TAKEDA GMBH, *Opposer,*	}	**IPC No. 14-2014-00266** Opposition to:
-versus-	}	Appln. Serial No. 4-2014-003723 Date of Filed: 25 March 2014
ELLEBASY MEDICAL TRADING, *Respondent-Applicant.*	}	**TM: PENTOLAC**

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 457 dated 14 December 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 15 December 2016.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

TAKEDA GMBH
Opposer,

- versus -

ELLEBASY MEDICAL TRADING,
Respondent-Applicant.
x ---------- x

IPC No. 14-2014-00266
Opposition to:

Appln. No. 4-2014-003723
Date Filed: 25 March 2014
Trademark: **"PENTOLAC"**

Decision No. 2016 - 457

DECISION

TAKEDA GMBH ("Opposer"),[1] filed a Verified Opposition to Trademark Application Serial No. 4-2014-003723. The application, filed by ELLEBASY MEDICAL TRADING ("Respondent-Applicant")[2], covers the mark "PENTOLAC" for use on *"pharmaceutical product - non-steroidal anti-inflammatory drug"* under class 05 of the International Classification of Goods.[3]

The Opposer alleges that it is the owner of the mark PANTOLOC, which was first filed for registration with this Honorable Office on 16 September 1994. It obtained said registration under Certificate of Registration No. 62852 for goods under Class 5 (Human medicines, in particular gastrointestinal drugs and/or drugs for the treatment of osteoporosis) on 21 May 1996. On the other hand, Respondent-Applicant only applied for the registration of the mark PENTOLAC for the same class of goods (Class 5 for pharmaceutical product - no-steroidal anti-inflammatory drugs) on March 25, 2014, and has yet to present proof of use of said mark. Clearly, Opposer's trademark was filed and registered much earlier than the filing of Respondent-Applicant of its application with this Honorable Office.

Opposer likewise alleged that it has been using its mark for 20 years as early as February 1994 in South Africa. In the Philippines, Opposer first used its PANTOLOC mark in April 1997 and has consistent distribution ever since. It is imported in the Philippines by Takeda Pharma and sold through its official sales distributor Zuellig Pharma, and are available to consumers in countless hospitals and pharmacies.

Accordingly, Opposer's goods bearing PANTOLOC marks enjoy global acclaim and are internationally well-known. Apart from the Philippines, Opposer's goods are also sold and distributed worldwide for many years in such countries as but not limited to: Austria, Australia, Canada, People's Republic of China, Denmark, Hong Kong, Korea, Sweden, Vietnam and South Africa among others.

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1 A corporation duly organized and existing under the laws of Germany, with principal office at Byk-Gulden-Str. 2, 78467 Konstanz, Germany.

2 With address at Room 201 DMC Building, Diamond Street, corner Felix Avenue, CVS Homes I, Cainta, Rizal.

3 The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

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Opposer or its affiliates also extensively and continuously advertise its products, trademarks and name in various newspapers and magazines worldwide. It has prevalent online presence through its website, www.takeda.com.

This opposition is therefore based on Respondent-Applicant's use of the mark PENTOLAC which results in likelihood of confusion. The similarity between the Respondent-Applicant's PENTOLAC mark and the Opposer's duly-registered PANTOLOC mark is beyond repute. PENTOLAC and PANTOLOC are both simple arbitrary word marks with the same number of letters and syllables. The marks are applied on the same or similar kind of product, offered to the same target market and sold through the same channels.

The Opposer's evidence consists of the following:

1. Legalized and authenticated Affidavit-Testimony;
2. Certified true copy (Ctc) of Philippine Trademark Reg. No. 62852;
3. Ctc of Deutchland Reg. No. 1184611;
4. Ctc of Osterreich Austia Reg. No. 138803;
5. Ctc of Australia Reg. No. A605932;
6. Ctc of WIPO Madrid Reg. No. 603783;
7. Ctc of Hong Kong Reg. No. 04900;
8. Ctc of South Africa Reg. No. 93/6564;
9. Ctc of Alicante Spain Reg. No. 003176013;
10. Ctc of Sales Invoice Nos. 0082700151, 0082700152, 0082700153, 0082700157, 0082700166, 0082700167, 0082700168, and 0082700169;
11. Brochure;
12. Catalogs;
13. Annual Report 2014;
14. Packaging materials;
15. Product samples (tablet pack);
16. Vial sample;
17. Legalized and authenticated Special Power of Attorney; and
18. Legalized and authenticated Secretary's Certificate.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 23 September 2014. Respondent-Applicant however, did not file an answer. Thus, it is declared in default and this case is deemed submitted for decision[4].

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

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, otherwise 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 25 March 2014[5], the Opposer has already an existing and active trademark registration for

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4 Order No. 2015-226 dated 03 February 2015.
5 Filewrapper records.

the mark PANTOLOC bearing Registration No. 62852 issued on 21 May 1996[6]. It also has registration of its PANTOLOC mark in various foreign countries[7]. Unquestionably, the Opposer's applications and registrations preceded that of Respondent-Applicant's.

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

Opposer's Trademark	Respondent-Applicant's Trademark
Pantoloc	Pentolac

The competing marks consist of three (3) syllables and evidently use the same consonants, such that when the marks are pronounced, the marks generate the same aural resonance. Moreover, they are both written in a combination of upper case and lower case letters in simple font without any device. Thus, the marks also appear visually similar. The only difference are the vowels in the first and last syllable which are not significant to distinguish the marks from one another.

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.[8] 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.[9]

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.[10] 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:[11]

> 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

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6 Exhibit "B" of Opposer. IPPhil Trademark Database, available at http://www.wipo.int/branddb/ph/en/ (last accessed 13 December 2016).
7 Exhibits "C-1" to "C-6" of Opposer.
8 Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.
9 Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.
10 American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.
11 Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.

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.

This Bureau further underscores the fact that the competing marks cover goods which are similar and/or related in its kind, use, purpose and nature. This determines the likelihood of confusion by reason of Opposer's PANTOLOC registration which covers *"human medicines, in particular gastrointestinal drugs and/or drugs for the treatment of osteoporosis"*[12], which is identical to the goods covered by that of Respondent-Applicant's PENTOLAC, which as indicated in the application documents as *"pharmaceutical product - non-steroidal anti-inflammatory drug"*. They are deemed related to each other because anti-inflammatory drugs are used to manage osteoporosis pain. They are intended for related purpose, cater to the same group of purchasers or patients, and available in the same channels of trade. Moreover, the coverage of the Respondent-Applicant's trademark registration would allow using the mark PENTOLAC on goods or pharmaceutical products that are already dealt in by the Opposer using the mark PANTOLOC.

Finally, it must be emphasized that the Respondent-Applicant was given opportunity to defend its trademark application. It, however, failed to do so. 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. 4-2014-003723 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 14 DEC 2016

Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

[12] Id. at 6.