

BOEHRINGER INGELHEIM PHARMA,
Opposer,

-versus-

ATTY. AMBROSIO V. PADILLA,
Respondent-Applicant.

X-----X

IPC No. 14-2014-00381
Opposition to:
Application No.: 4-2014-0002625
Date filed: 03 March 2013
TM: "CATADIN"

NOTICE OF DECISION

CASTILLO LAMAN TAN PANTALEON & SAN JOSE

Counsel for the Opposer
2nd, 3rd, and 4th Floors, The Valero Tower
122 Valero Street, Salcedo Village
Makati City

ATTY. AMBROSIO V. PADILLA III


Respondent-Applicant
Unit 1001, 88 Corporate Centers
Sedeno corner Valero Streets
Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 03 dated January 08, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 08, 2016.

For the Director:


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

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- versus -

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Opposition to:

Appln. No. 4-2014-00002625
Date Filed: 03 March 2013
Trademark : "CATADIN"

Decision No. 2016 - 03

DECISION

BOEHRINGER INGELHEIM PHARMA ("Opposer"),¹ filed a verified opposition to Trademark Application Serial No. 4-2014-00002625. The application, filed by ATTY. AMBROSIO V. PADILLA ("Respondent-Applicant"),² covers the mark "CATADIN" for use on "*pharmaceutical preparation with the generic name clonidine used to treat hypertension, which may be employed alone or concomitantly with other antihypertensive agents*" under class 05 of the International Classification of Goods.³

The Opposer alleges the following grounds for opposition:

"a. Respondent's 'CATADIN' mark is confusingly similar with Opposer's registered CATAPRES mark, covering the same or similar goods.

"b. Because of the confusing similarity between the opposing marks, Respondent's products may be assumed to originate from Boehringer thereby deceiving the public into believing that there is some connection between the Respondent and the Opposer, which, in fact, does not exist (Confusion of Origin).

"c. Respondent's use of the CATADIN mark, which is confusingly similar to the Opposer's registered mark, blurs the distinctiveness of the CATAPRES mark.

"d. Respondent intends to pass of his CATADIN goods as those of Opposer."

The Opposer's evidence consists of the following:

1. Printed copy of the website of boehringer-ingelheim.com;
2. Special Power of Attorney;
3. Printout of webpage of "Clonidine." Brayfield, A,ed. (13 January 2014);
4. Printout of webpage of "The Imidazoline Receptor in Control of Blood Pressure by Clonidine and Allied Drugs." Donald J. Reisd and John E. Piletz;
5. Printout of webpage of "The Role of Alpha 2 Agonists in the Attention Deficit/Hyperactivity Disorder Treatment Paradigm." Sallee, FR (2008);

¹ A foreign corporation duly organized and existing under the laws of the Federal Republic of Germany with principal offices at Binger Straße 148, 55216 Ingelheim, Germany.

² With registered address at Unit 1001, 88 Corporate Center, Sendeno corner Valero Streets, Salcedo Village, 1227 Makati City.

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

6. Printout of webpage of "A historical perspective: development of clonidine." Helmut Stähle;
7. Printout of webpage of the Catapres TTS product information leaflet and patient instructions;
8. Printout of webpage of children's manuals;
9. Printout of webpage of Studies on CATAPRES's value in alcohol and tobacco withdrawal;
10. Certificate of Registration No. 4-2008-000034 for CATAPRES;
11. Printout of webpage of Physicians' Desk Reference (PDRHealth);
12. Printout of webpage of Medscape Reference;
13. Printout of webpage of Drugs.com;
14. Printout of webpage of Everydayhealth.com;
15. Printout of webpage of MedicineNet.com;
16. Printout of webpage of C-health.canoe.ca;
17. Printout of webpage of Child Development Network;
18. Printout of webpage of Electronic Medicines Compendium of the United Kingdom;
19. Pharmaceutical Products Directory;
20. Printout of webpage of Comparison of moxonidine and clonidine;
21. Printout of webpage of Effect of Intrathecal Clonidine in Hypertensive Subjects with Poorly Controlled Blood Pressure;
22. Printout of webpage of Clinical trial with intravenous clonidine in treatment of severe hypertension;
23. Printout of webpage of Bioequivalence of Two Transdermal Clonidine Administrations;
24. Printout of webpage of Effect of Clonidine-enhanced Sedation;
25. Printout of webpage of Labor Analgesia With Ropivacaine and Clonidine (LA);
26. Printouts of webpages of DrugLib.com.
27. Trademark registrations of CATAPRES in various countries;
28. List of worldwide registrations of CATAPRES;
29. Printouts of IPOPHIL's trademark webpage of Respondent's applications;
30. Judicial Affidavit of Mr. Kammler; and,
31. Affidavit of Atty. Teresa Paz G. Pascual.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 17 March 2015. However, this Bureau did not receive an answer and thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision.⁴

Should the Respondent-Applicant be allowed to register the trademark CATADIN?

Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 03 March 2014⁵, the Opposer has already an existing trademark registration for the mark CATAPRES bearing Registration No. 4-2008-000034 issued on 31 March 2008⁶ in the Philippines. It has also various registrations for CATAPRES in different countries in its name.⁷ Unquestionably, the Opposer's application and registration preceded that of Respondent-Applicant's.

⁴ Order No. 2015-413 dated 17 March 2015.

⁵ Filewrapper records.

⁶ Exhibit "J" of Opposer.

⁷ Exhibits "U" and series of Opposer.

A comparison of the Opposer's mark with the Respondent-Applicant's is depicted below:

CATAPRES

Catadin

Opposer's Trademark

Respondent-Applicant's Trademark

The foregoing marks contain the prominent first two syllables *CA* and *TA*. While it is true that they differ in the last syllable *PRES* for CATAPRES; and *DIN* for CATADIN, this is not sufficient to remove the doubt of likelihood of confusion of one mark as against the other. First, a scrutiny of the goods covered by the mentioned marks show the similarity and relatedness of the pharmaceutical products covered by the marks in classification no. 5. Both pharmaceutical products carry the generic name CLONIDINE.⁸ Second, they are intended generally for the treatment of hypertension.⁹ Obviously, they are intended for the same purpose and use, cater to the same group of purchasers, and available in the same channels of trade. Finally, it appears that Opposer's mark CATAPRES is a coined word mark. It was not derived from its generic name CLONIDINE. A coined word mark is an invented word and has the advantage of being easy to protect as it is more likely to be considered distinct.¹⁰

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.¹¹ Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.¹²

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.¹³ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:¹⁴

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase on 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

⁸ Filewrapper records; Exhibits "C" and "J" of Opposer.

⁹ Filewrapper records; Exhibit "J" of Opposer.

¹⁰ Creating or Selecting a Trademark, available at www.wipo.int/sme/en/ip_business/marks/tm_creation.htm (last accessed 23 December 2015).

¹¹ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

¹² Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.

¹³ American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.

¹⁴ Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.

poorer quality of the of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, 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.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code. It must be emphasized that the Respondent-Applicant was given opportunity to defend its trademark application. It, however, failed to do so.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-00002625 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 08 January 2016.


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