

THERAPHARMA, INC.,
Opposer,

-versus-

TABROS PHARMA PVT. LIMITED,
Respondent- Applicant.

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IPC No. 14-2013-00384
Opposition to:
Appln. Serial No. 4-2013-006579
Date Filed: 07 June 2013
TM: "ROGREL"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 190 dated June 27, 2016 (copy enclosed) was promulgated in the above entitled case.

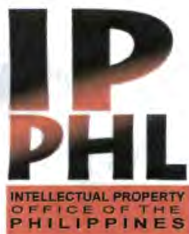
Taguig City, June 27, 2016.

For the Director:


MARILYN F. RETUTAL
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INTELLECTUAL PROPERTY OFFICE

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THERAPHARMA, INC.,

Opposer,

- versus -

IPC NO. 14 - 2013 - 00384

Opposition to:
Trademark Application Serial No.
42013006579

**TABROS PHARMA PVT.
LIMITED,**

Respondent-Applicant.

TM: "ROGREL"

DECISION NO. 2016 - 190

X-----X

DECISION

THERAPHARMA, INC. (Opposer)¹ filed an Opposition to Trademark Application Serial No. 4-2013-006579. The trademark application filed by TABROS PHARMA PVT. LIMITED (Respondent-Applicant)², covers the mark ROGREL for "*Pharmaceutical products used in thromboembolic disorders. It is an analogue of ticlopidine and acts by inhibiting adenosine diphosphate-mediated platelet aggregation. It is given phrophylactically as an alternative to aspirin in patients with atherosclerosis who are at risk of thromboembolic disorders such as myocardial infarction, periperal arterial disease and stroke. Clopidogrel is also used with aspirin in acute coronary syndrome including myocardial infarction and unstable angina.*" under Class 5 of the International Classification of Goods and Services³.

The Opposer alleges:

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

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

¹ A company organized and existing by virtue of and under the laws of Italy, with a registered office address at Vis Tornabuoni 73/R 50123, Firenze (Florence), Italy.

² An individual with a given Philippine address at Stall No. 2F-38 168 Shopping Mall, Binondo, Manila with trademark agent Jeffrey Gomez with address at 23B Northern Polytech St., University Hills Subd., Portrero, Malabon 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.

"9. The registration of the mark 'ROGREL' in the name of the Respondent-Applicant will violate Sec. 123.1. (d) of the IP Code, x x x

"10. Respondent-Applicant's use and registration of the 'ROGREL' will diminish the distinctiveness of Opposer's trademark 'PLOGREL'. x x x

"11. Opposer is the registered owner of the trademark 'PLOGREL'. It is engaged in the marketing and sale of a wide range of pharmaceutical products.

11.1. The trademark application for the trademark 'PLOGREL' was filed with the IPO on 15 October 2007 by Opposer and was approved for registration on 18 February 2018. Thus, the registration of the trademark 'PLOGREL' subsists and remains valid to date. x x x

"12. The trademark 'PLOGREL' has been extensively used in commerce in the Philippines.

12.1. Opposer has dutifully filed Declarations of Actual Use pursuant to the requirement of the law. x x x

12.2. A sample product label bearing the trademark 'PLOGREL' actually used in commerce is hereto attached x x x

12.3. No less than the Intercontinental Marketing Services ('IMS') itself, the world's leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than one hundred (100) countries, acknowledged and listed the brand 'PLOGREL' as one of the leading brands in the Philippines in the category of '*B01C - Platelet Aggreg Inhibitors*' in terms of market share and sales performance. x x x

12.4. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, the product has been registered with the Bureau of Food and Drugs (now Food and Drug Administration). x x x

"13. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark, 'PLOGREL' to the exclusion of all others.

"14. As provided in Section 138 of the IP Code, 'A certificate of registration of a mark shall be *prima facie* evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.'

"15. The registration of Respondent-Applicant's mark 'ROGREL' will be contrary to Section 123.1. (d) of the IP Code. 'ROGREL' confusingly similar to Opposer's trademark 'PLOGREL'.

"15.1 There are no set rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or is a colorable imitation of, another. Nonetheless, jurisprudence provides enough guidelines and tests to determine the same.

x x x

"15.1.6 Thus, applying the dominance test in the instant case, it can be readily concluded that the mark 'ROGREL', owned by Respondent-Applicant, so resembles Opposer's trademark 'PLOGREL', that it will likely cause confusion, mistake and deception on the part of the purchasing public.

"15.1.6.1 Respondent-Applicant's mark 'ROGREL' appears and sounds almost the same as Opposer's trademark 'PLOGREL'.

"15.1.6.2 The last five letters of five (5) letters of Respondent-Applicant's mark 'R-O-G-R-E-L' are exactly the same as Opposer's trademark 'P-L-O-G-R-E-L'.

"15.1.6.3. Respondent-Applicant merely changed the first two (2) letters 'PL' of Opposer's trademark 'PLOGREL' to 'R' in arriving at its mark 'ROGREL'.

"15.1.6.4. Both marks are composed of two (2) syllables, i.e., Respondent-Applicant's mark PLO/GREL and Opposer's mark RO/GREL.

"15.1.7. Clearly, Respondent-Applicant's mark 'ROGREL' adopted the dominant features of the Opposer's trademark 'PLOGREL'.

"15.1.8. As further ruled by the High Court in the *McDonald's Corporation* case (*supra*, p.33-34 [2004])

In short, aurally the two marks are the same, with the first word of both marks phonetically the same, and the second word of both marks also phonetically the same. Visually, the two marks have both two words and six letters, with the first word of both marks having the same letters and the second word having the same letters and the second word having the same first two letters. In spelling, considering the Filipino language, even the last letters of both marks are the same.

x x x

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. x x x

"15.2. Opposer's trademark 'PLOGREL' and Respondent-Applicant's mark 'ROGREL' are practically identically marks in sound and appearance that they leave the same commercial impression upon the public.

"15.3. Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed mark "Rogrel" is applies for the same class and goods as that of Opposer's trademark 'PLOGREL' under Class 05 of the International Classification of Goods for pharmaceutical preparations. x x x

16. To allow Respondent-Applicant to market its products bearing the mark 'ROGREL' undermines Opposer's right to its trademark 'PLOGREL', Opposer is entitled to prevent the Respondent-Applicant from using a confusingly similar in the course of trade where such would likely mislead the public.

16.1. Being the lawful owner of 'PLOGREL', Opposer has the exclusive right to use and/or appropriate the said trademark and prevent all third parties not having its consent from using in the course of trade identical or similar marks, where such would result in a likelihood of confusion.

16.2. By reason of Opposer's ownership of the trademark 'PLOGREL', it also has the right to prevent third parties, such as Respondent-Applicant, from claiming ownership over Opposer's trademark or any depiction similar thereto, without its authority or consent.

16.3. Moreover, following the illustrative list of confusingly similar sounds in trademarks cited in the *McDonald's Corporation* case (*supra*, p. 34 [2004]), it is evident that Respondent-Applicant's mark 'ROGREL' is aurally confusingly similar to Opposer's trademark 'PLOGREL':

"The following random list of confusingly **similar sounds** in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Mark*, 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 'Trade-Mark Law and Practice', pp.419-421, cities, 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. (Emphasis supplied)

16.4. Further, the fact that Respondent-Applicant seeks to have its mark 'ROGREL' registered in the same class (Nice Classification 05) as Opposer's trademark 'PLOGREL' will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

17. The registration and use of Respondent-Applicant's confusingly similar mark 'ROGREL' on its goods will enable the latter to obtain benefit from Opposer's reputation and goodwill, and will tend to deceive and/or confuse the public into believing that Respondent-Applicant is in any way connected with the Opposer. x x x

17.2. The doctrine of confusion of business or origin is based on cogent reasons of equity and fair dealing. It has to be realized that there can be unfair dealing by having one's business reputation confused with another. 'The owner of a trademark of trade or trade name has a property right in which he is entitled to protection, since there is damage to him from confusion of reputation or goodwill in the mind of the public as well as from confusion of goods.' (Ang vs. Teodoro, 74 Phil 50, 55-56 [1942])

17.3. Applying the foregoing to the instant case, to allow Respondent-Applicant to use its mark 'ROGREL' on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the product of Respondent-Applicant with a mark 'ROGREL' originated from or is being manufactured by Opposer, or at the very least, is connected or associated with the 'PLOGREL' product of Opposer, when such connection does not exist.

