



S.V. MORE PHARMA CORP.,
Opposer,

-versus-

WESTFIELD PHARMACEUTICALS INC.,
Respondent-Applicant.

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}
} IPC No. 14-2015-00034
} Opposition to:
} Appln. Serial No. 4-2014-013644
} Date Filed: 03 November 2014
} TM: "PRO-CEE"
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}
}
}
}

NOTICE OF DECISION

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WESTFIELD PHARMACEUTICAL, INC.
Respondent-Applicant
#831- A, Eugenio Lopez St. cor. EDSA
Quezon City

GREETINGS:

Please be informed that Decision No. 2015 - 133 dated June 29, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 29, 2015.

For the Director:

Edwin O. Datin
Atty. EDWIN DANILO A. DATIN
Director III
Bureau of Legal Affairs



S.V. MORE PHARMA CORP., } IPC NO. 14-2015-0034
Opposer, } Opposition to:
-versus- } Appln. Ser. No. 4-2014-013644
WESTFIELD PHARMACEUTICALS INC., } Date Filed: 3 November 2014
Respondent-Applicant. } Trademark: "PRO-CEE"
x-----x } Decision No. 2015- 133

DECISION

S.V. MORE PHARMA CORP., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-013644. The application, filed by WESTFIELD PHARMACEUTICALS INC. (Respondent-Applicant)², covers the mark "PRO-CEE", for use on "vitamins" under Class 32 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"1. Opposer is the earlier registrant of the trademark 'PRO-C' cased on the Certificate of Registration ('COR') issued to it, to wit:

- a. COR No. 11711- Date of Registration: July 22, 2010
- b. COR No. 12070- Date of Registration: June 19, 2014

For sure, the COR's were issued long before the filing date in November 3, 2014 and/or publication date in December 15, 2014 of Respondent-Applicant's application for registration or its opposed mark 'PRO-CEE'.

"2. Opposer is likewise the 'prior or earlier user' of the trademark 'PRO-CE' having utilized the same since may 20, 2011;

"3. Respondent-Applicant's opposed mark 'PRO-CEE' bears a very strong resemblance aurally if not exactly sound the same as Opposer's registered trademark 'PRO-C'. Moreover, a side by side comparison of the marks would also clearly show they have the same dominant features- xxx or the letters 'P', 'R', 'O' and 'C' to its proposed 'PRO-CEE'.

¹ A corporation duly organized and existing under Philippine laws with address at S.V. More Group Corporate Center, #16 Scout Tuason Street corner Roces Avenue, Brgy. Laging Handa, Quezon City

² A domestic corporation with address at #831-A Eugenio Lopez St. cor EDSA, Quezon City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

"4. To allow the registration of the opposed mark 'PRO-CEE' will not only likely but most definitely in confusion, mistake, deception on the part of the purchasing public considering further that the opposed mark 'PRO-CEE' is being applied under exactly the same class (class 5 of the Nice Classification of goods) and goods (Vitamins) as that of Opposer's trademark 'PRO-C' not to mention that the goods on which the marks are sued are likely to be brought by the same class of purchasers and flow through the same channels of trade.

"5. Moreover, to allow the registration of the mark 'PRO-CEE' in the name of Respondent-Applicant is in contravention of Sec. 123.1 (d) of the Intellectual Property Code of the Philippines, to wit:

xxx

(d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) the same goods or services; or
- (ii) closely related goods or services; or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion;

That Respondent-Applicant's 'PRO-CEE' is identical or related with Opposer's registered trademark 'PRO-C' is also evident from the fact that a comparison of the goods/products bearing the respective marks would readily reveal that they are composed of a similar substance namely: Sodium Ascorbate.

"6. Finally, to allow the use and registration by Respondent-Applicant of the mark 'PRO-CEE' will not only diminish the distinctive character of Opposer's prior registered trademark 'PRO-C' but also dilute the goodwill and reputation established by Opposer for its trademark 'PRO-C' among consumers. It would also compete unfairly with Opposer especially as the parties are engaged in 'competitive' or similar business, in particular, the distribution and sale of pharmaceutical products."

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of E-Gazette showing Respondent-Applicant's trademark application;
2. Motion for Time to file Notice of Opposition;
3. Copy of Certificate of Registration No. 4-2009-011711 issued on 22 July 2010 for the mark "PRO.C" for goods under class 5, namely "Pharmaceutical preparation as vitamin C (Sodium Ascorbate)";
4. Copy of Certificate of Registration No. 4-2013-00012070 issued on 19 June 2014 for the mark "PRO-C" for goods under class 5, namely "Pharmaceutical preparation as vitamin C (Sodium Ascorbate)";
5. Copy of Declaration of Actual Use dated 2 October 2013;
6. List of drugstores selling the product;

7. Sample of actual label of the product "PRO-C";
8. Sales Invoices indicating the name "PRO-C";
9. Print-out of webpage showing of "PRO-C 500";
10. Print-out of webpage showing definition of "CEE" and "sodium ascorbate";
and
11. Secretary's Certificate dated 3 February 2015.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 24 February 2015. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 24 June 2015 Order No. 2015-901 declaring the Respondent-Applicant in default.

Records show that at the time Respondent-Applicant applied for registration of the mark "PRO-CEE" the Opposer already registered the mark "PRO-C" under of Registration No. 4-2009-011711 issued on 22 July 2010⁵ and Registration No. 4-2013-00012070 issued on 19 June 2014⁶. The goods covered by the Opposer's trademark registration are under Class 05, namely: "Pharmaceutical preparation as Vitamin C (sodium ascorbate)", while the Respondent-Applicant's trademark application indicates use as "vitamins" under Class 05.

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

The competing marks are reproduced below:

PRO·C

PRO-CEE

Opposer's mark

Respondent-Applicant's mark

The marks are identical differentiated only by Respondent-Applicant adding the letters "EE". When pronounced, the marks are phonetically similar or *idem sonans*. Visually and aurally, the marks are confusingly similar. The Supreme Court in the case of *Marvex Commercial Co., Inv. V. Petra Hawpia & Co. and the Director of Patents*⁷ is instructive on the matter, to wit:

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. 1 citing *Nims, The Law of Unfair Competition and Trademarks*,

⁴ Exhibit "A" to "M" inclusive of submarkings

⁵ Exhibit "C"

⁶ Exhibit "D"

⁷ G.R. No. L-19297, 22 December 1966

4th ed., vol. 2, pp. 678-679). xxxConsidering their striking similarity, the buying public may likely be confused specially since the marks are used on related goods. Even if the marks are applied on goods of different classification, dietary supplements and sports drinks and beverages may be sold through the same channels of trade.

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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.⁸

The public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-013644 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 June 2015.


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

⁸*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁹*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).