UNITED HOME PRODUCTS, INC.,	}	**IPC No. 14-2015-00373**
Opposer,	}	Opposition to:
	}	Appln. Serial No. 4-2015-002483
	}	Date Filed: 06 March 2015
-versus-	}	**TM: RAPIDOL**
	}	
	}	
PASTEUR PHARMACEUTICALS,INC.,	}	
Respondent- Applicant.	}	

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NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for the Opposer
No. 66 United Street
Mandaluyong City

GLENN P. GAMBOA
Respondent-Applicant's Representative
First Floor, SGS Foundation Building
1335 G. Araneta Avenue
Quezon City

GREETINGS:

Please be informed that Decision No. 2017 - 91 dated March 23, 2017 (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, March 24, 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

UNITED HOME PRODUCTS, INC.,
Opposer,

versus-

PASTEUR PHARMACEUTICALS, INC.,
Respondent-Applicant.
x----------x

IPC NO. 14-2015-00373

Appln. Ser. No. 4-2015-002483
Filing Date: 06 March 2015
Trademark: **RAPIDOL**

Decision No. 2017 - 91

DECISION

UNITED HOME PRODUCTS, INC.,[1] ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2015-002483. The application, filed by PASTEUR PHARMACEUTICALS, INC.[2] ("Respondent-Applicant") covers the mark RAPIDOL for use on *"pharmaceutical product -tablet"* under Class 05 of the International Classification of Goods[3].

Opposer alleges that the mark RAPIDOL filed by Respondent-Applicant so resembles its own trademark REXIDOL which they own and is duly registered with the Intellectual Property Office (IPO) prior to the publication of the application for the mark RAPIDOL. According to Opposer, the mark RAPIDOL will likely cause confusion, mistake and deception on the part of the purchasing public because it is being applied for the same class and goods, in violation of Section 123.1(d) of the IP Code.

The Opposer's evidence consists of the following:

1. Copy of the printout page of IPOPHL's E-Gazette dated 06 July 2015;
2. Certified true copy of Registration No. 20524 for the mark REXIDOL issued on 08 November 1973;
3. Certified copy of the Assignment of Registered Trademark;
4. Certified copy of Certificate of Renewal Registration issued on 08 November 2013
5. Certified true copies of Affidavits of Use for the mark REXIDOL;
6. Sample product label bearing the mark REXIDOL;
7. Certified true copy of the Certificate of Product Registration for REXIDOL issued by the Food and Drug Administration; and
8. Certified true copy of Certification and sales performance issued by IMS Health.

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[1] A domestic corporation with address at 4th Floor Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.
[2] A domestic corporation with address at 1/F SGS Foundation Building, 1335 G. Araneta Avenue, Quezon City.
[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.

This Bureau issued on 25 August 2015 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 03 September 2015. On 30 September 2015, Respondent-Applicant filed the Answer.

Respondent-Applicant alleges that it is the prior registrant of the mark RAPIDOL. According to Respondent-Applicant, the present application for registration of the mark RAPIDOL is a mere re-filing of an earlier approved mark. Respondent-Applicant also claims that the mark RAPIDOL has been in use, well-known and existing not only in the local commerce but also in the international market. Also, Respondent-Applicant posits that RAPIDOL is not confusingly similar to Opposer's REXIDOL visually and aurally.

Opposer's evidence consists of the following:

1. Copy of Certificate of Registration No. 4-2004-010339 for the mark RAPIDOL issued on 18 September 2006;
2. Certified copy of the List of Products to Be Manufactured under License No. KD-237 by M/S Flamingo Pharmaceuticals Ltd. in India;
3. Certified photocopy of the packaging label, leaflet and RAPIDOL product; and
4. Certified photocopy of the sample packaging label for REXIDOL product, the product itself and leaflet.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation on 09 October 2015. However, the parties failed to settle their dispute. The preliminary conference was terminated on 21 June 2016 and Opposer was directed to submit position paper. On the other hand, Respondent-Applicant's right to file its position paper was deemed waived for failure to appear during the preliminary conference. On 01 July 2016, Opposer filed its Position Paper.

Should the Respondent-Applicant be allowed to register the mark **RAPIDOL**?

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 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.[4]

Section 123.1 (d) of Republic Act No. 8293, as amended, otherwise known as the "Intellectual Property Code of the Philippines, as amended, provides:

Section 123.*Registrability*. - 123.1. A mark cannot be registered if it:

x x x

(d) Is identical with a registered mark belonging to a different proprietor or a

[4]See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

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;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, said mark cannot be registered.

The records show that at the time the Respondent-Applicant filed its application for the mark RAPIDOL on 06 March 2015, the Opposer already has an existing registration for the trademark REXIDOL issued way back in 08 November 1973 under Certificate of Registration No. 22459. As such, pursuant to Section 138 of the IP Code, being a holder of a certificate of registration, such "certificate of registration is a prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto."

But are the competing marks, as shown below, identical or similar or resemble each other such that confusion, mistake or deception is likely to occur?

REXIDOL	**Rapidol**
Opposer's Mark	Respondent-Applicant's Mark

A perusal of the composition of the competing trademarks involved in this case show that both marks contain three syllables "RE-XI-DOL" for the Opposer's mark and "RA-PI-DOL" for Respondent-Applicant's. Both marks contain seven (7) letters, the first and the last four (4) letters being the same; they also have similar first letter "R" and third syllable "DOL". They differ only in two letters, that is, the letters "E-X" in Opposer's mark is changed or replaced with "A-P" to form the mark RAPIDOL. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark.[5] The difference noted in the Respondent-Applicant's mark when compared to Opposer's, does not in any way deviate from a finding of confusing similarity. Respondent-Applicant's mark has a similar overall impression as that of Opposer's.

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two marks is such that there is possibility of the older brand

[5] See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

mistaking the newer brand for it.[6]

Colorable imitation does not mean such similitude as amounts to identity. Nor does it require that all the details be literally copied. Colorable imitation refers to such similarity in form, content, words, sound, meaning, special arrangement, or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely mislead or confuse persons in the ordinary course of purchasing the genuine article.[7]

In *Societe Des Produits Nestle vs. Court of Appeals*,[8] the Supreme Court stated that:

> "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 giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other."

Furthermore, aside from the visual similarity, when Respondent-Applicant's RAPIDOL mark is pronounced, it produces the same sound as that of Opposer's REXIDOL such that to the ears they are indistinguishable from one other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it.

In *Marvex Commercial Co. Inc. v. Petra Hawpia & Co., et. Al.*[9], the Supreme Court ruled:

> 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 special significance (Co Tiong Sa vs. Director of Patents, 95 Phil. I, citing Nims, The Law of Unfair Competition and Trademarks, 4th ed., Vol. 2, pp. 678-679). 'The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must depend entirely on the ear' (Operators, Inc. vs. Director of Patents, supra).
>
> 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 '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

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6 American Wire & Cable Company Vs. Director Of Patents [G.R. No. L-26557. February 18, 1970.]
7 Emerald Garments Manufacturing Corporation vs. Court of Appeals, G.R. No. 100098. December 29, 1995.
8 G.R. No. 112012. April 4, 2001
9 *G.R. No. L-19297. 22 December 1966*

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).

It is also stressed that the Respondent-Applicant's products are similar or closely related to the Opposer's, that is, they are used on paracetamol to Class 5. Considering, therefore, the similarity in the appearance and sound of the marks as well as the fact that the marks are used on similar or related goods, it is likely that the usually unwary or incautious or confused person may make a mistake in buying or selling or dispensing the Respondent-Applicant's product supposing it to be the product of Opposer or vice versa.

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. 4-2015-002483, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 MAR 2017.

MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs