



INTELLECTUAL PROPERTY
OFFICE OF THE
PHILIPPINES

BIOMEDIS INC.,
Opposer,

-versus-

THE CATHY DRUG COMPANY, INC.,
Respondent-Applicant.

X-----X

IPC No. 14-2013-00166
Opposition to:
Appln. Serial No. 4-2012-014146
Date Filed: 20 November 2012

TM: TAMPROS

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 288 dated 03 July 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, 05 July 2017.

MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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BIOMEDIS INC.,	} IPC NO. 14-2013-00166
Opposer,	} Opposition to:
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-versus-	} Appln. Ser. No. 4-2012-014146
	} Date Filed: 20 November 2012
	}
THE CATHAY DRUG COMPANY, INC.,	} Trademark: "TAMPROS"
Respondent-Applicant.	}
x-----x	} Decision No. 2017- <i>288</i>

DECISION

BIOMEDIS INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2012-014146. The application, filed by THE CATHAY DRUG COMPANY, INC. Respondent-Applicant)², covers the mark "TAMPROS", for use on "pharmaceutical preparations" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The mark 'TAMPROS' owned by Respondent-Applicant so resembles the trademark 'ATEPROS' owned by Opposer, and duly registered with the IPO prior to the publication for opposition of the mark 'TAMPROS'.

"8. The mark 'TAMPROS' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'TAMPROS', is applied for the same class of goods as that of Opposer's trademark 'ATEPROS', i.e. Class (5) of the International Classification of Goods for pharmaceutical preparations.

"9. The registration of the mark 'TAMPROS' in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides, in part, that a mark cannot be registered if it:

(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:

¹ A domestic corporation with address at Dynavision Building, 108 Rada Street, Legaspi Village, Makati City

² A domestic corporation with address at 2nd Floor Vernida I, Amorsolo St., Legaspi Village, Makati City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

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- (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;

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.

The Opposer also alleges, among other things, the following facts:

“10.1. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark ‘ATEPROS’ was filed with the IPO on 2 October 2006 by Opposer was approved for registration on 3 September 2007 to be valid for a period of ten (10) years, or until 3 September 2017. Thus, the registration of the trademark ‘ATEPROS’ subsists and remains valid to date.

“11. The trademark ‘ATEPROS’ has been extensively used in commerce in the Philippines.

“11.1. Opposer has dutifully filed Declarations of Actual Use pursuant to the requirement of the law.

“11.3. 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 100 countries, acknowledged and listed the brand ‘ATEPROS’ as one of the leading brands in the Philippines in the category of ‘G04C- BPH Products’ in terms of market share and sales performance.

“11.4. By virtue of the foregoing, there is no doubt that the Opposer has acquired an exclusive ownership over the trademark ‘ATEPROS’ to the exclusion of all others. xxx

“12. The registration of Respondent-Applicant’s mark ‘TAMPROS’ will be contrary to Section 123.1 (d) of the IP Code. ‘TAMPROS’ is confusingly similar to Opposer’s trademark ‘ATEPROS’. xxx”

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of page of Intellectual Property Office (“IPO”) E-Gazette showing published mark “TAMPRO S”;
2. Copy of Registration No.4-2006-010737, issued on 3 September 2007 for the mark “ATEPROS” covering goods under class 5, namely: “antibacterial pharmaceutical preparation”;

3. Copies of Declaration of Actual Use;
4. Sample product label for the pharmaceutical product "ATEPROS"; and
5. Certification from Intercontinental Marketing Services dated 11 April 2013.⁴

The Respondent-Applicant filed its Answer on 19 June 2013, alleging, among others, the following special and affirmative defenses:

"16. The Respondent-Applicant asserts that confusing similarity should be measured by how the marks are actually used and appear in the market place given the fundamental principal in trademark law that trademarks are for the protection of consumers who should be able to distinguish between trademarks in the market place. xxx

"17. Applying the holistic test to the present case, it becomes apparent that Opposer's allegation that 'TAMPROS' is confusingly similar to 'ATEPROS' is utterly baseless considering the substantial and obvious dissimilarities between the marks as they appear in their actual product packaging. xxx

"18. The boxes of Opposer's ATEPROS and Respondent-applicant's TAMPROS employ different color schemes. The Respondent-Applicant's TAMPROS employs a color scheme of blue, green, beige and brown. On the other hand, Opposer's ATEPROS uses a color scheme of blue, brown and yellow green. Further, the Opposer adopted an arrow-like vertical lines with hexagon in yellow green, brown and blue colors. xxx

"20. Moreover, in compliance with Republic Act No. 6675 or the Generics Law of 1998 ('Generics Law' for brevity) and Department of Health Administrative Order No. 55 series of 1988, the label of TAMPROS clearly indicates that AMN Lifescience PVT Ltd. is the manufacturer, the products generic name is Tamsulosin Hydrochloride, its pharmacologic category is Alpha-1-Adrenoceptor Blocker and the product is in 400 mcg. capsules. On the other hand, Opposer's label shows that ATEPROS is manufactured by Amherst Laboratories, Inc. for the Opposer, the products generic name is Finasteride, its pharmacologic category is 5a-Reductase Inhibitor and it is in 5mg. tablets. It is also noteworthy that on both labels, the generic names of the pharmaceutical products appear immediately above the respective brand names, they have the highest point size among the various printed elements on the labels and are enclosed exclusively by outline boxes. xxx"

The Respondent-Applicant submitted the following evidence:

1. Secretary's Certificate;
2. Copy of Trademark Application for the mark "TAMPROS";

⁴ Exhibits "A" to "E"

3. Affidavit of Nona F. Crisol; and
4. Package of the product with the mark "TAMPROS".⁵

On 6 February 2014, the Preliminary Conference between the parties was terminated, and the Hearing Officer directed them to file their respective position papers. Both filed their position papers on 17 February 2014.

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

Records show that at the time Respondent-Applicant applied for registration of the mark "TAMPROS" the Opposer already registered the mark "ATEPROS" under of Registration No. 4-2006-010737⁶ on 3 September 2007. The goods covered by the Opposer's trademark registration are also under Class 05, namely: "for the treatment and control of benign prostatic hyperplasia and for the prevention of urologic events to reduce the risk of acute urinary retention and reduce the risk of the need of surgery including transurethral resection of the prostate and prostatectomy", same as Respondent-Applicant's trademark application which indicates use as "pharmaceutical preparations".

Do the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

Atepros

TAMPROS

Opposer's mark

Respondent-Applicant's mark

The marks are similar with respect to their suffix, ("PROS") and two letters in the first syllable, "A" and "T". Such similarities however, are not sufficient to conclude that confusion among the consumers is likely to occur. The arrangement of the letters, the Opposer's use of the vowel "e" and the Respondent-Applicant's use of the consonant "M", produce a dissimilar appearance and phonetically different sound in the syllables, "ATE" and "TAM". When combined with the syllable PROS, the result are marks with different phonetic sounds, ATEPROS and TAMPROS. Visually and aurally the marks are not the same.

It is noteworthy that the products involved in this case are pharmaceutical products, where the purchaser will be more wary and exercise precaution in buying these. The Supreme Court in *Etepha A. G v. Director of Patents*⁷ is relevant to this case, to wit:

⁵⁵ Exhibits "1" to "4" inclusive of submarkings

⁶ Exhibit "B"

⁷ G.R. L. No. 20635, 31 March 1996

In the solution of a trademark infringement problem, regard too should be given to the *class* of persons who buy the particular product and the circumstances ordinarily attendant to its acquisition.¹⁶ The medicinal preparation clothed with the trademarks in question, are unlike articles of everyday use such as candies, ice cream, milk, soft drinks and the like which may be freely obtained by anyone, anytime, anywhere. Petitioner's and respondent's products are to be dispensed upon medical prescription. The respective labels say so. An intending buyer must have to go first to a licensed doctor of medicine; he receives instructions as to what to purchase; he reads the doctor's prescription; he knows what he is to buy. He is not of the incautious, unwary, unobservant or unsuspecting type; he examines the product sold to him; he checks to find out whether it conforms to the medical prescription. The common trade channel is the pharmacy or the drugstore. Similarly, the pharmacist or druggist verifies the medicine sold. The margin of error in the acquisition of one for the other is quite remote.

We concede the possibility that buyers might be able to obtain Pertussin or Attusin without prescription. When this happens, then the buyer must be one thoroughly familiar with what he intends to get, else he would not have the temerity to ask for a medicine — specifically needed to cure a given ailment. In which case, the more improbable it will be to palm off one for the other. For a person who purchases with open eyes is hardly the man to be deceived.

As seen from the Opposer's packaging⁸, its product is a Reductase Inhibitor, which as indicated in its Trademark Registration, is used "for the treatment and control of benign prostatic hyperplasia and for the prevention of urologic events to reduce the risk of acute urinary retention and reduce the risk of the need of surgery including transurethral resection of the prostate and prostatectomy" which is a prescription drug. Thus, the physician in prescribing and the patient in procuring the drug would exercise extreme care and prudence. The chances of committing a mistake or being deceived are slim, considering that the difference is not only in the name or visual appearance of the products but in their medical use.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-014146 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 03 JUL 2017



ATTY. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs

⁸ Exhibit "D"