

THERAPHARMA, INC.,
Opposer,

-versus-

BRAINTREE TRI-MEDIA
CORPORATION,
Respondent- Applicant.

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}
} **IPC No. 14-2011-00048**
} Opposition to:
} Appln. Serial No. 4-2010-011141
} Date Filed: 11 October 2010
} **TM: "RELAXAN"**
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}
}
}

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for Opposer
No. 66 United Street
Mandaluyong City

VERALAW
[DEL ROSARIO RABOCA GONZALES GRASPARIL]
Counsel for Respondent-Applicant
2nd Floor, A & V Crystal Tower, 105 Esteban St.
Legazpi Village, Makati Ctiy

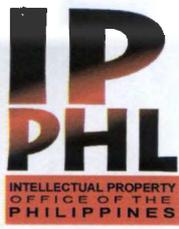
GREETINGS:

Please be informed that Decision No. 2016 - 493 dated December 23, 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 23, 2016.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



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**BRAINTREE TRI-MEDIA
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} **IPC NO. 14-2011-00048**

} Opposition to:

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} Appln. Ser. No. 4-2010-011141

} Date Filed: 11 October 2010

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} Trademark: **RELAXAN**

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} Decision No. 2016- **493**

DECISION

THERAPHARMA, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2010-011141. The application, filed by BRAINTREE TRI-MEDIA CORPORATION (Respondent-Applicant)², covers the mark “RELAXAN”, for use on “medicated plaster” under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

“7. The mark ‘RELAXAN’ owned by Respondent-Applicant so resembles the trademark ‘ALAXAN’ owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark ‘RELAXAN’.

“8. The mark ‘RELAXAN’, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark ‘RELAXAN’ is applied for the same class of goods as that of Opposer’s trademark ‘ALAXAN’, i.e. Class (5) of the International Classification of Goods.

“9. The registration of the trademark ‘RELAXAN’ in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides, in part, that a mark cannot be registered if it:

¹ A corporation duly organized and existing under Philippine laws with principal address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue

² A domestic corporation with address at Penthouse Solar Century Tower, No. 100 Tordesillas cor. H.V. Dela Costa Streets, Salcedo Village, Makati City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

- (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.

Under the above-quoted provision, any mark, which is similar to a registered mark, shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

According to the Opposer:

“10. Opposer is the registered owner of the trademark ‘ALAXAN’.

“10.1. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark ‘ALAXAN’ was filed with the IPO on 1 September 1967 by Opposer and was approved for registration on 2 June 1969 to be valid for a period of ten (10) years, or until 2 June 1989. A certified true copy of *Certificate of Registration No. 14803* for the trademark 'ALAXAN' is hereto attached and made an integral part hereof as 'Exhibit 'B'.

“10.2. Before the expiration of the registration, Opposer filed an application for renewal, which was accordingly granted to be valid for another period of twenty (20) years effective 2 June 1989, or until 2 June 2009.

“10.3. On 12 May 2009, before the expiration of the registration, Opposer filed an application for renewal of the registration of the trademark 'ALAXAN' with the IPO, which was granted for a period of ten (10) years, or until 2 June 2019.

“10.4. Thus, the registration of the trademark ‘ALAXAN’ subsists and remains valid to date.

“11. The trademark ‘ALAXAN’ has been extensively used in commerce in the Philippines.

“11.1. Opposer has dutifully filed Affidavits of Use pursuant to the requirement of the law.

“11.2. A sample of product label bearing the trademark ‘ALAXAN’ actually used in commerce is hereto attached and made an integral part hereof as Exhibit ‘E’.

“11.3. In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, Opposer registered the product with the Bureau of Food and Drugs Administration (‘BFAD’). A copy of the Certificate of Product Registration issued by the BFAD is hereto attached and made an integral part hereof as Exhibit ‘F’.

“13. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark ‘ALAXAN’ to the exclusion of all others. xxx”

“14. The registration of the Respondent-Applicant's mark 'RELAXAN' is contrary to Section 123.1 (d) of the IP Code. 'RELAXAN' is confusingly similar to Opposer's trademark 'ALAXAN'.

