

HEINRICH MACK NACHF,)	INTER PARTES CASE NO. 2083
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 45828
)	Filed : August 8, 1981
- versus -)	Applicant : Aktiebolaget Astra
)	Trademark : RHINOCORT
)	Used on : Pharmaceutical
)	preparations and
)	substances
)	
)	<u>DECISION NO. 92-31 (TM)</u>
)	
AKTIEBOLAGET ASTRA,)	November 16, 1992
Respondent-Applicant.)	
x-----x)	

DECISION

On January 5, 1988, HEINRICH MACK NACHF, a corporation duly organized under the laws of West Germany with business address at Illertissen Germany, filed its Verified Notice of Opposition (Inter Partes Case No. 2083) Application Serial No. 45828 for the trademark "RHINOCORT" used on pharmaceutical preparations and substances in Class 5 filed on August 18, 1981 by Aktiebolaget Astra, a Swedish Company of Sodertalje, Sweden, and which application was published for opposition in the Classified Ads section of the Philippine Daily Inquirer, Inc. on September 24, 1987.

The grounds upon which opposer bases its opposition are as follows:

"1. The Opposer is the owner-registrant of the trademark "RHINOPRONT" having been the first to adopt and use the same in actual trade and commerce for the following goods, to wit:

"Medical supplies, chemical substances, for curative purposes and the care of health, pharmaceutical drugs, plasters, material for bandaging, pesticides and herbicides, disinfecting and sterilizing substances, substances for keeping foodstuffs fresh and preserving them."

2. The trademark "RHINOPRONT" was first registered by Opposer with the Patent Office of West Germany on 29 January 1964 under Certificate of Registration No. 783,141;

3. The foregoing Home Registration was made the basis for Opposer's trademark application in this jurisdiction under Application Serial No. 15748 on 26 March 1968. This latter application subsequently matured to registration under Certificate of Trademark Registration No. 15675 granted to Opposer on 2 July 1970;

4. The trademark "RHINOPRONT" which the Opposer created and adopted is well-known in the Philippines and throughout the world for the good quality and high reputation of its products."

Opposer relies on the following facts to support its Opposition:

“1. The trademark “RHINOCORT” of Respondent-Applicant is a flagrant and veritable imitation of herein Opposer’s mark “RHINOCORT” as likely to cause confusion, mistake and deception to the buying public;

2. Opposer’s trademark has acquired tremendous goodwill in the Philippines and abroad and its goods have acquired the reputation of high quality products, Opposer having continuously published and/or advertise said trademark in various well-known newspapers, magazines and other publications around the world;

3. The application subject of this Opposition was filed only on 18 August 1981, while Opposer has enjoyed trademark protection in this jurisdiction since 2 July 1970;

4. Respondent-Applicant’s mark sought to be registered is confusingly similar and identical to Opposer’s trademark “RHINOCORT”. Moreover, the goods covered by both marks are practically the same.

5. The registration of Respondent-Applicant’s mark would violate Opposer’s rights and interest in its trademark “RHINOPRONT” because the marks are confusingly similar and identical. Moreover, confusion between the Opposer’s and Respondent-Applicant’s respective business and products as well as the dilution and loss of distinctiveness of Opposer’s trademark is inevitable.”

On January 26, 1988, A.B. Astra, the herein Respondent-Applicant filed its Answer denying the material allegations in the Opposition, thus --

1. Respondent-Applicant’s mark “RHINOCORT” was registered in Sweden, its Home Country, as early as June 13, 1980 under Registration No. 172, 519. The mark likewise enjoys trademark protection in several other countries abroad, thereby distinctly pointing out to the public the origin and ownership of the goods manufactured under said trademark;

2. The trademark as previously registered in Australia and other countries worldwide in favor of the Respondent-Applicant has been in continuous use since the time of its adoption, hence, the same has gained tremendous goodwill for the Respondent-Applicant and has become clearly distinctive of the goods it manufactures and distributes;

3. No confusing similarity exists between Opposer’s mark and Respondent-Applicant’s mark, both marks being applied or utilized on medicinal preparations and hence, either the same requires medical prescription for purposes of purchase or that the purchaser will due to the nature of the product he is buying;

4. Moreover, as they appear in their respective labels, the contending word marks are clearly distinctive from each other not only in their spelling but also as shown in their overall label presentation;

5. As a consequence of all the foregoing, Opposer does not have and the opposition does not state any cause of action against the Respondent-Applicant.”

The issues having been joined, this Office called this case for pre-trial. Failing to reach amicable settlement, parties went into trial, adduced testimonial and documentary evidences and, together with their respective memoranda, submitted the case for decision.

The issue in this case is whether or not there exists confusing similarity between the Respondent-Applicant's trademark "RHINOCORT" and the Opposer's trademark "RHINOPRONT". The applicable provision in Section 4(d) of R.A. No. 166 as amended which provides:

"Section 4. Registration of trademarks, tradenames and service marks on the Principal Register. – xxx – The owner of a trademark, tradename or service mark used to distinguish his goods, business or services from the goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register, unless it:

xxx

(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers xxx."

A close and careful consideration of the records sets forth the findings, to wit:

1. No confusion would exist even if "RHINOCORT" and "RHINOPRONT" appear simultaneously and side by side with each other in the market;
2. Both marks may co-exist independently from each other without giving rise to confusion among consumers as both differ in meaning, spelling, sound, appearance, color, pictorial representation, size, shape and container; and
3. The only similarity between them is the common use of the word "RHINO"

In resolving whether or not RHINOCORT is confusingly similar with "RHINOPRONT", the test is not simply to take their words and compare the spelling and pronunciation of said words. Rather it is to consider the two marks in their entirety as they appear in their respective labels, in relation to the goods to which they are attached. (Mead Johnson & Co. vs. N.V.J. VAN DORP, LTD. L-17501, April 27, 1963).

Trademarks having the same suffix and similar sounding prefixes but with strikingly different backgrounds; are not apt to confuse prospective customers. As stated by the Supreme Court in the case Bristol Myers Company. Petitioner vs. the Director of Patents and United American Pharmaceuticals, Inc. Respondent [17 SCRA 128]: "For though the words "BIOFERIN" and "BUFFERIN" have the same suffix and similar-sounding prefixes, they appear in their respective labels with strikingly different backgrounds and surroundings, as to color, size and design. Furthermore, the product covered by "BIOFERIN" is expressly stated as DISPENSABLE only upon DOCTORS PRESCRIPTION, while that of "BUFFERIN" does not require the same. The chances of the consumer being confused into purchasing one for the other therefore are the more rendered negligible."

Furthermore, the goods or products covered by the competing marks are "pharmaceutical preparations and substances pharmaceutical drugs and medical supplies" and are obtained from the market upon doctor's prescription as indicated in their respective labels.

One important factor to be considered is the class of purchasers of the products in question.

“xxx regard too should be given to the class of persons who buy the particular product and the circumstances ordinarily attendant to its acquisition. The medicinal preparation clothed with the trademarks in question, as unlike articles of everyday use such as candies, ice cream, milk, soft drinks and the like which may be freely obtained by anyone, anytime, anywhere.” (Etepha vs. Director of Patents, et.al., SUPRA, at p. 501)

It must be noted that both Respondent’s and Opposer’s products or goods are to be dispensed upon medical prescription. An intending buyer must have to go first to a licensed doctor of medicine; he receives instructions as to what to purchase; he reads the doctors prescription.

He knows what he is to buy, he is not of the incautious, unwary, unobservant or unsuspecting type; he examines the product sold to him; he checks to find out whether it conforms to the medical prescription. The common trade channel is the pharmacy or the drugstore. Similarly, the pharmacist or druggist verifies the medicine sold. The margin of error in the acquisition of one for the other is quite remote.

The Supreme Court has consistently held that in cases requiring a prescription of a doctor before a product could be purchased, the possibility of confusion by the purchaser is quite remote, and consequently, could not cause confusion, or mistake or to deceive purchasers.” (Etepha vs. Director of Patents, et.al., SUPRA; Bristol Myers Co. vs. Director of Patents, 17 SCRA 129; Mead Johnson & Co. vs. N.V.J. VAN DORP. LTD., 7 SCRA 168; American Cyanamid Co. vs. Director of Patents, 76 SCRA 568)

In another case, the Supreme Court ruled: It is true that between Petitioner’ trademark “ALACTA” and respondent’s trademark “ALASKA” there are similarities in spelling, appearance, and sound for both are composed of six letters of three syllables each and each syllables has the same vowel, but in determining if they are confusingly similar a comparison of said words is not the only determining factor. The two marks in their entirety as they appear in the respective labels must also be considered in relation to the goods to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion similar to the other. (Mead Johnson Co. vs. N.V.J. VAN DORP. LTD. et.al., 7 SCRA 768)

Applying these tests to the trademarks involved in this case, it is clear that no likelihood of confusion among the consumers of the products carrying the competing marks could take place.

WHEREFORE, in view of all the foregoing, this case is DISMISSED. Accordingly, Application Serial No. 45828 for the trademark “RHINOCORT” filed on August 18, 1981 by Aktiebolaget Astra, Respondent-Applicant, is hereby GIVEN DUE COURSE.

Let a filewrapper of this case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision. Likewise, let a copy of this Decision be furnished the Trademark Examining Division for information and to update its records.

SO ORDERED.

IGNACIO S. SAPALO
Director