



SCHERING CORPORATION,
Petitioner,

-versus-

**DABUR PHARMA LIMITED (now known
AS FRESENIUS KABI ONCOLOGY LIMITED),**
Respondent-Registrant.

} **IPC No. 14-2009-00227**
} Cancellation of:
} Reg. No. 4-2006-005477
} Date Issued: 21 May 2007
} **TM: "TEMOZAM"**
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 123 dated June 29, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 29, 2015.

For the Director:


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



SCHERING CORPORATION

Petitioner,

-versus-

DABUR PHARMA LIMITED
(now known as **FRESENIUS KABI**
ONCOLOGY LIMITED),

Respondent-Registrant.

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IPC No. 14-2009-00227

Cancellation of:

Reg. No. 4-2006-005477

Date Issued: 21 May 2007

Trademark: **"TEMOZAM"**

Decision No. 2015 - 123

DECISION

SCHERING CORPORATION ("Petitioner")¹ filed a petition for cancellation of Trademark Registration No. 4-2006-005447. The registration, issued to DABUR PHARMA LIMITED now known as FRESENIUS KABI ("Respondent-Registrant")², covers the mark "TEMOZAM" for use on goods under class 05³ namely pharmaceutical medicine used for treating cancer.

The Petitioner alleges that it is the registered owner of the mark TEMODAR for Alkylating Cytotoxic Agent for the treatment of various types of cancer in Class 5 under U.S. Certificate of Registration No. 2,378,174 issued on 15 August 2000. Petitioner has also registered TEMODAL for Alkylating Cytotoxic Agent for the treatment of various types of cancer in Class 5 in the Philippines under Certificate of Registration No. 4-2001-008310 issued on 12 December 2003. Petitioner, either itself or through its affiliated companies Essex Chemic A.G. of Switzerland, Schering-Plough Ltd. of Switzerland and others, all belonging to the Schering family of businesses, with cross shareholding and control, has registered in the Philippines and in over 100 countries the trademarks TEMODAL and/or TEMODAR, the earliest being since 1978 in South Africa, Norway, Denmark and Sweden.

According to the Petitioner, TEMODAL is amongst the world's best known cancer medicines. For more than fifteen (15) years, it has been the single most selling medicine drug worldwide for the treatment of malignant gliomas-glioblastoma multiforme or anaplastic astrocytoma (cancer, particularly brain cancer). TEMODAL is a well-known mark having international fame and recognition and trusted over a generation of cancer patients, doctors and healthcare professionals.

Furthermore, the Petitioner argues that the mark TEMOZAM is confusingly and deceptively similar to TEMODAL as to be likely, when applied to or used in connection with Respondent-Registrant's goods, to cause confusion or mistake and deceive the public or the public may be led to believe that such goods are owned by or originated from or sponsored by the Petitioner.

The Petitioner's evidence consists of the following:

1. United States Patent and Trademark Office Registration of TEMODAR;
2. Certified True Copy of Certificate of Registration of TEMODAL;

¹ A foreign corporation organized under the laws of State of New Jersey, United States. It is affiliated with a local company, Schering-Plough Corporation that is in charge of the sale of TEMODAL in the Philippines.

² A corporation duly organized and existing under the laws of India and has Philippine office located at Fresenius Kabi Philippine, Inc., Equitable Bank Tower, 16th Floor Unit-D, 8751 Paseo de Roxas, Makati City, Philippines

³ Verified Answer to the Petition for Cancellation filed on 17 September 2009.

3. List of Worldwide Trademark Registrations for TEMODAL/TEMODAR; and,
4. Package sample of TEMODAL.

On the other hand, Respondent-Registrant raised the following Affirmative Defenses: (1) Petitioner's Petition for Cancellation must be dismissed outright as it was filed, verified and certified against forum shopping by a person who is not authorized by Petitioner; (2) Respondent-Registrant's mark TEMOZAM is not a colorable imitation of, nor confusingly similar to Petitioner's mark TEMODAL; (3) Respondent-Registrant's mark TEMOZAM is capable of exclusive use and appropriation and is inherently registrable; and (4) Respondent-Registrant's registration of the mark TEMOZAM is not contrary to the provisions of the Paris Convention, the TRIPS Agreement and Section 123.1 (e) and (f) of the Intellectual Property Code of the Philippines.

The Respondent-Registrant's evidence consists of the following:

1. Certificate of Authentication;
2. Certificate of Product Registration for the brand name TEMOZAM;
3. Package sample of TEMOZAM;
4. WHO Drug Information (Recommended INN List 27);
5. The Trademarks Act 1999 (Act 47 of 1999), Government of India; and,
6. Affidavit of Dr. Tommy U. Reyes.

The preliminary conference of this instant case was terminated on 05 October 2010 followed by the submission of the parties' respective position papers.

Should Respondent-Registrant's trademark registration for TEMOZAM be cancelled?

Records show that Petitioner's registration for the trademark TEMODAL on 12 December 2003, preceded that of Respondent-Registrant's registration of its trademark TEMOZAM on 21 May 2007.

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

TEMODAL

Petitioner's Trademark

Temozam

Respondent's Trademark

There is no doubt that the syllables "TE/MO" are derived from the generic name "*TEMOZOLOMIDE*", which covers the goods of the Petitioner and the Respondent-Registrant. This observation is supported by the product samples submitted by the Petitioner as evidence, which indicates the generic name of the pharmaceutical brand "TEMODAL" covers. Pharmaceutical products under the brands or trademarks starting with these syllables are indicative of the illness or diseases on which the

products are applied to, that is for the treatment of cancer. In this regard, the Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, consist of marks that start or contain the syllables "TE/MO" such as TEMOLON (Reg. No. 2034), TEMOLON 20 (Appln. No. 42013055632), and TEMOXOL (abandoned with finality). There are even other pharmaceutical products not for the purpose of cancer treatment, but has the syllables "TE/MO" on it, such as TEMO (Reg. No. 1216808); TEMOFF (Reg. No. 42011010271), TEMOFF ITCH OFF (Reg. No. 42011010272), and TEMOX MULTI-INSECT KILLER (Reg. No. 42011010270).⁴ These marks are owned by entities other than the Petitioner. Hence, to sustain this opposition solely on the ground that the competing marks both consist of "TE/MO" would have the unintended effect of giving the Petitioner exclusive use of the same.

Thus, to determine whether these marks are confusingly similar, there is a need to examine the other letters or components of the marks. The suffix "DAL" from "TEMODAL", as against the suffix "ZAM" from "TEMOZAM" are visually and aurally different. Even though they are both a single syllable added to "TE/MO", the distinct consonants of each mark spell individuality to the marks, suggesting a sufficient ground to eliminate the likelihood of confusing one mark for the other.

This Bureau, therefore is constrained from granting the petition, to do so would have the unintended effect of giving the Petitioner the right to exclude others from appropriating a trademark with the syllables "TE/MO", which appears to be a shortened version of the generic name "TEMOZOLOMIDE".

WHEREFORE, premises considered, the instant petition is hereby DENIED. Let the filewrapper of Trademark Application Registration No. 4-2006-005477 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

⁴ IPOPHEL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/>.