

WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

INTERPHIL LABORATORIES, INC.,
Respondent- Applicant.

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IPC No. 14-2010-00184
Opposition to:
Appln. Serial No. 4-2010-000996
Date Filed: 28 January 2010
TM: "AXELLA"

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NOTICE OF DECISION

OCHAVE & ASSOCIATES

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GREETINGS:

Please be informed that Decision No. 2016 - 68 dated March 03, 2016 (copy enclosed) was promulgated in the above entitled case.

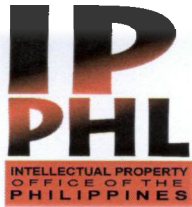
Taguig City, March 03, 2016.

For the Director:


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

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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Decision No. 2016 - 68

DECISION

WESTMONT PHARMACEUTICALS, INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2010-000996. The application, filed by INTERPHIL LABORATORIES, INC. ("Respondent-Applicant")², covers the mark "AXELLA" for use on "*pharmaceutical preparation for human use*" under Class 5 of the International Classification of Goods³.

The Opposer alleges that "AXELLA" is confusingly similar to its registered mark "AXERA" such that its registration in the name of the Respondent-Applicant will violate Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, its use and registration by the Respondent-Applicant will also diminish the distinctiveness and dilute the goodwill of the mark "AXERA".

To support its opposition, the Opposer submitted as evidence a print-out of the "IPO-e-Gazette" showing the Respondent-Applicant's trademark application, copy of Certificate of Registration No. 4-2008-010454 for the mark "AXERA", sample product label bearing the mark "AXERA", and a copy of Certificate of Product Registration ("CPR") issued by the Food and Drugs Authority ("FDA") dated 29 May 2009⁴.

The Respondent-Applicant filed its Answer on 13 December 2010, alleging among other things, that there could be no confusion between the marks nor in respect to their medical preparations. According to the Respondent-Applicant:

¹ A domestic corporation duly organized and existing under Philippine laws with principal address at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

² A domestic corporation with address at Calunbang, Industrial Estate, Bo. Pittland, Cabuyao, Laguna.

³ The Nice Classification of Goods and services is for registering trademarks and services marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

⁴ Annex "A" to "D".

1. "AXELLA" is an anti-histamine or a pharmaceutical preparation intended to treat allergies and hypersensitive reactions and colds, while "AXERA" on the other hand, is an anti-bacteria or an anti-biotic pharmaceutical preparation;
2. "AXELLA" is dispensed in syrup form, while "AXERA" is in powder form for subcutaneous or intravenous injection and dispensed in vials;
3. "AXELLA" is an over-the-counter medicine, or it can be bought without a doctor's prescription;
4. "AXELLA" is a pharmaceutical preparation that was approved and was issued a CPR by the FDA on 09 July 2009, while "AXERA" was issued a CPR earlier - on 29 May 2009;
5. the CPR issued to "AXELLA" shows that Respondent-Applicant was the first to use the mark when it filed its application for CPR and paid the corresponding fees on 24 April 2007, while the CPR application for "AXERA" was filed only on 29 April 2008;
6. despite the issuance of a CPR for "AXERA" forty days earlier, the FDA found nothing irregular in the application for "AXELLA" and issued a CPR both in tablet form and syrup form;
7. by issuing the CPRs, the FDA did not find that "AXELLA" as a brand for an "over-the-counter" anti-histamine will be confused with "AXERA" which is a brand for injectable anti-biotic, hence there is no factual basis for the Opposer's claim that the marks are confusingly similar;
8. the short interval of time (40 days) between the issuances of the CPRs and the Respondent-Applicant's prior use of the mark "AXELLA" belie the Opposer's bare claim that "AXELLA" seeks to benefit from the alleged albeit unsubstantiated goodwill that "AXERA" has supposedly earned and established; and
7. the goods covered by the subject marks are pharmaceutical preparations and are not simple household goods or items of everyday purchase; pharmaceutical preparations are bought by consumers who are familiar with such goods and who purchase after deliberate comparative and analytical investigation in which in the case of "AXERA", only with a prescription issued by a duly licensed medical doctor.

After the conduct and termination of the preliminary conference on 23 June 2011, the parties submitted their respective position papers on 4 July 2011.

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

Records show that at the time the Respondent-Applicant applied for registration of the mark "AXELLA", the Opposer has already registered the mark "AXERA" (Reg. No. 4-2008-010454, issued on 15 December 2008). Considering that the coverage of the Respondent-Applicant's trademark application

is broadly stated as "*pharmaceutical preparation for human use*", this could include pharmaceutical products under the Opposer's trademark registration for the mark AXERA.

But, is AXELLA confusingly similar to the mark AXERA?

The differences in the spelling notwithstanding, the marks look and sound very similar to one another. In fact, when pronounced, AXELLA is hardly distinguishable from AXERA. Time and again, the court has taken into account the aural effects of the words and letters contained in the marks in determining the issue of confusing similarity.⁵ In *Marvex Commercial Co., Inc. v. Petra Hawpia & Co., et al*⁶, the Court held:

"The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, Vol. 1, will reinforce our view that 'SALONPAS' and 'LIONPAS' are confusingly similar in sound: 'Gold Dust' and 'Gold Drop'; 'Jantzen' and 'Jass-Sea'; 'Silver Flash' and 'Supper Flash'; 'Cascarete and Celborite'; 'Celluloid' and 'Cellonite'; 'Chartreuse' and 'Charseurs'; 'Cutex' and 'Cuticlean'; 'Hebe' and 'Meje'; 'Kotex' and 'Femetex'; 'Zuso' and 'Hoo Hoo'. Leon Amdur, in his book Trademark Law and Practice, pp. 419-421, cites, as coming within the purview of the *idem sonans* rule, 'Yusea' and 'U-C-A', 'Steinway Pianos' and 'Steinberg Pianos', and 'Seven-Up' and 'Lemon-Up'. In *Co Tiong vs. Director of Patents*, this Court unequivocally said that 'Celdura' and 'Cordura' are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name 'Lusolin' is an infringement of the trademark 'Sapolin', as the sound of the two names is almost the same."

The differences as to the dispensation and application of the pharmaceutical products bearing the contending marks are of no moment. These do not negate the likelihood of mistake or confusion, which could be fatal due to the nature of the goods. Also, this Bureau finds unconvincing the Respondent-Applicant's claim that its use of the mark AXELLA preceded the Opposer's use of the mark AXERA. The Respondent-Applicant relies on its filing with the FDA an application for the issuance of CPR on 24 April 2007. Aside from the filing of the application for CPR, there is no evidence that the Respondent-Applicant sold its AXELLA products earlier than the Opposer's AXERA. In fact, the Opposer was issued a CPR for its AXERA on 29 May 2009, which is earlier than the Respondent-Applicant's CPR which was issued on 09 July 2009. The Respondent-Applicant itself stated in its Answer to the Opposition:

"6.a. A CPR issued by the FDA is required prior to any sale or distribution of a pharmaceutical preparation to the public."⁷ (Underscoring supplied)

It is emphasized that 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 out 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.⁸

⁵ *Prosource International Inc. v. Horphag Research Management S.A.*, G.R. No. 180073, 25 November 2009.

⁶ G.R. No. L-19297, 22 December 1966.


⁷ Verified Answer, p. 4.

⁸ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

WHEREFORE, premises considered, the instant Opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2010-000996 be returned together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 03 March 2016.



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