

THERAPHARMA, INC.,
Opposer,

-versus-

AMBICA INTERNATIONAL TRADING CORP.,
Respondent-Applicant.

IPC No. 14-2014-00464
Opposition to:
Appln. Serial No. 4-2014-00007047
Date Filed: 04 June 2014

TM: HALONOL

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NOTICE OF DECISION

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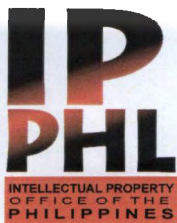
GREETINGS:

Please be informed that Decision No. 2017 - 58 dated 28 February 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, 01 March 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



THERAPHARMA, INC.,
Opposer,

IPC No. 14-2014-00464
Opposition to:

- versus -

Appln. No. 4-2014-00007047
Date Filed: 04 June 2014
Trademark: "**HALONOL**"

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

Decision No. 2017 - 58

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DECISION

THERAPHARMA, INC. ("Opposer")¹, filed verified opposition to Trademark Application Serial No. 4-2014-00007047. The application, filed by AMBICA INTERNATIONAL TRADING CORPORATION ("Respondent-Applicant")², covers the mark "HALONOL" for use on goods under class 05³ namely: *pharmaceutical preparations namely anti-emetic*.

The Opposer alleges the following grounds for opposition:

"7. The mark 'HALONOL' applied for by Respondent-Applicant so resembles the trademark 'LLANOL' owned by Opposer and duly registered with this Honorable Bureau prior to the publication of the application for the mark 'HALONOL'.

"8. The mark 'HALONOL' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'HALONOL' is applied for the same class and goods as that of Opposer's trademark 'LLANOL', i.e., Class 05 of the International Classification of Goods for pharmaceutical preparations.

"9. The registration of the mark 'HALONOL' in the name of the Respondent-Applicant will violate Sec. 123.1 (d) of the IP Code, which provides, in part, that 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**

¹ A domestic corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines with office address at Bonaventure Plaza, Greenhills, San Juan, Metro Manila.

² With office address at No. 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.

(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

x x x" (Emphasis supplied)

"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.

"10. Respondent-Applicant's use and registration of the mark 'HALONOL' will diminish the distinctiveness of Opposer's trademark 'LLANOL'."

The Opposer's evidence consists of the following:

1. Pertinent page of the IPO E-Gazette;
2. Certified True Copy (CTC) of the Principal Register No. 20420 for LLANOL;
3. CTC of the Petition for Renewal of Registration;
4. CTCs of the Affidavits of Use;
5. Sample product label bearing the trademark LLANOL;
6. CTC of the Certification and sales performance; and,
7. CTC of Certificate of Product Registration No. DR-7571 for LLANOL.

On 02 February 2015, the Respondent-Applicant filed its Answer containing among others, the following allegations:

"11. The trademark 'HALONOL' is not identical to, nor does so resemble, the trademark 'LLANOL' so as to cause confusion, mistake or deception on the part of the purchasing public. These marks are clearly different in spelling and have distinctive pronunciations, fonts, colors and designs, nor do they nearly resemble or are confusingly similar to each other as to be likely to deceive or cause confusion.

x x x

"12. The generic name for the product 'HALONOL' is 'Haloperidol' while 'Llanol' is 'Allopurinol'. The Generics Act of 1998 (R.A. No. 6675) requires that 'the generic name shall appear prominently and immediately above the brand name in all product labels as well as in advertising and other promotional materials' obviating any risk of confusion. In fact, 'All medical, dental and veterinary practitioners, including private practitioners, shall write prescriptions using the generic name. The brand name may be included if so desired.' Due to the great disparity between 'Haloperidol' and 'Allopurinol', there is no basis for any charge of confusion between the two products.

