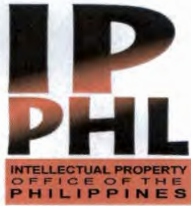

UNITED AMERICAN PHARMACEUTICALS INC., Opposer, **-versus-** **SUHITAS PHARMACEUTICALS INC.,** Respondent- Applicant.	}	**IPC No. 14-2015-00376** Opposition to: Appln. Serial No. 4-2015-001545 Date Filed: 12 February 2015 **TM: "PIOTAZ"**

x---x

NOTICE OF DECISION

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

SUHITAS PHARMACEUTICALS, INC.
Respondent- Applicant
3rd Floor Centrepoint Building
Pasong Tamo corner Export Bank Drive
Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 228 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 01, 2016.

For the Director:

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

UNITED AMERICAN PHARMACEUTICALS INC.,
Opposer,

- versus -

SUHITAS PHARMACEUTICALS INC.,
Respondent-Applicant.
x -- x

IPC No. 14-2015-00376
Opposition to:

Appln. No. 4-2015-001545
Date Filed: 12 February 2015
Trademark : **"PIOTAZ"**

Decision No. 2016 - 228

DECISION

UNITED AMERICAN PHARMACEUTICALS INC. ("Opposer"),[1] filed a verified opposition to Trademark Application Serial No. 4-2015-001545. The application, filed by SUHITAS PHARMACEUTICALS INC. ("Respondent-Applicant")[2], covers the mark "PIOTAZ" for use on goods under class 05[3] namely: *pharmaceutical preparations (anti-diabetic)*.

The Opposer alleges the following grounds for opposition:

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

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

"9. The registration of the mark 'PIOTAZ' in the name of the Respondent-Applicant will violate Sec. 123.1 (d) 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 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 (Emphasis supplied)

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[1] A domestic corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines with office address at132 Pioneer Street, Mandaluyong City, Metro Manila.
[2] With office address at 3rd Floor Centrepoint Bldg., Pasong Tamo cor. Export Bank Drive, Makati City, Metro Manila.
[3] The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE
Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio, Taguig City 1634 Philippines •www.ipophil.gov.ph
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"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.

"11. Respondent-Applicant's use and registration of the mark 'PIOTAZ' will diminish the distinctiveness of Opposer's trademark 'PIPTAZ'."

The Opposer's evidence consists of the following:

1. Pertinent page of the IPO E-Gazette;
2. Certified true copy (Ctc) of Certificate of Registration No. 4-2006-010078 for PIPTAZ;
3. Ctc of Certificate of Product Registration No. DR-XY32669;
4. Ctc of the Declarations of Actual Use;
5. Sample product label bearing the trademark PIPTAZ; and,
6. Certification and sales performance by IMS Health Philippines, Inc.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer dated 24 August 2015 which was received by the Respondent-Applicant on 13 September 2015. However, this Bureau did not receive an answer. Respondent-Applicant is declared default and this case is deemed submitted for decision.[4]

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

Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property Code ("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 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 12 February 2015[5], the Opposer has already an existing trademark registration for the mark PIPTAZ bearing Registration No. 4-2006-010078 dated 12 September 2006 in the Philippines falling under Class 05 for anti-infective medicinal preparation.[6] It has also filed Declarations of Actual Use within 3 years from filing date[7], and in the 5th year anniversary.[8]

The marks are hereby reproduced for comparison:

PIPTAZ	PIOTAZ
Opposer's Trademark	Respondent-Applicant's Trademark

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[4] Order No. 2016-271 dated 11 February 2016.
[5] Filewrapper records.
[6] Exhibit "B" of Opposer.
[7] Exhibit "D" of Opposer.
[8] Exhibit "E" of Opposer.

The foregoing marks contain identical letters except for the middle letter "P" in PIPTAZ, as against the middle letter "O" in PIOTAZ. The fonts illustrated also create an apparent aural similarity creating the likelihood of confusion of one mark as against the other.

Further, 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. Opposer's PIPTAZ are medicines for severe infections.[9] A scrutiny of the Certificate of Product Registration issued by the Food and Drug Administration reveals the diseases it is intended to treat, including acute ischemic/diabetic foot infections.[10] Similarly, Respondent-Applicant's PIOTAZ is an anti-diabetic medicine. Thus, they are both medicines for the treatment of diabetis; side-effect or upshot of diabetis. 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.

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 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.

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9 Exhibit "B" of Opposer.
10 Exhibit "C" of Opposer.
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.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED.** Let the filewrapper of Trademark Application Serial No. 4-2015-001545 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 3 0 JUN 2016

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