

PFIZER INC. and PFIZER PRODUCTS, INC.,
Opposers,

-versus-

AAA PHARMA INC.,
Respondent-Applicant.

IPC No. 14-2014-00277
Opposition to:
Appln. No. 4-2013-500039
Date Filed: 04 January 2013

TM: AZIMAX

X-----X

NOTICE OF DECISION

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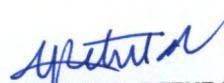
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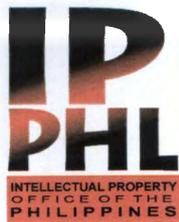
GREETINGS:

Please be informed that Decision No. 2017 - 246 dated 22 June 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, 23 June 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



PFIZER INC. and PFIZER PRODUCTS, INC., }
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 AAA PHARMA INC., }
Respondent-Applicant. }
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IPC No. 14-2014-00277
 Opposition to:
 Application No. 4-2013-500039
 Date Filed: 4 January 2013
 Trademark: "AZIMAX"
 Decision No. 2017- 246

DECISION

PFIZER INC.¹ and PFIZER PRODUCTS, INC.² ("Opposers") filed an opposition to Trademark Application Serial No. 4-2013-500039. The application, filed by AAA PHARMA INC.³ ("Respondent-Applicant"), covers the mark "AZIMAX" for use on "antibacterial" under Class 05 of the International Classification of Goods and Services.⁴

The Opposers allege:

x x x

"5. Sometime in 1991, Pfizer coined and adopted 'ZITHROMAX' for the purpose of using the word as a trademark for its pharmaceutical product, azithromycin, which is a broad-spectrum antibiotic that actively works against various bacteria that cause a wide variety of infections of the upper or lower airways, skin or soft tissue, or ears. In the same year, pharmaceutical products bearing the ZITHROMAX mark were launched and made available for sale in the United Kingdom. Since then, pharmaceutical products bearing the ZITHROMAX mark have been marketed and sold in numerous other countries worldwide, such as Australia (1994), Austria (1994), Canada (1994), Chile (1993), China (1995), Dominican Republic (1996), Egypt (1995), Finland (1992), France (1994), Germany (1993), Great Britain (1991), Greece (1995), Indonesia (1995), Ireland (1993), Korea (1993), Malaysia (1995), Morocco (1994), Netherlands (1994), New Zealand (1998), Portugal (1995), Puerto Rico (1992), Saudi Arabia (1994), Singapore (1995), South Africa (1994), Switzerland (1993), Taiwan (1994), Thailand (1994), and Tunisia (1995).

"6. Sometime in 2005, Pfizer coined and adopted 'ZMAX' for the purpose of using the word as a trademark for its single-dose version of the pharmaceutical product, azithromycin. In the same year, pharmaceutical products bearing the ZMAX mark were launched and made available for sale in the U.S.A. Since then, pharmaceutical products bearing the ZMAX mark have been marketed and sold in numerous other countries worldwide, such as Bulgaria (2007, Egypt (2008), Hong Kong (2009), Hungary (2009),

¹With address at 235 East 42nd Street, New York, New York 10017.

²With address at Eastern Point Road Groton, Connecticut 06340, U.S.A.

³With address at 105 Maryland Street, Cubao, Quezon City, Metro Manila, Philippines.

⁴The Nice Classification is a classification of goods and services for the purpose of registering trademark 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 Purposes of the Registration of Marks concluded in 1957.

Lithuania (2010), Malaysia (2008), Puerto Rico (2005), Romania (2007), Singapore (2008), Slovak Republic (2009), and Thailand (2007).

"7. Attached as Annex 'A-Series' hereof are representative samples of product packaging used by Pfizer for ZITHROMAX and ZMAX products around the world.

