

**UNITED LABORATORIES, INC.,**  
*Opposer,*

**-versus-**

**INNOLAB INDUSTRIES, INC.,**  
*Respondent-Applicant.*

X-----X

}	<b>IPC No. 14-2016-00012</b>
}	Opposition to:
}	
}	Appln. Serial No. 4-2015-008549
}	Date Filed: 29 July 2015
}	
}	<b>TM: INNOLAB</b>
}	
}	
}	

**NOTICE OF DECISION**

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


**INNOLAB INDUSTRIES INC.**  
*Respondent- Applicant*  
316 M.L. Quezon Street,  
Lower Bicutan, Taguig City

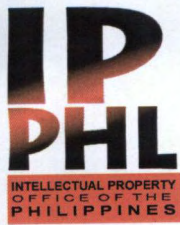
**GREETINGS:**

Please be informed that Decision No. 2017 - 131 dated 19 April 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, 20 April 2017.

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



UNITED LABORATORIES, INC.,  
Opposer,

IPC NO. 14-2016-00012

versus-

Appln. Ser. No. 4-2015-008549  
Filing Date: 29 July 2015  
Trademark: INNOLAB

INNOLAB INDUSTRIES, INC.,  
Respondent-Applicant.

Decision No. 2017 - 131

x-----x

**DECISION**

UNITED LABORATORIES, INC.,<sup>1</sup> ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2015-008549. The application, filed by INNOLAB INDUSTRIES, INC.<sup>2</sup> ("Respondent-Applicant") covers the mark INNOLAB for use on "soaps, perfumery, oils, cosmetics and cosmetic preparations, personal care, skin care and hair care products" under Class 03 and "pharmaceutical and sanitary preparations, food supplements, dietetic substances adapted for medical use, disinfectants" under Class 05 of the International Classification of Goods<sup>3</sup>.

Opposer alleges, among others, the following:

"12. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. Opposer is the registered owner of the following trademarks (collectively referred to as the 'UNILAB' trademarks):

- A. Trademark: UNILAB ( Registration No. 31859)
- B. Trademark: UNILAB ( Registration No. 4-2007-008192)
- C. Trademark: UNILAB & LOGO ( Registration No. 4-2007-008193)
- D. Trademark: UNILAB & LOGO ( Registration No. 4-2006-001926)
- E. Trademark: UNILAB ( Registration No. 4-2013-008607)

"13. The 'UNILAB' trademarks owned by Opposer have been extensively used in commerce in the Philippines;

x x x

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

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

<sup>1</sup> A domestic corporation with address at 66 United Street, Mandaluyong City.

<sup>2</sup> A domestic corporation with address at 316 M.L. Quezon Street, Lower Bicutan, Taguig City.

<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. o market i

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

x x x

"17. To allow Respondent-Applicant to market its products bearing the mark 'INNOLAB' undermines the Opposer's right to its 'UNILAB' trademarks. As the lawful owner of the 'UNILAB' trademarks, Opposer is entitled to prevent the Respondent-Applicant from using a confusingly similar mark in the course of trade where such would likely mislead the public.

"17.1. Being the lawful owner of the 'UNILAB' trademarks, Opposer has the exclusive right to use and/or appropriate the said trademarks and prevent all third parties not having its consent from using in the course of trade identical or similar marks, where such would result in a likelihood of confusion.

"17.2. By reason of the Opposer's ownership of the 'UNILAB' trademarks, it has also the right to prevent third parties, such as Respondent-Applicant from claiming ownership over Opposer's trademarks or any depiction similar thereto, without its authority and consent.

x x x

"18. By virtue of the Opposer's prior use of the 'UNILAB' trademarks, the same has established valuable goodwill to the consumers and the general public as well. The registration and use of Respondent-Applicant's confusingly similar mark 'INNOLAB' on its goods will enable the latter to obtain benefit from the Opposer's reputation and goodwill, and will tend to deceive and/or confuse the public into believing that the Respondent-Applicant is in any way connected to the Opposer.

"19. Clearly, the scope of protection accorded to the trademark owner includes not only the confusion of goods but also confusion of origin. As in this case, there is undoubtedly also a confusion of the origin of the goods covered by the mark of Respondent-Applicant and trademarks of the Opposer, which should not be allowed.

x x x

"19.2. The registration of the Respondent-Applicant's 'INNOLAB' will unfairly limit the already established and protected rights of the Opposer over its 'UNILAB' trademarks.

"20. Respondent-Applicant's use of the mark 'INNOLAB' in relation to any goods covered by the opposed application, if these goods are considered not similar or closely related to the goods covered by Opposer's 'UNILAB' trademarks will undermine the distinctive character or reputation of the latter's trademarks. Potential damage to the Opposer will be caused as a result of its inability to control the quality of the products put on the market by Respondent-Applicant under the mark 'INNOLAB'.

x x x

"22. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent-Applicant of the mark 'INNOLAB'.

