

MEDICHEM PHARMACEUTICALS INC.,
Opposer,

-versus-

ZYDUS PHILIPPINES, INC.,
Respondent-Applicant.

X-----X

IPC No. 14-2014-00043

Opposition to:

Appln. Serial No. 4-2013-012874

Date Filed: 24 October 2013

TM: ZOLDAC

NOTICE OF DECISION

OCHAVE & ESCALONA

Counsel for Opposer
No. 66 United Street,
Mandaluyong City

ZYDUS PHILIPPINES, INC.

Respondent- Applicant
Unit 903 & 904, 9th Fl., Ecotower
32nd Street corner 9th Avenue,
Bonifacio Global City, Taguig

GREETINGS:

Please be informed that Decision No. 2017 - 65 dated 10 March 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.

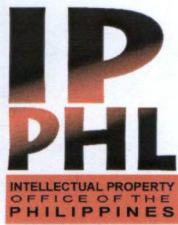
Taguig City, 13 March 2017.

MARILYN F. RETUTAL
IPRS IV

Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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IPC NO. 14-2014-00043

Appln. Ser. No. 4-2013-012874
Filing Date: 24 October 2013
Trademark: ZOLDAC

Decision No. 2017 - 65

DECISION

UNITED MEDICHEM PHARMACEUTICALS INC.¹ (“Opposer”) filed an Opposition to Trademark Application No. 4-2013-012874. The application, filed by ZYDUS PHILIPPINES, INC.² (“Respondent-Applicant”), covers the mark ZOLDAC for use on “Alprazolam (pharmaceutical product: anxiolytics)” under Class 05 of the International Classification of goods³.

Opposer alleges that the mark ZOLDAC filed by Respondent-Applicant so resembles its own mark ZOLDEM registered with the Intellectual Property Office (IPO) prior to the publication of the application for the mark ZOLDAC. According to Opposer, the mark ZOLDAC will likely cause confusion, mistake and deception on the part of the purchasing public especially that it is being applied for the same class and goods, in violation of Section 123.1(d) of the IP Code.

The Opposer’s evidence consists of the following:

1. Copy of the printout page of IPOPHL's E-Gazette dated 06 January 2014;
2. Certified true copy of Registration No. 4-2006-005900 for the mark ZOLDEM;
3. Certified true copies of Declaration of Actual Use;
4. Sample product label bearing the mark ZOLDEM;
5. Certified true copy of the Certificate of Product Registration for ZOLDEM issued by the Food and Drug Administration; and
6. Certified true copy of Certification and sales performance issued by IMS Health.

On 17 February 2014, this Bureau issued a Notice to Answer and personally served a copy thereof to the Respondent-Applicant on 19 February 2014. The Respondent-Applicant, however, did not file the Answer. On 03 June 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 ZOLDAC?

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

¹ A corporation duly organized and existing under the laws of the Philippines with principal address at No. 132 Pioneer Street, Mandaluyong City.

² A domestic corporation with office address at Unit Penthouse 1, 19th Floor, Goldloop Tower A, Escriva Drive, Barangay San Antonio, 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.

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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 Thus, Sec. 123.1 (d) of the IP Code 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 or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its application for the mark ZOLDAC on 24 October 2013, the Opposer already has an existing registration for the trademark ZOLDEM issued way back in 30 April 2007. 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."

Opposer's mark is used on goods falling under Class 05, namely, "*sedative/hypnotic pharmaceutical preparations*". On the other hand, the Respondent-Applicant's mark is being applied for use on "*Alprazolam (pharmaceutical product: anxiolytics)* also under Class 05. "Anxiolytics" are *anti-anxiety medication; a tranquilizer*.⁵ Although sedatives are distinct from tranquilizer drug, they are both calming drugs. As such, they are closely related goods.

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?

Zoldem

Opposer's Mark

ZOLDAC

Respondent-Applicant's Mark

Both marks are "word marks" that appeal to the visual sense. The composition of the competing trademarks show that they contain two syllables "ZOL-DEM" for the Opposer's mark and "ZOL-DAC" for Respondent-Applicant's. Both marks have similar first syllable. As to the second syllable, Respondent-Applicant merely dropped the letters "E" and "M" in Opposer's mark and replaced it with the letters "A" and "C" to form its mark "ZOLDAC". Also, both marks are written in plain letters. 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 because Respondent-Applicant's mark has a similar overall impression as that of Opposer's.

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 other⁶. Colorable imitation does not mean such similitude as amounts 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 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 to mislead or confuse persons in the ordinary course of purchasing the genuine article⁷.

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

⁵ anxiolytic. (n.d.) *Miller-Keane Encyclopedia and Dictionary of Medicine, Nursing, and Allied Health, Seventh Edition*. (2003). Retrieved March 7 2017 from <http://medical-dictionary.thefreedictionary.com/anxiolytic>

⁶ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁷ *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

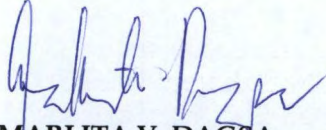
Succinctly, because the Respondent-Applicant, like the Opposer, will use the mark ZOLDAC on closely related pharmaceutical products, there is the likelihood that the public will likely believe or be mistaken that Respondent-Applicant's goods, if and when its mark will be allowed to be registered, is manufactured or sourced from Opposer and that the variations in the respective marks is just a branding strategy to market a closely related product.

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. 4-2013-012874, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 MAR 2017


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs