

AMERICAN CYANAMID COMPANY,
Opposer,

INTER PARTES CASE NO. 2027

OPPOSITION TO:

- versus -

Application Serial No. 51376
Filed : June 13, 1983
Applicant : Pediatrica, Inc.
Trademark : PEDIAMOX
Used on : Antibiotic Preparation

PEDIATRICA, INC.,
Respondent-Applicant.
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DECISION NO. 88-114 (TM)
December 29, 1988

DECISION

American Cyanamid Company, an American corporation, filed an Opposition to Application Serial No. 51376 for the trademark "PEDIAMOX" used on antibiotic preparation, which application was filed on June 13, 1983 by Pediatrica Inc., a domestic corporation.

Opposer filed this Opposition on the ground, among others, that Respondent-Applicant's Trademark "PEDIAMOX" is confusingly similar with Opposer's registered mark "DIAMOX" (Certificate of Registration No. 29817; Exh. "C"). Opposer argued that the trademarks "DIAMOX" and "PEDIAMOX" are similar both in sound and spelling, that the rule against confusingly similarity of trademarks should be applied with greater force to prescription drugs, and that the registration and use of the trademark "PEDIAMOX" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "DIAMOX".

Respondent-Applicant, on the other hand, filed its Answer raising the following affirmative defenses: (1) that "PEDIAMOX" is distinctive and different from "DIAMOX" in dosage format, spelling, packaging, layout, colors and other details as evidenced by the labels; (2) that in pronouncing "PEDIAMOX", the emphasis on "PEDIA", as in "pediatrics", while in pronouncing "DIAMOX", the emphasis is on "DIA", as in "diamond"; (3) that "PEDIAMOX" and "DIAMOX" are both prescription products that may be dispensed only by physicians, and both products are promoted in different segments of the pharmaceutical market; and (4) that Respondent-Applicant has, over the years and at considerable expense, developed a tremendous amount of goodwill for its pediatric pharmaceutical products bearing brand names starting with the prefix "PEDIA".

The issue to be resolved is whether or not Respondent-Applicant's trademark "PEDIAMOX" is confusingly similar with Opposer's trademark "DIAMOX".

A comparison of the trademarks "PEDIAMOX" and "DIAMOX", particularly their respective labels (Exhs. "1", "2" and "A"; see actual label of "DIAMOX"), shows the following similarities and differences:

A. SIMILARITIES

1. Spelling- The trademarks are similar in 6 letter or in 2 syllables ("PE-DIA-MOX"; "DIA-MOX").
2. Class of Goods- Both trademarks are used on goods belonging to Class 5 (Pharmaceutical products.)

3. Dispensation of Goods. - Both parties goods are dispensable only upon doctor's prescription. This prescription requirement is evidenced by their respective drug registration Certificates (Exhs. "3", "4", and "C") and by cautionary notices appearing in their respective labels, to wit: "CAUTION: Food, Drug and Cosmetic Law prohibits dispensing without prescription"; and "Rx".

B. Differences

1. Sound - In pronouncing "PEDIAMOX", the emphasis is on "PEDIA" as in "pediatrics", while in pronouncing "DIAMOX", the emphasis is on "DIA" as in "diamond" (Respondent-Applicant's Answer, p.2; see Testimony of Dr. Evelyn Dy, Opposer's witness, T.S.N., June 10, 1987, p.11).
2. Size of Labels. The sizes of the "PEDIAMOX" labels are 3-3/4 inches x 2 inches (Exh."1"), and 2-1/8 inches x 1 inch (Exh."2"), while the size of "DIAMOX" label is 5-7/8 x 2-3/8 inches (see actual labels).
3. Coloring Scheme - The "PEDIAMOX" labels are dark green and white color with the word "PEDIAMOX" printed in black, while the "DIAMOX" label is predominantly yellow and white with the word "DIAMOX" printed in blue.
4. Printed matter on the Labels:
 - a) Generic Name- The generic name of "PEDIAMOX" (brand name) is Amoxicillin" printed clearly below said brand name, while that of "DIAMOX" (brand name) is "Acetazolamide" also printed clearly below the brand name.
 - b) Dosage Form. - The words "PEDIATRIC DROPS" with the contents "10 mL" are printed in bold letter on the "PEDIAMOX" Pediatric Suspension label (Exh. "1"), and the words "PEDIATRIC VIAL" with contents "1 Vial" are clearly printed on "PEDIAMOX" For Injection Label (Exh. "2"). The "DIAMOX" product, on the other hand, is described prominently as "Tablets 250 mg".
 - c) Direction for Use - The printed directions for the preparation of "PEDIAMOX" Pediatric Suspension (Exh. "1") read as follows: "Add 6 mL of water and shake well until the contents are evenly suspended". The printed directions for the use of "PEDIAMOX" For Injection (Exh. "2") indicate that water must also be added to the contents thereof and that "(t)he solution should be prepared immediately before injection and not used more than half an hour after preparation". On the other hand, the "DIAMOX" product should be taken orally, the same being in tablet form.
 - d) Representative Made.- The "PEDIAMOX" labels contain representation of a woman or mother carrying a child on her arms, which representation is printed in white within an oval shape against a dark green background; whereas, the "DIAMOX" label has no such representation.
 - e) Distributor and Manufacturer. - The distributor of the "PEDIAMOX" products is indicated by the word "PEDIATRICA" printed in black capital letters between two dark green parallel lines at the bottom of their labels. Moreover, the manufacturers of the said products are indicated by the following words printed in small letters at the side

