



UNITED LABORATORIES, INC.,
Opposer,

-versus-

CHUGAI SEIYAKU KABUSHIKI
KAISHA (CHUGAI PHARMACEUTICAL
CO., LTD.),
Respondent-Applicant.

} IPC No. 14-2012-00404
}
} Opposition to:
} Appln. Serial No. 4-2012-500538
} Date Filed: 05 March 2012
} TM: "RENAGEL"

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NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for the Opposer
No. 66 United Street
Mandaluyong City


HECHANOVA BUGAY & VILCHEZ
Counsel for Respondent-Applicant
Ground Floor Chemphil Building
851 Antonio Arnaiz Avenue
Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 229 dated October 23, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 23, 2015.

For the Director:


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



UNITED LABORATORIES, INC.,	}	IPC No. 14-2012-00404
Opposer,	}	Opposition to:
	}	
- versus -	}	Application No. 4-2012-500538
	}	Date Filed: 05 March 2012
CHUGAI SEIYAKU KABUSHIKI	}	
KAISHA (CHUGAI PHARMACEUTICAL	}	Trademark: RENAGEL
CO., LTD.),	}	
Respondent-Applicant.	}	Decision No. 2015 - <u>229</u>
x-----x		

DECISION

UNITED LABORATORIES, INC.¹ ("Opposer") filed a Verified Notice of Opposition to Trademark Application No. 4-2012-500538. The contested application, filed by CHUGAI SEIYAKU KABUSHIKI KAISHA (CHUGAI PHARMACEUTICAL CO., LTD.)² ("Respondent-Applicant"), covers the mark RENAGEL for use on "*pharmaceutical preparations for hyperphosphatemia and other disorders namely in the treatment of renal failure*" under Class 05 of the International Classification of goods³.

The Opposer alleges, among other things, that:

"7. The mark RENAGEL owned by Respondent-Applicant so resembles the trademark RENOGEN owned by Opposer and duly registered with this Honorable Bureau prior to the publication of the present application for the mark RENAGEL.

"8. The mark RENAGEL will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark RENAGEL is applied for the same class and goods as that of Opposer's trademark RENOGEN, *i.e.*, Class 05 of the International Classification of Goods for pharmaceutical preparations for the treatment of renal disorder.

"9. The registration of the mark RENAGEL in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides, in part, that 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

1 A domestic corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines, with office address at 66 United Street, Mandaluyong City, Philippines.
2 Appears to be a foreign corporation, with office address at 5-1, Ukima 5-Chome, Kita-ku, Tokyo, Japan.
3 Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This 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.

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; 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."

The Opposer's evidence consists of the following:

1. Copy of the pertinent pages of the IPO e-Gazette bearing publication date of 30 July 2012 (*Exhibits "A" to "A-1"*);
2. Certified true copy of Certificate of Registration No. 4-2004-001545 for the trademark RENOGEN (*Exhibit "B"*);
3. Certified true copy of the Assignment of Registered Trademark dated 24 October 2007 (*Exhibit "C"*);
4. Certified true copies of the Declaration of Actual Use and Affidavit of Use (*Exhibits "D" to "D-1"*);
5. Sample product label bearing the trademark RENOGEN (*Exhibit "E"*);
6. Certified true copy of the Certificate of Product Registration for RENOGEN issued by the Food and Drug Administration (*Exhibit "F"*); and
7. Computer print-out downloaded from the IPOPHIL website showing the trademark RENAGEL (*Exhibit "G"*).

For its part, the Respondent-Applicant avers that its RENAGEL mark is not confusingly similar to Opposer's RENOGEN. According to the Respondent-Applicant, the trademark RENAGEL has already been registered in its name two (2) years earlier than the Opposer's application for the registration of the mark RENOGEN. In support thereof, the Respondent-Applicant submitted in evidence the following:

1. Special Power of Attorney issued in favor of Hechanova Bugay & Vilchez (*Exhibit "1"*);
 2. Authenticated Affidavit-Direct Testimony of Masahisa Yamaguchi (*Exhibit "2"*);
 3. Trademark Application No. 41998006056 filed on 12 August 1998 for the mark RENAGEL (*Exhibit "3"*);
 4. Application No. 41999001520 filed on 04 March 1999 for the mark RENAGEL (*Exhibit "4"*);
 5. Application No. 42001005839 filed on 10 August 2001 for the mark RENAGEL (*Exhibit "5"*);
 6. Registration No. 42002001787 filed on 01 March 2002 for the mark RENAGEL (*Exhibit "6"*);
 7. Registration No. 42005008747 filed on 05 September 2005 for the mark RENAGEL (*Exhibit "7"*);
 8. Registration No. 42005002020 filed on 02 March 2005 for the mark RENAGEL (*Exhibit "8"*).
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The case was referred to mediation, however, the same was terminated for failure of the parties to settle the dispute through mediation. Then after, the case proceeded to preliminary conference. After its termination, the parties submitted their respective position papers.

The main issue to be resolved in this case is whether the Respondent-Applicant's trademark application for RENAGEL should be allowed.

The Opposer's claim hinges on the alleged confusing similarity between its RENOGEN and the Respondent-Applicant's RENAGEL trademark arguing that the registration of the latter's mark will violate Section 123.1 (d) of R. A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), which provides that a mark cannot be registered if it:

(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; x x x

This issue, however, has already been ruled and passed upon by this Bureau in IPC No. 14-2010-00012, which involves the same parties, the same trademarks and goods, differing only in the application serial number and the date of filing. In a decision⁴ rendered in the said case, this Bureau categorically ruled that:

"The marks reveal disparity in both aural and visual appearance. The middle vowel letter "O" in RENOGEN and "E" in RENAGEL and the corresponding ending letters "N" and "L", respectively, create the distinction when the marks are entirely pronounced. The similarity in the beginning letters "R", "E" and "N" obviously came from the disorder treated by the said medicines, which is renal failure.

Further, a scrutiny of the goods covered by the contending marks show that while both fall under Class 5 goods, they are particularly addressed for the treatment of different illnesses. Opposer's RENOGEN is a medicinal preparation for use as hematopoietic agent. This is an agent that promotes the formation of blood cells, which includes bone marrow, spleen, thymus, and lymph nodes. On the other hand, Respondent-Applicant's RENAGEL is a preparation for hyperphosphatemia and for the treatment of renal failure. Hyperphosphatemia is a condition consisting of abnormal high serum phosphate intake and/or decreased phosphate excretion. Thus, the peculiarity of the goods and the illnesses these drugs treat will not cause confusion to patients who will definitely exercise discretion and intelligence in purchasing medicines for specific illness.

While there may be similarities between the marks, the differences as

⁴ Decision No. 2015-05 dated 21 January 2015.

discussed above far outweigh the likelihood of confusion. It is doubtful if the consumers in encountering the mark RENAGEL will have in mind or be reminded of the mark RENOGEN. The Opposer has not established that RENOGEN is a well-known mark nor famous, so as to support a claim that the Respondent-Applicant's trademark application and use of the mark RENAGEL is intended to ride in on the goodwill supposedly earned by the Opposer's mark. The marks were both registered and have been co-existing for several years now. This debunks any assertion of the existence of the likelihood of confusion."

This Bureau finds no cogent reason to deviate from its previous findings that there exists no likelihood of confusion between the contending marks.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-500538 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 October 2015.


Atty. NATHANIEL S. AREVALO
Director *W*, Bureau of Legal Affairs