

UNITED LIFE SCIENCES PTE. LTD.,
Opposer,

-versus-

PASTEUR PHARMACEUTICALS INC.,
Respondent- Applicant.

X-----X

}
} IPC No. 14-2016-00526
} Opposition to:
} Appln. Serial No. 4-2016-005815
} Date Filed: 25 May 2016
} TM: "ZYHEX"

NOTICE OF DECISION

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PASTEUR PHARMACEUTICALS, INC.
Respondent-Applicant
1/F SGS Foundation Bldg.
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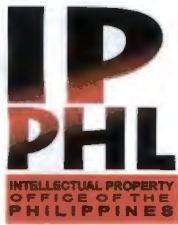
GREETINGS:

Please be informed that Decision No. 2017 - 269 dated June 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, June 30, 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



UNITED LIFE SCIENCES PTE. LTD.,
Opposer,

IPC NO. 14-2016-00526

versus-

Appln. Ser. No. 4-2016-005815

Filing Date: 25 May 2016

PASTEUR PHARMACEUTICALS INC.,
Respondent-Applicant.

Trademark: ZYHEX

x-----x

Decision No. 2017 - 269

DECISION

UNITED LIFE SCIENCES PTE. LTD.¹ ("Opposer") filed an opposition to Trademark Application No. 4-2016-005815. The application, filed by PASTEUR PHARMACEUTICALS INC.² ("Respondent-Applicant") covers the mark ZYHEX for use on "*pharmaceutical product - antibacterial (tablet)s*" under Class 05 of the International Classification of goods³.

The Opposer alleges the following grounds:

"1. The mark 'ZYHEX' applied for by Respondent-Applicant so resembles the trademark 'SYNEX' owned by the Opposer and duly registered with the Honorable Bureau prior to the filing of, and publication for, the application of the mark 'ZYHEX'.

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

"3. The registration of the mark 'ZYHEX' in the name of the Respondent will violate Sec. 123 (d) of the IP Code, which provides, in part, that a mark cannot be registered if it:

x x x

"4. 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/services 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's evidence consists of the following:

¹ A corporation duly organized and existing under the laws of Singapore with address at 152 Beach Road #10-03/04 Gateway East Singapore 189271.

² A domestic corporation with office address at 1/F SGS Foundation Bldg., 1335 G. Araneta Avenue Quezon City, Metro Manila.

³ 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.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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1. Exhibit "A" - Printout of relevant page of IPO E-Gazette which was officially released on 22 August 2016;
2. Exhibit "B" - Certified copy of Certificate of Reg. No. 4-2011-007913 for the trademark "SYNEX";
3. Exhibit "C" - Certified copy of the Actual Declaration of Actual Use of the trademark "SYNEX" filed on 4 July 2014; and
4. Exhibits "D" - Sample of product packaging bearing the trademark "SYNEX".

This Bureau issued on 06 October 2016 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant on 28 October 2016. The Respondent-Applicant, however, did not file the Answer. 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 "ZYHEX"?

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.⁴

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 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 ZYHEX on 25 May 2016, the Opposer already has an existing

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

registration for the trademark SYNEX issued on 24 November 2011. 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."

But does the mark of the Respondent-Applicant resembles Opposer's mark as to likely cause confusion, mistake or deception on the part of the public?

SYNEX

Opposer's Mark

ZYHEX

Respondent-Applicant's Mark

A perusal of the composition of the competing trademarks involved in this case show that the competing marks are mere word marks written in plain upper case letters. Both marks contain two (2) syllables consisting of five (5) letters. Opposer's mark consists of the syllables "SY-NEX" while that of Respondent-Applicant's consists of the syllables "ZY-HEX". The letters "S" and "N" in Opposer's SYNEX mark are replaced with the letters "Z" and "H" to form the Respondent-Applicant's mark "ZYHEX". Although the marks are not entirely the same, there are no appreciable disparities between the two marks so as to avoid the likelihood of confusing one for the other.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other⁵. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁶.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the

⁵ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁶ *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

purchaser of the older brand mistaking the newer brand for it.⁷

Further, the subject marks may differ in spelling but when Respondent-Applicant's ZYHEX mark is pronounced, it is aurally similar to Opposer's SYNEX mark such that it becomes indistinguishable from each other. 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 *Marvox Commercial Co. Inc. vs. Petra Hawpia & Co., and The Director of Patents*⁸, 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 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, cities, 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)."

In addition, the likelihood of confusion between Opposer's and Respondent-Applicant's mark is made more apparent because the goods upon which Respondent-Applicant's mark is being applied for is covered by the goods of the Opposer bearing

⁷ *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.
⁸ G.R. No. L-19297. 22 December 1966

the mark SYNEX. Considering therefore the similarity in the appearance of the marks as well as the fact that marks are used on related products, there is likelihood that the usually unwary or incautious person would be confused or mistaken that Opposer's SYNEX is the same as ZYHEX or that one is just a variation of the other. As such, if allowed to be registered, any impression or information regarding Respondent-Applicant's product bearing the mark ZYHEX may be unfairly attributed to the Opposer.


It must be emphasized that the registration of trademarks involves public interest. Public interest, therefore, require that only marks that would not likely cause deception, mistake or confusion should be registered. The consumers must be protected from deception, mistake or confusion with respect to the goods or services they buy. Trademarks serve to guarantee that the product to which they are affixed comes up to a certain standard quality. Modern trade and commerce demands that deprecations on legitimate trademarks should not be countenanced. The law against such deprecations is not only for the protection of the owner but also, more importantly, for the protection of consumers from confusion, mistake, or deception as to the goods they are buying.⁹

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. 4-2016-005815, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 JUN 2017.


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs

⁹ *Le Chemise Lacoste, S.A. v. Oscar C. Fernandez et. al.*, G.R. Nos. 63796-97 and G.R. No. 65659, 21 May 1984.