



INNOVITELLE, INC.,  
Opposer,

-versus-

ALKEM LABORATORIES, LTD.,  
Respondent-Applicant.

x-----x

}  
} IPC No. 14-2009-00253  
} Opposition to:  
} Appln. Serial No. 4-2009-001555  
} Date Filed: 13 February 2009  
} TM: "SWICH"

**NOTICE OF DECISION**

**OCHAVE & ESCALONA**  
Counsel for Opposer  
66 United Street, Mandaluyong City

**FORTUN NARVASA & SALAZAR**  
Counsel for the Respondent-Applicant  
23<sup>rd</sup> Floor, Multinational Bancorporation Centre  
6805 Ayala Avenue, Makati City

**GREETINGS:**

Please be informed that Decision No. 2014 - 05 dated January 13, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 13, 2014.

For the Director:

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



**INNOVITELLE, INC.,**

Opposer,

-versus-

**ALKEM LABORATORIES, LTD.,**

Respondent-Applicant.

x ----- x

IPC No. 14-2009-000253

Opposition to Trademark

Application No. 4-2009-001555

Date Filed: 13 February 2009

Trademark: **"SWICH"**

Decision No. 2014- 05

### DECISION

Innovitelle, Inc.<sup>1</sup> ("Opposer") filed on 26 October 2009 an opposition to Trademark Application Serial No. 4-2009-001555. The contested application, filed by Alkem Laboratories, Ltd.<sup>2</sup> ("Respondent-Applicant"), covers the mark "SWICH" for use on *"pharmaceutical products namely, antibiotic preparations"* under Class 05 of the International Classification of Goods<sup>3</sup>.

According to Opposer, it filed for application for registration of its trademark "SWISH" on 12 March 2008. The application was granted on 20 October 2008 for a period of ten (10) years. It maintains to have extensively used the mark in commerce in the Philippines. It also registered its products with the Bureau of Foods and Drugs (BFAD). It thus avers that by virtue of its certificate of registration, uninterrupted use of the mark "SWISH" and the fact that it is well known among consumers and internationally well-known pharmaceutical providers, it has exclusive ownership over the mark.

Opposer further contends that its registered mark "SWISH" is confusingly similar both in sound and appearance to Respondent-Applicant's mark "SWICH". It claims that the registration of the latter mark would likely cause confusion or mistake in the mind of the public or deceive the purchasers into believing that the "SWICH" products originate or is manufactured or at the very least, connected or associated with its own

<sup>1</sup> A corporation organized and existing under the laws of the Philippines with principal office located at No. 66 United Street, Mandaluyong City.

<sup>2</sup> With address at Devashish, Alkem House, Senapati Bapat Marg, Lower Parel Mumbai India.

<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 concluded in 1957.

"SWISH" products. It also insists that the registration of Respondent-Applicant's mark will diminish the distinctiveness and dilute the goodwill of its registered mark.

In support of its allegations, the Opposer submitted the following as evidence:

1. copy of the IPO E-Gazette which was officially released on 27 July 2009;
2. copy of the Certificate of Registration No. 4-2008-002922; and,
3. sample product label bearing the trademark "SWISH".

For its part, Respondent-Applicant denies that there is a confusing similarity between the competing marks. It bewails that the side-by-side comparison advanced by the Opposer is extremely short-sided, completely disregarding the different nature of the goods they represent. It asserts that its mark pertains to an antibiotic preparation, to be marketed and sold as a prescription drug with chemical composition *cefepodoxime proxetil*. It insists that mouthwash and prescription medicine pass through different channels of trade and hence, the likelihood of confusion is highly reduced, if not negated. In the same manner, it avers that the attitude of the consumers respecting the said goods differ such that an everyday item of small value like a mouthwash is subjected to less examination as oppose to a medicine.

Respondent-Applicant contends that the product packaging of the two goods should erase the apprehension and fear of the Opposer. It also refutes the claim that it adopted the dominant features of the mark "SWISH" stating its prior use of "SWICH" in foreign jurisdictions. Further, it alleges to have been using the mark in India since 2002.

The following are annexed by Respondent-Applicant in its Answer as evidence:

1. copy of the 12 May 2009 letter of Respondent-Applicant to the Intellectual Property Philippines (IPOPPL) and
2. photograph of the packaging of a "SWICH" product.

The Preliminary Conference was officially terminated on 29 September 2010. The parties were then directed to submit their respective position papers. After which, the case was submitted for decision.

The primordial issue to be resolved is whether Application Serial No. 4-2009-001555 should be allowed.

The instant opposition is anchored on Section 123.1 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code ("IP Code"), which 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 priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

Records reveal that at the time Respondent-Applicant filed its application for its mark "SWICH", Opposer has an existing registration of the mark "SWISH" issued on 20 October 2008 under Certificate of Registration N. 4-2008-002922. Clearly, the latter is the prior registrant.

The competing marks are shown below for comparison:

**Swish**

*Opposer's mark*

**SWICH**

*Respondent-Applicant's mark*

Upon scrutiny of the competing marks, this Bureau finds that there is no confusing similarity between the two. Although they have common first three letters, the pronunciation of the marks are very different. Opposer's mark when orally read will produce a hushing sound at the end while that of the Respondent-Applicant's is pronounced as "k". Hence, it will be easy to differentiate /swish/ from /swik/.

More importantly, the confusion, much more deception, is improbable in the instant case as the marks pertain to different goods. Opposer's registration covers "*non-antiseptic mouthwash, mouth rinse, breath fresheners cosmetic tooth whiteners, tooth whitening strips, breath freshening dissolving strips and toothpaste*" and "*medicated mouthwash, antiseptic and medicated rinse*" while Respondent-Applicant's application seeks to register its mark for the use on "*pharmaceutical products namely, antibiotic preparations*". The products flow in different channels of trade. While Opposer's goods are ordinary grocery item, that of Respondent-Applicant is a prescription drug. Hence, it is highly unlikely for a purchaser to mistake a mouthwash for a medicine, and vice-versa.

Aptly, the Supreme Court in the case of **Canon Kabushiki Kaisha vs. Court of Appeals<sup>4</sup>**, ruled in this wise:

*"In Faberge, Incorporated vs. Intermediate Appellate Court, the Director of patents allowed the junior user to use the trademark of the senior user on the ground that the briefs manufactured by the junior user, the product for which the trademark BRUTE was sought to be registered, was unrelated and non-competing with the products of the senior user consisting of after shave lotion, shaving cream, deodorant, talcum powder, and toilet soap. The senior user vehemently objected and claimed that it was expanding its trademark to briefs and argued that permitting the junior user to register the same trademark would allow the latter to invade the senior user's exclusive domain. In sustaining the Director of Patents, this Court said that since '(the senior user) has not ventured in the production of briefs, an item which is not listed in its certificate of registration, (the senior user), cannot and should not be allowed to feign that (the junior user) had invaded (the senior user's) exclusive domain.' We reiterated the principle that the certificate of registration confers upon the trademark owner the exclusive right to use its own symbol only to those goods specified in the certificate, subject to the conditions and limitations stated therein. Thus, the exclusive right of petitioner in this case to use the trademark CANON is limited to the products covered by its certificate of registration." (Emphasis supplied.)*

The Opposer neither alleged nor proved that its mark is well known such that the protection covered by its registration of its mark "SWISH" includes products which are unrelated. It cannot claim that medicine, particularly antibiotics, are within its normal expansion of business. Thus, it could not prevent the registration of the mark "SWICH", which pertains to unrelated goods and targets a completely different market.

Finally, it is emphasized that 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.<sup>5</sup> Respondent-Applicant's mark sufficiently met this function.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-001555

---

4

<sup>5</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 13 January 2014.



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