

**UNILAB, INC. (formerly United American  
Pharmaceuticals, Inc.),**  
*Opposer,*

**-versus-**

**GLENMARK PHARMACEUTICALS LIMITED,**  
*Respondent-Applicant.*

**IPC No. 14-2016-00574**

Opposition to:  
Appln. Serial No. 4-2016-00502251  
Date Filed: 29 April 2016

**TM: ASCOVENT**

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**NOTICE OF DECISION**

**OCHAVE & ESCALONA**  
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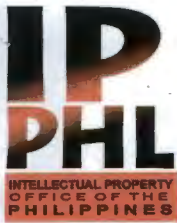
**GREETINGS:**

Please be informed that Decision No. 2017 - 187 dated 01 June 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 June 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



**UNILAB, INC. (formerly United American  
Pharmaceuticals, Inc.),**  
Opposer,

IPC No. 14-2016-00574  
Opposition to:

- versus -

Appln. No. 4-2016-00502251  
Date Filed: 29 April 2016  
Trademark: "ASCOVENT"

**GLENMARK PHARMACEUTICALS LIMITED,**  
Respondent-Applicant.

Decision No. 2017 - 187

X ----- X

### DECISION

UNILAB, INC. [formerly United American Pharmaceuticals, Inc.] ("Opposer")<sup>1</sup>, filed an opposition to Trademark Application Serial No. 4-2016-00502251. The application, filed by GLENMARK PHARMACEUTICALS LIMITED (Respondent-Applicant)<sup>2</sup>, covers the mark "ASCOVENT" for use under class 05, particularly as "*medicines bronchodilator with anti-inflammatory properties for cough management*" of the International Classification of Goods.<sup>3</sup>

The Opposer alleges the following grounds for opposition:

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

"8. The mark 'ASCOVENT' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'ASCOVENT' is applied for the same class as that of Opposer's trademark 'ASMAVENT', i.e., Class 05 of the International Classification of Goods. In fact, in a similar case, this Honorable Bureau has already ruled, which ruling has become final and executory, that 'ASCOVENT' is confusingly similar to 'ASMAVENT'. Hence, said ruling is res judicata on the issue of whether or not there is confusing similarity between the two marks.

<sup>1</sup> A corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines, with office address at No. 66 United Street, Mandaluyong City, Metro Manila, Philippines.

<sup>2</sup> With office address at B/2, Mahalaxmi Chambers, 22, Bhulabhai Desai Road, Mumbai 400 026, India.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

"9. The registration of the mark 'ASCOVENT' 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**
- (iii) **if it nearly resembles such a mark as to be likely to deceive or cause confusion;**

x x x' (Emphasis supplied)

"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 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 'ASCOVENT' will diminish the distinctiveness of Opposer's trademark 'ASMAVENT'.

The Opposer's evidence consists of the following:

1. Print-out of the pertinent page of the IPO E-Gazette on the subject trademark ASCOVENT;
2. Certified true copy (Ctc) of Certificate of Registration No. 4-2004-001760 for the trademark ASMAVENT;
3. Ctc of the Certificate of Renewal of Registration No. 4-2004-00001760 for the trademark ASMAVENT;
4. Ctcs of the Declaration of Actual Use and Affidavit of Use for the trademark ASMAVENT;
5. Ctc of Certificate of Product Registration No. DR-XY29472;
6. Sample product label bearing the trademark 'ASMAVENT';
7. Certifications and sales performance issued by the Intercontinental Marketing Services; and,
8. Notice of Decision and copy of Decision No. 2015-286 dated 23 December 2015.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 08 November 2016. The latter however, did not file an answer. Thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision<sup>4</sup>.

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

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<sup>4</sup> Order of Default dated 18 May 2017.

The Opposer anchors its opposition 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.

The Opposer further cites that a certificate of registration of a mark shall be a 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.<sup>5</sup> In this connection, it is also provided that the owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.<sup>6</sup>

Records show that at the time the Respondent-Applicant filed its trademark application on 29 April 2016, the Opposer has an existing trademark registration for the mark ASMAVENT with Registration No. 4-2004-001760 issued on 01 October 2005.<sup>7</sup> The registration covers "anti-asthma medicinal preparation" under Class 05,<sup>8</sup> which is closely-related to the goods indicated in the Respondent-Applicant's trademark application, specifically "medicines bronchodilator with anti-inflammatory properties for cough management".

A comparison of the competing marks are reproduced below:

**ASMAVENT**

**ASCOVENT**

Opposer's trademark

Respondent-Applicant's trademark

The marks show that confusion is likely to occur. This Bureau noticed that the pharmaceutical products covered by the marks are closely-related. Respondent-Applicant's ASCOVENT is a medicine bronchodilator with anti-inflammatory properties for cough management in Class 05. Opposer's products on the other hand, is an anti-asthma medicinal preparation also under Class 05. Respondent-Applicant's mark ASCOVENT adopted the dominant features of Opposer's mark ASMAVENT. ASCOVENT appears and sounds almost the same as Opposer's trademark ASMAVENT. Both ASMAVENT and ASCOVENT marks have the same first syllable "AS" and end with the same suffix "VENT". Respondent-Applicant merely changed the letters M and A in Opposer's ASMAVENT with the letters C and O to come up with the mark ASCOVENT. It could result to mistake with respect to perception because the

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<sup>5</sup> Sec. 138, IP Code.

<sup>6</sup> Sec. 147, IP Code.

<sup>7</sup> Exhibit "B" of Opposer.

<sup>8</sup> Id.



marks sound so similar. Under the *idem sonans* rule, the following trademarks were held confusingly similar in sound "BIG MAC" and "BIG MAK"<sup>9</sup>, "SAPOLIN" and "LUSOLIN"<sup>10</sup>, "CELDURA" and "CORDURA"<sup>11</sup>, "GOLD DUST" and "GOLD DROP". The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS": the first letter a and the letter s. be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of special significance..."SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.<sup>12</sup>

In conclusion, this Bureau finds that the subject trademark application is covered by the proscription under Section 1123.1 (d) (iii) of the IP Code.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2016-00502251 is hereby **SUSTAINED**. 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. 07 JUN 2017

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

<sup>9</sup> MacDonalds Corp. et. al v. L.C. Big Mak Burger, G.R. No. L-143993, 18 August 2004.

<sup>10</sup> Sapolin Co. v. Balmaceda and Germann & Co., 67 Phil. 705.

<sup>11</sup> Co Tiong SA v. Director of Patents, G.R. No. L-5378, 24 May 1954; Celanes Corporation of America v. E.I. Du Pont de Nemours & Co. (1946), 154 F 2d 146 148).

<sup>12</sup> Marvex Commercial Co. Inc. v. Petra Hawpia & Co., et al., G.R. No. L-19297, 22 December 1966.