



INTELLECTUAL PROPERTY OFFICE OF THE PHILIPPINES

UNITED AMERICAN PHARMACEUTICALS, INC., }
Opposer, }

-versus-

CIPLA LIMITED, }
Respondent-Applicant. }

IPC No. 14-2015-00255
Opposition to:
Appln. Serial No. 4-2014-014751
Date Filed: 28 November 2014

TM: ASTHALIN

x-----x

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 96 dated 29 March 2017 (copy enclosed) was promulgated in the above entitled case.

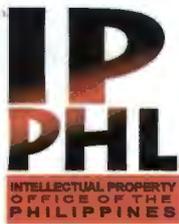
Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 29 March 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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UNITED AMERICAN PHARMACEUTICALS, INC.,

Opposer,

-versus-

CIPLA LIMITED,

Respondent-Applicant.

IPC No. 14-2015-00255

Opposition to Trademark

Appln. No. 4-2014-014751

Date Filed: 28 November 2014

Trademark: **"ASTHALIN"**

X ----- X Decision No. 2017- 96

DECISION

United American Pharmaceuticals, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-014751. The contested application, filed by Cipla Limited² ("Respondent-Applicant"), covers the mark "ASTHALIN" for use on *"pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides"* and *"surgical, medical, dental and veterinary apparatus and instruments, inhalers, actuators, inhalators, spacers for inhalers, artificial limbs, eyes and teeth; orthopaedic articles; suture materials"* under Classes 05 and 10, respectively, of the International Classification of Goods³.

The Opposer contends that the Respondent-Applicant's applied mark "ASTHALIN" is confusingly similar with its own mark "ASMALIN". According to the Opposer, its sister company, Biomedis, Inc., filed an application for the mark "ASMALIN" with the then Philippine Patent Office ("PPO") on 25 September 1972 and the same was eventually issued registration on 27 November 1973. Before expiration of the trademark registration, Biomedis, Inc. timely filed a petition for renewal of the mark this time with the Bureau of Patents, Trademarks and Technology Transfer, which was accordingly granted renewal until 27 November 2013. In the meantime, on 08 June 1999, the said trademark registration was assigned to the Opposer. Thus on 27 November 2013, the Opposer filed the pertinent petition for renewal, which was also granted. It dutifully filed its Affidavit of Actual Use and registered its product with the Food and Drug Administration (FDA). Also, the Intercontinental Marketing Services (IMS) listed "ASMALIN" as one of the

¹ A corporation duly organized and existing the laws of the Philippines, with office address at 132 Pioneer Street, Mandaluyong City, Philippines.

² With known address at Cipla House, Peninsula Business Park, Ganpatrao Kadam Marg, Lower Parel, Mumbai, 400 013, India.

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.

leading brands in the Philippines in the category of "R03A-Beta2-Stimulants" in terms of market share and sales performance.

In support of its Opposition, the Opposer submitted the following as evidence:⁴

1. copy of the pertinent page of the IPO E-Gazette publishing Respondent-Applicant's application;
2. certified true copy of Certificate of Registration No. 20775;
3. certified true copy of the Assignment of Registered Trademark;
4. certified true copy of Certificate of Renewal of Registration No. 4-1972-20775;
5. certified true copies of the Affidavits of Actual Use;
6. sample product label;
7. copy of the certification and sales performance issued by IMS; and,
8. certified true copy of the Certificate of Product registration issued by the FDA.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 22 June 2015. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Adjudication Officer issued on 19 April 2016 Order No. 2016-639 declaring the Respondent-Applicant in default and submitting the case for decision.

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

Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), states that:

"Section 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; x x x"

Records reveal that the Opposer's predecessor-in-interest filed an application for its mark "ASMALIN" as early as 25 September 1972. The Certificate of

⁴ Marked as Exhibits "A" to "H".

Registration No. 20775 was eventually issued on 27 November 1973.⁵ On the other hand, the Respondent-Applicant filed its application for the contested mark "ASTHALIN" only on 28 November 2014.

The question is whether the competing marks, as shown hereafter, are confusingly similar:

ASMALIN

ASTHALIN

Opposer's mark

Respondent-Applicant's mark

Both marks begin with the syllable "AS" and end with the letters "ALIN". It appears that the Respondent-Applicant merely replaced the third letter "M" in the Opposer's mark for the letters "TH" in arriving at its mark. Thus, in spelling, pronunciation and connotation, the marks remain confusingly similar. Succinctly, 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 purchasers as to cause him to purchase the one supposing it to be the other.⁶

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*. "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁷

In this case, it is noteworthy that both marks cover goods under Class 05. The Opposer's registration covers "*an anti-asthma preparation designed for effective and prompt symptomatic relief of the distressing symptoms of bronchial asthma*", which is closely-related, if not similar, to the goods the Respondent-Applicant uses or

⁵ Marked as Exhibit "B".

⁶ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁷ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

intends to use the mark "ASTHALIN". Hence, it is highly likely that the consumers will confuse or mistake "ASMALIN" as being a mere variation of or in any way connected to "ASTHALIN", and vice-versa. Furthermore, the field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitations, the unanswered riddle is why of the millions of terms and the combinations of letters and designs available, the Respondent-Applicant has come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁸ The latter was given ample opportunity to explain how it came up with the contested mark but failed to timely file an Answer.

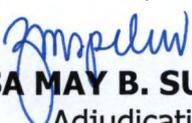
Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market 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.⁹ The Respondent-Applicant's trademark fell short in meeting this function.

Accordingly, this Bureau finds and concludes 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. 4-2014-014751 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 MAR 2017


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

⁸ American Wire & Cable Company vs. Director of Patents, G.R. No. L-26557, 18 February 1970.

⁹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.