"8. To ensure Pfizer's exclusive use over its brand and protect the goodwill which it had long tried to build through years of extensive marketing, Pfizer and/or its subsidiaries, joint ventures, sister concerns, predecessors-in-title or assignees, sought the trademark registration of the ZITHROMAX mark in several jurisdictions all over the world, the earliest of which were in 1989. A representative sample of the different certificates of registration secured by Pfizer worldwide is listed as follows: x x x

"9. On the other hand, Pfizer and its subsidiaries, joint ventures, sister concerns, predecessors-in-title or assignees sought the trademark registration of the ZMAX mark in several jurisdictions all over the world, the earliest of which were in 2005. A representative sample of the different certifications of registration secured by Pfizer worldwide for ZMAX is listed as follows: x x x

'10. In the Philippines, Pfizer's ZITHROMAX mark was first used in March 1994, following its launch by Pfizer, Inc., with principal address at the 23rd Floor Ayala Life-FGU Center, 6811 Ayala Avenue, Makati City. Soon thereafter, the ZITHROMAX was registered in the name of Pfizer Inc. for goods in class 5, particularly 'antibiotic preparations,' as evidenced by Certificate of Registration No. 4-2000-007549 issued by this Honorable Office on 5 August 2004. On the other hand, ZMAX first used in October 2005 and was registered in the name of Pfizer Products Inc. on 19 February 2007 under Certificate of Registration No. 4-2005-001349 for antibiotic preparations, among others, under International Class 5.

"11. Attached as Annex 'B-Series' and made an integral part hereof are tables regularly updated and maintained by Pfizer showing the details of applications and registrations for the ZITHROMAX and ZMAX marks worldwide. Representative copies of registrations of the ZITHROMAX and ZMAX mark are attached as Annex 'C-Series,' which are faithful reproductions of the originals that Pfizer maintains in its records.

"12. From the time products bearing the ZITHROMAX mark first became available in 1991 and products bearing the ZMAX mark first became available in 2005, Pfizer and its worldwide affiliates have continuously and exclusively marketed the product. The ZITHROMAX and ZMAX products have proved to be an important treatment option for many different types of infections caused by bacteria, such as respiratory infections, skin infections, ear infections, and sexually transmitted diseases. Over the years, medical publications, journals and scholarly articles published worldwide and over the internet reported the various uses of the ZITHROMAX and ZMAX products. In the course of Pfizer's extensive and notorious use and appropriation of ZITHROMAX and ZMAX to identify its azithromycin products throughout the world, ZITHROMAX and ZMAX were firmly established as well-known marks and have obtained goodwill and general international consumer recognition as belonging to only one source, i.e., Pfizer. Soon, ZITHROMAX and ZMAX became trusted names among medical professionals and patients, synonymous with azithromycin's profile and Pfizer's worldwide reputation for quality. This is readily supported by the following:

"12.1 Pharmaceutical products bearing the ZITHROMAX mark have been advertised in magazines and publications having international circulation, such as The Journal of Antimicrobial Chemotherapy.

"12.2 ZITHROMAX or ZMAX have appeared in major international listings and publications dealing with pharmaceutical products, such as in Antimicrobial Agents and Chemotherapy, Drugs 2007, The Journal of the Society of Academic Medicine, Clinical Immunology, Diagnostic Microbiology and Infectious Disease, International Journal of Antimicrobial Agents, International Journal of Cardiology, The Lancet, Journal of Pharmaceutical and Biomedical Analysis, Journal of Adolescent Health, and Advances in Pediatrics.

"12.3 Pfizer has participated in international trade fairs where the ZITHROMAX and ZMAX brands have been extensively promoted.

"12.4 Information and promotional videos relating to pharmaceutical products bearing the ZITHROMAX and ZMAX marks are provided on the www.pfizer.com and www.zmaxinfo.com websites, which are accessible throughout the world including the Philippines.

"13. This worldwide reputation likewise reached Philippine borders. Since the Philippine launch of ZITHROMAX in 1994 and the Philippine launch of ZMAX in 2005, Pfizer Philippines has undertaken activities to familiarize doctors and other medical practitioners with the ZITHROMAX and ZMAX products, such as:

"13.1 Medical Representative Detailing, by which Pfizer Philippines' medical representatives regularly visit doctors all over the Philippines, providing them with information and materials relating to the use of the ZITHROMAX and ZMAX products. During these visits, the medical representatives also provide samples of the ZITHROMAX and ZMAX products and items bearing the ZITHROMAX and ZMAX marks, e.g., stationery and detail aides, to serve as brand reminders.

"13.2 Continuing Medical Education Programs and other medical conventions, with which Pfizer Philippines is regularly involved, participating in roundtable discussions with doctors and medical professionals. During these events, Pfizer Philippine promotes the use of and disseminates information on the ZITHROMAX and/or ZMAX products. The following are some of the recent Continuing Medical Education activities that have been conducted by Pfizer Philippines, during which the ZITHROMAX or ZMAX products were promoted:

x x x

"14. Attached as Annex 'D-Series' are copies of the above-mentioned advertisements, studies, letters, lists, screen shots, and other evidence of the extensive promotion of the ZITHROMAX and ZMAX marks around the world.

"15. Sometime in November 2009, it has come to the attention of Pfizer that Respondent was able to register the trademark 'AZIMAX' under Certificate of Registration No. 4-2007-013558 issued on 26 May 2008 for 'antibacterial' pharmaceutical preparations under International Class 5. In view thereof, Pfizer sent a letter dated 1 March 2010 by hand and registered mail to Respondent, informing the latter that its registration and use of the AZIMAX mark infringes upon Pfizer's registered trademarks,

particularly because AZIMAX and ZMAX, when read aloud, constitute idem sonans to a striking degree, which alone constitutes sufficient ground for the Honorable Office to rule that the two marks are confusingly similar, especially since both marks involve pharmaceutical products. Furthermore, AZIMAX is substantially similar to Pfizer's ZITHROMAX trademark, particularly as Respondent's mark is clearly intended for use on the exact same type of pharmaceutical preparations, namely, azithromycin dehydrate, under Class 5. Respondent, however, conveniently ignored any Pfizer's lawful demands.

"16. In view thereof, Opposers filed a Petition for Cancellation against Respondent's trademark registration, which was docketed as IPC No. 14-2011-00044. Said case has been submitted for decision since October 2011 and has yet to be resolved. However, Respondent's trademark registration was cancelled by operation of law in light of its failure to file its Declaration of Actual Use that fell due on 10 December 2010, or within 3 years from the trademark application's filing date. Hence, said case should be regarded as moot. The trademark subject of the cancellation proceedings has already lost its validity through Respondent's own fault.

"17. Sometime in May 2014, Opposers learned that Respondent is once again trying to appropriate Pfizer's trademark rights and goodwill over the ZITHROMAX and ZMAX marks by again applying for the registration of AZIMAX. Pfizer reiterated to Respondent its demand through a letter dated 3 July 2014, Yet again, Respondent did not heed Pfizer's lawful demands.

"18. Hence, this Opposition, which rests on the following grounds:

"(a) Opposers are the prior users and first registrants of the ZITHROMAX and ZMAX marks in the Philippines, well before the filing date of Respondent's AZIMAX trademark application. The registration details are as follows: x x x

"(b) Pfizer, as the registered owner of the ZITHROMAX and ZMAX marks, enjoys the exclusive right to prevent all third parties not having its consent from using in the course of trade identical or similar signs for goods which are identical or similar to those in respect of which the trademark is registered (i.e., antibiotic preparations) where such use would result in a likelihood of confusion. In fact, there shall be a presumption that a likelihood of confusion will result if what is used is an identical sign for identical goods.

"(c) The goods for which Respondent intends to sue its AZIMAX mark are exactly the same, or are at the very least closely related, to the goods currently being sold by Pfizer in the Philippine market. Respondent's AZIMAX mark covers 'antibacterial' preparations in class 5. These goods are the same or closely related to those covered by Pfizer's marks. Opposers' ZITHROMAX mark covers 'antibiotic preparations' in class 5, while ZMAX covers 'pharmaceutical preparations namely antibiotic preparation; veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters; materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

"(d) Respondent's AZIMAX mark is identical and confusingly similar to ZMAX and ZITHROMAX, and thus runs contrary to Section 123 of the IP Code. Sections 123 (d), (e), (f), and (g) of the IP Code provide: x x x

“(e) Pfizer’s ZITHROMAX and ZMAX are not only well-known marks, both internationally and in the Philippines, but are likewise registered as trademarks in the Philippines. As such, Opposers are entitled to a wider scope of protection under Philippine law and to protect their ZITHROMAX and ZMAX marks against marks that are liable to create confusion in the minds of the public or used in bad faith under Article 6bis of the Paris Convention, thus: x x x

“(f) If allowed to proceed to registration, the consequent use of Respondent’s mark by Respondent will amount to unfair competition with and dilution of Opposers’ ZITHROMAX and ZMAX well-known marks, which have attained valuable goodwill and reputation through more than 24 years of extensive and exclusive use. This is prohibited under Section 168 of the IP Code. x x x

“(g) The registration of Respondent’s mark will work to impede the natural expansion of Pfizer’s use of its ZITHROMAX and ZMAX marks in the Philippines.