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of IPO e-Gazette showing the Respondent-Applicant’s trademark application published for opposition;
2. Copy of Certificate of Registration No. 148034 for the trademark “ALAXAN” dated 2 June 1969;
3. Copy of Certificate of Renewal of Registration No. 014803 for the trademark “ALAXAN” dated 2 June 2009;
4. Copies of Affidavits of Use dated 1979, 1984, 1994;
5. Sample Packaging/label of “ALAXAN”; and
6. Copy of Certificate of Product Registration issued by the Bureau of Food and Drugs dated 14 May 2010⁴

The Respondent-Applicant filed its Answer on 12 August 2012, alleging among other things, the following affirmative defenses:

“15. A perusal of the competing marks would reveal, all too clearly, that they are visually and aurally distinct and different from each other.

“16. Contrary to Opposer's claim, the competing marks are NOT similar.

“17. At the onset it should be noted that the Bureau of Trademarks has already examined the Respondent's mark and has determined that it is NOT similar to any mark either registered or pending application in the Register and while the Bureau of Trademarks' opinion is not binding upon this Bureau, the same deserves great weight and consideration.

⁴ Exhibits “A” to “F” inclusive of sub-markings

“18. The mark RELAXAN evokes a different image as ALAXAN. It should be mentioned that ALAXAN does not have any special significance neither does it create or evoke any visual meaning or image. In contrast, RELAXAN reminds one of the word RELAX and evokes a feeling of comfort and tranquility- by these facts alone, confusion is already rendered impossible.

“19. On top of the obvious oral and visual impression created by the competing marks, it should also be noted that they are used or cover substantially different goods. While Opposer's mark cover the generic drug IBUPROFEN PARACETAMOL' tablets taken orally, Respondent's RELAXAN covers MEDICATED PLASTERS applied topically -clearly the goods covered by the competing marks are substantially different and distinct from each other, again rendering the possibility of confusion impossible.

“20. It should also be noted that IBUPROFEN PARACETAMOL and MEDICATED PLASTERS have different applications and use and are found in different sections of drugstores. Furthermore, IBUPROFEN PARACETAMOL and MEDICATED PLASTERS have different packaging and appearance- facts which again renders the possibility of confusion impossible.

“21. In addition, as can be noted from the packaging of Opposer's product and in compliance with existing laws and regulation, the generic name is written in bold and pronounced in the packaging of Opposer's product -again rendering the likelihood of confusion impossible. xxx

“32. Even assuming for the sake of argument, without conceding, that the competing marks are similar, the Opposition should still be dismissed and the registration of Respondent's application be allowed.

“33. In the case of Sanofi-Aventis v. Dairyfarm Establishment, this Honorable Bureau of Legal Affairs ruled that the marks GARDAN and GUARDIAN are similar that while GARDAN is registered for goods under Class 5, specifically 'pharmaceutical product namely analgesics, anti-pyretics, anti-inflammatories', it ruled that mark GUARDIAN (which this Bureau ruled as similar to GARDAN) may still be registered for the following goods in Class 5 namely: 'pharmaceutical and sanitary preparations, dietetic substances adapted for medicinal use, food for babies, plasters, material for dressings, disinfectants, anthelmintics, anti-rheumatism bracelets and rings, antiseptics, therapeutic preparations for baths, medicated bath preparations, bath salts for medical purposes, bismuth preparations for pharmaceutical purposes, capsules for medicines, capsules for pharmaceutical purposes, medicines for alleviating constipation, hemorrhoid preparations, laxatives, suppositories, contact lens cleaning preparations, eye-wash, antiseptic cotton, cotton for medical purposes, surgical dressing, adhesive tapes for medical purposes, gauze for

dressing, plasters for medical purposes, bandages for dressings, pharmaceutical preparations for treating dandruff, articles for headache, stomach medicine, insect repellants, moth balls, lecithin for medical purposes, magnesia for pharmaceutical purposes, medicinal alcohol, anti acne medicine, medicinal oils, cod liver oil, nutritional additives for medical purposes, salt for medical purposes, pharmaceutical preparations for skin care, thymol for pharmaceutical purposes, tincture of iodine, vitamin preparations, medicinal chewing gums/medicated confectionary, herbs and tonics, health food supplements, medical preparations for slimming purposes, food for babies, deodorants, other than for personal use, air freshening preparations, first aid box, vulnery sponges, contraceptives, impregnated tissues for cleaning (medicated), sanitary pads' despite of the registration of the mark GARDAN in the following Class 05 goods, namely 'pharmaceutical product namely analgesics, antipyretics, anti-inflammatories'.

