



THERAPHARMA INC.,

Opposer,

-versus-

METZ PHARMACEUTICALS, INC.,

Respondent-Applicant.

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IPC No. 14-2010-00202

Opposition to:

Application No. 4-2009-009905

(Filing Date: 30 September 2009)

Trademark: "HISTAMED"

Decision No. 2015- 189

DECISION

THERAPHARMA INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2009-009905. The application, filed by Metz Pharmaceuticals, Inc.² ("Respondent-Applicant"), covers the mark "HISTAMED" for use on "*pharmaceutical preparations for anti-allergy/antihistamines*" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"GROUNDS FOR OPPOSITION

"The grounds for this verified opposition are as follows:

"7. The mark 'HISTAMED' owned by Respondent-Applicant so resembles the trademark 'HISTACORT' owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark 'HISTAMED'.

"8. The mark 'HISTAMED' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'HISTAMED' is applied for the same class of goods as that of the Opposer's trademark 'HISTACORT', i.e. Class (5) of the International Classification of Goods for Anti-Allergic Drug.

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

²A domestic corporation organized and existing under the laws of the Republic of the Philippines with principal office address at 27 Scout Bayoran Street, South Triangle, Quezon City, Philippines.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957

"9. The registration of the mark 'HISTAMED' in the name of the Respondent will violate Sec. 123 of the IP Code, which provides, in part, that a mark cannot be registered if it:

x x x

"10. Under the above-quoted provision, any mark which is similar to a registered mark shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

"ALLEGATIONS IN SUPPORT OF THE OPPOSITION

"In support of this Opposition, Opposer will rely upon and prove the following facts:

"11. Opposer is the registered owner of the trademark 'HISTACORT'.

"11.1. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. The trademark application for the trademark 'HISTACORT' was filed with the Philippine patent Office on 9 November 1982 by Opposer and was approved for registration on 9 February 1987 to be valid for a period of twenty (20) years, or until 9 February 2007. A certified true copy of the Certificate of Registration No. 36642 for the trademark 'HISTACORT' is hereto attached x x x

"11.2. Before the expiration of the registration, Opposer filed an application for renewal which was accordingly granted to be valid for another period of ten (10) years from 9 February 2007, or until 9 February 2017. x x x

"12. The trademark 'HISTACORT' has been extensively used in commerce in the Philippines.

"12.1. Opposer dutifully filed Affidavits of Use pursuant to the requirement of law to maintain the registration of the trademark 'HISTACORT' in force and effect. x x x

"12.2. A sample product label bearing the trademark 'HISTACORT' actually used in commerce is hereto attached x x x

"12.3. No less than the Intercontinental Marketing Services ('IMS') itself, the world's leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand 'HISTACORT' as one of the leading brands in the Philippines in the category of 'HO2B-Comb Costicosteroids Market' in terms of market share and sales performance. x x x

"13. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark 'HISTACORT' to the exclusion of all others.

"14. As provided in Section 138 of the IP Code, ' A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.'

"15. The registration of Respondent-Applicant's mark 'HISTAMED' will be contrary to Section 123.1(d) of the IP Code. 'HISTAMED' is confusingly similar to Opposer's trademark 'HISTACORT'.

15.1. There are no set rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or is a colorable imitation of, another. Nonetheless, jurisprudence provides enough guidelines and tests to determine the same.

15.1.1. In fact, in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* [356 SCRA 207, 216] the Supreme Court, citing *Ethepe v. Director of Patents*, held '[i]n determining if colorable imitation exists, jurisprudence has developed two kinds of tests - the Dominancy Test and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitute infringement. On the other side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity.

15.1.2. It is worthy to note at this point that in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* [Supra, p. 221,] the Supreme Court held '[T]he totality or holistic test only relies on visual comparison between two trademarks whereas the dominancy test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks.'

