

THERAPHARMA, INC.,
Opposer,

-versus-

BROWN & BURK PHILS., INC.,
Respondent- Applicant.

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IPC No. 14-2015-00262
Opposition to:
Appln. Serial No. 4-2015-002147
Date Filed: 27 February 2015
TM: CARVIDON

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for the Opposer
No. 66 United Street
Mandaluyong City

BROWN & BURK PHILIPPINES, INC.
Counsel for Respondent-Applicant
U-501,5F SEDCCO Building
120 Rada corner Legaspi Streets
Legaspi Village, Makati City

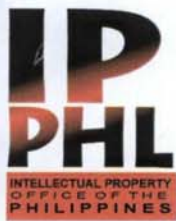
GREETINGS:

Please be informed that Decision No. 2017 - 173 dated May 29, 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 30, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



THERAPHARMA, INC.,
Opposer,
 -versus-
 BROWN & BURK PHILS., INC.,
Respondent-Applicant.
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IPC No. 14-2015-00262
 Opposition to:
 Application No. 4-2015-002147
 Date Filed: 27 February 2015
 Trademark: "CARVIDON"
 Decision No. 2017- 173

DECISION

THERAPHARMA, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2015-002147. The application, filed by Brown & Burk Phils., Inc.² ("Respondent-Applicant"), covers the mark "CARVIDON" for use on "pharmaceutical (anti-angina)" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
"GROUNDS FOR OPPOSITION"

"The grounds for this Verified Notice of Opposition are as follows:

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

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

"9. The registration of the mark 'CARVIDON' 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:

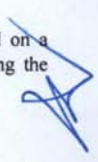
x x x

"10. 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

¹With office address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan, Metro Manila, Philippines.

²With address at U-501, 5F SEDCCO 1 Bldg., 120 Rada cor. Legaspi Sts., Legaspi Village, Makati City, Metro Manila, Philippines.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.



the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

"11. Respondent-Applicant's use and registration of the mark 'CARVIDON' will diminish the distinctiveness of Opposer's trademark 'CARVID'.

"ALLEGATIONS IN SUPPORT OF THE OPPOSITION

"In support of this Verified Notice of Opposition, Opposer will rely upon and prove the following facts:

"12. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical and other healthcare products and is the registered owner of the trademark 'CARVID'.

"12.1. The trademark application for the trademark 'CARVID' was filed with the IPO on 9 August 2006 by Westmont Pharmaceuticals, Inc. ('Westmont') and was approved for registration on 28 May 2007 to be valid for a period of ten (10) years, or until 28 May 2017. Thus, the registration of the trademark 'CARVID' subsists and remains valid to date. A certified true copy of the Certificate of Registration No. 4-2006-008727 for the trademark 'CARVID' is attached hereto as Exhibit 'B' and made an integral part hereof.

"12.2. Subsequently, on 23 October 2008, Westmont assigned the trademark 'CARVID' to herein Opposer. A certified true copy of Assignment of Registered Trademark duly filed with, and accepted and recorded by, the IPO on 6 November 2008 is attached hereto as Exhibit 'C' and made an integral part hereof. Likewise attached hereto as Exhibit 'D' is a print out of the IPO website showing that based on the records of the IPO the assignment by Westmont to Opposer of the trademark 'CARVID' has been reflected in the records of the IPO.

"12.3. Thus, the registration of the trademark 'CARVID' subsists and remains valid to date.

"13. The trademark 'CARVID' owned by Opposer has been extensively used in commerce in the Philippines.

"13.1. Opposer has dutifully filed Declarations of Actual Use to maintain the registration of the trademark 'CARVID' in force and effect pursuant to the requirement of the law. Certified true copies of the Declarations of Actual Use are attached hereto as Exhibits 'E' and 'F' and made integral parts hereof.

"13.2. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, the product has been registered with the Food and Drug Authority. As evidence of such registration a certified true copy of Certificate of Product Registration No. DR-XY36162 is attached hereto as Exhibit 'G' and made an integral part hereof.

