

E.I. DU PONT DE NEMOURS AND
COMPANY,

Opposer,

- versus -

BROWN & BURK PHILIPPINES, INC.,
Respondent-Applicant.

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IPC No. 14-2008-00136
Opposition to:

Appln. Serial No. 4-2007-005885
Date Filed 08 June 2007

Trademark: "ANGIZAAR-H"

Decision No. 2009-94

DECISION

This pertains to a Verified Opposition filed on 20 June 2008 by herein opposer, E.I. Du Pont De Nemours and Company, a corporation duly organized and existing under the laws of Delaware, U.S.A. with principal office at 1007 Market St., Wilmington, Delaware U.S.A. 19898, against the application filed on 08 June 2007 bearing Serial No. 4-2007-005885 for the registration of the trademark "ANGIZAAR-H" used for goods in Class 05 namely, pharmaceutical product used for the treatment of hypertension, which application was published in the Intellectual Property Office Official Gazette, officially released for circulation on 22 February 2008.

The respondent-applicant in this instant opposition is Brown & Burk Philippines, likewise a domestic corporation with principal address at 302-B RCI Building, 105 Rada St., Legaspi Village, Makati City, Philippines.

The grounds of this instant opposition case are as follows:

"1. The trademark ANGIZAAR-H nearly resembles the Opposer's COZAAR and HYZAAR trademarks registered respectively under Registration no. 060158 issued on March 29, 1995 for "pharmaceutical preparation used in the treatment of hypertension" and Registration No. 064377 issued on April 29, 1997 for "cardiovascular pharmaceuticals", both in class 5 as to be likely to deceive or cause confusion.

Furthermore, the trademark ANGIZAAR-H, just like the Opposer's COZAAR AND HYZAAR trademarks, designates exactly the same class 5 goods for cardiovascular or hypertension related ailments.

Section 123 (d) of R.A. 8293 otherwise known as the Intellectual Property Code provides:
x x x

2. The trademark ANGIZAAR-H is unquestionable confusingly similar to the opposer's COZAAR and HYZAAR trademarks.

2.1 ANGIZAAR-H has exactly the same suffix as that of COZAAR and HYZAAR.

2.2 The similarity in their suffixes renders the words similar in pronunciation as well. Although the prefix "ANGI" sounds different from the prefixes "CO" and "HY", said difference does not substantially change the over-all sound of the words. x x x

2.3 Adding to the likelihood of confusion between ANGIZAAR-H on the one hand and COZAAR on the other hand is that they all designate exactly the same type of pharmaceutical product in class 5.

2.4 Furthermore, the suffix "ZAAR" has become associated with Class 5 goods belonging to or registered to Opposer E.I. Du Pont De Nemours and Company.

2.5 Also, Opposer owns registrations worldwide of other members of the “ZAAR” family of trademarks under Class 5.

3. Due to the obvious similarities between ANGIZAAR-H and the Opposer’s trademarks COZAAR and HYZAAR including other “ZAAR” products local and international, in terms of spelling, pronunciation, over-all appearance and the goods which they respectively designate, the Respondent-Applicant’s use of the trademark ANGIZAAR-H is likely to mislead the public into believing that its goods originated from the Opposer, or conversely, that the Opposer’s goods came from the Respondent-Applicant. The Respondent-Applicant’s use of the trademark ANGIZAAR-H will falsely and misleadingly indicate a connection between it and its product, on the one hand, and the Opposer and the Opposer’s COZAAR and HYZAAR products, on the other hand.

4. The Opposer’s COZAAR and HYZAAR trademarks are internationally well-known. Under Section 123 (e) of the Code, a trademark which is confusingly similar to an internationally well-known mark cannot be registered. x x x The respondent-applicant’s mark is descriptive and is therefore not capable of exclusive appropriation. x x x

5.1 The respondent-applicant’s mark consists of the first two (2) syllables “ANGI” and the suffix “ZAAR”. It is highly significant to note that “ANGI” is descriptive of the designated goods.

5.1.1 “ANGI”, a Latin word, literally means “receptacle, vessel, often a blood vessel; covered by a seed or vessel, a seed vessel; a learned borrowing from Greek meaning vessel, or container.”

5.1.2 In the field of medicine, it is generally associated with the heart vessels hence such terms as “Angina’ and “Angioplasty”, “Angina”, short for “angina pectoris” is Latin for “squeezing of the chest”. It is a chest discomfort that occurs when there is a decreased blood oxygen supply to an area of the heart muscle. “Angioplasty” is a procedure for the repair of a blood vessel.

5.1.3 Through use and practice, the prefix “ANGI” has become associated with heart-related illnesses and/or methods of treatment.

6. As early as 1955, the Supreme Court in *Ong Ai Gui vs Director, Phil. Patent Office*, had the opportunity to discuss the reasons why a descriptive word or a combination thereof cannot be accorded protection as a trademark, x x x

6.1 Otherwise stated, when a certain word or combination of words is commonly used and understood to refer to or describe a certain thing, said word or word combination attains the status of property free for all to utilize to describe their products or merchandise. Hence, no person or entity may appropriate for themselves these types of words or combination of words.

6.2 The respondent-applicant’s trademark covers pharmaceutical products used for the treatment of hypertension. Hence, consistent with law and jurisprudence, respondent-applicant may not claim the term “ANGI” for being clearly descriptive or indicative of such goods.

7. In addition, the component “-H” found after ANGIZAAR may also not be appropriated pursuant to Rule 123 U) of the Code. “H” refers to one of the ingredients that may be found in respondent-applicant’s product.

7.1 One of the components of ANGIZAAR-H is “hydrochlorothiazide”. Pharmaceutical companies add “-H” to the brand names of pharmaceutical preparations that contain the drug component “hydrochlorothiazide”. Hence, the presence of “-H” in a drug’s brand informs consumers of the presence of “hydrochlorothiazide” in the product.

7.2 For the same reasons that respondent-applicant may not appropriate the prefix “ANGI”, the component “-H” should also not be allowed for being obviously descriptive.

8. Considering that “ANGI” in ANGIZAAR-H is descriptive while “ZAAR” is exactly the same suffix as in Opposer’s registered COZAAR and HYZAAR trademarks, the Respondent-Applicant’s ANGIZAAR-H trademark cannot and should not be registered.

8. It emerges from -the foregoing discussion that the interests of the Opposer, as the owner of the registered trademarks COZAAR and HYZAAR, will be damaged and prejudiced by the continued use and adoption as well as registration of the trademark ANGIZAAR-H by the Respondent-Applicant.”

The allegation of facts is as follows

“1. The Opposer is the owner of Philippine Trademark Registration No. 60158 for COZAAR issued on 29 March 1995 and effective until 29 March 2015 for “pharmaceutical preparation used in the treatment of hypertension”. x x x

2. The Opposer is likewise the owner of Philippine Trademark Registration No. 64377 for HYZAAR issued on 22 April 1997 and effective until 22 April 2017 for “cardiovascular pharmaceuticals”. x x x

4. The Opposer has registered and/or applied for the registration of the trademarks COZAAR and HYZAAR in numerous jurisdictions all over the world. x x x

5. The opposer has registered and/or applied for the registration of other trademarks using the “ZAAR” suffix. x x x

6. In the U.S.A., the trademarks COZAAR and HYZAAR are registered respectively x x x

7. The trademark COZAAR has been used in the Philippines since 1995 and is used in the treatment of hypertension while the trademark HYZAAR has been in use in the Philippines since 1997 for cardiovascular pharmaceuticals.

8. COZAAR and HYZAAR products are sold in many countries worldwide, including but not limited to the Philippines. x x x

9. Net revenue from local and global sales of COZAAR and HYZAAR produces in the period 2005-2007 x x x

10. The Opposer invests heavily in advertising and publicizing the trademarks COZAAR and HYZAAR worldwide, adding to the popularity of the trademarks and the products they designate. x x x”

Subsequently, this Bureau issued a Notice to Answer dated 17 July 2008 to Santosh Bel vi, for respondent-applicant, requiring the filing of Answer within thirty (30) days from receipt. The notice was duly received on 24 July 2008 by a certain Carmina Regudo, but despite sufficient lapse of time, this Bureau did not receive an Answer nor any motion related thereto from respondent-applicant or its agent. Thence, in accordance to Section 11 of Office Order No. 79, series of 2005 or the Amendments to the Regulations on Inter-Partes Proceedings, this instant case is deemed submitted for decision on the basis of the opposition and its evidence, offered as follows: Exhibit “A”, inclusive of sub-markings; and Annexes “A” to “G”.

Be it noted that documentary evidence which are mere photocopies of original documents are inadmissible in evidence pursuant to Section 7.1, Order No. 79, series of 2005 or the Amendments to the Regulations on Inter Partes Proceedings, which provides in substance that in filing the petition or opposition, the affidavits of witnesses and originals of the documents and other requirements shall be filed, provided, that in case of public documents, certified copies shall be allowed in lieu of the originals.

The Issues -

I. Whether or not opposer's trademarks "COZAAR" and "HYZAAR" are confusingly 'similar to respondent-applicant's trademark "ANGIZAAR-H" covering goods under classification 05.

II. Whether or not opposer's trademarks are well-known marks.

The instant opposition is mainly anchored on the following grounds: (1) confusing similarity of contending marks covering the same classification of goods; and (2) international well-known status of its mark "COZAAR" and "HYZAAR".

In a contest involving registration of trademark, the determinative factor is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would *likely* cause confusion or mistake on the part of the buying public.

It does not require that the competing trademarks must be so identical as to produce actual error or mistake. It is rather sufficient that the similarity between the two trademarks is such that there is a possibility or likelihood of the older brand mistaking the newer brand for it.

On the issue of confusing similarity, the contending trademarks are hereunder reproduced for comparison:



Respondent-Applicant's Trademark

The existence of confusion of trademark or the possibility of deception to the public hinges on "colorable imitation", which has been defined as "such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade name in their overall presentation or in their essential and substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article." (Emerald Garment Mfg. Corp. vs Court of Appeals, 251 SCRA 600)

In resolving the issue of confusing similarity, the law and jurisprudence has developed two kinds of tests — the *Dominancy Test* as applied in a litany of Supreme Court decisions including *Asia Brewery, Inc. vs Court of Appeals*, 224 SCRA 437; *Co Tiong vs Director of Patents*, 95 Phil. 1; *Lim Hoa vs Director of Patents*, 100 Phil. 214; *American Wire & Cable Co. vs Director of Patents*, 31 SCRA 544; *Philippine Nut Industry, Inc. vs Standard Brands, Inc.*, 65 SCRA 575; *Converse Rubber Corp. vs Universal Rubber Products, Inc.*, 147 SCRA 154; and the *Holistic Test* developed in *Del Monte Corporation vs Court of Appeals*, 181 SCRA 410; *Mead*

Johnson & Co. vs N.V.J. Van Dorp, Ltd., 7 SCRA 771; Fruit of the Loom, Inc. vs. Court of Appeals, 133 SCRA 405.

As its title implies, the Test of Dominancy focuses on the similarity of the prevalent features, or the main, essential and dominant features of the competing trademarks which might cause confusion or deception. The Holistic Test on the other hand, requires that the entirety of the marks in question be considered in resolving confusing similarity. Comparison of words is not the only determining factor. In the case of Mighty Corporation vs E & 3 Gallo Winery, 434 SCRA 473, "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 whether one is confusingly similar to the other.

The Honorable Supreme Court has consistently relied on the Dominancy Test in determining questions of infringement of trademark. As to what constitutes a dominant feature of a label, no set of rules can be deduced. Usually, these are signs, color, design, peculiar shape or name, or some special, easily remembered earmarks of the brand that easily attracts and catches the eye of the ordinary consumer.

In *Marvex Commercial Co. Inc. vs Petra Hawpia & Co.*, 18 SCRA 1178, the Supreme Court held:

"The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Marks*, 1947, vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop", "Jantzen" and "Jazz-Sea"; "Silver-splash" and "Supper-Flash"; "Cascarete" and "Celborite", "Celluloid" and "Cellonite", "Charteuse" and "Charseurs", "Cutes and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo-hoo" Leon Amdur, In his book "Trademark Law and Practice", pp. 419-421, cites, as coming within the purview of the idem sonans rule "Yusea" and "U-C-A", "Steinway Pianos" and "Stienberg Pianos" and "Seven-Up" and "Lemon-Up". In *Co Tiong vs Director of Patents*, this Court unequivocally said that "Celdura" and "Condura" are confusingly similar in sound; this Court held in *Sapolin Co. vs Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same."

In the instant case, this Bureau finds several dominant features in the competing trademarks equating a likelihood of confusion. *First*. The visual and aural similarities between the marks are obvious because of the ending syllables "ZA-AR". *Second*. The font and style of the contending marks (Exhibits "A-1" and "A-2" of the opposer; file wrapper records) appear similar, absent any device or design to distinguish the concerned marks. *Third*. Records, consisting of opposer's Exhibits "A-1" and "A-2", and respondent-applicant's "ANGIZAAR" file wrapper records reveal that the contending marks cover the same class 05 of goods classification. They are competing goods because they serve the same purpose, for the treatment of hypertension; and, they flow through the same channel of trade, as they are marketed in drugstores. *Final point*. The contending marks have similar generic names. Opposer's "COZAAR" is registered under the generic name "Losartan Potassium", and "HYZAAR is registered under the generic name "Losartan + Hydrochlorothiazide". On the other hand, respondent-applicant's "ANGIZAAR-H" appears to be registered under the generic name "Losartan Potassium + Hydrochlorothiazide".

It has to be noted that the provisions of Section 6, Republic Act No. 6675 or "The Generic Act of 1988", as amended by Section 38 of Republic Act No. 9502 or "The Universally Accessible Cheaper and Quality Medicine Act of 2008", enjoins the following to use the generic name of all medicines, to wit:

"Section 6. Who Shall Use Generic Terminology.
x x x

- (a) All government health agencies and their personnel as well as other government agencies shall use generic terminology or generic names in all transactions related to purchasing, prescribing, dispensing and administering of drugs and medicines.
- (b) All medical, dental and veterinary practitioners, including private practitioners, shall write prescriptions using the generic name. The brand name may be included if so desired.
- (c) Any organization or company involved in the manufacture, importation, repacking, marketing and/or distribution of drugs and medicines shall indicate prominently the generic name of the product. In the case of brand name products, the generic name shall appear prominently and immediately above the brand name in all product labels as well as in advertising and other promotional materials.”

Therefore, considering the similarity in the generic names and the confusing similarity in the brand names, the possibility of confusion in the public mind is not far from happening as the physician’s prescription will bear similar generic and brand names.

The collateral issue raised by herein opposer, that respondent-applicant’s applied mark is descriptive, need not be resolved following the in-depth discussion of the existence of confusion between the contending trademarks.

Anent the issue of well-known mark, this Bureau cannot declare opposer’s trademarks “COZAAR” and “HYZAAR” as well-known marks because opposer failed to submit eloquent proof to substantiate its allegation that its marks has gained and enjoyed a worldwide reputation internationally and in the Philippines. The further requirement in Section 123.1 (e), R.A. 8293, that account shall be taken of the knowledge of the relevant sector of the public including knowledge in the Philippines obtained as a result of the promotion of the mark, was not similarly proved. Further, the criteria enshrined under the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers (Rule 102), were not satisfied by the presentation of registrations in foreign countries. The fact that the mark is well-known has to be established in foreign places as well as in the Philippines not alone through registrations but also by evidence of use, adoption and patronization of goods and services by the consumers as to cause the acquisition of mark distinction and reputation.

“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:

- (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.”

WHEREFORE, premises considered the Notice of Opposition filed by E.I. Du Pont De Nemours and Co., is as it is hereby SUSTAINED. Accordingly, Application Serial No. 4-2007-005885 filed by respondent-applicant, Brown & Burk Philippines, Inc., in 08 June 2007 for the mark “ANGIZAAR-H” under Class 5, is as it is hereby, REJECTED.

Let the file wrapper of “ANGIZAAR-H” subject matter of this case be forwarded to the Bureau of Trademarks for appropriate action in accordance with this decision.

SO ORDERED.

Makati City, 27 July 2009.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office