



THERAPHARMA, INC.,

*Opposer,*

IPC No. 14-2010-00318

Opposition to:

Appln. Serial No. 4-2010-007777

Date Filed: 16 July 2010

TM: "CHOLEFEN"

- versus -

D.B. MANIX INTERNATIONAL CORP.,

*Respondent-Applicant.*

Decision No. 2012- 20

x-----x

## DECISION

THERAPHARMA, INC. ("Opposer")<sup>1</sup> filed on 17 December 2010 an opposition to Trademark Application Serial No. 4-2010-007777. The application, filed by D.B. MANIX INTERNATIONAL CORP. ("Respondent-Applicant")<sup>2</sup>, covers the mark "CHOLEFEN" for use on "*Dyslipidaemic agent for treatment of very high elevations of serum triglyceride levels*" under Class 5 of the International Classification of Goods.<sup>3</sup> The Opposer alleges that "CHOLEFEN" resembles its registered mark "CHOLINERV" and will likely cause confusion, mistake and deception. According to the Opposer, "CHOLEFEN" is applied for the same class and goods covered by the mark "CHOLINERV", and if registered in the name of the Respondent-Applicant will violate Sec. 123 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

The Opposer's evidence consists of copies of the pertinent page of the "IPO E-Gazette", dated 18 October 2010 indicating trademark applications published for opposition including Application No. 4-2010-007777, certified copy of Cert. of Reg. No. 4-2007-006994 for the mark "CHOLINERV", certified copy of the Declaration of Actual Use pertaining to the mark "CHOLINERV", sample product label bearing the mark "CHOLINERV", copy of the certification and sales data for "*CO4A-Cereb+Periphe Vaso therap Market in values, share, and growth for the period MAT August 2010 (September 2009-August 2010)*" signed by Bienvenido C. Lazaro, Sales and Marketing Manager, IMS Health Philippines, Inc., and a certified copy of the certificate of the product registration issued by the Bureau of Food and Drugs for the mark/brand "CHOLINERV".<sup>4</sup>

On 07 April 2011, this Bureau issued Order No. 2011-457 granting the Respondent-Applicant's motion for the extension of the period within which to file the Answer. Said party was given until 15 April 2011 to file the Answer. However, the Respondent-Applicant failed to do so. Hence, the instant case was deemed submitted for decision.

Should the registration of the mark CHOLEFEN be allowed?

<sup>1</sup> A domestic corporation duly organized and existing under the laws of the Philippines, with principal business address at 3<sup>rd</sup> floor Bonaventure plaza, Ortigas Avenue, Greenhills San Juan City Philippines

<sup>2</sup> With principal business address at 67 Scout Fuentebella, Tomas Morato, Quezon City, Philippines

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement concerning the International Classification of goods and services for the purpose of the Registration of marks cancelled in 1957.

<sup>4</sup> Exhibits "A" to "F" (inclusive).

Sec. 123.1(d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to different proprietor or mark with an earlier filing or priority date, in respect of the same goods or services, or closely related goods and services; or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 16 July 2010, the Opposer has an existing registration for the mark "CHOLINERV" under Reg. No. 4-2007-006994 issued on 25 February 2008. However, the competing marks, as shown below, are not identical:

**Cholinerv**

*Opposer's mark*

**CHOLEFEN**

*Respondent-Applicant's mark*

Also, the goods covered by the Opposer's mark - "*pharmaceutical preparation for acute and recovery phase of cerebral infarction; cognitive dysfunction to degenerative and cerebrovascular disease; cerebral insufficiency due to head trauma or brain injury*" - are different from the goods indicated in the Respondent-Applicant's application. While the goods covered by competing marks all pertain to pharmaceutical products, the Opposer's are different from the Respondent-Applicant's as to composition and intended purposes.

If ever there is resemblance between the competing marks, this is insufficient to cause the likelihood of deception or confusion. Both marks start with the syllable "CHO". But while the marks' respective fourth letter is the same ("L"), the succeeding letters made the competing marks clearly distinct from one another. The last two syllables of the Opposer's mark, "LINERV" is obviously different from the Respondent-Applicant's "LEFEN". In appearance and sound, one can easily distinguish one from the other.

Significantly, a mark that starts with the syllable "CHO" or syllables "CHOLE" used on pharmaceutical products is apparently not unique. The Trademark Registry, which this Bureau can take judicial notice of, is replete with registered marks that start with "CHO" or "CHOLE" and used on pharmaceutical products. Such registered marks, belonging to different proprietors, appear to be suggestive of the product, like treating or managing "*cholesterol*". Thus, what will make a mark that starts with the prefix or syllable "CHO" distinctive are the succeeding or other words or letters, as well as features or devices if any, found or incorporated therein. Corollarily, the point of comparison for purposes of determining whether two marks that start with the prefix or syllable "CHO" and used on the aforementioned pharmaceutical products confusingly similar, are the other words and letters, or features or devices if any, that comprise the mark.

Succinctly, the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the

public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.<sup>5</sup> This Bureau finds the Respondent-Applicant's mark consistent with this function.

WHEREFORE, Premises considered, the instant opposition is hereby DISMISSED. Let the filewrapper of Trademark application Serial No. 4-2010-007777 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 February 2012.

  
ATTY. NATHANIEL S. AREVALO  
Director IV  
Bureau of Legal Affairs



---

<sup>5</sup> See *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.