"13.3. A sample product packaging bearing the trademark 'CARVID' actually used in commerce is attached hereto as 'Exhibit 'H' and made an integral part hereof.

"13.4. No less than the Intercontinental Marketing Services ('IMS') itself, the world's leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than one hundred (100) countries, acknowledged and listed the brand 'CARVID' as one of the leading brands in the Philippines in the category of 'C07A-Beta Blocking Agents Pln' in terms of market share and sales performance. An original copy of the Certification and sales performance issued by the IMS is attached hereto as Exhibit 'I' and made an integral part hereof.

"14. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark 'CARVID' to the exclusion of all others.

"15. As provided in Section 138 of the IP Code, 'A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.'

"16. The registration of Respondent-Applicant's mark 'CARVIDON' will be contrary to Section 123.1 (d) of the IP Code. 'CARVIDON' is confusingly similar to Opposer's trademark 'CARVID'.

"16.1. There are no set rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or is a colorable imitation of, another. Nonetheless, jurisprudence provides enough guidelines and tests to determine the same.

"16.1.1. In *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* (356 SCRA 207, 216 [2001]), the Supreme Court, citing *Ethepa v. Director of Patents* (16 SCRA 495, 497-498 [1966]), held "[i]n determining if colorable imitation exists, jurisprudence has developed two kinds of tests - the Dominancy Test and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitute infringement. On the side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity."

"16.1.2. It is worthy to note at this point that in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* (Supra, p. 221) the Supreme Court held "[T]he totality or holistic test only relies on visual comparison between two trademarks whereas the dominancy test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks."

"16.1.3. Relative thereto, the Supreme Court in *McDonalds' Corporation vs. L.C. Big Mak Burger, Inc.* (437 SCRA 10, 32-33 [2004]) held:

x x x

"16.1.4. This was affirmed in *McDonald's Corporation vs. Macjoy Fastfood Corporation* (514 SCRA 95, 109 [2007]), which held

that, '[t]he Court has consistently used and applied the dominancy test in determining confusing similarity or likelihood of confusion between competing trademarks.'

"16.1.5. In fact, the dominancy test is 'now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code, which defines infringement as the colorable imitation of a registered mark xxx or a dominant feature thereof.' (MacDonald's Corporation, supra, p. 33 [2004])

"16.1.6. Thus, applying the dominancy test in the instant case, it can be readily concluded that the mark 'CARVIDON', owned by Respondent-Applicant, so resembles Opposer's trademark 'CARVID', that it will likely cause confusion, mistake and deception on the part of the purchasing public.

"16.1.6.1. Respondent-Applicant's mark 'CARVIDON' appears and sounds almost the same as Opposer's trademark 'CARVID'.

"16.1.6.2. The first six (6) letters in Respondent-Applicant's mark 'C-A-R-V-I-D-O-N' is Opposer's trademark 'C-A-R-V-I-D'.

"16.1.6.3. Both marks are pronounced with the same intonation.

"16.1.6.4. Notably, the only difference between the two marks is the suffix 'ON' in Respondent-Applicant's mark, which by itself would not be sufficient to eliminate the possibility of confusion between the two marks. As held by this Honorable Bureau in a recent decision in the case of United Home Products, Inc. vs. TGP Pharma, Inc. docketed as IPC No. 14-2014-00532, [c]onfusion cannot be avoided by merely adding, removing, or changing some letters of a registered mark. x x x

"16.1.7. Clearly, Respondent-Applicant's mark 'CARVIDON' adopted the dominant features of the Opposer's trademark 'CARVID'.

"16.1.8. As further ruled by the High Court in the McDonald's Corporation case (supra p. 33-34 [2004]):

x x x

"16.1.9. In American Wire & Cable Co., vs. Director of Patents (31 SCRA 544, 547-548 [1970]), the Supreme Court explained:

x x x

"16.2. Opposer's trademark 'CARVID' and Respondent-Applicant's mark 'CARVIDON' are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