17.4. In *Canon Kabushiki Kaisha vs. Court of Appeals* (336 SCRA 266, 275 [2000]), the Supreme Court explained that:

'In cases of confusion of business or origin, the question that usually arises is whether the respective goods or services of the senior user and the junior user are so related as to likely cause confusion of business or origin, and thereby render the trademark or tradenames confusingly similar. **Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose** x x x' (Emphasis supplied)

17.5. Clearly, the scope of protection accorded to trademark owners includes not only confusion of goods but also confusion of origin. As in this case, there is undoubtedly also a confusion of the origin of the goods covered by the mark of Respondent-Applicant and trademark Opposer, which should not be allowed.

18. In case of grave doubt, the rule is that, '[a]s 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.' (*Del Monte Corporation, et. Al. vs. Court of Appeals*, 181 SCRA 410, 420 [1990])

19. Respondent-Applicant's use of the mark 'ROGREL' in relation to any of the goods covered by the opposed application, if these goods are considered not similar or closely related to the goods covered by Opposer's trademark 'PLOGREL', will undermine the distinctive character or reputation of the latter trademark. Potential damage to Opposer will be caused as a result of its inability to control the quality of the products put on the market by Respondent-Applicant under the mark 'ROGREL'.

20. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent-Applicant of the mark 'ROGREL.' The denial of the application subject of this opposition is authorized under the IP Code."

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

Exhibit "A" – Copy of the pertinent page of the IPO E-Gazette;

Exhibit "B" – Certified True Copy of the Certificate of Registration No. 4-2007-011440 for the trademark PLOGREL;

Exhibit "C" and "C-1" – Certified True Copies of the Declaration of Actual Use ;

Exhibit "D" – Sample of product label bearing the "PLOGREL" mark;

Exhibit "E" – Certification and Sales Performance issued by IMS;

Exhibit "F" – Certificate of Listing of Identical Drug Product No. 01488;

This Bureau issued and served a Notice to Answer to the Respondent-Applicant on 30 September 2013. However, the Respondent-Applicant did not file an Answer to the Opposition. In view of the failure to file an Answer, an Order dated 3 February 2014 was issued declaring the Respondent-Applicant in default. Consequently, this case was deemed submitted for decision.

The basic issue to be resolved in the instant case is whether Respondent-Applicant's trademark ROGREL should be allowed for registration.

The competing marks are reproduced below for comparison:

Plogrel

Opposer's Trademark

ROGREL

Respondent-Applicant's Trademark

The instant opposition is anchored on Section 123.1, paragraph (d), of the IP Code which 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 mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed her trademark application on 7 June 2013, the Opposer has already a prior and existing trademark registration for the mark PLOGREL. Nevertheless, this Bureau finds that it is unlikely that the coexistence of the marks will cause confusion, much less deception, among the public.

Both the mark ends with the suffix “-OGREL.” In this regard, there is sufficient reason to infer and conclude that the common suffix came from CLOPIDOGREL, which is the generic name for the pharmaceutical products subject of the two trademarks. Thus, the said trademarks are suggestive mark and therefore a weak mark with respect to medical goods or services. It readily gives away or tells the consumers the goods or service, and/or the kind, nature, use or purpose thereof. The Opposition therefore cannot be sustained solely on account of the marks having the same suffix (“OGREL”) because to do so would have the unintended effect of giving the Opposer practically the exclusive right to use “OGREL” which obviously refers to the generic name.

Hence, what will set apart or distinguish two trademarks that both contain the suffix OGREL and used on similar or related goods are the letters and/or syllables that precedes or accompany the said suffix. In the instant case, Respondent-Applicant’s mark starts with the letter “R” which is totally different in both visual appearance and phonetic effect from the letters “P” and “L” of Opposer’s mark, “PLOGREL”.

Undoubtedly, the clear differences in the starting letters of the contending word marks are sufficient safeguard in order not to misled or confused the consumer into believing that the Respondent-Applicant's goods came or originated from or connected to or associated with the Opposer's.

Time and again, it has been held in our jurisdiction 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 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. This Bureau finds the Respondent-Applicant's mark consistent with this function.

WHEREFORE, premises considered, the instant Opposition to the Trademark Application No. 4201300006579 is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4201300006579 be returned together with a copy of this **DECISION** to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 27 JUN 2016


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