

UNITED LIFE SCIENCES PTY. LTD.,
Opposer,

-versus-

WESTFIELD PHARMACEUTICAL, INC.,
Respondent- Applicant.

X-----X

IPC No. 14-2015-00265

Opposition to:

Appln. Serial No. 4-2014-00012547

Date Filed: 10 October 2014

TM: "ASFLEM"

NOTICE OF DECISION

OCHAVE & ESCALONA

Counsel for Opposer
No. 66 United Street
Mandaluyong City

WESTFIELD PHARMACEUTICAL, INC.

Respondent-Applicant
831-A Eugenio Lopez St. cor. EDSA
Quezon City

GREETINGS:

Please be informed that Decision No. 2016 - 256 dated July 19, 2016 (copy enclosed) was promulgated in the above entitled case.

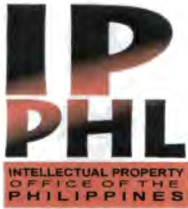
Taguig City, July 20, 2016.

For the Director:


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

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
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph



UNITED LIFE SCIENCES PTY. LTD.,
Opposer,

- versus -

**WESTFIELD
PHARMACEUTICAL INC.,**
Respondent-Applicant.

X ----- X

IPC No. 14-2015-00265

Opposition to:

Appln. No. 4-2014-012547

Date Filed: 10 October 2014

Trademark: **"ASFLEM"**

Decision No. 2016 - 256

DECISION

UNITED LIFE SCIENCES PTY. LTD. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2014-012547. The application, filed by WESTFIELD PHARMACEUTICAL INC. ("Respondent-Applicant")², covers the mark "ASFLEM" for use on goods under class 05³ namely: pharmaceutical products containing the following as active ingredients: vitex negundo lagundi leaf.

The Opposer alleges the following grounds for opposition:

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

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

"9. The registration of the mark 'ASFLEM' 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:

xxx

(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;**

xxx (Emphasis supplied)

¹ A corporation duly organized and existing under and by virtue of the laws of Singapore with office address at No. 1 Sophia Road #08-01/04, Peace Center, Singapore 228149.

² With office address at #831-A Eugenio Lopez St. cor. EDSA, Quezon City, Metro Manila, Philippines.

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.

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.

"10. Respondent-Applicant's use and registration of the mark 'ASFLEM' will diminish the distinctiveness of Opposer's trademark 'EXFLEM'."

The Opposer's evidence consists of the following:

1. Copy of the pertinent page of the IPO E-Gazette released on 11 May 2015;
2. Certified true copy of the Certificate of Registration No. 4-2011-009659 for the trademark EXFLEM dated 05 January 2012;
3. Certified true copy of the Declaration of Actual Use of EXFLEM; and,
4. Certification and sales performance issued by the Intercontinental Marketing Services ("IMS").

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 13 July 2015. Respondent-Applicant however, did not file an answer. Thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision.⁴

Should the Respondent-Applicant be allowed to register the trademark "ASFLEM"?

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 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.⁵

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, also known as the Intellectual Property 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 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 10 October 2014⁶, the Opposer has already an existing trademark registration for the mark EXFLEM bearing Registration No. 4-2011-009659 issued on 05 January 2012⁷ in the Philippines. The Opposer also submitted its Declaration of Actual Use⁸ within three (3) years from filing thereof. Unquestionably, the Opposer's application and registration preceded that of Respondent-Applicant's.

A comparison of the Opposer's mark with the Respondent-Applicant's is depicted below:

EXFLEM

Opposer's Trademark

ASFLEM

Respondent-Applicant's Trademark

⁴ Order No. 2016-269 dated 11 February 2016.

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

⁶ Filewrapper records.

⁷ Exhibit "B" of Opposer.

⁸ Exhibit "C" of Opposer.

The competing marks consist of two (2) syllables, with identical suffix "FLEM". The only difference are the prefixes "EX" in EXFLEM; as against "AS" in ASFLEM, which prominently contains a vowel and a consonant, respectively. The visual and aural similarities of the marks are very apparent. The font design depicts no significant individuality. The aural effect when the marks are pronounced creates perplexity because of the prevailing similarities in its letter component.

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 class 05. Opposer's EXFLEM covers pharmaceutical preparations for cough.⁹ On the other hand Respondent-Applicant's ASFLEM pharmaceutical products containing the following as active ingredients: vitex legundo lagundi leaf. Lagundi (scientific name: *Vitex negundo*) is a shrub that grows in the Philippines. It is one of the ten herbal medicines endorsed by the Philippine Department of Health as an effective herbal medicine with proven therapeutic value. Commonly known in the Ilocos region as dangla, lagundi has been clinically tested to be effective in the treatment of colds, flu, bronchial asthma, chronic bronchitis, and pharyngitis. Studies have shown that Lagundi can prevent the body's production of leukotrienes, which are released during an asthma attack. Lagundi contains Chrysoplenol D, a substance with anti-histamine and muscle relaxant properties. Even in Japan, lagundi is becoming recognized as an effective herbal medicine, especially since researches have shown that it contains properties that make it an expectorant and it has been reported to function as a tonic as well. More than that, most of the parts of the lagundi plant have medicinal value. likewise covers pharmaceutical preparations namely anti-bacterial.¹⁰ Thus, they are intended for the same or related illness. It may happen that these medicines are disposed by the pharmacist by mistake committed either in reading the prescription, or simply by disposing because these are over-the-counter type of medicine.

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

⁹ Id. at 7.

¹⁰ Philippine Herbal Medicine, available at <http://www.philippineherbalmedicine.org/lagundi.htm> (last accessed 14 July 2016).

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.

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.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-00012547 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City

19 JUL 2018


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