15.1.3. Relative thereto, the Supreme Court in *McDonalds' Corporation vs. L.C. Big Mak Burger, Inc.* [437 SCRA 10] held:
x x x

15.1.4. This was affirmed in *McDonald's Corporation vs. Macjoy Fastfood Corporation* (514 SCRA 95, 109 [2007]), which held that, '[t]he Court has consistently used and applied the dominancy test in determining confusing similarity or likelihood of confusion between competing trademarks.'

15.1.5. In fact, the dominancy test is 'now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code, which defines infringement as the colorable imitation of a registered mark xxx or a dominant feature thereof xxx

15.1.6. Thus, applying the dominancy test in the instant case, it can be readily concluded that the mark 'HISTAMED', owned by Respondent-Applicant, so resembles Opposer's trademark

'HISTACORT', that it will likely cause confusion, mistake and deception on the part of the purchasing public.

15.1.6.1. Respondent-Applicant's mark 'HISTAMED' appears and sounds almost the same as Opposer's trademark 'HISTACORT'.

15.1.6.2. The first five letters of Opposer's trademark 'HISTACORT' is exactly the same with Respondent-Applicant's mark 'HISTAMED'.

15.1.6.3. Both marks are composed of three (3) syllables: /HIS/-/TA/-/CORT/ and /HIS/-/TA/-/MED/. First, b514 SCRAoth marks are composed of three syllables;

15.1.7. Clearly, the Respondent-Applicant's mark 'HISTAMED' adopted the dominant features of the Opposer's trademark 'HISTACORT';

15.1.8. As further ruled by the High Court in McDonald's Corporation case [p33]

x x x

15.1.9. In American Wire & Cable Co., vs. Director of Patents (31 SCRA 544, 547-548 [1970]), the Supreme Court explained:

x x x

15.2 Opposer's trademark 'HISTACORT' and Respondent-Applicant's mark 'HISTAMED' are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

15.3. Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed mark 'HISTAMED' is applied for the same class and goods as that of Opposer's trademark 'HISTACORT' under Class 05 of the International Classification of Goods for Anti-Allergic Drug.

15.4. Yet, Respondent-Applicant still filed a trademark application for 'HISTAMED' despite its knowledge of the existing trademark registration of 'HISTACORT', which is confusingly similar thereto in both its sound and appearance, to the extreme damage and prejudice of Opposer.

15.5. Opposer's intellectual property right over its trademark is protected under Section 147 of the IP Code, which states:

x x x

15.6. 'When, as in the present case, one applied for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill.' x x x

"16. To allow Respondent-Applicant to continue to market its products bearing the mark 'HISTAMED' undermines Opposer's right to its trademark 'HISTACORT'. As the lawful owner of the trademark 'HISTACORT', Opposer is entitled to prevent the Respondent-Applicant from using a confusingly similar mark in the course of trade where such would likely mislead the public.

16.1. Being the lawful owner of 'HISTACORT', Opposer has the exclusive right to use and/or appropriate the said mark and prevent all third parties not having its consent from using in the course of trade identical or similar marks, where such would result in a likelihood of confusion.

16.2. By virtue of Opposer's ownership of the trademark 'HISTACORT', it also has the right to prevent the third parties, such as Respondent, from claiming ownership over Opposer's marks or any depiction similar thereto, without its authority or consent.

16.3. Moreover, following the illustrative list of confusingly similar sounds in trademarks cited in McDonald's Corporation case (supra, p. 34 [2004]), it is evident that the mark 'HISTAMED' is aurally confusingly similar to Opposer's trademark 'HISTACORT':

x x x

16.4. Further, the fact that Respondent-Applicant seeks to have its mark 'HISTAMED' registered in the same class (Nice Classification 05) as Opposer's trademark 'HISTACORT', coupled by the fact that both are Anti-Allergic Drug, will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

"17. The registration and use of Respondent-Applicant's confusingly similar mark 'HISTAMED' on its goods will enable the latter to obtain benefit from Opposer's reputation, goodwill and advertising and will tend to deceive and/or confuse the public into believing that Respondent-Applicant is in any way connected with the Opposer.

17.1. As held in *Sterling Products International, Inc. vs. Farbenfabriken Bayer Aktiengesellschaft, et. al.* (27 SCRA 1214, 1227 [1968]) there are two types of confusion in trademark infringement. '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 be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist.'

