



THERAPHARMA, INC.,  
Opposer,

-versus-

THE GENERICS PHARMACY INC.,  
Respondent-Applicant.

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}  
} IPC No. 14-2011-00511  
} Opposition to:  
} Appln Serial No. 4-2011-005189  
} Date Filed: 05 May 2011  
} TM: "HISTAPEN"  
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### NOTICE OF DECISION

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Counsel for the Opposer  
66 United Street  
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**THE GENERICS PHARMACY INC.**  
Respondent-Applicant  
459 Quezon Avenue  
Quezon City

#### GREETINGS:

Please be informed that Decision No. 2015 - 168 dated August 27, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 27, 2015.

For the Director:

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



THERAPHARMA, INC.,

*Opposer,*

-versus-

THE GENERICS PHARMACY INC.

*Respondent-Applicant.*

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IPC No. 14-2011-00511

**Opposition to:**

**Application No. 4-2011-005189**

**Date Filed: 05 May 2011**

**Trademark: "HISTAPEN"**

*Decision No. 2015- 168*

## DECISION

THERAPHARMA, INC.<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-005189. The application, filed by THE GENERICS PHARMACY INC.<sup>2</sup> ("Respondent-Applicant"), covers the mark "HISTAPEN" for use as "*medicine, antihistamine, chlorpenamine preparations*" under Class 05 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x x x

### "GROUNDS FOR OPPOSITION

"The grounds for this opposition are as follows:

"1. The trademark 'HISTAPEN' so resembles the trademark 'HISTACORT' trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark 'HISTAPEN'. The trademark 'HISTAPEN', which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'HISTAPEN' is applied for the same class of goods as that of trademark 'HISTACORT', i.e. Class (5); for treatment of allergy.

"2. The registration of the trademark 'HISTAPEN' in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the 'Intellectual

<sup>1</sup>A domestic corporation organized and existing under the laws of the Philippines with principal business address at 3<sup>rd</sup> Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

<sup>2</sup>A domestic corporation with principal office address at 459 Queozon Avenue, Quezon City.

<sup>3</sup>The 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.

Property Code of the Philippines', which provides, in part, that a mark cannot be registered if it:

xxx

"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.

"3. Respondent's use and registration of the trademark 'HISTAPEN' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'HISTACORT'.

#### "ALLEGATIONS IN SUPPORT OF THE OPPOSITION

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

"4. Opposer, the registered owner of the trademark 'HISTACORT', 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 09 November 1987 and valid for a period of twenty (20) years. Prior to the expiration, Opposer applied for a renewal of its registration which was approved and valid for another ten (10) years effective 09 February 2007 until 09 February 2017. Hence, Opposer's registration of the 'HISTACORT' trademark subsists and remains valid to date. x x x

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

"5.1 Opposer dutifully filed Affidavits of Use pursuant to the requirement of law, to maintain the registration of 'HISTACORT' in force and effect. A copy of the Affidavits of Use filed by Opposer is hereto attached x x x.

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

"6. There is no doubt that by virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark 'HISTACORT' for more than forty (40) years, and the fact that they are well-known among consumers, the Opposer has acquired an exclusive ownership over the 'HISTACORT' mark to the exclusion of all others.

"7. 'HISTAPEN' is confusingly similar to 'HISTACORT'.

"7.1. 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.

"7.1.1. In fact, in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* (356 SCRA 207, 216,) the Supreme Court, citing *Ethepa 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.'

"7.1.2 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."

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

x x x

"7.1.4 Applying the dominancy test, it can be readily concluded that the trademark 'HISTAPEN', owned by Respondent, so resembles the trademark 'HISTACORT', that it will likely cause confusion, mistake and deception on the part of the purchasing public.

"7.1.4.1 First, both marks are composed of three syllables;

"7.1.4.2 Second, the first two (2) syllables of both marks are the same;

"7.1.4.3 Third, the first five (5) letters of both marks are the same;

"7.1.4.4 Fourth, both marks have the same dominant feature i.e. 'HISTA';

"7.1.5 Clearly, the Respondent adopted the dominant features of the Opposer's mark 'HISTACORT';

"7.1.6. As further ruled by the High Court in the McDonald's case [p. 33]

x x x

"7.2 The trademark 'HISTACORT' and Respondent's trademark 'HISTAPEN' are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

"7.2.1 Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed trademark 'HISTAPEN' is applied for the same class and goods as that of trademark 'HISTACORT', i.e. Class (5); for treatment of allergy, to the Opposer's extreme damage and prejudice.

"7.3 Yet, Respondent still filed a trademark application for 'HISTAPEN' despite its knowledge of the existing trademark registration of 'HISTACORT' which is confusingly similar thereto in both its sound and appearance.

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

x x x

"8. Moreover, Opposer's intellectual property right over its trademark is protected under Section 147 of Republic Act No. 8293, otherwise known as the Philippine Intellectual Property Code ("IP Code"), which states:

x x x

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

"9.1 Being the lawful owner of 'HISTACORT', Opposer has the exclusive right to use and/or appropriate the said marks 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.

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

"9.3 Moreover, following the illustrative list of confusingly similar sounds in trademarks which the Supreme Court cited in McDonald's Corporation, McGeorge Food Industries, Inc. vs. L.C. Big Mak Burger, Inc., 147 SCRA 268 (2004), it is evident that the mark 'HISTAPEN' is aurally confusingly similar to Opposer's mark 'HISTACORT'.

"9.4 To allow Respondent to use its 'HISTAPEN' mark on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the 'HISTAPEN' products of Respondent originate from or is being manufactured by Opposer, or at the very least, is connected or associated with the 'HISTACORT' products of Opposer, when such connection does not exist.

"9.5 In any event, as between the newcomer, Respondent, which by the confusion loses nothing and gains patronage unjustly by the association of its products bearing the 'HISTAPEN' mark with the well-known 'HISTACORT' mark, and the first user and actual owner of the well-known mark, Opposer,

which by substantial investment of time and resources and by honest dealing has already achieved favor with the public and already possesses goodwill, any doubt should be resolved against the newcomer, Respondent, considering that Respondent, as the latter entrant in the market had a vast range of marks to choose from which would sufficiently distinguish its products from those existing in the market.

"10. By virtue of Opposer's prior and continued use of the trademark 'HISTACORT', the same have become well-known and established valuable goodwill to the consumers and the general public as well. The registration and use of Respondent's confusingly similar trademark 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 Opposer.

"11. Likewise, the fact that Respondent seeks to have its mark 'HISTAPEN' registered in the same class (Nice Classification 5) as the trademark 'HISTACORT' of Opposer plus the fact that both are medicinal preparation for treatment of allergy will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

"12. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent of the trademark 'HISTAPEN'. In support of the foregoing, the instant Opposition is herein verified by Mr. John Dumpit, which likewise serves as his affidavit (Nasser v. Court of Appeals, 191 SCRA 783 [1990]).

The Opposer's evidence consists of printout of the "IPO E-Gazette" with releasing date 17 October 2011; copies of Certificate of Reg. No. 36642 and the Certificate of Renewal of Registration for the mark HISTACORT; copies of the Affidavits of Use filed by Opposer for the mark 'HISTACORT'; and, a sample of product label bearing the trademark HISTACORT.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 06 January 2012. The Respondent-Applicant, however, did not file an Answer.

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

Records show that at the time the Respondent-Applicant filed its trademark application on 05 May 2011, the Opposer has an existing trademark registration for the mark HISTACORT (Reg. No. 36642). The registration covers "*anti-allergic drug*" under Class 05. Thus, the goods indicated in the Respondent-Applicant's trademark application, specifically, "*medicine, antihistamine, chlorphenamine preparations*" are similar and/or closely related to those covered by the Opposer's trademark registration.

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<sup>4</sup>Marked as Annexes "A" and "G", inclusive.

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.

The competing marks are shown below:

Histacort

**HISTAPEN**

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*"<sup>5</sup>. 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.

<sup>5</sup> Source/Reference: <http://www.merriam-webster.com/dictionary/antihistamine>

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 HISTAPEN 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 "PEN" is appended to the prefix "HISTA" resulting in the Respondent-Applicant's mark "HISTAPEN". "CORT" is so visually and aurally different to "PEN". Thus, the consumers can easily distinguish HISTAPEN 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 sale of an inferior and different article as his product.<sup>6</sup> 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. 4-2011-005189 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

**SO ORDERED.**

Taguig City, 27 August 2015.

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

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<sup>6</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.