

VIFOR (INTERNATIONAL) INC.,	} IPC NO. 14-2015-00056
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2014-008051
	} Date Filed: 25 June 2014
	}
EUROHEALTHCARE EXPONENTS, INC.,	} Trademark: "FEOFER"
Respondent-Applicant.	}
	}
x-----x	} Decision No. 2016- 382

DECISION

VIFOR (INTERNATIONAL) INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-008051. The application, filed by EUROHEALTHCARE EXPONENTS, INC. (Respondent-Applicant)², covers the mark "FEOFER", for use on "Pharmaceutical preparation as anti-anemic for treatment of iron deficiencies disease and for pr & post natal" under Class 5 of the International Classification of Goods³.

The Opposer alleges the following, among other things:

"11. The Respondent-Applicant's application for the registration of the mark FEOFER should not be given due course because its registration is contrary to Section 123.1 (d) and Section 123.1 (f) of the Intellectual Property Code, which prohibit the registration of a mark that:

- (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.

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¹ A corporation duly organized and existing under the laws of Switzerland with address at Rechenstrasse 37, 9014 St. Gall, Switzerland.

² Philippine corporation with address at 67 Scout Fuentebella Street, Brgy. Laging Handa, Tomas Morato, Quezon City.

³ The Nice Classification of Goods and Services is for registering trademarks and service 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.

- (f) Is identical with or confusingly similar to, or constitutes a translation of a mark, considered well known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods and services which are not similar to those with respect to which registration is applied for: Provided, that the use of the mark in relation to the goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, that the interests of the owner of the registered mark are likely to be damaged by such use.

“12. The act of the Respondent-Applicant in adopting the mark FEOFER for its pharmaceutical products in International Class 5 is clearly an attempt to trade unfairly on the goodwill, reputation and consumer awareness of the Opposer’s internationally well-known VENOFER mark that was previously registered before this Honorable Office. Such act of the Respondent-Applicant results in the diminution of the value of the Opposer’s internationally well-known VENOFER mark.xxx”

The Opposer alleges the following facts:

“4. Opposer is the owner and first user of the internationally well-known VENOFER mark, by prior actual use in commerce and prior registration in the Philippines.

4.1. The Opposer first registered its internationally well-known VENOFER mark in the Philippines on November 11, 1998 under Trademark Registration No. 66530.

“5. The Opposer is the owner of the internationally well-known VENOFER mark, by prior actual use in commerce and prior registration worldwide.

“6. The Opposer first registered its internationally well-known VENOFER mark on January 17, 1951 in Sweden. The Opposer has been using the mark openly and continuously around the world since then. To date, VENOFER mark is protected in various jurisdictions worldwide.

“7. The Opposer has extensively sold and promoted its products bearing its internationally well-known VENOFER trademark across the world, including the Philippines xxx

“8. As a result of its promotion, sales and of the excellence of the Opposer’s goods, the Opposer has built and now enjoys valuable goodwill in its business represented by its internationally well-known VENOFER mark. xxx”

To support its opposition, the Opposer submitted as evidence the following:

1. Special Power of Attorney dated 4 March 2015;
2. Joint Affidavit of Dr. Cyrill Blattler and Jean-Marc Ligibel dated 4 March 2015 ;
3. Affidavit of Mr. Claro Enrico A. Borja dated 23 March 2015 ; and
4. Affidavit of Duane Salayog dated 23 March 2015⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 10 April 2015. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 9 September 2015 Order No. 2015-1410 declaring the Respondent-Applicant to have waived its right to file an Answer.

Should the Respondent-Applicant be allowed to register the mark "FEOFER"?

Records show that at the time Respondent-Applicant applied for registration of the mark "FEOFER" the Opposer already registered the mark "VENOFER" under Registration No. 66530 on 11 November 1998 for the goods, namely "Pharmaceutical preparations for the treatment of iron deficiency and iron deficiency anaemia" both under Class 5.

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

Opposer's mark

VENOFER

Respondent-Applicant's mark

FEOFER

The marks are similar with respect to the five letters, "E" and "O-F-E-R". The substitution by the Respondent-Applicant of the first letter of the mark "F" for "V" and the presence of the letter "N" before the suffix "OFER" in Opposer's mark is of no moment. Also, the resultant marks when pronounced are *idem sonans* or phonetically similar. Confusion cannot be avoided by replacing letters of a mark. The Supreme Court in *Dermaline, Inc. v. Myra Pharmaceuticals, Inc.*⁵, held:

While it is true that the two marks are presented differently – Dermaline's mark is written with the first "DERMALINE" in script going diagonally upwards from left to right, with an upper case "D" followed by the rest of the letters in lower case, and the portion "DERMALINE, INC." is written in upper case letters, below and smaller than the long-hand portion; while Myra's mark "DERMALIN" is written in an upright font, with a capital "D" and followed by lower case letters – the likelihood of confusion is still apparent. This is because they are almost spelled in the same way, except for Dermaline's mark which ends with the letter "E," and they are pronounced practically in the same manner in

⁴ Annexes "A" to "C" with submarkings

⁵ G.R. No. 190065, 16 August 2010

three (3) syllables, with the ending letter "E" in Dermaline's mark pronounced silently. Thus, when an ordinary purchaser, for example, hears an advertisement of Dermaline's applied trademark over the radio, chances are he will associate it with Myra's registered mark.

The Supreme Court in the case of Marvex Commercial Co., Inv. V. Petra Hawpia & Co. and the Director of Patents⁶ is instructive on the matter, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS"; the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance (Co Tiong Sa vs. Director of Patents, 95 Phil. 1 citing Nims, The Law of Unfair Competition and Trademarks, 4th ed., vol. 2, pp. 678-679). xxx

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 "Jazz-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.

In the case at bar, "SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see Celanese Corporation of America vs. E. I. Du Pont, 154 F. 2d. 146, 148).

Moreover, as mentioned above, the Opposer's mark are pharmaceutical preparations used for the treatment of iron deficiency and iron deficiency anemia. The Respondent-Applicant's trademark application indicate that the mark will be used on "pharmaceutical products that are anti-anemic for treatment of iron deficiencies, diseases and for pre and post natal".

Succinctly, the public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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

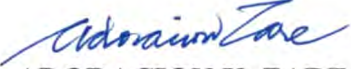
⁶ G.R. No. L-19297, 22 December 1966

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.⁷

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-008051 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 OCT 2016


Atty. **ADORACION U. ZARE, LL.M.**
Adjudication Officer
Bureau of Legal Affairs

⁷*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).