

BIOFARMA,
Opposer,

-versus-

AMBICA INTL. TRADING CORP.,
Respondent- Applicant.

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IPC No. 14-2014-00121
Opposition to:
Appln. No. 4-2013-006711
Date Filed: 11 June 2013
TM: "CALAN SR"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 87 dated March 22, 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, March 23, 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

BIOFARMA,

Opposer,

-versus

AMBICA INTL. TRADING CORP.

Respondent-Applicant.

X ----- X

IPC No. 14-2014-00121

Opposition to Trademark

Application No. 4-2013-006711

Date Filed: 11 June 2013

Trademark: "CALAN SR"

Decision No. 2017- 87

DECISION

Biofarma¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-006711. The contested application, filed by Ambica International Trading Corporation² ("Respondent-Applicant"), covers the mark "CALAN SR" for use on "*pharmaceutical preparations namely calcium channel blocker*" under Class 05 of the International Classification of Goods³.

The Opposer anchors its opposition on the provision of Section 123.1 (d), (e) and (f) of the Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). It alleges, among others, that the Respondent-Applicant's mark "CALAN SR" is confusingly similar to its registered mark "CORALAN" for the following reasons:⁴

- i. the marks are phonetically and aurally similar. Both marks begin with the letter "C" and end with the suffix "ALAN". The omission of the letters "OR" from CORALAN does distinguish CALAN SR from the former, as the stress in the pronunciation of the marks lie in the suffix or the last syllables pertaining to "ALAN";
- ii. the marks are applied on identical or related goods; CALAN SR is being applied for goods under Class 5, under which class Opposer's CORALAN mark is likewise registered;
- iii. the parties are engaged in competitive business;
- iv. the goods on which the marks are used are purchased by the same class of purchasers or flow through the same channels of trade.

¹ A corporation duly organized and existing under the laws of France with principal address at 50 rue Carnot, 92284 Suresnes Cedex, France.

² With known address at #9 Amsterdam Extension, Merville Park Subdivision, Metro Manila.

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

⁴ See Verified Opposition, p. 3.

In support of its Opposition, the Opposer submitted as evidence the affidavit of Catherine Boudot, with annexes.⁵

On 07 August 2014, a Notice to Answer was served upon the Respondent-Applicant. The latter, however, failed to comply. Thus, the Adjudication Officer issued Order No. 2015-1116 on 03 August 2015 declaring the Respondent-Applicant in default and submitting the case for decision.

The issue to be resolved is whether the Respondent-Applicant's mark "CALAN SR" should be allowed registration.

Records reveal that at the time the Respondent-Applicant filed the contested mark on 11 June 2013, the Opposer has a valid and existing registration of the mark "CORALAN" under Certificate of Registration No. 4-2003-011156 issued on 16 October 2006.

But are the competing marks, as shown below, confusingly similar?

CORALAN

CALAN SR

Opposer's mark

Respondent-Applicant's mark

From the illustration, it can be observed that the marks are readily distinguishable from each other. Although both begin with the letter "C" and end with the syllable "ALAN", the additional letters "OR" in the Opposer's mark sufficiently distinguish the competing trademarks. The Opposer's documentary exhibits including the trademark registration certificate, certificate of product registration and MIMS manual indicate that "CORALAN" is for treatment of coronary diseases. It can thus be presumed that the "COR" in "CORALAN" is derived from the generic and/or descriptive word "CORONARY". While the addition of "ALAN" makes the Opposer's mark registrable, the mark is considered merely suggestive of the purpose or use of the goods which the same pertains. Without the letters "OR", the mark will connote a different product altogether thus making confusion unlikely. The presence or absence of the said letters "OR" also creates a distinction in the pronunciation and spelling of the competing marks.

⁵ Marked as Exhibits "B", inclusive.

Moreover, although both marks cover goods under Class 05, the Respondent-Applicant's trademark application indicates calcium blockers. These are not similar to those covered by the Opposer's trademark registration which refer to "*pharmaceutical products and preparations namely cardiovascular, respiratory, metabolism, cytostatic, anxiolytic agents or acting on the central nervous systems; dietetic substances, plasters, materials for dressings, material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides*". This is especially true in this case wherein the products involved are pharmaceuticals which are only dispensed or purchased through a prescription of a physician and aid of a pharmacist.


Furthermore, the Opposer failed to prove that its trademark "CORALAN" is well-known for it to be conferred protection outside what is stated in its certificate of registration. Nor that its mark's fame could support the claim that the Respondent-Applicant's trademark application and use of the mark "CALAN SR" manifest the latter's intent of riding in on the goodwill supposedly earned and enjoyed by the former.

Finally, it is emphasized that 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.⁶ The Respondent-Applicant's trademark sufficiently met this requirement.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-006711 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 22 MAR 2017


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.