation duly organized and existing under the laws of Israel with address located at 5 Basel Street, Petach Tikva, Israel 49131.

² A domestic corporation with address at Unit 1903 Jollibee Plaza Condominium, F. Ortigas Road, Ortigas Center, Pasig City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

9. Printout of AZILECT Detailed Prescribing Information downloaded from <http://www.mims.com>;
10. Printout from <http://www.rxlist.com> about drug information AZILECT;
11. Printout from <http://www.webmd.com> about drug information AZILECT;
12. List of Trademark Records for the mark AZILECT worldwide and representative samples of trademark registrations;
13. Legalized and authenticated Judicial Affidavit of Mr. Charles Nochumsohn with annexes; and
14. Judicial Affidavit of Atty. Aurora M. Hipol.

This Bureau issued on 29 August 2013 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 13 September 2013. The Respondent-Applicant, however, did not file the answer. On 06 January 2014, this Bureau declared Respondent-Applicant in default. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark AZIACT?

The essence of trademark registration is to give protection to the owners of trademarks. 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 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.⁴ \

Section 123.1 (d) of Republic Act No. 8293, as amended, otherwise known as the "Intellectual Property Code of the Philippines", provides:

Section 123. Registrability. - 123.1. A mark cannot be registered if it:

x x x

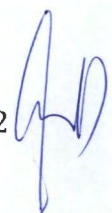
(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- 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;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, said mark cannot be registered.

The records show that at the time the Respondent-Applicant filed its application for the mark AZIACT on 23 November 2012, the Opposer already has an existing registration for the trademark AZILECT issued on 03 May 2012 under Certificate of Registration No. 4-2012-000999. As such, pursuant to Section 138 of the IP Code, being a holder of a certificate of registration, such "certificate of registration is a prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto."

⁴See *Pribidas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.



But are the competing marks, as shown below, identical or similar or resemble each other such that confusion, mistake or deception is likely to occur?

AZILECT

Opposer's Mark

AZIACT

Respondent-Applicant's Mark

A perusal of the composition of the competing trademarks involved in this case show that both marks contain three syllables "A-ZI-LECT" for the Opposer's mark and "A-ZI-ACT" for Respondent-Applicant's. Both marks have similar first and second syllables "A-ZI". As to the third syllable, Respondent-Applicant merely dropped the letters "L" and "E" in Opposer's mark and replaced it with the letter "A" to form its mark "AZIACT". Also, both marks are written in plain upper case letters. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark.⁵ The difference noted in the Respondent-Applicant's mark when compared to Opposer's, does not in any way deviate from a finding of confusing similarity. Respondent-Applicant's mark has a similar overall impression as that of Opposer's.

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two marks is such that there is possibility of the older brand mistaking the newer brand for it.⁶

Colorable imitation does not mean such similitude as amounts to identity. Nor does it require that all the details be literally copied. Colorable imitation refers to such similarity in form, content, words, sound, meaning, special arrangement, or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely mislead or confuse persons in the ordinary course of purchasing the genuine article.⁷

In the case of *Societe Des Produits Nestle vs. Court of Appeals*,⁸ the Supreme Court stated that:

"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 giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other."

Furthermore, aside from the visual similarity, when Respondent-Applicant's AZIACT mark is pronounced, it produces the same sound as that of Opposer's AZILECT mark such that to the ears they are indistinguishable from one 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 Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it.

⁵ See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁶ *American Wire & Cable Company Vs. Director Of Patents* [G.R. No. L-26557. February 18, 1970.]

⁷ *Emerald Garments Manufacturing Corporation vs. Court of Appeals*, G.R. No. 100098. December 29, 1995.

⁸ G.R. No. 112012. April 4, 2001

As to the goods, Opposer's mark is used on "pharmaceutical preparations for the treatment of Parkinson's disease and other central nervous system disorders" under Class 05. On the other hand, the Respondent-Applicant's mark will be used on "pharmaceutical and medical preparations for the treatment of infections and diseases, illness and ailments, health, food and dietary supplements, home remedy and herbal preparations, food products, medical devices, sanitary preparations; dietetic substances adapted for medical use, food for babies" also under Class 05. In this instance, the Respondent-Applicant's trademark application covers a broad range of pharmaceutical and medicinal preparations that may cover the goods of Opposer. Thus, the use of confusingly similar mark on similar or closely related goods will likely cause confusion, mistake or deception on the consumers into believing that there's a connection between Opposer and Respondent-Applicant, when in fact there is none or that their goods comes from the same source or origin.

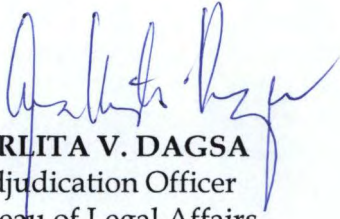
Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-014289, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City,

20 JAN 2017


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs