

WESTMONT PHARMACEUTICALS INC.,	}	Inter Partes Case No. 14-2008-00329
	}	Case Filed : 02 December 2008
<i>Opposer,</i>	}	Opposition to:
	}	
-vs-	}	Appl'n. Serial No. : 4-2008-008316
	}	Date Filed : 11 July 2008
SUHITAS PHARMACEUTICALS INC.,	}	Trademark : "LEV-OD"
	}	
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2009-77

DECISION

This is an opposition to the registration of the mark "LEV-OD" bearing Application Serial No. 4-2008-008316 filed on 11 July 2008 covering the goods "*antibacterial preparations used in the treatment of infections, infected bites and sting, bone and joints infections, brucellosis, gastroenteritis, gonorrhoea, meningitis, lower respiratory tract infections, skin and urinary tract infection*" falling under Class 5 of the International Classification of goods which trademark application was published for opposition on page four (4) of the Intellectual Property Philippines (IPP) Electronic Gazette (E-Gazette), which was officially released for circulation on 03 October 2008.

The Opposer in the instant case is "WESTMONT PHARMACEUTICALS, INC.", a corporation duly organized and existing under the laws of the Philippines with principal office address located at 4th Floor Bonaventure Building, Greenhills, San Juan City.

On the other hand, the Respondent-Applicant is "SUHITAS PHARMACEUTICALS, INC.", a domestic corporation with principal office address at 3rd Floor Centerpoint Building, Pasong Tamo corner Export Bank Drive, Makati City.

The grounds of the opposition are as follows:

- "1. The trademark "LEV-OD" so resembles "LEVOX" trademarks owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark "LEV-OD". The trademark "LEV-OD", which is owned by Respondent-Applicant, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark "LEV-OD" is applied for the same class and good as that of trademarks "LEVOX", i.e. Class (5) used as antibacterial;
- "2. The registration of the trademark "LEV-OD" in the name of the Respondent-Applicant will violate Section 123 of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", which provides, in part, that a mark cannot be registered if it:
 - (d) Is identical with a registered mark belonging to a different proprietor or 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; (Emphasis supplied)

Under the above-quoted provision, any mark which is similar to a registered mark shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely to result.

- “3. Respondent-Applicant’s use and registration of the trademark “LEV-OD” will diminish the distinctiveness and dilute the goodwill of Opposer’s trademark “LEVOX”.

Opposer relied on the following facts in support of its opposition:

- “1. Opposer, the registered owner of the trademark “LEVOX”, is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark “LEVOX” was filed with the Intellectual Property Office on 15 October 1998 by Opposer and was approved for registration on 14 December 2003 and valid for a period of ten (10) years or until 14 December 2013. The Opposer’s registration of the “LEVOX” trademark subsists and remains valid to date. A copy of the Certificate of Registration No. 4-1998-007705 for the trademark “LEVOX” is hereto attached as Annex “B”.

- “2. The trademark “LEVOX” has been extensively used in commerce in the Philippines.

- “3. There is no doubt that by virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark “LEVOX”, and the fact that they are well-known among consumers as well as to internationally known pharmaceutical information provider, the Opposer has acquired an exclusive ownership of the “LEVOX”

- “4. “LEV-OD” is confusingly similar to “LEVOX”.

- “5. Moreover, Opposer’s intellectual property right over its trademark is protected under Section 147 of Republic Act No. 8293, otherwise known as the Philippine Intellectual Property Code (“IP Code”), which states:



“The owner of a registered mark shall have the exclusive right to prevent all parties not having the owner’s consent from using in the course of trade identical or similar to those in respect of which the trademark is registered where such use would result in likelihood of confusion.” [Emphasis supplied]

- “6. To allow Respondent-Applicant to continue to market its products bearing the “LEV-OD” mark undermines Opposer’s right to its marks. As the lawful owner of the mark “LEVOX”, Opposer is entitled to prevent the Respondent from using a confusingly similar mark in the course of trade where such would likely mislead the public.

- “7. By virtue of Opposer’s prior and continued use of the trademark “LEVOX”, the same have become well-known and established valuable goodwill to the consumers and general publics as well. The registration and use of Respondent’s confusingly similar trademark on its goods will enable the latter to obtain benefit from Opposer’s reputation, goodwill and advertising and will tend to deceive and/or confuse the public into believing that Respondent is in any way connected with the Opposer.

- (iii) If it nearly resemble such a mark as to be likely to deceive or cause confusion;

The contending trademarks are reproduced below for comparison and scrutiny.

	
Opposer's mark	Respondent-Applicant's mark

The two trademarks are both composed of five (5) letters each and two (2) syllables. The first four (4) letters “L”, “E”, “V” and “O” are exactly the same. Their distinction lies in the last letter, of which the Opposer’s mark ends in letter “X” while the Respondent-Applicant’s mark ends in letter “D”, however, this slight distinction is insignificant because it does not negate the presence of confusing similarity. The contending trademarks are almost the same or identical as to sound and appearance. At a glance, you could hardly distinguish one from the other, hence, in totality, the two trademarks are confusingly similar to each other.

In “American Wire & Cable Company vs. Director of Patents et. al., [31 SCRA 544] [G.R. No. L-26557, February 18, 1970]” the Supreme Court ruled:

“The determinative factor in a contest involving registration of trademark is not whether the challenge mark would actually cause confusion or deception of the purchasers, but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. In short, to constitute an infringement of an existing trademark and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake, it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.”

In another case, Emerald Garments Manufacturing Corp. vs. Court of Appeals, (251 SCRA 600) [G.R. No. L-100098, December 29, 1995], the Supreme Court stated:

“The essential element of infringement is *colorable imitation*. This term has been defined as “such a close or ingenious imitation as to calculated to deceive ordinary purchaser, or such resemblance of the infringing mark to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other.”

In the case at bar, the goods or products covered by the contending trademarks are the same/identical, “antibacterial preparations” falling under Class 5 of the International Classification of goods.

Another vital consideration to be taken is the fact that the contending trademarks have the same “generic name” which is “levofloxacin” (Annex “2”) for the Respondent-Applicant and (Annex “C”) for the Opposer.

Evidence at hand will show that the Opposer's mark "LEVOX" has been registered with the Intellectual Property Office bearing Registration No. 4-1998-007705, date of registration December 14, 2003 for the goods "*broad-spectrum antibacterial medicinal preparation*" under Class 5 (Annex "B").

Section 138 of Republic Act No. 8293 provides:

"Section 138. *Certificates of Registration.* – A certificate of registration of a mark shall be *prima facie* evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate."

The Supreme Court in the case "Chuan Chow Soy & Canning Co. vs. The Director of Patents and Rosario Villapanta [G.R. No. L-13947, June 30, 1960]" stated:

"When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill."

WHEREFORE, in view of all the foregoing, the opposition is, as it is hereby SUSTAINED. Consequently, Trademark Application No. 4-2008-008316 for the mark "LEV-OD" filed on July 11, 2008 by SUHITAS PHARMACEUTICALS, INC. is, as it is hereby REJECTED.

Let the filewrapper of the trademark "LEV-OD" subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 23 June 2009.

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