

UNITED LABORATORIES, INC.,
Opposer,

-versus-

SUN PHARMA PHILIPPINES, INC.,
Respondent-Applicant.

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IPC No. 14-2014-00241
Opposition to:

Appln. Serial No. 4-2014-0003144
Date Filed: 13 March 2014

TM: TYROGEF

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NOTICE OF DECISION

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


SUN PHARMA PHILIPPINES, INC.
Respondent- Applicant
Unit 604, 6th Floor, Liberty Center Building
104 H.V. Dela Costa Street, Salcedo Village,
Makati City

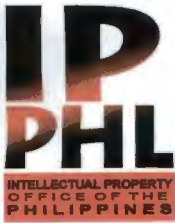
GREETINGS:

Please be informed that Decision No. 2017 - 239 dated 20 June 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHEL 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 June 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



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Opposer,

-versus-

SUN PHARMA PHILIPPINES, INC.,
Respondent-Applicant.

}IPC NO. 14-2014-00241

}Opposition to:

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}Appln. Ser. No. 4-2014-0003144

}Date Filed: 13 March 2014

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}Trademark: "TYROGEF"

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x-----x }Decision No. 2017- 239

DECISION

UNITED LABORATORIES, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-0003144. The application, filed by SUN PHARMA PHILIPPINES, INC., (Respondent-Applicant)², covers the mark "TYROGEF", 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 'TYROGEF' owned by Respondent-Applicant so resembles the trademark 'TERGECEF' owned by Opposer, and duly registered with the IPO prior to the publication for opposition of the mark 'TYROGEF'.

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

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

¹ A domestic corporation organized and existing under the laws of the Philippines with address at No. 66 United Street, Mandaluyong City

² A Philippine corporation with address at Unit 604, 6th Floor Liberty Center, 104 H.V. Dela Costa St., Salcedo 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.

(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;

“10. Under the above-quoted provision, any mark, which is similar to a registered mark or a mark with an earlier priority date, 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 others, the following facts:

“11. Opposer is the part owner of the trademark ‘TERGECEF’.

“11.1. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. xxx

“11.3. In the meantime, on 22 December 1994, Medichem assigned the Trademark Application for the mark ‘TERGECEF’ to herein Opposer. xxx

“11.7. The Intercontinental Marketing Services (‘IMS’), 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 ‘TERGECEF’ as one of the leading brands in the Philippines in the category of ‘*J01D-Cephalosporins & Combs*’ in terms of market share and sales performance.

“11.8. By virtue of the foregoing, there is no doubt that the Opposer has established its rights, title and interests over the trademark ‘TERGECEF’.

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

“13. Thus, Opposer’s interests are likely to be damaged by the registration and use of the Respondent-Applicant of the mark ‘TYROGEF’. The denial of the application subject of this opposition is authorized under the IP Code. 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 “TYROGEF”;

2. Copy of trademark application for the mark 'TERGECEF';
3. Copy of Assignment of Application for Registration of Trademark between Medichem Pharmaceutical, Inc and United Laboratories, Inc.;
4. Copy of Assignment of Application for Registration of Trademark between United Laboratories, Inc. and Fujisawa Pharmaceuticals Co. Ltd. ;
5. Copy of Registration No. 66409 issued on 4 November 1998 for the mark "TERGECEF" in the name of applicant, Fujisawa Pharmaceutical (50% of the rights) covering goods under class 5, namely: "medicinal preparation for use as antibacterial";
6. Copies of Affidavits of Use; and
7. Certification from Intercontinental Marketing Services dated 4 June 2014.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 25 June 2014. The Respondent-Applicant however did not file an Answer.

Records show that at the time Respondent-Applicant applied for registration of the mark "TYROGEF" the Opposer already registered the mark "TERGECEF" under of Registration No. 66409 issued on 4 November 1998.⁵ The goods covered by the Opposer's trademark registration are also under Class 05, namely: "medicinal preparation for use as antibacterial", 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?

Tergecef

Opposer's mark

TYROGEF

Respondent-Applicant's mark

The marks are similar with respect to the five letters. T, R, G, E, and F. Both marks begin with the letter "T" and end with the two letters "EF" and the marks consist of three syllables. Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. Opposer uses the "e" vowel sound while the Respondent-Applicant uses the vowels "o" and "e". The prefixes "TERGE" and "TYRO" are different visually and aurally. Likewise, the last syllables, "CEF" and "GEF" are not the same. When pronounced, both marks produce a distinctive sound.

Moreover, deception or confusion would depend on the circumstances attendant to the manner of purchasing the goods involved. 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*⁶ is relevant to this case, to wit:

⁴ Exhibits "A" to "J"

⁵ Exhibit "E"

⁶ 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.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-0003144 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, 20 JUN 2017¹


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