



UNITED LABORATORIES, INC.,
Opposer,

-versus-

REACH MED PHARMA,
Respondent- Applicant.

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}
} IPC No. 14-2011-00137
} Opposition to:
} Appln. Serial No. 4-2010-010478
} (Filing Date: 24 September 2010)
} TM: "COLDEZENT"

NOTICE OF DECISION

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


REACH MED PHARMA
Respondent-Applicant
25 Kabignayan Street
Quezon City

GREETINGS:

Please be informed that Decision No. 2014 - 136 dated May 13, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 13, 2014.

For the Director:


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



UNITED LABORATORIES, INC.,
Opposer,

IPC No. 14-2011-00137
Opposition to:

- versus -

Appln. Serial No. 4-2010-10478
(Filing Date: 24 September 2010)
TM: "COLDEZENT"

REACH MED PHARMA,
Respondent-Applicant.

Decision No. 2014- 136

DECISION

UNITED LABORATORIES, INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2010-10478. The application, filed by REACH MED PHARMA ("Respondent-Applicant")², covers the mark "COLDEZENT" for use on "*drugs, namely: analgesic, antipyretic, antihistamine and nasal decongestant*" under Class 5 of the International Classification of Goods or Services.³

The Opposer alleges, among other things, that the mark COLDEZENT so resembles its registered mark "COLDEASE". According to the Opposer, registration of the mark COLDEZENT in favor 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 also contends that the Respondent-Applicant's use and registration of COLDEZENT will diminish the distinctiveness and dilute the goodwill of COLDEASE.

To support its opposition, the Opposer submitted as evidence a printout of page 1 of the "IPO E-Gazette" with releasing date of 07 March 2011 and other documents relating to the mark COLDEASE, particularly, copy of Cert. of Reg. No. 4-2008-005165, sample product label, and copy of the certificate of product registration issued by the Bureau of Food and Drugs.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 03 June 2011. The Respondent-Applicant, however, did not file an Answer.

The opposition is anchored on Sec. 123.1(d) of the 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 filing or 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.

- ¹ A corporation duly organized and existing under the laws of the Philippines with principal office address at No. 66 United Street, Mandaluyong City.
- ² With address at No. 25 Kabigyanan St., Quezon City.
- 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 Annexes "A" to "D".

This Bureau noticed that both marks start with the word "COLD". The goods covered by the Opposer's trademark registration are "*medicine/food supplement for cold*". The Respondent-Applicant's trademark application meanwhile states that COLDEZENT is used also on goods ~~that~~ relate to cold and respiratory illnesses ("*analgesic, antipyretic, antihistamine and nasal decongestant*"). In this regard, the word "COLD" if used on pharmaceutical products that apply to or treat cold and/or respiratory illnesses is descriptive and thus cannot be appropriated exclusively by any party. While adding some letters/syllables to the word "COLD" may have given the resulting mark sufficient distinctive quality to make it eligible for registration, such mark at most is considered a suggestive mark, which is a weak mark. Aptly, this opposition cannot be sustained solely on account of competing marks having the same word which is descriptive of the goods involved. The comparison must be on the letters and/or syllables that are attached to the word "COLD".

In the Opposer's mark, "COLD" is combined with the word "EASE". Meanwhile, the Respondent-Applicant appended to the word COLD the syllables "EZENT". "EZENT" is visually different from "EASE". Also, the ears can easily distinguish the sound created when pronouncing "EZENT", composed of two syllables, from that of the monosyllabic "EASE".

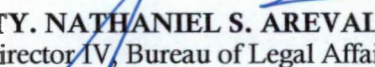
Furthermore, it is emphasized that an opposition case is essentially a review of the trademark application in question. Corollarily, this Bureau evaluates the evidence submitted by the parties and also can take cognizance via judicial notice of the contents of the Trademark Registry and of the official records in connection with the subject trademark application.

In this regard, the filewrapper and the Trademark Registry reveal that the Respondent-Applicant had filed an earlier trademark application for the mark COLDEZENT on 09 March 2007 covering "*drugs, namely: analgesic, antipyretic, antihistamine and nasal decongestant*" under Class 5. The application was allowed and the Respondent-Applicant was issued Registration No. 4-2007-002467 on 30 December 2007. The registration was even earlier than the filing of the Opposer's application for the registration of the mark COLDEASE on 02 May 2008. Hence, while it is true that when the Respondent-Applicant filed its trademark application there is already a pending trademark registration for an identical mark, that registration belongs to the Respondent-Applicant itself. In fact, if one subscribes to the Opposer's argument that COLDEZENT is confusingly similar to COLDEASE, then the said party's application for registration of COLDEASE should have been rejected because at the time it filed the application, the Respondent-Applicant had already obtained Registration No. 4-2007-002467.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-010478 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 13 May 2014.


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