

PHARMACHEMIE B.V.,
Opposer,

-versus-

AMBICA INTERNATIONAL
TRADING CORPORATION,
Respondent- Applicant.

x-----x

}
} **IPC No. 14-2014-00415**
} Opposition to:
} Appln. Serial No. 4-2014-006098
} Date Filed: 15 May 2014
} **TM: "DOXORUBA"**
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 156 dated May 15, 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, May 15, 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

PHARMACHEMIE B.V.,
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- versus -

**AMBICA INTERNATIONAL
TRADING CORPORATION,**
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IPC No. 14-2014-00415
Opposition to:

Appln. No. 4-2014-006098
Date Filed: 15 May 2014
Trademark: "**DOXORUBA**"

Decision No. 2017 - 156

DECISION

PHARMACHEMIE B.V. ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2014-006098. The application, filed by AMBICA INTERNATIONAL TRADING CORPORATION ("Respondent-Applicant")², covers the mark "DOXORUBA" for use on goods under class 05³ namely: "*pharmaceutical preparations namely oncology.*"

The Opposition alleges that Opposer was founded in Haarlem by Messrs. Teves and De Vita in 1946. In the late 1970s, Opposer started production of sterile compositions for the treatment of cancer. Opposer is the owner of the trademark DOXORUBIN for use on its product doxorubicin hydrochloride, one of Opposer's drug products for its product line on oncology, cytostatics or anti-cancer treatment. DOXORUBIN is an anti-cancer chemotherapy drug and is classified as an anthracycline antibiotic which works by slowing or stopping the growth of cancer cells. It is used to treat acute leukaemia, lymphomas, and a variety of solid tumors and may also be used with other medications to treat other types of cancer. Opposer first used DOXORUBIN in 1989 in the Netherlands. In the Philippines, Opposer started using it for its generic products in 1992 when it was first issued a Certificate of Product Registration for DOXORUBIN by then Bureau of Food and Drugs. Opposer has used DOXORUBIN worldwide for over 25 years and is currently available in over 15 countries worldwide.

According to the Opposer, DOXORUBIN is registered in more than 25 countries, including the Philippines under Registration No. 4-2007-012428 issued on 05 May 2008. It has been listed in Drugcore.com, DrugAbout.com, Drughealth.org and MIMS.com among other drug listing websites. It has become internationally well-known not only as an effective drug for the

¹ A corporation duly organized and existing and registered under the laws of The Netherlands, with principal offices at Swensweg 5, 2031 GA Haarlem, The Netherlands.

² A domestic corporation with office address at #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.

treatment of cancer, but also as a mark associated with Opposer. The Opposer details the following grounds for this instant opposition:

1. Respondent's DOXORUBA mark is confusingly similar with Opposer's registered DOXORUBIN mark, covering the same or similar goods and services;
2. Respondent's products may be assumed to originate from Pharmachemie B.V. thereby deceiving the public into believing that there is some connection between the Respondent and the Opposer which, in fact, does not exist;
3. Respondent's use of the DOXORUBA mark which is confusingly similar to the Opposer's registered mark, blurs the distinctiveness of the registered DOXORUBIN trademark; and,
4. Respondent intends to pass off its DOXORUBA goods as those of Opposer.

The Opposer's evidence consists of the following:

1. Special Power of Attorney;
2. Respondent's General Information Sheet for the year 2014;
3. Print-out of the webpage of Teva Netherlands;
4. Print-out of the webpage of the company profile of Teva Pharmaceutical Industries Ltd.;
5. Print-out of the webpage showing Teva Pharmaceuticals operating through Teva Netherlands;
6. Print-out of Teva Pharmachemie Strategy and the development and production of oncology injectables and dry powder inhalation products;
7. Print-out of Pharmaceutical Industries Ltd. Oncology Products;
8. Print-out of National Cancer Institute's Cancer Drug Information;
9. Certificate of Product Registration for DOXORUBIN;
10. Print-out of Drugs.com, DrugCore.com and, Drugs-About.com showing Doxorubin;
11. Packaging samples of Doxorubin and Drug Information;
12. Certified true copy (Ctc) of Certificate of Registration for DOXORUBIN;
13. Print-out of Medical Health for Families (Philippines) for DOXORUBIN;
14. Print-out of Mims.com Philippines on DOXORUBIN Dosage & Drug Information;
15. 7th Annual Report on The World's Top 50 Pharmaceutical Companies;
16. Article by Andriyanov, Koren , Barenholz and Goldberg;
17. Article on Drug-induced histone eviction from open chromatin and effects of DOXORUBIN;
18. Journal of the National Cancer Institute;
19. Clinical Research Institute on Differential Effect of DOSORUBIN and Zoledronic Acid;
20. British Journal of Pharmacology;
21. Print-out of Novel pH-sensitive micelles;
22. Trademark Records by Country;
23. Copies of trademark registration and renewal of trademark registration;

