

WESTMONT PHARMACEUTICALS, INC.,
Opposer,

-versus-

INNOGEN PHARMACEUTICALS, INC.,
Respondent- Applicant.

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}
} **IPC No. 14-2013-00153**
} Opposition to:
} Appln. Serial No. 4-2012-013448
} Date Filed: 06 November 2012
} **TM: "DESLOGEN"**
}

NOTICE OF DECISION

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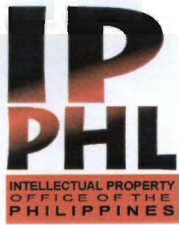
GREETINGS:

Please be informed that Decision No. 2016 - 477 dated December 20, 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, December 20, 2016.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



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Opposer,

- versus -

INNOGEN PHARMACEUTICALS, INC.,
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IPC No. 14-2013-00153
Opposition to:

Appln. No. 4-2012-013448
Date Filed: 06 November 2012
Trademark : "DESLOGEN"

Decision No. 2016 - 477

DECISION

WESTMONT PHARMACEUTICALS, INC. ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2012-013448. The application, filed by INNOGEN PHARMACEUTICALS, INC. ("Respondent-Applicant")², covers the mark "DESLOGEN" for use on "*anti-allergy preparations*" under class 05 of the International Classification of Goods³.

The Opposer alleges the following grounds for this instant opposition:

"7. The mark 'DESLOGEN' owned by Respondent-Applicant so resembles the trademark 'DECOLGEN' owned by Opposer and duly registered with the IPO prior to the publication for opposition of the mark 'DESLOGEN'.

"8. The mark 'DESLOGEN' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'DESLOGEN' is applied for the same class and goods as that of Opposer's trademark 'DECOLGEN', i.e. Class 05 of the International Classification of Goods as Anti-Allergy. Opposer's trademark 'DECOLGEN' is being used in pharmaceutical preparation, which contains Chlorphenamine Maleate, an active substance for anti-allergy.

"9. The registration of the mark 'DESLOGEN' in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides, in part, that a mark cannot be registered if it:

(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;
- (Emphasis supplied)

¹ A domestic corporation duly organized and existing under the laws of the Philippines, with principal business address at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

² A domestic corporation, with office address at 29 Scout Bayoran St., Quezon City, Philippines.

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.

x x x

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."

The Opposer's evidence consists of the following:

1. Copy of the pertinent page of the IPO E-Gazette on the publication for opposition of Respondent-Applicant's application for registration of trademark DESLOGEN;
2. Certified true copy (Ctc) of the Certificate of Registration No. 14438 for the trademark DECOLGEN;
3. Ctc of the Certificate of Renewal of Registration No. 014438;
4. Ctcs of the Affidavits of Use;
5. Sample product label and product insert bearing the trademark DECOLGEN;
6. Copy of the Certification and sales performance; and,
7. Ctc of the Certificate of Product Registration issued by the BFAD for DECOLGEN.

On 31 May 2013, Respondent-Applicant filed its Answer stating the following Affirmative Defenses:

"2. The crux of the matter is the issue of confusing similarity between Opposer's mark DECOLGEN and Respondent's mark DESLOGEN, i.e. DE-COL-GEN and DES-LO-GEN considering that they are both pharmaceutical preparations.

2.1 However, assuming that they MAY sound/spelled similarly- the circumstances and facts in relation to prevailing doctrines do not favor Opposer's position.

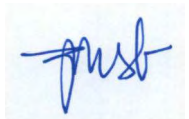
"3. First, although the goods to which the marks are used are within the same class, they are not confusingly similar.

a) In Opposer's DECOLGEN- the pharmaceutical preparation contains three (3) different active ingredients namely: Phenylephrine HCl + Chlorphenamine Maleate + Paracetamol.

b) On the other hand, Respondent's DESLOGEN has only one active ingredient- DESLORATADINE- a substance totally different in chemical structure.

c) Under the generics law and its implementing rules, pharmaceutical products are to be sold under a standard format, i.e. the generic name of the product should be more visible and enclosed in a box. This is the case in the corresponding packaging of the competing marks. On the other hand, the same law also provides that in issuing prescriptions- doctors should issue such prescription using generic names with the trademark only as an option.

3.1 Consequently, when a patient will submit the prescription to the pharmacist in a drug store to buy DECOLGEN products- the prescription will readily read the active ingredients (Phenylephrine HCl + Chlorphenamine Maleate + Paracetamol) thereof with the name DECOLGEN only as an option. Thus, it is far-fetched that a patient intending to buy a DECOLGEN could buy Respondent's product DESLOGEN as the latter's packaging will clearly indicate that the active ingredient is DESLORATADINE.



