

WORLD TRIATHLON CORPORATION,
Opposer,

-versus-

**PROSEL PHARMACEUTICALS AND
DISTRIBUTORS, INC.,**
Respondent-Applicant.

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IPC No. 14-2014-00221
Opposition to:
Appln. Serial No. 4-2013-008658
Date Filed: 22 July 2013

TM: IRONMOM

X-----X

NOTICE OF DECISION

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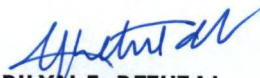
LOURDES DELA CRUZ
Respondent- Applicant's Agent
Prosel Pharmaceuticals and Distributors, Inc.
9724 Pillilia Street corner Baler Street,
Makati City

GREETINGS:

Please be informed that Decision No. 2017 - 94 dated 28 March 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, 29 March 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

WORLD TRIATHLON CORPORATION,
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**PROSEL PHARMACEUTICALS AND
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IPC No. 14-2014-00221

Opposition to:
Appln. Serial No. 4-2013-008658
Date Filed: 22 July 2013

Trademark: "**IRONMOM**"

Decision No. 2017- 94

DECISION

World Triathlon Corporation¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-008658. The application, filed by Prosel Pharmaceuticals and Distributors Inc. ("Respondent-Applicant")², covers the mark "IRONMOM" for use on *"for the treatment and prevention of iron deficiency anemia (IDA), also used for patients who have low blood cells and/or are pregnant"* under Class 05 of the International Classification of goods and services³.

The Opposer anchors its opposition on Section 123.1 (d), (e) and (f) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It alleges, among others, that it is the owner of the marks "IRONMAN", "IRONGIRL" and "IRONKIDS", which it registered in various countries. It avers that it applies the said marks on various goods and services, the most prominent of which is the conduct of athletic events involving swimming, bicycling and/or running. It contends that the Respondent-Applicant's mark "IRONMON" is confusingly similar to its own registered marks. In support of its opposition, the Opposer submitted the following:⁴

1. affidavit of its Chief Legal Officer, Mr. Steve Johnston, with attachments;
2. details of its worldwide trademark applications and registrations for the mark "IRONMAN" including copies the trademark certificates;
3. representative sample of certified true copies of its registrations for the "IRONMAN" mark;
4. list of the worldwide "IRONMAN" and "IRONMAN 70.3" triathlon events in year 2012;

¹ A corporation duly organized and existing under the laws of the State of Florida with business address at Suite 1250, 2701 North Rocky Point Drive, Tampa, Florida 33607, United States of America.

² With known address at No. 9724 Pililia Street cor. Baler Street, Makati City, Philippines.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a 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.

⁴ Marked as Exhibits "B" to "K", inclusive.

5. samples of materials used in the promotional activities of the "IRONMAN" mark;
6. articles on the "IRONMAN" triathlon appearing in various publications;
7. photographs of licensed "IRONMAN" products;
8. computer printouts of official "IRONMAN" merchandise available at www.ironmanstore.com; and,
9. samples of materials used in the promotion of the "IRONMAN" mark.

A Notice to Answer was issued and served upon the Respondent-Applicant on 12 August 2014. It however failed to timely file a Verified Answer. Thus, the Adjudication Officer issued Order No. 2015-245 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved is whether the Respondent-Applicant's mark "IRONMOM" should be allowed registration.

To determine whether there is confusing similarity, the competing marks are reproduced as follows:

Opposer's marks:

IRONMAN IRONKIDS

Iron  Girl

Respondent-Applicant's mark:

IronMom

Looking at the Opposer's marks, what is impressed in the eyes and mind is the word "IRON" compounded with another word, particularly "MAN", "KIDS" and "GIRL". The Respondent-Applicant's mark, on the other hand, similarly begins with the word "IRON". Be that as it may, this Adjudication Officer finds that the latter mark may be allowed registration. Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

"123.1. 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:

(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; xxx"(Emphasis supplied.)

Confusion, much more deception, is highly unlikely in this case because of the disparity of the goods involved. The Opposer's trademark registrations show that the marks cover sports events and clothing, among others. The Opposer, however, failed to present any evidence that it is engaged in goods "*for the treatment and prevention of iron deficiency anemia (IDA), also used for patients who have low blood cells and/or are pregnant*" or any pharmaceutical product, which the Respondent-Applicant uses or intends to use its mark. Nor did it show proof that the target consumers and the channels of trade of the competing marks are the same. Therefore, the consumers of one will not be confused, misled and/or deceived that the Opposer's goods and/or services are in any way related or connected to the Respondent-Applicant's pharmaceuticals.

Moreover, the Respondent-Applicant's application specifically states that it intends to use the mark "IRONMOM" for iron deficiency anemia. This is presumably where the Respondent-Applicant derived the word "IRON" thus negating the allegation that it is merely riding on the Opposer's goodwill. Using a word that gives away an idea as to the nature, purpose or composition of the goods the marks cover is a common practice. Noteworthy, the Trademark Registry, which this Adjudication Officer may take judicial notice, reveals that there are registered marks also under Class 05 that begin with the word "IRON" such as "IRON-VET" and "IRON ADVANCE". The appropriation of the word "IRON" in these marks merely gives the consumers an indication of what composes the product.

Furthermore, it is emphasized that 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.⁵ The Respondent-Applicant's mark sufficiently met this function.

Finding no confusing similarity between the Opposer's and the Respondent-Applicant's marks, there is no necessity to determine whether the former's marks are well-known.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-008658 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 MAR 2017


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.