“(h) The registration and consequent use of the mark will result in a confusion of source or reputation, which is proscribed under the IP Code and applicable precedents; and

“(i) Other provisions of the IP Code and related international agreements or conventions on the subject of intellectual property rights warrant the denial by this Honorable Office of Respondent’s trademark application.

“19. Except for the letters A and I, Respondent’s AZIMAX mark appropriates much of the elements of Pfizer’s ZMAX trademark that would support a finding of sufficient similarity, *fi not identity*, between the competing marks in terms of spelling, pronunciation and appearance. AZIMAX and ZMAX, when read aloud, constitute *idem sonans* to a striking degree, which alone constitutes sufficient ground for the Honorable Office to rule that the two marks are confusingly similar. Furthermore, AZIMAX is substantially similar to Pfizer’s ZITHROMAX trademark, more so as Respondent’s mark is clearly intended for use in connection with the exact same type of goods under which Pfizer’s marks are registered.. This will confuse consumers by suggesting a connection, association or affiliation with Pfizer, thereby causing substantial damage to the goodwill and reputation associated with the ZMAX and ZITHROMAX trademarks, as well as Pfizer’s business reputation.

“20. In resolving the issue of confusing similarity, courts have resorted to the Dominancy Test which focuses on the similarity of the prevalent, essential or dominant features of the competing marks. In the instant case, the dominant feature of Opposers’ marks are the syllables ‘ZI’/‘Z’ and ‘MAX’. Respondent conveniently copied these elements and made the same the dominant element of its own ‘AZIMAX’ mark. There is no doubt that ‘ZITHROMAX’/‘ZIMAX’ and ‘AZIMAX’ marks are confusingly similar in pronunciation and sound. These marks both consist of the syllables ‘Z’/‘ZI’ and ‘MAX’. Applying the Dominancy Test to the instant case, it appears that the syllables ‘Z’/‘ZI’ and ‘MAX’, which are common to both marks, predominate both marks and attract the attention of the ordinary purchaser. Clearly, Respondent’s ‘AZIMAX’ mark is but a slavish copy of Opposers’ ‘ZITHROMAX’ and ‘ZMAX’ Trademarks.



"21. The addition of the first letter 'A' does not add a distinguishing element. It has been established that similarity of sound is sufficient ground for the courts to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.

"22. It is settled that where a comparison between two competing marks shows such resemblance in general appearance or general features as would likely to deceive the ordinary purchaser exercising ordinary care, and to induce him to believe that the goods bearing the marks are products of one and the same enterprise, the junior mark is confusingly similar to the other. In a case decided by the Supreme Court, it was stressed that confusing similarity is to be determined on the basis of visual, aural, connotative comparisons and overall impressions engendered by the marks in controversy as they are encountered in the realities of the marketplace.

"23. Opposers and/or their respective subsidiaries, joint ventures, sister concerns, predecessors-in-title, licensees and assignees in several other countries have extensively promoted the ZITHROMAX and ZMAX trademarks worldwide, and have obtained significant exposure for the goods upon which the ZITHROMAX and ZMAX trademarks are used in various media, including advertisements, internationally well-known print publications, and other promotional events.

"24. Opposers have not consented to Respondent's use and registration of the AZIMAX trademark, or any other mark identical or similar to the ZITHROMAX and ZMAX trademarks. If Respondent uses the AZIMAX mark in class 5 for 'antibacterial' preparations, which are similar, identical or closely related to the goods that are produced by, originate from, or are under the sponsorship of Opposers, the purchasing public will be misled into believing that Respondent's goods are produced by, originate from, or are under the sponsorship of Opposers, upon which potential damage to Opposers may result in light of their inability to control the quality of the products offered or put on the market by Respondent under the AZIMAX mark.

"25. At the very least, the use by Respondent of the AZIMAX mark in relation to its goods, whether or not identical, similar or closely related to the Opposers' goods will take unfair advantage of, dilute and diminish the distinctive character or reputation of the ZITHROMAX and ZMAX trademarks.

"26. To be sure, if Respondent were to be allowed to register and use its mark in connection with the advertisement, sale and distribution of its goods that are similar, identical, or closely related to Pfizer's own goods, the consuming public would no doubt be misled into assuming or believing that Respondent's goods are delivered by, originate from, or are under the sponsorship of Pfizer. Respondent's use of its mark would indicate a connection between Respondent's products and Opposers', when in truth and in fact there is none. This no doubt results in the clear irreparable damage of Opposers' goodwill and reputation. It is apparent that Respondent's mark is calculated to ride on or cash in on the popularity of the ZITHROMAX and ZMAX marks, which undoubtedly has earned goodwill and reputation worldwide through Opposers' extensive use and promotion since 1989 and 2005, respectively.

"27. Moreover, considering the substantial investment incurred by Opposers in promoting their goods and identifying themselves throughout the world through the ZITHROMAX and ZMAX marks, it is clear that Respondent's deceitful conduct in

securing the registration of a mark similar to Opposers' and in exploiting the same is aimed towards unduly enriching itself at the expense of Opposers.

"28. Finally, Opposers will suffer grave and irreparable injury to their goodwill, reputation and business as a whole should the registration and consequent use of the subject mark be allowed by this Honorable Office.

"29. Under the circumstances, Respondent's trademark application for AZIMAX under Application No. 4-2013-00500039 filed on 4 January 2012 be denied.

The Opposer's evidence consists of the Notice of Opposition; copies of the Certificates of Authority and Special Powers of Attorney dated 13 August 2014 executed by Richard A. Friedman; actual product labels from various countries; table showing the details of applications and registrations for the ZITHROMAX and ZMAX marks worldwide; representative copies of certificates of registration for the ZITHROMAX and ZMAX marks all over the world; copies of journal articles, studies, letters, and lists; copy of the letter dated 1 March 2010 sent by Quisumbing Torres to Respondent; copy of letter dated 12 March 2010 of Respondent through counsel Sanidad Abaya Te Viterbo Enriquez & Tan; copy of second cease and desist letter dated 3 July 2014 sent by Quisumbing Torres to Respondent; copy of letter dated 17 July 2014 of Respondent's counsel to Quisumbing Torres.⁵

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 6 November 2014. The Respondent-Applicant filed their Answer on 4 February 2015 and avers the following:

x x x

"SPECIAL AND AFFIRMATIVE DEFENSES

"10. Just like its first petition, opposers' current position to respondent-applicant's application remain the same. It still accuses respondent-applicant of outright fraud for filing an application of AZIMAX without its knowledge and consent, as if they were the clearing house of all pharmaceutical trademark applications.

"11. Even then, opposers used the case of Shangri-La International Hotel Management, Ltd., et al. v. Developer Group of Companies, Inc. (GR No. 159938, 31 March 2006) to show that the combined use of the word, font, lettering style, logo style are indicators of bad faith and the malicious intent to take advantage of one's goodwill. It bears repeating that, four years later, such indicators are still not present in AZIMAX, making the use of the case all for naught. Instead, it even crystallizes the discernible difference between the marks.

"12. Phonetically and logically, it would be hard to confuse AZIMAX with either ZITHROMAX and ZMAX. The confusion which exists in the mind of opposers becomes an exercise of solipsism instead. Besides, the confusion is made

⁵Marked as Exhibits "A" to "J, inclusive.

less likely because of the admitted efforts of opposers in Paragraph 13.2 to familiarize doctors and other medical practitioners with ZITHROMAX and ZMAX as early as 2008. Opposers themselves appease their fears of confusion with their allegations of engaging in advertisements, studies, letters, lists, screen shots, information materials and promotional videos, continuing medical education, samples, stationary and detail aides and other brand reminders that they have aggressively showered these doctors and medical practitioners. Necessarily, with the aggressive familiarity with the product, the required prescription needed to obtain the product, and not to mention, basic reading, phonics and spelling skills expected of professionals, the confusion/identity/similarity between the AZIMAX and ZITHROMAX and ZMAX is more imagined than real.

