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UNITED AMERICAN PHARMACEUTICALS, INC., }
Opposer, }

IPC No. 14-2012-00134
Opposition to:

-versus-

Appln. Serial No. 4-2011-010635
Date Filed: 06 September 2011

AUTOMED PHARMACEUTICALS, INC., }
Respondent-Applicant. }

TM: ALLERCEF

X-----X

NOTICE OF DECISION

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4/25/17

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Courier → Received on 5-29-17
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GREETINGS:

Please be informed that Decision No. 2017 - 125 dated 18 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, 19 April 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

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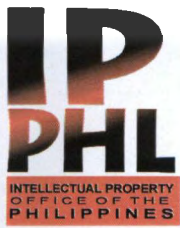
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UNITED AMERICAN
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AUTOMED PHARMACEUTICALS INC.,
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}IPC NO. 14-2012-00134

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}Opposition to:

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}Appln. Ser. No. 4-2011-010635

}Date Filed: 6 September 2011

}

}Trademark: ALLERCEF

}

}Decision No. 2017- 125

DECISION

UNITED AMERICAN PHARMACEUTICALS, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-010635. The application, filed by AUTOMED PHARMACEUTICALS, INC. (Respondent-Applicant)², covers the mark "ALLERCEF", for use on "pharmaceutical product categorized as antihistamine for symptomatic relief of allergic conditions particularly rhinitis and chronic urticaria" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"1. The trademark 'ALLERCEF' so resembles 'ALLERZET' trademark owned by Opposer which was applied for registration with this Honorable Office prior to the application of the mark 'ALLERCEF'. The trademark 'ALLERCEF' which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'ALLERCEF' is applied for the same class of goods as that of trademark 'ALLERZET', i.e. Class (5) as anti-histamine.

"2. The registration of the trademark 'ALLERCEF' in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines' which provides, in part, that a mark cannot be registered if it:

¹ A corporation organized and existing under Philippine laws with principal address at No 132 LVP Compound, Pioneer St., Mandaluyong City

² A domestic corporation with address at Room 202 J. Borromeo Bldg., F. Ramos St. Cebu 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.

Under the above-quoted provision, any mark, which is similar to a mark with an earlier filing 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.

“3. Respondent's use and registration of the trademark 'ALLERCEF' will diminish the distinctiveness of Opposer's trademark 'ALLERZET'.

According to the Opposer:

“4. Opposer is the owner of the trademark 'ALLERZET', is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'ALLERCEF' was filed with the Intellectual Property Office on 22 November 2010 by Opposer and was approved for registration on 12 May 2011 and valid for a period of ten (10) years.

“5. There is no doubt that by virtue of its prior registration, the Opposer has acquired an exclusive ownership over 'ALLERZET' mark to the exclusion of all others.

“6. 'ALLERCEF is confusingly similar to 'ALLERZET'.xxx

“7. To allow Respondent to continue to market its products bearing the 'ALLERCEF' mark undermines Opposer's right to its marks. As the lawful owner of the mark 'ALLERZET', Opposer is entitled to prevent the Respondent from using a confusingly similar mark in the course of trade where such would likely mislead the public.xxx”

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

1. Print-out of IPO e-Gazette showing the Respondent-Applicant's trademark application published for opposition; and
2. Copy of Certificate of Registration No. 4-2019-012560 for the trademark "ALLERZET"⁴

⁴ Annex "A" and "B"

The Respondent-Applicant filed its Answer on 17 May 2012, alleging among other things, the following:

“1. In determining the likelihood of confusion, jurisprudence has developed two tests, the dominancy and holistic test. xxx

“5. As to the registration of trademark 'ALLERCEF' compared to the trademark 'ALLERZET', it does not in any way resembles and will not likely cause confusion, mistake and deception on the part of the purchasing public despite the fact that said opposed trademark is applied for the same class of goods. i.e. anti-histamine.

“6. First, the generic name of 'ALLERZET' is LEVOCETIRIZINE DIHYDROCHLORIDE with 2.5 mg/5ml syrup content. Whereas, the generic name of 'ALLERCEF' is CETIRIZINE DIHYDROCHLORIDE with 1mg. ml oral solution content.

