



SCHERING CORPORATION,
Opposer,

-versus-

SYNERGEN ASIA PTE. LTD.,
Respondent-Applicant.

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IPC No. 14-2009-00170
Opposition to:
Appln. Serial No. 4-2008-012536
(Filing Date: 15 October 2008)
TM: "CLARITAB"

X-----X

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 52 dated March 18, 2013 (copy enclosed)
was promulgated in the above entitled case.

Taguig City, March 18, 2013.

For the Director:


Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



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IPC No. 14-2009-00170
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Decision No. 2013- 52

DECISION

SCHERING CORPORATION ("Opposer")¹ filed on 10 July 2009 an opposition to Trademark Application Serial No. 4-2008-012536. The application, filed by SYNERGEN ASIA PTE. LTD. ("Respondent-Applicant")², covers the mark "CLARITAB" for use on "*Pharmaceutical (antibacterial of respiratory tract infection)*" under Class 5 of the International Classification of Goods or Services.³

The Opposer alleges, among other things, that the mark CLARITAB is confusingly similar to its registered mark "CLARITIN". According to the Opposer, registration of the mark CLARITAB in favor of the Respondent-Applicant will violate Section 123 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). To support its opposition, the Opposer submitted as evidence the Sworn Statement of its Vice-President Nancy L. Rowe and the attachments thereto, as follows:

1. copy of Philippine Certificate of Reg. No. 47860 issued on 10 April 1990 for the mark CLARITIN;
2. copy of United States Certificate of Reg. No. 1,498,292 issued on 02 August 1988 and Notice of Acceptance of Renewal issued on 28 August 2007;
3. a list of alleged registration and trademark application in various countries; and
4. sample labels for CLARITIN products.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 28 August 2009. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant trademark application be allowed?

In this regard, the Opposer anchors its case on Sec. 123.1(d) of the IP Code which provides that a mark shall not 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

¹ A corporation of the State of New Jersey, United States of America ("U.S.A."), with principal office located at 2000 Galloping Hill Road, Kenilworth, New Jersey 07033, U.S.A.

² With address at 10 Anson Road # 21-02, International Plaza, Singapore 069113.

³ 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.

⁴ Marked as Exhibits "A" to "D".

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. It also invokes Sec.123.1, pars. (e) and (f) of the IP Code, to wit:

Sec.123. Registrability. - 123.1 A mark cannot be registered if it:

xxx

(e) Is Identical with, or confusingly similar to, or constitutes a translation of mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large , including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;"

(f) Is Identical with, or confusingly similar to, or constitutes a translation of mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided, further*, That the interest of the owner of the registered mark are likely to be damaged by use;"

The records and evidence shows that at the time the Respondent-Applicant filed its trademark application on 15 October 2008, the Opposer has already an existing trademark registration in the Philippines for CLARITIN bearing No. 47860 issued on 10 April 1990. This registration covers "*Anti-histamine preparations*" under Class 5. While the goods indicated in the Respondent-Applicant's application – "*Antibacterial of respiratory tract infection*" –also fall under Class 5, these are, however, different pharmaceutical products.

In this regard, this Bureau finds that it is unlikely that the co-existence of the marks will cause confusion, much less deception, among the public. It is true that both marks start with the syllables "CLARI". But the last syllable in the Respondent-Applicant's mark – "TAB" – is visually and aurally different from the last syllable in the Opposer's mark, which is "TIN". This difference sufficiently rendered the Respondent-Applicant's mark distinguishable from the Opposer's.

This Bureau cannot sustain the opposition just because the marks both start with the prefix "CLARI". The Opposer should not be given exclusive right over the use of the prefix "CLARI" for pharmaceutical goods or products. "CLARI" is commonly used as a prefix in trademarks used in pharmaceutical products, particularly, "*antibacterial*" or "*antibiotics*". The Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, shows a number of registered marks starting with the syllables or prefix "CLARI", namely, "CLARISCAN"⁵, "CLARIGET"⁶, "CLARIZ"⁷, and "CLARIMID"⁸. The Registry also reveals several registered mark starting with the prefix "KLARI" which looks similar and sounds

⁵ Reg. No. 064449, issued on 22 Apr. 1997 to Amersham Health AS.

⁶ Reg. No. 4-2005-001344, issued on 03 Sept. 2006 to Getz Pharma Private Limited

⁷ Reg. No. 4-2007—004474, issued on 02 June 2008 to Innogen Pharma Group, Inc.

⁸ Reg. No. 4-2007-009607, issued on 21 Jan. 2008 to Interphil Laboratories, Inc.


identical to the prefix "CLARI", to wit, "KLARICID"⁹, "KLARIM"¹⁰, and "KLARIPED"¹¹. The marks "CLARIZ" and "KLARICID" for example, are derived from the generic name of the products to which the marks are used, that is, "*clarithromycin*". That confusion, much less deception, is unlikely in this case is highlighted by the fact that the Opposer's registered mark is not used for "*antibacterial*" or "*antibiotics*". CLARITIN covers "*anti-histamine preparations*".

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.¹² 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. 4-2008-012536 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 18 March 2013.


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



⁹ Reg. No. 4-2003-006334, issued on 03 Sept. 2006 to Abbot Laboratories

¹⁰ Reg. No. 4-2005-000863, issued on 16 Oct. 2006 to AAA Pharma, Inc.

¹¹ Reg. No. 4-2006-005122, issued on 30Apr. 2007 to Pediatrica, Inc.

¹² *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.