

INTERVET INTERNATIONAL B.V.,
Opposer,

-versus-

MASSIVE DYNAMICS AGRO RESOURCES, INC.,
Respondent-Applicant.

X-----X

IPC No. 14-2016-00073

Opposition to:

Appln. Serial No. 4-2015-010346

Date Filed: 08 September 2015

TM: PARACURE

NOTICE OF DECISION

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Respondent- Applicant
#23 A Howmart Road, Brgy. Apolonio Samson,
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GREETINGS:

Please be informed that Decision No. 2017 - 127 dated 19 April 2017 (copy enclosed) was promulgated in the above entitled case.

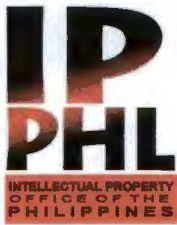
Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 20 April 2017.

MARILYN F. RETUAL

IPRS IV

Bureau of Legal Affairs



INTERVET INTERNATIONAL B.V.,
Opposer,

IPC NO. 14-2016-00073

versus-

Appln. Ser. No. 4-2015-010346
Filing Date: 08 September 2015
Trademark: PARACURE

MASSIVE DYNAMICS AGRO
RESOURCES, INC.,
Respondent-Applicant.

x-----x

Decision No. 2017 - 127

DECISION

INTERVET INTERNATIONAL B.V.¹ ("Opposer"), filed an Opposition to Trademark Application No. 4-2015-010346. The application, filed by MASSIVE DYNAMICS AGRO RESOURCES, INC.² ("Respondent-Applicant") covers the mark PARACURE for use on "*pharmaceutical and veterinary preparations*" under Class 05 of the International Classification of Goods³.

The Opposer alleges that it is the creator and registered owner of the mark PANACUR which is covered by Registration No. 026308 issued on December 29, 1978 by the then Bureau of Patents and Trademarks (now Intellectual Property Office "IPO") for "*pharmaceutical preparations for veterinary use*" in Class 5. According to Opposer, the mark PARACURE being applied for registration by Respondent is a colorable imitation of, and confusingly similar to opposer's registered mark PANACUR as to be likely when applied to or used in connection with respondent's goods, to cause confusion or mistake and deceive the public, in that the public may be led to believe that the goods of the respondent are owned by opposer, or originated from or sponsored by opposer. Also, the approval of the application will violate the opposer's right to the exclusive use of its registered mark PANACUR and will cause grave and irreparable damage and injury pursuant to Sec. 134 of the IP Code.

The Opposer's evidence consists of the following:

1. Legalized and authenticated Sworn Statement of Henriette J. van RIJSEN;
2. Certified copy of Certificate of RENEWAL Registration No. 26308 for the mark PANACUR issued originally on 29 December 1978 and renewed on 29 December 1998;
3. Legalized and authenticated Special Power of Attorney; and
4. Photocopy of the label or packaging material for the PANACUR powder premix product.

This Bureau issued on 22 April 2016 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 05 May 2016. The Respondent-Applicant, however, did not file the answer. On 28 February 2017, this Bureau declared Respondent-Applicant in default. Accordingly,

¹ A corporation duly organized and existing under the laws of The Netherlands with address at Wim de Korverstraat, 5831 An Boxmeer, The Netherlands.

² A domestic corporation with address at at 23 A Howmart Road, Brgy. Apolonio Samson, Balintawak, 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.

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pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

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

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 (IP Code), 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 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 **PARACURE** on 08 September 2015, the Opposer already has an existing registration for the trademark **PANACUR** issued way back on 29 December 1978 under Certificate of Registration No. 26308. 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, resemble each other such that confusion, mistake or deception is likely to occur?

Panacur

Opposer's Mark

PARACURE

Respondent-Applicant's Mark

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

The competing marks are word marks that appeal both to the visual and aural senses. A comparison of the marks shows that they contain three syllables, "PA-NA-CUR" for the Opposer's and "PA-RA-CURE" for Respondent-Applicant's. Both marks have similar first syllable "PA"; in the second syllable, Respondent-Applicant changed the letter "N" in Opposer's mark to letter "R"; and in the third syllable both marks contain the letters "C-U-R" with an addition of a letter "E" at the end in Respondent's mark. These differences, however, between the marks are very trivial to evade a finding of confusing similarity. Respondent-Applicant's mark has a similar overall impression as that of Opposer's.

Aside from the visual similarity, when Respondent-Applicant's PARACURE mark is pronounced, it produces the same sound as that of Opposer's PANACUR mark that it becomes undistinguishable from each 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. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

In *Maroex Commercial Co. Inc. vs. Petra Hawpia & Co., and The Director of Patents*⁵, 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 especial 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, cites, 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.

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)."

Furthermore, the likelihood of confusing similarity between the marks of the parties are made

⁵ G.R. No. L-19297. 22 December 1966

more evident because both marks are used on "pharmaceutical and veterinary preparations" under Class 05. Considering that the goods of the parties are similar, there is likelihood that any impression, perception or information about the goods advertised under the mark PARACURE may be unfairly attributed or confused with Opposer's PANACUR, and vice versa.


It must be emphasized that the registration of trademarks involves public interest. Public interest, therefore, require that only marks that would not likely cause deception, mistake or confusion should be registered. The consumers must be protected from deception, mistake or confusion with respect to the goods or services they buy. Trademarks serve to guarantee that the product to which they are affixed comes up to a certain standard quality. Modern trade and commerce demands that depredations on legitimate trademarks should not be countenanced. The law against such depredations is not only for the protection of the owner but also, more importantly, for the protection of consumers from confusion, mistake, or deception as to the goods they are buying.⁶

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. 4-2015-010346, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 APR 2017


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs

⁶ *Le Chemise Lacoste, S.A. v. Oscar C. Fernandez et. al.*, G.R. Nos. 63796-97 and G.R. No. 65659, 21 May 1984.