17.2. The doctrine of confusion of business or origin is based on the cogent reasons of equity and fair dealing. It has to be realized that there can be unfair dealing by having one's business reputation confused with another. 'The owner of a trademark or trade name has a property right in which he is entitled to protection, since there is damage to him from confusion of reputation or

goodwill in the mind of the public as well as from confusion of goods.’ (Ang vs. Teodoro, 74 Phil 50, 55-56 [1942])

17.3. Applying the foregoing to the instant case, to allow Respondent-Applicant to use its mark ‘HISTAMED’ on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the product of Respondent-Applicant with a mark ‘HISTAMED’ originate from or is being manufactured by Opposer, or at the very least, is connected or associated with the ‘HISTACORT’ product of Opposer, when such connection does not exist.

17.4. In Canon Kabushiki Kaisha vs. Court of Appeals (336 SCRA 266, 275 [2000]), the Supreme Court explained that:

x x x

17.5. Clearly, the scope of protection accorded to trademark owners includes not only confusion of goods but also confusion of origin. As in this case, besides from the confusion of the goods already discussed, there is undoubtedly also a confusion of the origin of the goods covered by the marks of Respondent-Applicant and Opposer, which should not be allowed.

“18. In case of grave doubt, the rule is that, ‘[a]s between a newcomer who by confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favor with the public, any doubt should be resolved against the newcomer inasmuch as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.’ (Del Monte Corporation, et. al. vs. Court of Appeals, 181 SCRA 410, 420 [1990])

18.1. In American Wire & Cable Co., vs. Director of Patents (supra, p. 551), it was observed that:

x x x

18.2. When, as in the instant case, Respondent-Applicant used, without a reasonable explanation, a confusingly similar trademark as that of Opposer ‘though the field of its selection was so broad, the inevitable conclusion is that it was done deliberately to deceive.’ (Del Monte Corporation, et. al. vs. Court of Appeals, supra, p. 419-420)

“19. Respondent-Applicant’s use of the mark ‘HISTAMED’ in relation to any of the goods covered by the opposed application, if these goods are considered not similar or closely related to the goods covered by Opposer’s trademark ‘HISTACORT’, will take unfair advantage of, dilute and diminish the distinctive character or reputation of the latter trademark. Potential damage to Opposer will be caused as a result of its inability to control the quality of the products put on the market by Respondent-Applicant under the mark ‘HISTAMED’. Thus, Opposer’s interests are likely to be damaged by the registration and use of the Respondent-Applicant of the mark ‘HISTAMED’. The denial of the application subject of this opposition is authorized under the IP Code.”

The Opposer's evidence consists of the following:

1. printout of the pertinent pages of the "IPO E-Gazette" ("Release Date: 8/9/2010");
2. copies of the Certificate of Reg. No. 3662 for the mark HISTACORT and the certificate of renewal thereof;
3. copies of the affidavits of use filed by Opposer for the mark HISTACORT;
4. and a sample product label bearing the mark HISTACORT.⁴

The Respondent-Applicant filed its Answer on 13 December 2010, alleging among other things the following:

x x x

"II. AFFIRMATIVE DEFENSES

"2.1 The mark for the Respondent is HISTAMED that contains CETIRIZINE as the active ingredient which is an anti-histamine agent.

"2.2 On the other hand, the Opposer's mark is HISTACORT that contains PREDISOLONE as the active ingredient (Exhibit 'G') which is a topical corticosteroid or an anti-allergic drug (Exhibit 'C'). Clearly, the common elements in the competing marks are the letters H-I-S-T-A.

"2.3 There is no question that the competing marks are pharmaceutical preparations and more specifically anti-allergic drugs.

"2.4 On the other hand, histamine is a substance produced by the body to combat foreign matters. However, high levels of histamine in the blood may produce allergic reactions such as running nose. It is for this reason that doctors usually dispense antihistamine drugs to combat the ill effects of high histamine levels in the blood.