"13. Moreover, Republic Act No. 5921, also known as an Act Regulating the Practice of Pharmacy also requires that 'No medicine, pharmaceutical, or drug of whatever nature and kind or device shall be compounded, dispensed, sold or resold, or otherwise be made available to the consuming public except through a prescription drugstore or hospital pharmacy, duly established in accordance with the provisions of this Act' and that 'Every pharmacy, drugstore or hospital pharmacy whether owned by the government or a private person or firm shall at all times when open for business be under the personal and immediate supervision of a registered pharmacist. These pharmacists tasked to dispense medicine further insure against possible confusion that Opposer claim to be guarding against."

just

The Respondent-Applicant's evidence consists of the following:

1. Copy of Respondent-Applicant's mark HALONOL; and,
2. Certificate of Product Registration issued by the Food and Drug Administration,

The Preliminary Conference was held and terminated on 02 July 2015. Consequently, this case is deemed submitted for decision.

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

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, also known as the Intellectual Property Code ("IP 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.

Records show that at the time Respondent-Applicant filed its trademark application on 04 June 2014, the Opposer already owns trademark registration for the mark "LLANOL" bearing Principal Register No. 20420 as early as 19 October 1973 falling under Class 05 for Allopurinol, an antihyperuricemic agent⁴ or anti-gout preparations. Unquestionably, the Opposer's application and registration preceded that of Respondent-Applicant's.

A comparison of the competing marks are reproduced below:

Llanol

HALONOL

Opposer's Trademark

Respondent-Applicant's mark

What is common between the competing marks is the suffix "NOL". It appears that the suffix "NOL" is not an accurate indicator of the existence of confusing similarity in the marks. In the case of LLANOL, the "NOL" is obviously derived from its generic name "Allopurinol". On the other hand, HALONOL's is perceptibly taken from its generic name "**Haloperidol**". It is a fair inference that the parties derived a part or component of their marks from its respective generic names. Corollary, this Bureau cannot sustain the instant opposition on the basis of the mere similarity of the suffix "NOL". The greater part of the competing marks consist of "LLA" in LLANOL; and "HALO" in HALONOL", which are distinct and unique from one another.

Moreover, the competing pharmaceutical products are intended for different illnesses. Opposer's LLANOL (Generic Name: Allopurinol) is an anti-gout medicine.⁵ It reduces the production of uric acid in the body which can lead to gout or kidney stones. It also decrease levels of uric acid in people who are receiving cancer treatment.⁶ Respondent-Applicant's HALONOL is an anti-emetic medicine which can

⁴ Exhibit "B" and "C" of Opposer.

⁵ Exhibit "J" and "L" of Opposer.

⁶ Allopurinol, available at <https://www.drugs.com/allopurinol.html> (last accessed 28 February 2017).

help relieve nausea and vomiting.⁷ In the Certificate of Product Registration, it is indicated that HALONOL is used in the treatment of various psychoses including schizophrenia and mania, and in behavior disturbances, in Tourette's syndrome and severe tics, in intractable hiccups, and in severe anxiety, including for the sedation of patients in intensive care or palliative care.⁸ Thus, the goods involved are different in terms of characteristics, nature and its intended purpose. Thus, because of the difference in the appearance of the marks, and the goods or pharmaceutical products, Respondent-Applicant's HALONOL cannot be said to have the intent to ride in the goodwill of Opposer's LLANOL. It is unlikely for one when confronted with the mark HALONOL to be reminded of the mark LLANOL and *vice versa*.

It is noteworthy that the competing goods are prescription drugs that are not directly taken off the rack by the purchasers. For both pharmaceutical products to pass on to the buyers, the latter must present a licensed physician's prescription to a pharmacist, who will dispense the pharmaceutical product. Thus, it was ruled that with regard to medicines, the requirement of a prescription makes "the chances of being confused into purchasing one for the other are therefore all the more rendered negligible."⁹

Finally, 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.¹⁰ This Bureau finds the Respondent-Applicant's mark consistent with this function.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-00007047 is hereby **DISMISSED**. Let the file wrapper of subject trademark application be returned, together with a copy of the Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 28 FEB 2017



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

⁷ Antiemetic medicines, available at <https://familydoctor.org/antiemetic-medicines-otc-relief-for-nausea-and-vomiting/> (last accessed 28 February 2017).

⁸ Exhibit "2" of Respondent-Applicant.

⁹ Bristol Myers Co. vs. Director of Patents 17 SCRA 128 (1966), involving trademarks "BUFFERIN" and "BIOFERIN".

¹⁰ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.