"4. Second, the use of the letters D-E-S-L-O was not intended to ride on the popularity of the mark DECOLgen as alleged in essence by the Opposer. The truth of the matter is that the letters D-E-S-L-O were taken from active ingredient of Respondent's product which is DESLO-GEN.

"4.1 On the other hand, the letters G-E-N were taken from the name of the Applicant-INNOGEN.

"5. Moreover, the name of the Respondent (INNOGEN) as the source of DESLOGEN products are clearly seen from the trade boxes."

The Respondent-Applicant's evidence consists of the following:

1. Sample packaging in box of DESLOGEN bearing the generic name DESLORATADINE;
2. Sample product insert of DESLOGEN;
3. Sample product packaging of DESLOGEN tablets; and,
4. Affidavit of Sonny Bob Cardinal.

The Preliminary Conference was held and terminated. The parties submitted their respective position papers. Thereafter, this case is submitted for decision.

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

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.⁴

Section 123.1 paragraph (d) of R.A. No. 8293, also 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.

Records show that the Opposer has registration for the trademark DECOLGEN dated 09 June 1967, covering class 05 goods namely "a medicinal preparation comprising of Phenylpropanolamine HCl, N-Acetyl-P-Aminophenol, Chlorpheniramine Maleate and Ascorbic Acid used as a treatment against common cold and other upper respiratory affections"⁵. A Certificate of Renewal of Registration for DECOLGEN was granted until 30 January 2019⁶. Unquestionably, the Opposer's application and registration preceded that of Respondent-Applicant's application for the subject mark DESLOGEN⁷.

⁴ 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).

⁵ Exhibit "B" of Opposer.

⁶ Exhibit "C" of Opposer.

⁷ Filewrapper.

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

DECOLGEN **DESLOGEN**

Opposer's Trademark

Respondent-Applicant's Trademark

A perusal of the above-illustrated competing marks reveal a word structure of three (3) syllables, with similar first two (2) letters and last three (3) letters. However, these similarities are outweighed by elements that distinguish one mark from another. "DE" and "DES", which are the starting syllables of the Opposer and the Respondent-Applicant's marks, respectively, do not sound the same because of the letter "S" vibration from the syllable "DES". Moreover, the middle syllables "COL" and "LO" respectively, differ in its component and character that cause the apparent visual and aural distinction of the marks.

The Respondent-Applicant justified the adoption of the trademark DESLOGEN. Respondent-Applicant has substantial proof that the generic name of DESLOGEN is DESLORATADINE⁸. It is therefore reasonable to believe that the first two syllables "DES-LO" are taken from its generic name. This is a common practice in branding pharmaceutical products. Moreover, the Respondent-Applicant affirmed that the last syllable "GEN" in DESLOGEN was taken from its company name "INNOGEN". On the other hand, Opposer's mark DECOLGEN has the generic name PHENYLEPHRINE HCI CHLORPHENAMINE MALEATE PARACETAMOL⁹. The generic names are both boldly printed in their sample packaging and on the product, prominently enclosed in rectangular box. The presence of which cannot be mistaken or left unnoticed by the drug pharmacists and the consumers.

Corollarily, the likelihood of the consumers being deceived, mistaken or confused is remote because Opposer's DECOLGEN is a medicine against common cold and other upper respiratory affections; in contrast to Respondent-Applicant's DESLOGEN which is an anti-allergy drug, particularly used for the symptomatic relief of allergy such as hay fever and ulticaria¹⁰. While the competing products belong to the same classification of goods, they are directed for different purposes. In fact, both medicines display different generic names, both visibly sufficient to distinguish the marks without possibility of confusion.

The sheer disparity of the nature and purposes of the goods and the manner by which the Respondent-Applicant's goods under the mark DESLOGEN are sold, distributed and eventually used precludes the probability of confusion or mistake. Moreover, the Respondent-Applicant cannot be said to have the intent to ride in the goodwill of the mark DECOLGEN. It is unlikely for one when confronted with the mark DESLOGEN to be reminded of the mark DECOLGEN and *vice versa*.

⁸ Exhibit "1" to "4" of Respondent-Applicant.

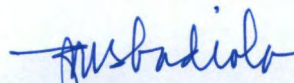
⁹ Exhibit "E" of Opposer.

¹⁰ Exhibits "2" and "3" of Respondent-Applicant. (define hay fever and ulticaria)

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-013448 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. **20 DEC 2016**



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