



INTELLECTUAL PROPERTY  
OFFICE OF THE PHILIPPINES

**HORPHAG RESEARCH  
MANAGEMENT S.A.,**  
Opposer,

**-versus-**

**AMBROSIO V. PADILLA III,**  
Respondent- Applicant.

X-----X

} **IPC No. 14-2016-00629**  
} Opposition to:  
} Appln. Serial No. 4-2016-009925  
} Date Filed: 18 August 2016  
} **TM: "PYCNOMAX"**

**NOTICE OF DECISION**

**SAPALO VELEZ BUNDANG & BULILAN**  
Counsel for the Opposer  
11<sup>th</sup> Floor, Security Bank Centre  
6776 Ayala Avenue, Makati City

**ATTY. AMBROSIO V. PADILLA III**  
Respondent-Applicant  
Unit 1001-88 Corporate Center  
Sedeno corner Valero Streets  
Salcedo Village, Makati City

**GREETINGS:**

Please be informed that Decision No. 2017 - 437 dated December 22, 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOP HL 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, January 03, 2018.

**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs



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Date Filed: 18 August 2016

Trademark : "PYCNOMAX"

Decision No. 2017 - 437

## DECISION

HORPHAG RESEARCH MANAGEMENT S.A. ("Opposer"),<sup>1</sup> filed a verified opposition to Trademark Application Serial No. 4-2016-009925. The application, filed by AMBROSIO V. PADILLA III ("Respondent-Applicant")<sup>2</sup>, covers the mark "PYCNOMAX" for use on goods under Class 05<sup>3</sup> namely *"pharmaceutical product namely pharmaceutical products for treating circulation problems, allergies, asthma, ringing in the ears, high blood pressure, muscle soreness, pain diabetes, attention deficit-hyperactivity disorder, endometriosis, menopausal symptoms, painful menstrual periods, erectile dysfunction, retinopathy and osteoarthritis."*

The Opposer alleges the following:

"I. Opposer is the true and exclusive owner of, prior adopter, first user and registrant of the 'PCYNO' and 'PYCNOGENOL' trademarks. Under Sec. 147.1 of Republic Act No. 8293 otherwise known as the Intellectual Property Office of the Philippines ('IP Code'). Opposer enjoys the right to exclude others from registering or using identical or confusingly similar marks such as Respondent-Applicant's 'PYCNOMAX' mark, for goods falling under the International Class 5.

"II. Opposer's 'PYCNO' and 'PYCNOGENOL' trademarks are both well-known internationally and in the Philippines, taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being trademark expressly and directly referring to and owned by the Opposer, hence, Respondent-Applicant's 'PYCNOMAX' mark cannot be registered in the Philippines pursuant to the express provision of Sec. 147.2 of R.A. No. 8293.

<sup>1</sup> A foreign corporation duly organized, existing and in good standing under the laws of Switzerland with address at Louis-Casal 71, 1216 Meyrin, Switzerland.

<sup>2</sup> With registered address at Unit 1001, 88 Corporate Center, Sedeno corner Valero Sts., Salcedo Village, Makati City, Metro Manila, Philippines.

<sup>3</sup> The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.



"III. Respondent-Applicant's 'PYCNOMAX' mark is confusingly similar to Opposer's well-known 'PYCNO' and 'PYCNOGENOL' trademarks.

"IV. The registration of Respondent-Applicant's mark will effectively result in the confusion of business between the parties, to the damage and prejudice of Opposer. Being identical or at least confusingly similar, the registration of Respondent-Applicant's mark would indicate a connection with the goods covered by Opposer's internationally well-known 'PYCNOGENOL' and 'PYCNO' trademarks, such that consumers will be misled into believing that Respondent-Applicant and the Opposer are somehow related when the truth is, they are not.

"V. Respondent-Applicant's attempt to register its confusingly similar mark is made purposely to ride on the goodwill acquired by Opposer's well-known trademarks and business, to the prejudice and damage of the latter."

The Opposer's evidence consists of the following:

1. Certified true copy (Ctc) of Certificate of Trademark Registration for PYCNOGENOL;
2. Ctc of Certificate of Trademark Registration for PYCNO;
3. Copy of the case of Horphag Research Ltd. v. Larry Garcia, dba Healthierlife.com and Merlon Pellegrini, dba Healthdiscovery.com;
4. Printed copy of Opposer's websites;
5. Printed copy of <http://www.wipo.int/branddb/en/showDataisp?ID=CATM.671082-00>;
6. Printed copy of <http://www.wipo.int/branddb/en/showDataisp?ID=CHTM.046151999>;
7. Printed copy of <http://www.wipo.int/branddb/em/showDataisp?ID=ILTM.104073>;
8. Printed copy of <http://www.wipo.int/branddb/em/showDataisp?ID=USTM.74022937>;
9. Printed copy of <http://www.wipo.int/branddb/em/showDataisp?ID=AUTM.585452>;
10. Printed copy of <http://www.wipo.int/branddb/em/showDataisp?ID=SGTM.T9108266B>;
11. Printed copy of <http://www.wipo.int/branddb/em/showDataisp?ID=ESTM.M1730081>;
12. Printed copy of <http://www.wipo.int/branddb/em/showDataisp?ID=MXTM.0119850189483>;
13. Printed copy of <http://www.wipo.int/branddb/em/showDataisp?ID=CHTM.029322003>;
14. Printed copy of <http://www.wipo.int/branddb/em/showDataisp?ID=MYTM.2013053472>;
15. Printed copy of <http://www.wipo.int/branddb/em/showDataisp?ID=SGTM.T0402867E>;
16. Printed copy of <http://www.wipo.int/branddb/em/showDataisp?ID=AUTM.991441>;  
and,
17. Printed copy of <http://www.wipo.int/branddb/em/showDataisp?ID=NZTM.756671>.

*Just*

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 22 March 2017. Respondent-Applicant however, did not file an answer. Thus, he is declared in default and this case is deemed submitted for decision.<sup>4</sup>

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

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property Code ("IP Code") which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application for the mark "PYCNOMAX" on 18 August 2016, the Opposer has already an existing Philippine trademark registrations for the following mark: "PYCNOGENOL" bearing Registration No. 4-2007-001125 dated 08 October 2007<sup>5</sup>; and, "PYCNO" bearing Registration No. 4-2009-011375 dated 29 April 2010<sup>6</sup> in the Philippines. Unquestionably, the Opposer's application and registration preceded that of Respondent-Applicant's.

A comparison of the Opposer's mark with the Respondent-Applicant's is depicted below:

**PYCNO**

**PYCNOGENOL**

Opposer's Trademarks

**Pycnomax**

Respondent-Applicant's Trademark

The trademarks are identical in so far as the first two (4) syllables "PYC" and "NO". The difference between the marks is the presence of the suffix "MAX" in Respondent-Applicant's "PYCNOMAX". Apparently however, the marks appear visually and aurally similar. It gives

<sup>4</sup> Order No. 2017-1694 dated 18 August 2017.

<sup>5</sup> Exhibit "A" of Opposer.

<sup>6</sup> Exhibit "A-1" of Opposer.





the impression that Respondent-Applicant's "PYCNOMAX" is a variation of Opposer's "PYCNO" drugs. The suffix "MAX" in "PYCNOMAX" may be construed as "maximum", whether in potency or drug-effectiveness, and amount.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.<sup>7</sup> Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.<sup>8</sup>

This Bureau further underscores the fact that the competing marks cover goods which are related in its kind, use, purpose and nature. This determines the likelihood of confusion by reason of Opposer's registered pharmaceutical products which are used for the treatment of circulatory organs, among other covered illnesses.<sup>9</sup> This is related to the covered goods of Respondent-Applicant's "PYCNOMAX", which indicates circulatory problems in its list of covered treatments.<sup>10</sup>

Succinctly, because the coverage of the Respondent-Applicant's trademark registration would allow using the mark "PYCNOMAX" on goods or pharmaceutical products that are already dealt in by the Opposer's marks containing the word "PYCNO", the minute changes in spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. The marks have similarity in sounds, both consisting of three syllables, which make it not easy for one to distinguish one mark from the other.

Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Petitioner's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound, however, is practically replicated when one pronounces the Respondent-Registrant's mark.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

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<sup>7</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

<sup>8</sup> Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.

<sup>9</sup> Id. at 5.

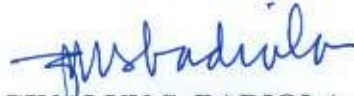
Philippine Trademark Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 19 December 2017).

<sup>10</sup> Filewrapper.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2016-00009925 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. **22 DEC 2017**



**Atty. GINALYN S. BADIOLA, LL.M.**  
*Adjudication Officer, Bureau of Legal Affairs*