"34. Clearly, even if we assume for the sake of argument and without conceding, that the competing marks in the case at bar are similar, the registration of the Respondent's RELAXAN mark should still be allowed because Respondent's RELAXAN is applied for 'medicated plasters' which is different and distinct from the goods covered by Opposer's mark which are 'medical preparations composed of n-isopropyl-2methyl-2propyl-1,3 propanediol dicarbamate (carisoprodol) 1-2-diphenyl-3, 5-diketo-4-butylprazolidin calcium (phenylbutazone), indicated for a more complete & effective relief of pain and stiffness in muscles & joints, and the restoration of normal functional movement in musculaskeletal disorder' and actually used for the generic drug IBUPROPEN PARACETAMOL."

The Respondent-Applicant submitted as evidence, the following:

1. Special Power of Attorney dated 11 August 2011; and
2. Verification and Certification Against Forum Shopping dated 12 August 2011.⁵

The Preliminary Conference was held on 6 February 2012 wherein the Hearing Officer directed the parties to submit their respective position papers. Both parties submitted their position papers on 22 February 2012.

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

Records show that at the time Respondent-Applicant applied for registration of the mark "RELAXAN" the Opposer already registered the mark "ALAXAN" under Certificate of Registration No. 014803. The goods covered by the Opposer's trademark registration are also under Class 05, same as indicated in the Respondent-Applicant's trademark application.

⁵ Exhibits "1" - "2"

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

alaxan **RELAXAN**

Opposer's mark

Respondent-Applicant's mark

Scrutinizing the composition of the trademarks involved in this case, it is observed that both marks, are similar with respect to the last two syllables "LAXAN", but when appended with different prefixes "A" and "RE", the resulting sounds are distinct, considering further that the Respondent-Applicant's mark begins with the word "RELAX". Furthermore, even if the marks are applied on goods under the same Class 5, the products are of different characteristics. Opposer's mark is applied on a "pharmaceutical product namely analgesics, antipyretics, anti-inflammatories" while Respondent-Applicant's mark is used for "medicated plasters". One product is taken orally and the other is merely applied to the skin and not taken into the body by mouth, thus, the goods are not related and not in competition with each other. The Supreme Court in the case of Canon Kabushiki Kaisha v. Court of Appeals and NSR Rubber Corporation⁶ discussed the theory of related goods and the use of identical marks on goods of different descriptive properties. The High Court explained:

Here, the products involved are so unrelated that the public will not be misled that there is the slightest nexus between petitioner and the goods of private respondent.

In cases of confusion of business or origin, the question that usually arises is whether the respective goods or services of the senior user and the junior user are so related as to likely cause confusion of business or origin, and thereby render the trademark or tradenames confusingly similar. Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores.

Thus, in *Esso Standard Eastern, Inc. vs. Court of Appeals*, this Court ruled that the petroleum products on which the petitioner therein used the trademark ESSO, and the product of respondent, cigarettes are "so foreign to each other as to make it unlikely that purchasers would think that petitioner is the manufacturer of respondent's goods" Moreover, the fact that the goods involved therein flow through different channels of trade highlighted their dissimilarity, a factor explained in this wise:

"The products of each party move along and are disposed through different channels of distribution. The (petitioner's) products are distributed principally through gasoline service and lubrication stations, automotive shops and hardware stores. On the other hand, the (respondent's) cigarettes are sold in sari-sari stores, grocery store, and other small distributor outlets. (Respondent's) cigarettes are even peddled in the streets while (petitioner's) 'gasul' burners are not. Finally, there is a marked distinction between oil and tobacco, as well as between petroleum and cigarettes. Evidently, in kind and nature the products of (respondent) and of (petitioner) are poles apart."

⁶ G.R. No. 120900, 20 July 2000

Undoubtedly, the paints, chemical products, toner and dyestuff of petitioner that carry the trademark CANON are unrelated to sandals, the product of private respondent.

Furthermore, the mark "RELAXAN" appears to be a play on the word "relax", which brings to mind, "rest", making it a suggestive mark. Suggestive terms are those which, in the phraseology of one court, require "imagination, thought and perception to reach a conclusion as to the nature of the goods." Such terms, "which subtly connote something about the product," are eligible for protection in the absence of secondary meaning. While suggestive marks are capable of shedding "some light" upon certain characteristics of the goods or services in dispute, they nevertheless involve "an element of incongruity," "figurativeness," or "imaginative effort on the part of the observer."⁷ Since the mark identifies "medicated plasters", the prefix, "RELAX" subtly connotes the feeling derived from soothing medicated plasters, hence, a valid trademark which is not confusing to Opposer's mark.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-011141 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 DEC 2016



ATTY. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs

⁷ Societe des Produits Nestle S.A. v. Court of Appeals, G.R. No. 112012, April 4, 2011