24. List of Generic Names of Drug and Brand Names;
25. Print-out of Court Judgment;
26. Print-out of DOXORUBIN Reviews and Brand Information;
27. Sales Invoices;
28. Judicial Affidavit of Hennie P. J. Henrichs; and,
29. Judicial Affidavit of Atty. Venus B. Ambrona.

This Bureau issued and served upon Respondent-Applicant a Notice to Answer.⁴ Respondent-Applicant failed to file an Answer, thus, declared in default.⁵ On 23 July 2015, Respondent-Applicant filed a Motion to Lift Order of Default stating that it filed a Verified Answer by registered mail on 13 February 2015. However, after examination by this Bureau, said motion was denied. This Bureau did not receive Respondent-Applicant's Verified Answer. Moreover, the date stamped in the Registry Receipt showing proof of mailing and filing, appeared irregular. Hence, this case is submitted for decision.

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

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

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 15 May 2014⁶, the Opposer has already an existing trademark registration for the mark DOXORUBIN bearing Registration No. 4-2007-012428 issued on 05 May 2008⁷. It also has various registration of its DOXORUBIN mark in foreign countries⁸. Unquestionably, the Opposer's applications and registrations preceded that of Respondent-Applicant's.

A comparison of the Opposer's mark with the Respondent-Applicant's is depicted below:

DOXORUBIN

DOXORUBA

Opposer's Trademark

Respondent-Applicant's Trademark

⁴ Dated 15 December 2014.

⁵ Order No. 2015-892 dated 19 June 2015.

⁶ Filewrapper records.

⁷ Exhibit "N" of Opposer.

⁸ Exhibits "Z", Z-1 to Z-15" of Opposer.

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The foregoing marks contain the identical word "DOXORUB". The only difference between the marks is the suffix "IN" in DOXORUBIN, as against the ending letter "A" in DOXORUBA.

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 other.⁹ Colorable imitation does not mean such similitude as amount 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 tradename with that of the other mark or tradename 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 article.¹⁰

This Bureau further underscores the fact that the competing marks cover goods which are similar and/or identical in its kind, use, purpose and nature. This determines the likelihood of confusion by reason of Opposer's DOXORUBIN registration which covers "*pharmaceutical products in relation to human use for the treatment of oncology patients*"¹¹, which is identical to the goods covered by Respondent-Applicant, indicated in the application documents as "*pharmaceutical preparations namely oncology.*"

Succinctly, because the coverage of the Respondent-Applicant's trademark registration would allow using the mark DOXORUBA on goods or pharmaceutical products that are already dealt in by the Opposer using the mark DOXORUBIN, the minute changes in spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. The marks have similarity in sounds, both consisting of three syllables, which make it not easy for one to distinguish one mark from the other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Petitioner's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound, however, is practically replicated when one pronounces the Respondent-Registrant's mark.

While it appears that the identical word "DOXORUB" is obviously taken or lifted from the generic name "DOXORUBICIN" of both competing marks¹², the Opposer's registered trademark DOXORUBIN is not identical or confusingly similar thereto. Further, there is no showing that the identical word DOXORUB is the customary or usual designation of the product, nor that which serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production or other characteristics thereof. The fact remains that the competing marks are similar in its appearance and sound, when the marks are spoken.

⁹ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

¹⁰ Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.

¹¹ Id. at 7.

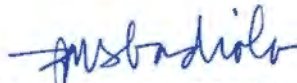
¹² Exhibits "L-1", "L-2" and "M" of Opposer.

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 or 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.¹³

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-006098 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 15 MAY 2017



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

¹³ Pribhdas J. Mirpuri vs. Court of Appelas (G.R. No. 114508, 19 November 1999).