



THERAPHARMA, INC.,
Opposer,

-versus-

AAA PHARMA, INC.,
Respondent-Applicant.

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}
} IPC No. 14-2009-00189
} Opposition to:
} Appln. Serial No. 4-2008-013443
} Date filed: 31 October 2008
} TM: "AMBES"
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}
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 – 196 dated October 10, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 10, 2012.

For the Director:

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



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AAA PHARMA, INC.,
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IPC NO. 14-2009-00189

Opposition to:

Appln. Ser. No. 4-2008-013443
(Filing Date: 31 October 2008)

Trademark: **AMBES**

Decision No. 2012 - 196

DECISION

THERAPHARMA, INC.¹ ("Opposer") filed on 29 July 2009 a Verified Opposition to Trademark Application No. 4-2008-013443. The application, filed by AAA PHARMA, INC.² ("Respondent-Applicant") covers the mark AMBES for use on "*anti-hypertensive*" under Class 05 of the International Classification of goods³.

The Opposer alleges that the trademark AMBES resembles its registered mark AMVASC, and will likely cause confusion, mistake and deception on the part of the purchasing public. According to the Opposer, both marks cover goods falling under Class 05 for the treatment of "*hypertension*", hence, the registration of AMBES will violate Sec. 123.1 (d) of Rep. Act No.8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). The Opposer further claims that the registration of AMBES will diminish the distinctiveness and dilute the goodwill of AMVASC.

To support its opposition, the Opposer submitted a computer print-out of the "IPO E-Gazette" containing the list of trademarks published for opposition with releasing date of 30 April 2009, copy of Cert. of Reg. No.4-2006-000470 for the mark AMVASC, copy of the Declaration of Actual Use of the mark AMVASC, sample product label bearing the mark AMVASC, copy of a certification issued on 03 September 2008 by Intercontinental Marketing Services on the sales data for "*calcium antagonists plain*" for the period July 2006 to June 2008, and a copy of the Certificate of Product Registration for the brand name AMVASC issued by the Bureau of Food and Drugs⁴.

The Respondent-Applicant filed its Answer on 22 October 2009 alleging among other things that while AMBES and AMVASC share the same number of syllables, they are pronounced differently with AMVASC ending with two (2) consonants. According to the Respondent-Applicant, there is no aural

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

² A domestic corporation with principal office at 105 Maryland St., Cubao, Quezon City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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 "F".

consistency between the marks. It also argues that AMBES and AMVASC have different generic names and their molecular composition is different.

The preliminary conference was conducted and terminated on 12 January 2010. The Opposer filed its position paper on 15 February 2010 while the Respondent-Applicant did so on 22 February 2010.

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

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.⁵ Thus, 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 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.

In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 31 October 2008, the Opposer already has an existing registration for the trademark AMVASC issued on 19 March 2007, covering goods falling under Class 05, namely, "*medicinal preparation for the treatment of hypertension, chronic stable angina and myocardial ischemia due to vasospastic angina*". The goods indicated in the Respondent-Applicant's trademark application are, therefore, similar and/or closely related to those covered by the Opposer's trademark registration.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

Scrutinizing the composition of the trademarks involved in this case, it is observed that both marks contain two syllables although AMVASC consists of six letters while AMBES only consists of five. Both marks start with "AM" but differ with the last syllable. Opposer's mark ends with the syllable "VASC", which Respondent-Applicant's ends with "BES". The AMBES mark is written in all caps, which is different from the AMVASC mark, which starts with a capital letter and all succeeding letters in the lower case.

Although not entirely the same, there are no appreciable disparities between the two marks so as to avoid the likelihood of confusing one for the other. The subject marks may differ in spelling but they sound alike due to "*hissing*" sound of the combination of the letters of "-ES" in AMBES on one hand, and of the letters "-ASC" in AMVASC on the other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is

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

the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other⁶. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁷.

Succinctly, because the Respondent-Applicant, like the Opposer, will use or uses the mark AMBES on pharmaceutical products that treat "*anti-hypertensive*" the difference in the spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. There is the likelihood that information, assessment, perception or impression about AMBES products delivered and conveyed through words and sounds and received by the ears may unfairly cast upon or attributed to the AMVASC products and the Opposer, and *vice-versa*.

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.⁸ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court.⁹

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

⁶ See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁷ See *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

⁸ See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

⁹ See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

It has been held time and **again** that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.¹⁰

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed 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. 4-2008-013443, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 October 2012.


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

¹⁰See *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990.