



INTELLECTUAL PROPERTY  
OFFICE OF THE PHILIPPINES

**ASPEN PHARMACARE HOLDINGS LTD.,**  
*Petitioner,*

**-versus-**

**PACIFIC PHARMACEUTICAL GENERICS INC.,**  
*Respondent-Registrant.*

}  
} **IPC No. 14-2016-00659**  
} Cancellation of:  
} Reg. No. 4-2009-004540  
} Date Issued: 11 June 2010

}  
} **TM: ASPEN**  
}

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### NOTICE OF DECISION

#### FEDERIS & ASSOCIATES LAW OFFICES

*Counsel for Petitioner*  
Suites 2004 and 2005 88 Corporate Center  
141 Valero corner Sedeño Streets,  
Salcedo Village, Makati City

#### PACIFIC PHARMACEUTICAL GENERICS INC.

*Respondent-Registrant*  
3<sup>rd</sup> Floor, LC Building  
459 Quezon Avenue, Quezon City

#### GREETINGS:

Please be informed that Decision No. 2017 - 384 dated 16 November 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, 21 November 2017.

**MARILYN F. RETUAL**  
IPRS IV

Bureau of Legal Affairs



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**TM: ASPEN**

Decision No. 2017 - 384

### DECISION

ASPEN PHARMACARE HOLDINGS LTD.,<sup>1</sup> ("Petitioner") filed a Petition for Cancellation of Trademark Registration No. 4-2009-004540. The registration issued to PACIFIC PHARMACEUTICAL GENERICS INC.,<sup>2</sup> ("Respondent-Registrant"), covers the mark "ASPEN" for use on "*pharmaceutical product namely, anti-thrombotic*" under Class 05 of the International Classification of Goods.<sup>3</sup>

The Petitioner alleges the following grounds:

"A. ASPEN is the trade/corporate name of Petitioner for its global pharmaceutical business and hence, it can no longer be appropriated, used and registered by Respondent-Registrant as a trademark pursuant to Section 165.2 of the Intellectual Property Code ("IP Code") and Article 8 of the Paris Convention.

"B. ASPEN is also a trademark of Petitioner of which it is a true owner, prior user and prior registrant in various countries, for use on goods in Class 5 and hence, the challenged registration for the same goods, is a bad faith registration and should be cancelled immediately pursuant to settled jurisprudence.

"C. Petitioner's registration for its ASPEN trademark in various countries which, like the Philippines, are members of the Paris Convention and World Trade Organization, is entitled to protection in the Philippines pursuant to Sections 3 and 160 of the IP Code, and Article 6bis of the Paris Convention.

"D. ASPEN of Petitioner has the status of a well-known mark and hence, it is protected under Section 123.1 (e) of the IP Code.

"E. The continued registration of ASPEN in the name of Respondent-Registrant will enable it to unfairly profit commercially from the goodwill, fame, and notoriety of Petitioner's ASPEN

<sup>1</sup>A foreign corporation organized and existing under the laws of South Africa with principal place of business at Building 8, Healthcare Park, Woodlands Dr., Woodmead, Gauteng, South Africa.

<sup>2</sup>A domestic corporation with principal business at TGP Bldg, Edison Street cor. Cul de Sac, Km. 14 West Service Rd. Sunvalley, Paranaque City.

<sup>3</sup>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. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

trademark and corporate name, to the damage and prejudice of Petitioner, contrary to Section 168.1 of the IP Code."

The Petitioner's evidence consists of the following:

1. Authenticated Affidavit-Testimony of Kurt Drieselmann;
2. Certificate of Change of Name of Company;
3. Listing of trademark registration and pending applications for the mark ASPEN in various countries;
4. Representative samples of certificate of registration for the mark ASPEN issued in South Africa, Zimbabwe, OHIM, Hong Kong, African Intellectual Property Organization;
5. Printout of relevant pages of Petitioner's website <http://www.aspenpharma.com>;
6. Sample catalogs, magazines, publications, articles, posters, directory, promotional and advertising materials used by petitioner in various countries;
7. Special Power of Attorney with Certification of Authority; and
8. Corporate Secretary's Certificate.

On 14 November 2016, this Bureau issued a Notice to Answer and served it to Respondent-Registrant on 18 January 2017. Despite receipt of the Notice, Respondent-Registrant failed to file the answer. On 08 June 2017, this Bureau declared Respondent-Registrant in default. Hence, this case is now submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended.

Should Trademark Registration No. 4-2009-004540 for the mark **ASPEN** be cancelled?

Section 151 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), as amended, provides:

Sec. 151. Cancellation. -151.1 A petition to cancel a registration of mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:

x x x

(b) At any time, if the registered mark becomes generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or *its registration was obtained fraudulently or contrary to the provisions of this Act*, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services or in connection with which the mark is used. xxx

Corollary, Section 123.1 (d) of the IP Code provides:



Section 123. Registrability. — 123.1. A mark cannot be registered if it:

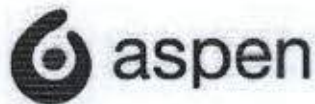
x x x

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, or to a well-known mark, said mark cannot be registered.

The marks of the parties are reproduced below:



Petitioner's Mark

**ASPEN**

Respondent-Registrant's Mark

There is no doubt that Petitioner and Respondent-Registrant's mark are similar because of the presence of the word "ASPEN". Although some differences can be observed between the two marks, the same is of no moment because of the manifest similarity between them. However, while the marks of the parties are similar, the records of this case will show that at the time Respondent-Registrant applied for registration of its mark ASPEN on 11 May 2009, Petitioner has no existing registration or pending application for registration of a similar mark. It was only in 25 July 2016 that Petitioner filed an application for registration of its own ASPEN mark. Even its earlier application for registration of the mark ASPEN filed on 07 May 2013, was a later application than that of Respondent-Registrant. As such, as a prior filer and prior registrant, the registration of Respondent-Registrant's ASPEN mark was made in accordance with the provisions of the IP Code.

There is likewise no merit in the Petitioner's contention that its ASPEN mark is a well-known mark. Rule 102 of the Trademark Regulations sets forth the following criteria in determining whether a mark is well-known:

RULE 102. *Criteria for determining whether a mark is well-known.* - In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

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- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

In this regard, any combination of the above-mentioned criteria may be taken into account to determine whether ASPEN is a well-known mark. In this case, while Petitioner submitted a list of existing registrations and pending applications for the mark ASPEN, it did not present evidence to show the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies. In order to be declared as a well-known mark by the competent authority, the mark must be well-known not only internationally but in the Philippines as well. As such, Petitioner's reliance on Section 123.1 (e) of the IP Code, has no leg to stand on.

Finally, Petitioner's argument that Respondent-Registrant's mark should be cancelled because the mark ASPEN is its trade name or corporate name is also without merit. While it is true that the word "ASPEN" is part of its corporate name, however, Petitioner failed to show that they operated in the Philippines prior to the filing of Respondent-Registrant's trademark application. Petitioner also failed to submit evidence to show that Respondent-Registrant copied its mark from Petitioner's corporate name. In fact, by its own admission, Aspen Philippines, Inc. began trading in the Philippines only in 2012, two (2) years after Respondent-Registrant's mark was registered.

Section 165. 2 of the IP Code provides:

165.2. (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any *subsequent use* of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

It is very clear from the provision that it is the subsequent use of the trade name by third party, as a trade name or a mark or collective mark that is unlawful. As already pointed out, the use by Respondent-Registrant of the mark ASPEN in the Philippines precedes that of Petitioner's use. Furthermore, the presence of the word "ASPEN" in Respondent-Registrant's corporate name is not sufficient to cancel the registration. In one case, the Supreme Court held that there is no automatic protection afforded to an entity whose trade name is alleged to have been infringed through the use of that name as a trademark.<sup>4</sup> It stressed that:

The Paris Convention for the Protection of Industrial Property does not automatically exclude all countries of the world from which have signed it from using a trade name which happen to be used in one country. To illustrate - if a taxicab or bus company in a town in the United Kingdom or India happens to use the trade name "Rapid Transportation", it does not necessarily follow that "Rapid" can no longer be registered in Uganda, Fiji, or the Philippines.

The trademark system functions to protect owners of trademark and the rights in a trademark, if validly acquired through registration made in accordance with existing laws. In this case, Respondent-Registrant has shown that it has complied with the provisions of Section 123.1 (d) of the IP Code, hence, there is no reason for this Bureau to cancel the registration.

**WHEREFORE**, premises considered, the instant Petition for Cancellation is hereby **DISMISSED**. Let the filewrapper of Trademark Reg. No. 4-2009-004540 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 16 NOV 2017

  
**MARLITA V. DAGSA**  
Adjudication Officer  
Bureau of Legal Affairs

<sup>4</sup> *Canon Kabushiki Kaisha v. Court of Appeals, G.R. No. 120900, 20 July 2000.*