"2.4.1 With the foregoing discussion, it is very clear that the common letters in the competing marks -HISTA refer to HISTAMINE- the substance they are formulated to control. Thus, Opposer has no exclusive right to the use of letters HISTA specifically so if the goods refer to anti-HISTAMines.

"2.5 Under the Generics Law, pharmaceutical products should be proscribed by highlighting the generic name of said product with the trademark being optional. In Opposer's label, it is very clear that the active ingredient is CETERZINE which is very much different from the active ingredient of Opposer's product which is PREDISOLONE. Doctors who will prescribe these active ingredients will not be confused because of their training. The same is true when the prescription is given

⁴ Marked as Annexes "A" to "G".

to the druggist/pharmacist because they also check the active ingredient prescribed against the goods they will sell to the buyers.

"2.6 Furthermore, the labels of Respondent's products belie any confusion as the manufacturer's name and the name of the Respondent are written thereon. In Respondent's products, the name of Respondent and the manufacturer's are named thereby removing confusion as to the origin.

"2.7 By way of reference, the affidavit of the witness of the Respondent is hereto attached and made part of this ANSWER."

The Respondent-Applicant's evidence consists of the affidavit of Sonny Bob Cardinal, the Intellectual Property research pharmacist of Innogen Group of Companies; and a sample packaging of Respondent-Applicant's products.⁵

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

Records show that at the time the Respondent-Applicant filed its trademark application on 30 September 2009, the Opposer has an existing trademark registration for the mark HISTACORT (Reg. No. 36642). The registration covers "*anti-allergic drug*" under Class 05, which is similar to the goods indicated in the Respondent-Applicant's trademark application, specifically, "*pharmaceutical preparations for anti-allergy/antihistamines*".

In this regard, the Opposer anchors its opposition on the following provisions of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

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

x x x

(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;"

Sec. 147.Rights Conferred. - 147.1. The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

⁵ Marked as Exhibits "1" to "2", inclusive.

The marks competing marks are shown below:

Histacort

HISTAMED

Opposer's trademark

Respondent-Applicant's mark

What is common between the marks is the prefix "HISTA". "HISTA" is obviously derived from the word "*anti-histamine*", which is "*any of the various compounds that counteract histamine in the body and that are used for treating allergic reactions (as hay fever) and cold symptoms*"⁶. It is a fair inference that the parties appropriated the prefix "HISTA" as part or component of their respective trademarks because the pharmaceutical products covered by the marks are for the treatment of allergies (anti-histamine). Thus, this Bureau cannot sustain the opposition on the basis of the prefix "HISTA" alone. To do so would have the effect of giving the Opposer the exclusive right to use the prefix "HISTA", which is already of common usage as far as the pharmaceutical products involved are concerned. In fact, in the Trademark Registry, the contents of which the Bureau can take cognizance of via judicial notice, there are registered marks covering pharmaceutical preparations or drugs that have the prefix - "HISTA", such as "HISTAM" with Reg. No. 4-2014-011889, "HISTAVID" with Reg. No. 42013011606, "HISTAFREE" with Reg. No. 4-2012-000356, "HISTALORE" with Reg. No. 42005007476 and "A-P-HISTALLIN" with Reg. No. 034980, which are owned by entities other than the Opposer.

Thus, in determining the issue of whether HISTAMED should not be registered on the ground that it is confusingly similar to HISTACORT, it is imperative to look into the components, features or elements of the marks aside from the prefix "HISTA". The syllable "CORT" is paired with the prefix "HISTA" producing the Opposer's mark HISTACORT. On the other hand, the syllable "MED" is appended to the prefix "HISTA" resulting in the Respondent-Applicant's mark "HISTAMED". "CORT" is so visually and aurally different to "MED". Thus, the consumers can easily distinguish HISTAMED from HISTACORT. Confusion, much less deception is unlikely to occur.

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

⁶ Source/Reference: <http://www.merriam-webster.com/dictionary/antihistamine>

sale of an inferior and different article as his product.⁷ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-009905 together with a copy of this Decision be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 September 2015.



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

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.