“7. ALLERZET is a third-generation non-sedative antihistamine, developed from the second-generation antihistamine cetirizine. Chemically, levocetirizine is the active enantiomer of cetirizine. It is the R-enantiomer of the cetirizineracemate. Levocetirizine works by blocking histamine receptors. It does not prevent the actual release of histamine from mast cells, but prevents it binding to receptors. This in turn prevents the release of other allergy chemicals and increased blood supply to the area, and provides relief from the typical symptoms of hayfever.

“8. On the other hand, ALLERCEF is a second generation antihistamine, is a major metabolite of hydroxyzine, and a racemic selective H1 receptor inverse agonist used on the treatment of allergies, hay fever, angioedema, and urticaria

“9. ALLERZET does not sound similar to ALLERCEF and it is pronounced differently.

“10. The last three letters of ALLERZET is ZET while the last three letters of ALLERCEF is CEF. ALLERZET is being pronounced as ALLERJET while ALLERCEF is pronounced as ALLERSEF.

“11. ALLERZET and ALLERCEF are brand names of medicines whose generic name are different from each other.

“12. As the competing product is a medicine, any person who wanted to buy the same is already aware of what kind of medicine she or he needs. Likewise, a purchasing public needs the assistance of a pharmacist who is knowledgeable as to the classes or kinds of medicine.

“13. The bottle presentation and its design/logo of ALLERZET and ALLERCEF are very different and no purchasing public can be misled by looking at the bottle and presentation of its design.

“14. As medicine, the purchasing public is usually guided by a prescription issued by a doctor coupled with the fact that the purchasing public is always assisted with a pharmacist who is knowledgeable of the product itself. xxx”

The Preliminary Conference was terminated on 21 November 2012.

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

Records show that at the time Respondent-Applicant applied for registration of the mark “ALLERCEF” the Opposer already registered the mark “ALLERZET” under of Registration No. 4-2019-012560 on 22 November 2010⁵. The goods covered by the Opposer’s trademark registration are also under Class 05, namely: “levocetirizine”, while the Respondent-Applicant’s trademark application indicates use as “pharmaceutical product categorized as antihistamine for symptomatic relief of allergic conditions particularly rhinitis and chronic urticaria”.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:



Opposer’s mark



Respondent-Applicant’s mark

The marks are similar with respect to the first syllables (“ALLER”). The prefix ‘ALLER’ used in both marks is obviously derived from the word “allergy”. Thus, it is predictably used for medicines relating to control allergies. When the suffixes “ZET” and “SEF” are appended, the resultant marks are not confusingly similar. Taking into account the goods involved, the prefix “ALLER” coined with other letters become suggestive marks. The consumers can easily distinguish one mark from the other. Hence, this Bureau will not sustain the opposition solely on the ground that Respondent-Applicant's mark also contain the prefix “ALLER”.

⁵ Annex "B"

Moreover, the generic name of the Opposer's goods is "LEVOCETIRIZINE dihydrochloride" while the generic name of the Respondent-Applicant's goods is "CETIRIZINE dihydrochloride". As pointed out by the Respondent-Applicant, ALLERZET is a third generation non-sedative antihistamine, developed from the second-generation antihistamine cetirizine.⁶ On the other hand, ALLERCEF is a second-generation antihistamine.⁷ Indeed, (t)hird-generation H₁-antihistamines are second-generation antihistamines informally labeled third-generation because the active enantiomer (levocetirizine) or metabolite (desloratadine and fexofenadine) derivatives of second-generation drugs are intended to have increased efficacy with fewer adverse drug reactions.⁸ While many of the antihistamines still commonly used to treat urticaria are first generation H₁ antagonists (e.g., diphenhydramine, hydroxyzine), the more recently developed second-generation agents (e.g., loratadine, cetirizine) and their metabolites—the third-generation antihistamines (e.g., fexofenadine, norastemizole, descarboxyloratadine)—possess many of the desirable clinical effects of the first-generation agents with a more tolerable side effect profile.⁹

Under the foregoing factual backdrop, this Bureau finds the Supreme Court's ruling in *Etepha A. G v. Director of Patents*¹⁰ relevant to this case, to wit:

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. 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.

⁶ page 3, Verified Answer

⁷ Ibid

⁸ https://en.wikipedia.org/wiki/H1_antagonist


⁹ <http://onlinelibrary.wiley.com/doi/10.1046/j.1529-8019.2000.00034.x/abstract>

¹⁰ G.R. L. No. 20635, 31 March 1996

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-010635 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, 18 APR 2017


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