"13. Aside from the above, no confusion can arise from the different packaging of the AZIMAX from ZITHROMAX and ZMAX. The fact that opposers are more uncompromising with its marketing of the uniqueness of ZITHROMAX and ZMAX reduces the possibility of the professionals or the public getting befuddled by them.

"14. Opposers also would like to make an issue that both products have the same similar letters. But we should not stop there. AZIMAX has a drastically different spelling, and, more letters and syllables than ZMAX. It need not go with the difference with ZITHROMAX because they are even more obvious in their variation in spelling, syllabication and sound. These marks, to put it plainly and simply, are still different.

On 14 October 2015, the Preliminary Conference was terminated and the parties were directed to file their respective position papers. Thereafter, the case was deemed submitted for resolution.

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

The Opposer anchors its opposition on Sections 123.1, paragraphs (d), (e) and (f) and (g) and Section 168 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

Sec. 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;"

- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered

here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

- (f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or service which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided further*, That the interests of the owner of the registered mark are likely to be damaged by such use;
- (g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

Sec. 168. *Unfair Competition, Rights, Regulation and Remedies.* – 168.1. A person who has identified in the mind of the public the goods he manufactures or deals in, his business or services from those of others, whether or not a registered mark is employed, has a property right in the goodwill of the said goods, business or services so identified, which will be protected in the same manner as other property rights.

Records show that at the time the Respondent-Applicant filed its trademark application on 04 January 2013, the Opposers have existing trademark registrations for ZITHROMAX and ZMAX under Trademark Reg. Nos. 42000-7549 and 4-2005-1349 issued on 5 August 2004 and 19 February 2007 respectively. These registrations cover antibiotic preparations in Class 5. This Bureau noticed that the pharmaceutical products covered by Respondent-Applicant's trademark application are similar or closely-related to the Opposers'.

The marks are shown below:

ZITHROMAX

ZMAX

AZIMAX

Opposer's trademarks

Respondent-Applicant's mark



This Bureau noticed that the products covered by the marks are similar. Designated as AZIMAX, Respondent-Applicant's products are antibacterial. Opposers' products covered under both ZITHROMAX and ZMAX marks are antibiotic preparations. Confusion is likely in this instance because of the close resemblance between the marks and that the goods are the same and are for human consumption. Respondent-Applicant's mark "AZIMAX" adopted the dominant features of Opposers' marks ZITHROMAX and ZMAX. Both AZIMAX and ZMAX marks have the letters "Z", "M", "A" and "X". Both marks have the same suffix MAX. Respondent-Applicant merely added the first letter "A" and the third letter "I" in Opposers' ZMAX to come up with the mark AZIMAX. It could result to mistake with respect to perception because the marks sound so similar. Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"⁶, "SAPOLIN" and LUSOLIN"⁷, "CELDURA" and "CORDURA"⁸, "GOLD DUST" and "GOLD DROP". The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, to wit:

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 especial significance...."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.⁹

It is emphasized that 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.¹⁰ This Bureau finds that the mark applied for registration by the Respondent-Applicant does not meet this function.

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1(d) (iii) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-500039 is hereby SUSTAINED. Let the filewrapper of the

⁶ *MacDonalds Corp. et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

⁷ *Sapolin Co. v. Balmaceda and Germann & Co.*, 67 Phil, 705.

⁸ *Co Tiong SA v. Director of Patents*, G.R. No. L- 5378, 24 May 1954; *Celanes Corporation of America vs. E. I. Du Pont de Nemours & Co.* (1946), 154 F. 2d 146 148.)

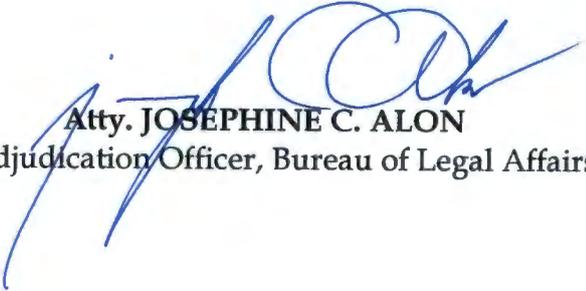
⁹ *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297, 22 Dec. 1966.

¹⁰ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepta v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 22 JUN 2017.



Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs