



BIONORICA AG,
Opposer,

-versus-

BREL PHARMACEUTICAL, INC.,
Respondent – Applicant.

X-----X

}
} **IPC No. 14-2010-00052**
} **Opposition to:**
} **Appl. Serial No. 4-2009-003126**
} **Date filed: 25 March 2009**
} **TM: "SYRUPRED"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 33 dated February 10, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 10, 2014.

For the Director:

Edwin A. Dating
Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



BIONORICA AG,	}	IPC No. 14-2010-00052
Opposer,	}	Opposition to:
	}	
- versus -	}	Application No. 4-2009-003126
	}	Date Filed: 25 March 2009
BREL PHARMACEUTICAL, INC.,	}	Trademark: SYRUPRED
Respondent-Applicant.	}	
x-----x	x	Decision No. 2014 - <u>33</u>

DECISION

BIONORICA A.G.¹ ("Opposer") filed on 23 February 2010 a Verified Opposition to Trademark Application No. 4-2009-003126. The application, filed on 25 March 2009 by BREL PHARMACEUTICAL, INC.² ("Respondent-Applicant") covers the mark SYRUPRED for use on "*pharmaceutical preparations*" under Class 5 of the International Classification of goods.³

The Opposer anchors its opposition on Section 123.1, paragraphs (d) and (f) of Republic Act No. 8293 or the Intellectual Property Code of the Philippines ("IP Code"). The Opposer alleges that its earlier registered mark SINUPRET nearly resembles the Respondent-Applicant's mark SYRUPRED as to be likely to deceive or cause confusion in respect of the same or closely related goods.

To further support its Opposition, the Opposer alleges the following facts:

1. Opposer's mark SINUPRET was first applied for registration in the Philippines on February 5, 1991. The registration was granted on May 28, 1993 under Registration No. 55206 which registration is in force and effect until now. x x x
2. Opposer's mark is actually used in the Philippines by Zuellig Corporation under authority from the Opposer as cited in the Affidavits of Use filed by Opposer to maintain Registration No. 55206. x x x
3. Opposer's mark has been used and registered by Opposer not only in the Philippines but also in various countries abroad. x x x
4. Opposer has the priority of use and registration of the mark SINUPRET in the Philippines and elsewhere and is therefore entitled to be protected from unfair competition in the market and

¹ A corporation duly organized under and by virtue of the laws of Germany, with business address at Kerschensteiner Strasse 11-15, 92318 Neumarkt, Germany.

² An entity with business address at Suite 709 National Life Building, #6762 Ayala Avenue, Makati City.

³ Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

infringement of its registration. Opposer's mark has been registered since 1993 and has been actually used in the Philippines for corresponding amount of time. Opposer has spent considerably in advertising and marketing its SINUPRET product in the Philippines. Respondent's mark, if allowed for registration, will cause Opposer damage and injury since it closely resembles Opposer's mark and is likely to cause error and confusion on the part of the indiscriminating purchaser. The two marks are closely similar and have the same number of syllables and letters. Respondent's mark SYRUPRED sounds nearly like SINUPRET raising the distinct possibility that one product may be mistakenly dispensed for the other.

5. Under the facts, it is apparent that Respondent-Applicant's mark SYRUPRED should not be allowed to proceed to registration for being confusingly similar to Opposer's mark SINUPRET which was earlier used and registered for the same or closely related goods.

The Opposer's evidence consists of the Opposition⁴ with annexes⁵, legalized Verification with Certification Against Forum Shopping⁶, notarial certification in lieu of Secretary's Certificate⁷, and legalized affidavit with attachment⁸.

This Bureau issued on 19 March 2010 a Notice to Answer and personally served a copy thereof to Respondent-Applicant on 06 April 2010. The Respondent-Applicant, however, has not filed its Answer. Accordingly, the instant case is deemed submitted for decision on the basis of the opposition, affidavit of witness, and documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark SYRUPRED?

The essence of trademark registration is to give protection to the owners of trademarks. 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.⁹ Thus, Section 123.1 (d) of R. A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") 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, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

⁴ Exhibit "A".

⁵ Copy of Certificate of Registration No. 55206 for the trademark SINUPRET (Annex "A"), actual specimen label showing the mark as actually used in the Philippines (Annex "B") and invoices showing sales of the product SINUPRET in the Philippines (Annex "C").

⁶ Exhibit "B".

⁷ Exhibit "B-1".

⁸ Exhibit "C".

⁹ See *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

The records and evidence show that at the time the Respondent-Applicant filed its application for the mark SYRUPRED on 25 March 2009, the Opposer already has an existing registration (No. 55206) for the trademark SINUPRET issued on 28 May 1993. The Opposer's mark covers goods under Class 5, namely, "pharmaceutical preparations" for the treatment of various ailments, as shown in its Certificate of Registration¹⁰. The Respondent-Applicant's trademark application, on the other hand, is also for goods under Class 5, specifically "pharmaceutical preparations". The marks, therefore, are both used on similar or closely related goods.

But do the marks, as shown below, resemble each other that confusion or even deception, is likely to occur?

SINUPRET

Opposer's Mark

SYRUPRED

Respondent-Applicant's Mark

Both marks consist of three (3) syllables and eight (8) letters. The Opposer's mark starts with syllable "SI" while the Respondent-Applicant's with the syllable "SY". Both "SI" and "SY", however, could be pronounced like the words "see" or "sigh". Corollarily, the ears can also hardly distinguish between "NUPRET" and "RUPRED".

Time and again, the court has taken into account the aural effects of the words and letters contained in the marks in determining the issue of confusing similarity. In a line of cases, it has already been ruled that similarity of sound is sufficient ground to rule that the marks are confusingly similar. In the case of *Marvex Commercial Co., Inc. vs. Petra Hawpia & Co. and the Director of Patents*¹¹, the Supreme Court categorically ruled that:

"Two letters of "SALONPAS" are missing in "LIONPAS": the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance (Co Tiong Sa vs. Director of Patents, 95 Phil. I, citing Nims, The Law of Unfair Competition and Trademarks, 4th ed., Vol. 2, pp. 678-679). The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must depend entirely on the ear (Operators, Inc. vs. Director of Patents, supra).

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 "Jass-Sea"; "Silver Flash" and "Supper Flash"; "Cascarete" and Celborite";

¹⁰ See Annex "A" of the Verified Opposition.

¹¹ G. R. No. L-19297, December 22, 1966.

"Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "Trade-Mark 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 "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" 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 case at bar, "SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see *Celanese Corporation of America vs. E. I. Du Pont*, 154 F. 2d. 146, 148)."

Succinctly, because the Opposer's and Respondent-Applicant's marks both deal with pharmaceutical products, the changes in the spelling therefore did not diminish the likelihood of the occurrence of mistake, confusion or even deception. As trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent 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.¹² The likelihood of confusion subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:¹³

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or

¹² *American Wire and Cable Co. v. Director of Patents, et. al.*, G. R. No. L-26557, 18 February 1970.

¹³ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

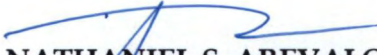
into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

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

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-003126 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 February 2014.


Atty. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs