



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

GRUNENTHAL GmbH,
Opposer,

-versus-

AMBICA INTERNATIONAL TRADING CORP.,
Respondent-Applicant.

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IPC No. 14-2014-00356
Opposition to:
Appln. Serial No. 4-2014-006090
Date Filed: 15 May 2014

TM: TRAMAZE

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 413 dated 12 December 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, 13 December 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

GRUNENTHAL GmbH,

Opposer,

-versus-

**AMBICA INTERNATIONAL
TRADING CORPORATION,**

Respondent-Applicant.

} **IPC NO. 14-2014-00356**

} Opposition to:

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} Appln. Ser. No. 4-2014-006090

} Date Filed: 15 May 2014

} Trademark: **TRAMAZE**

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x-----x} Decision No. 2017- *413*

DECISION

GRUNENTHAL GmbH, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-006090. The application, filed by AMBICA INTERNATIONAL TRADING CORPORATION (Respondent-Applicant)², covers the mark "TRAMAZE", for use on "Pharmaceutical preparations namely analgesic" under Class 5 of the International Classification of Goods³.

The Opposer relies on the following facts and grounds for the opposition:

"1. Opposer is the owner of the mark TRAMAL, which was first used in the Philippines on August 1, 1987, and then was registered on January 19, 1989 in class 5.

1.1. The mark TRAMAL was first used in the Philippines by Opposer on August 1, 1987 through its former licensee, Rhone Poulenc Nattermann Pharma, Inc. and has been continuously used through its current licensee, Mundipharma Distribution GmbH (Philippine Branch) for goods under class 05.

1.2. On April 12, 1985, Opposer filed a trademark Application for TRAMAL under Philippine Trademark Application No. 042630 for goods in class 5 described as 'pharmaceutical products, viz medicaments sold only on prescription which have an effect on the central nervous system'.

1.3. On January 19, 1989, the mark TRAMAL was accorded registration in class 5 and remains validly registered under Philippine Trademark Registration No. 042630.

¹ A foreign corporation organized and existing under the laws of Germany with address at Zieglerstrasse 6, 52078 Aachen, Germany

² A domestic corporation with address at #9 Amsterdam Extension, Merville Park Subdivision, Paranaque 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.

"2. On the other hand, Respondent-Applicant filed its application to register its mark TRAMAZE only on May 15, 2014-or twenty seven (27) years after Opposer's trademark TRAMAL was first used in the Philippines, and after twenty (25) years after it was registered locally. xxx

"3. Opposer's mark TRAMAL and Respondent-Applicant's mark TRAMAZE are unmistakably aurally and visually similar, likely to deceive or to cause confusion: xxx

"4. From the foregoing, it is reasonably clear that the registration of the trademark 'TRAMAZE' should be proscribed under Sec. 123.1 (d) of the Intellectual Property Code:

'Section 123. Registrability. 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;

"5. In addition, trademark infringement is evident in Respondent-Applicant's adoption of the dominant features of TRAMAL in its use of the mark TRAMAZE. It is settled that 'if the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place, as in the present case. xxx

"6. Opposer's trademark TRAMAL is also well-known internationally and in the Philippines. Thus, the Respondent-Applicant's mark TRAMAZE should be denied registration under Section 123.1 (e) of the Intellectual Property Code, to wit:

Sec. 123. Registrability. - 123.1. A mark cannot be registered if it:

x x x

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark with 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 public at large,

including knowledge in the Philippines which has been obtained as a result of the promotion of the mark; xxx

“7. Finally, it is apparent that Respondent-Applicant's use and attempted registration of the trademark TRAMAZE is done in bad faith, with manifest intent to ride on the popularity and goodwill of the trademark TRAMAL.xxx”

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

1. Affidavit of Mr. Marcus Heppner dated 2 October 2014;
2. List of TRAMAL worldwide trademark registrations and applications;
3. Samples of product packaging , inserts, promotional materials;
4. Certificates of Product Registration issued by the Food and Drug Administration dated 4 November 2011;
5. Print-out from websites where TRAMAL is advertised and promoted;
6. Print-out from IPOPHIL database of trademark application no. 4-2014-006090; and
7. Print-out from IPOPHIL database of trademark registration no. 042630 for the mark "TRAMAL"⁴

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 28 October 2014. The Respondent-Applicant filed an Answer on 22 December 2014. The Bureau issued Order No. 2015-0494 requiring the Respondent-Applicant to submit its original Secretary's Certificate and proof of service, however, it did not comply on time. Thus, the Hearing Officer issued on 10 September 2015 Order No. 2015-1406 declaring the Respondent-Applicant in default for failure to complete the requirements on time.

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

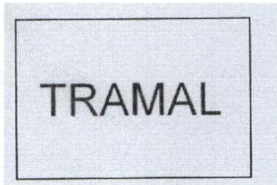
Records show that at the time Respondent-Applicant applied for registration of the mark “TRAMAZE” the Opposer already registered the mark “TRAMAL” under Registration No. 042630 issued on 19 January 1989 for "pharmaceutical products, viz medicaments sold only on prescription which have an effect on the central nervous system".⁵

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:

⁴ Exhibit "A"

⁵ Exhibit “A”-5



Opposer's mark



Respondent-Applicant's mark

Both marks start with the letters/syllables "TRAM"). This Bureau noticed that the generic or non-proprietary name of the Opposer's drug the is TRAMADOL as seen from a reproduction of the packaging⁶ below:

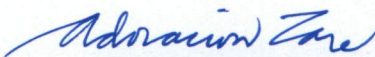


The Opposer merely copied the first five letters, "TRAMA" of the generic name of the product it is identifying, and added letters "L". Thus, this Bureau cannot consider the syllables "TRAMA" uniquely distinctive so as to sustain the opposition on account that the Respondent-Applicant's mark also starts with TRAMA. The Opposer's mark, which is almost a generic or descriptive word, is at most suggestive and therefore a weak mark. Thus, this Bureau finds that confusion much less deception, is likely to occur. The consumers can easily

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-006090 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, T2 DEC 2017


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

⁶ Exhibit "A-6"