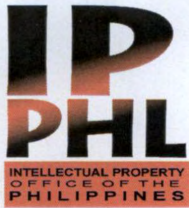


ACTAVIS GROUP PTC EHF, Opposer, **-versus-** **SYNERGEN ASIA PTE. LTD.,** Respondent- Applicant.	**IPC No. 14-2015-00274** Opposition to: Appln. Serial No. 4-2014-00505977 Date Filed: 19 December 2014 **TM: "PANTAZOL"**

x---x

NOTICE OF DECISION

CRUZ MARCELO & TENEFRANCIA
Counsel for Opposer
9th, 10th, 11th & 12th Floors, One Orion
11th Avenue corner University Parkway
Bonifacio Global City, Taguig City

SYNERGEN PHARMA, INC.
Respondent-Applicant's Agent
1908 Cityland 10 Tower
H.V. Dela Costa St., corner Ayala Avenue
Makati City

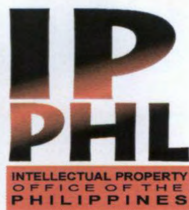
GREETINGS:

Please be informed that Decision No. 2016 - 163 dated June 02, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 02, 2016.

For the Director:

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



ACTAVIS GROUP PTC EHF,
Opposer,

-versus-

SYNERGEN ASIA PTE. LTD.,
Respondent-Applicant.

x---x

IPC NO. 14-2015-00274

Opposition to:
App.Serial No. 4-2014-505977
Date Filed: 19 December 2014
TM: "PANTAZOL"

DECISION NO. 2016- 163

DECISION

ACTAVIS GROUP PTC EHF ("Opposer"),[1] filed an opposition to the Trademark Application Serial No. 4-2014-505977. The application filed by SYNERGEN ASIA PTE. LTD. ("Respondent-Applicant")[2], covers the mark "PANTAZOL" for use on *"pharmaceutical preparation for the treatment of ulcers"* under Class 05 of the International Classification of Goods.[3]

The Opposer alleges that the mark PANTAZOL should be denied registration because it is confusingly similar to Opposer's registered mark PANRAZOL and it covers identical or closely related goods. Opposer also claims that the registration of the mark PANTAZOL will gravely erode the distinctiveness of Opposer's registered mark PANRAZOL and shall prejudice Opposer's right to exclusively use its mark to the exclusion of any other similar mark.

Opposer's evidence consists of the following:

1. Exhibit "A" – Copy of the Certificate of Registration for the PANRAZOL issued by IPOPHL on 28 August 2014 ;
2. Exhibit "B" – Copy of the Trademark Application No. 4-2014-505977 published in the IPO e-Gazette;
3. Exhibits "C" and "D" – copy of the Orders issued by the Bureau of Legal Affairs granting Opposer's Motions for Extension to File Verified Opposition; and
4. Exhibits "E" to "L" – copies of certificates of registration for the mark PANRAZOL issued in Malaysia, Hong Kong, Taiwan, Indonesia, Bosnia-Herzegovina, Iceland, Uzbekistan Kazakhstan.

This Bureau issued on 12 August 2015 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant on 26 August 2015. The Respondent-Applicant, however, did not file the Answer. On 04 May 2016, this Bureau declared Respondent-Applicant in default. Accordingly, pursuant to Rule 2 Section 10

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[1] A corporation duly organized and existing under the laws of Iceland with principal office address at Reykjavikurvegi 76-78, 220 Hafnarfjourdur, Iceland.
[2] A corporation duly organized and existing under the laws of Singapore with address at 20 Maxwell Road, #07-01 Maxwell House, Singapore, Singapore.
[3] The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty 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 Registration of Marks concluded in 1957.

of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark **PANTAZOL**?

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. Thus, Sec. 123.1 (d) of the IP 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 or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its application for the mark PANTAZOL on 19 December 2014, the Opposer has already been issued a registration for its trademark PANRAZOL 28 August 2014, covering goods falling under Class 05, namely, "pharmaceutical preparations and substances for the treatment of conditions such as heartburn, ulcers, gastroesophageal reflux disease (GERD), Zollinger-Ellison Syndrome and other conditions where the stomach produces too much acid" under Registration No. 4-2014-006712 . Respondent-Applicant's mark PANTAZOL will be used in *"pharmaceutical preparation for the treatment of ulcers"* which is covered by Opposer's goods bearing the mark PANRAZOL.

But, are the competing marks identical or confusingly similar and used on the same or closely related goods as to likely deceive or cause confusion?

The marks are reproduced below for comparison:

PANRAZOL	PANTAZOL
Opposer's Mark	Respondent-Applicant's Mark

A comparison of the above competing trademarks show that both marks contain the same number of letters and syllabels. Opposer's mark contains the syllables **"PAN-RA-ZOL"** while Respondent-Applicant's contains the syllables **"PAN-TA-ZOL".** In comparing both marks, Respondent-Applicant's mark contains almost all the letters of Opposer's mark except for the letter "**R**" which was replaced by the letter "**T**". The font used in both marks also differ from each other. However, the differences noted in the competing marks does not in any way deviate from a finding of confusing similarity. Respondent-Applicant's mark has a similar overall impression as that of Opposer's. Aside from the visual similarity, when Respondent-Applicant's PANTAZOL mark is pronounced, it produces the same sound as that of Opposer's PANRAZOL mark because the letter "R" in Opposer's mark becomes undistinguishable. Trademarks are designed

not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

The likelihood of confusing similarity between the marks of the parties are made more evident because both marks are used on drugs to treat ulcer under Class 05. Considering that the goods of the parties are similar, there is likelihood that any impression, perception or information about the goods advertised under the mark PANTAZOL may be unfairly attributed or confused with Opposer's PANRAZOL, and vice versa.

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[4]. Colorable imitation does not mean such similitude as amounts 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 trade name with that of the other mark or trade name 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[5].

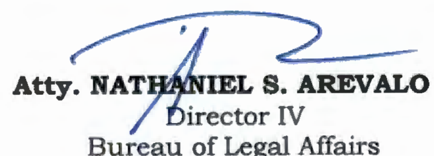
It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favor with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.[6]

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-505977, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 JUN 2016



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

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[4] See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.
[5] See *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.
[6] See *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990