"23. Further, Respondent-Applicant's use of the mark 'INNOLAB' in relation to Class 05 of the International Classification of Goods will take unfair advantage of, dilute and



diminish the distinctive character or reputation of the Opposer's 'UNILAB' trademarks. xxx"

The Opposer's evidence consists of the following:

1. Certified true copy of Registration No. 31859 for the mark UNILAB issued on 25 May 1983;
2. Certified true copy of Renewal Registration No. 31859 for the mark UNILAB issued on 25 May 2003;
3. Certified true copy of Renewal Registration No. 31859 for the mark UNILAB issued on 25 May 2013;
4. Certified true copy of Registration No. 4-2007-008192 for the mark UNILAB issued on 05 November 2007;
5. Certified true copy of Registration No. 4-2007-008193 for the mark UNILAB & LOGO issued on 05 November 2007;
6. Certified true copy of Registration No. 4-2006-001926 for the mark UNILAB & LOGO issued on 30 April 2007;
7. Certified true copy of Registration No. 4-2013-008607 for the mark UNILAB issued on 07 November 2013;
8. Declarations of Actual Use and Affidavits of Use for the mark UNILAB; and
9. Certified true copy of Certification and sales performance issued by IMS Health for 2014-2015;

This Bureau issued on 25 January 2016 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 29 January 2016. The Respondent-Applicant, however, did not file the answer. On 28 February 2017, this Bureau declared Respondent-Applicant in default. Accordingly, pursuant to Rule 2, Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark **INNOLAB**?

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.<sup>4</sup>

Section 123.1 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code), as amended, provides:

**Section 123. Registrability.** - 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;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier

<sup>4</sup>See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

filing or priority date, said mark cannot be registered.

The records show that at the time the Respondent-Applicant filed its application for the mark INNOLAB on 29 July 2015, the Opposer already has an existing registration for the trademark UNILAB issued way back in 25 May 1983 under Certificate of Registration No. 36554. As such, pursuant to Section 138 of the IP Code, being a holder of a certificate of registration, such "certificate of registration is a prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto." Opposer's first use of its UNILAB mark dates back to 29 July 1954. Since then, it has gained valuable goodwill among consumers and the general public as a manufacturer and distributor of drugs and medicine.

But are the competing marks, as shown below, identical or similar or resemble each other such that confusion, mistake or deception is likely to occur?

**UNILAB**

Opposer's Mark

**INNOLAB**

Respondent-Applicant's Mark

A perusal of the composition of the competing trademarks involved in this case show that both marks contain three syllables "U-NI-LAB" for the Opposer's mark and "IN-NO-LAB" for Respondent-Applicant's. Both marks also contain identical suffix "LAB" which is an abbreviation of the word "laboratory". A "laboratory" is "a room or building equipped for scientific experiments, research, or teaching, or for the manufacture of drugs or chemicals."<sup>5</sup> As such, the suffix "LAB" cannot be appropriated by anyone, therefore, the distinctive feature of the parties' marks are not in the suffix "lab" but in the other syllables or letters attached or affixed to it.

In the Opposer's mark, the letters attached to the suffix "LAB" are "U-N-I" while in Respondent-Applicant's, it is "I-N-N-O". While some letters affixed to the suffix "LAB" in the competing marks are different, their similarity is more noticeable because of how the respective marks are pronounced as a whole. In pronouncing the Respondent-Applicant's mark, the sound of the syllables "INNO" practically sounds similar to Opposer "UNI". 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 Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

In *Marvex Commercial Co. Inc. v. Petra Hawpia & Co., et. Al.*<sup>6</sup>, the Supreme Court ruled:

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

<sup>5</sup> <https://en.oxforddictionaries.com/definition/laboratory>, last accessed 10 April 2017.

<sup>6</sup> G.R. No. L-19297. 22 December 1966

similar. And where goods are advertised over the radio, similarity in sound is of special significance (Co Tiong Sa vs. Director of Patents, 95 Phil. I, citing Nims, The Law of Unfair Competition and Trademarks, 4th ed., Vol. 2, pp. 678-679). 'The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must depend entirely on the ear' (Operators, Inc. vs. Director of Patents, supra).

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, Vol. 1, will reinforce our view that 'SALONPAS' and 'LIONPAS' are confusingly similar in sound: 'Gold Dust' and 'Gold Drop'; 'Jantzen' and 'Jass-Sea'; 'Silver Flash' and 'Supper Flash'; 'Cascarete' and 'Celborite'; 'Celluloid' and 'Cellonite'; 'Chartreuse' and 'Charseurs'; 'Cutex' and 'Cuticlean'; 'Hebe' and 'Meje'; 'Kotex' and 'Femetex'; 'Zuso' and 'Hoo Hoo'. Leon Amdur, in his book 'Trade-Mark Law and Practice', pp. 419-421, cites, as coming within the purview of the idem sonans rule, 'Yusea' and 'U-C-A', 'Steinway Pianos' and 'Steinberg Pianos', and 'Seven-Up' and 'Lemon-Up'. In Co Tiong vs. Director of Patents, this Court unequivocally said that 'Celdura' and 'Cordura' are confusingly similar in sound; this Court held in Sapolin Co. vs. Balmaceda, 67 Phil. 795 that the name 'Lusolin' is an infringement of the trademark 'Sapolin', as the sound of the two names is almost the same.

In the case at bar, '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 (see Celanese Corporation of America vs. E. I. Du Pont, 154 F. 2d. 146, 148).


Considering, therefore, the similarity in the appearance and sound of the marks as well as the fact that the marks are used on similar or related goods, it is likely that the usually unwary or incautious or confused person may make a mistake into thinking that UNILAB and INNOLAB is one and the same.

Accordingly, this Bureau finds 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. 4-2015-008549, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 19 APR 2017.

  
**MARLITA V. DAGOSA**  
Adjudication Officer  
Bureau of Legal Affairs