portion of said labels; “Manufactured by United Laboratories, Inc. Mandaluyong, Metro Manila, Philippines for PEDIATRICA, INC. Mandaluyong, Metro Manila, Philippines” (Exh. “1”); Manufactured by Insituto Biiochimico Italiano Milano, Italy” (Exh. “2”). On the other hand, the distributor of the “DIAMOX” products is shown by the word “Lederle” distinctly printed at the upper left portion of its label in white letters within a blue oblong shape against a yellow background. And the following words printed in small letters appear at the bottom of said label: “Mfd. By Interphil Laboratories, Inc. Muntinlupa, Metro Manila, Philippines for LEDERLE LABORATORIES DIVISION CYANAMID PHILIPPINES INC. Makati, Metro Manila, Philippines”.

5. Medical Purpose Use - “PEDIAMOX”, which is intended for children, contains “Amoxycillin” (Exhs. “1”, “2” and “11”), an antibiotic for the treatment of respiratory, gastro-intestinal, genito-urinary tract infections, skin and soft tissue infections (Respondent-Applicant’s Answer, p.2). Whereas, “DIAMOX” contains “Acetazolamide”, a carbonic anhydrase inhibitor for the treatment of glaucoma, congestive heart failure and other edematous conditios (Exhs. “B” and “G”).

This Bureau is convinced that the above differences between the subject trademarks are substantial and striking to the eye, rendering the similarities in spelling and class of goods insignificant.

As to the spelling, although the trademarks are similar in 6 letters or 2 syllables, they are also dissimilar in the trademark of letters and syllables, and prefixes, namely: The trademark “PEDIAMOX” is composed of 8 letters in 3 syllables with the syllables “PEDIA” as its prefix, while the trademark “DIAMOX” is composed of 6 letters in 2 syllables with the syllable “DIA” as its prefix. These differences are material not only to the spelling but also to the pronunciation of the trademarks, because the prefixes “PEDIA” and “DIA” are the most pronounced, since they come first in the word combination “PEDIA-MOX” and “DIA-MOX”.

Thus, the Supreme Court has ruled in *Etepha vs. Director of Patents* (16 SCRA 495, 501) that:

“As we take up *Pertussin* and *Atussin* once again, we cannot escape notice of the fact that the two words do not sound alike – when pronounced. There is not much phonetic similarity between the two. The Solicitor General well observed that in *Pertussin* the Pronunciation of the prefix “Per”, whether correct or incorrect, includes a combination of three letters P, e and r; whereas, in *Atussin* the whole word tarts with the single letter A added to the suffix ‘tussin’. Appeals to the ear are dissimilar. And this, because in a word-combination, the part that comes first is the most pronounced. X x x” (Underscoring supplied)

Moreover, it should be emphasized that the name “PEDIAMOX” was coined from the prefix “PEDIA” from “Pediatrics” (respondent-Applicant’s Answer. P.2), which means medical science relating to care of children and treatment of their diseases” (Tabers Cyclopedical Medical Dictionary, 15th Edition), and “MOX” from “Amoxycilling”, the generic name or active ingredient of the “PEDIAMOX” products (Exhs. “1” and “2”)

The suffix “MOX”, therefore, is a descriptive and/or generic term which cannot be used or appropriated exclusively by either party. This non-exclusive use of the term “MOX” as a part of pharmaceutical brand names is evidenced by its common use in drug names such as AMOXIL, AMOXSTERYL, AMOXTREX, BISOLVOMOX, DANMOXIN, MAGNAMOX, MOXILLIN, MUCAMOX, POLYMOX, SUMOXIL, and TEREAMOXYL (Philippine Index of Medical Specialties or “PIMS”, Vol. 14, No. 1, April 1985).

In *American Cyanamid Company vs. Director of Patents* (76 SCRA 568), the Supreme Court cited the *Etepha* case (*supra*) and ruled as follows:

“x x x (T)he use of the word ‘tussin’ as a component of both trademarks cannot be considered as factor for declaring the two confusingly similar for ‘tussin’ is a descriptive and generic and is open for appropriation by anyone, and that while the word by itself cannot be used exclusively to identify one’s goods it may properly become a subject of a trademark by combination with another word or phrase; hence, *Etepha* ‘pertussin’ and *Westmont*’s ‘Atussin’.

Similarly, in the case before Us, as correctly stated by the Director of Patents, the word *SULMET* is derived from the combination of the syllables ‘SUL’ which is derived from *Sulfa* and ‘Met’ from *methyl* both of which are chemical compounds present in the article manufactured by the contending parties, and the addition of the syllable ‘INE’ in respondent’s label is sufficient to distinguish respondent’s product or trademark from that of petitioner.”

As regards the similarity in the class of goods, said similarity becomes insignificant because of the above-discussed difference in medical purpose or use. Furthermore, considering the dosage form, direction for use, and packaging of the “*PEDIAMOX*” products, said products are sold together with their labels or packages; the purchasing public necessarily examines the contents of these products and read the printed matters on their labels, particularly the instructions for their use or preparation. Purchasers are therefore not unfamiliar with the “*PEDIAMOX*” products.

Opposer’s argument that the rule against confusing similarity of trademarks should be applied with greater force to prescription drugs is without merit, because this argument is not supported by Philippine jurisprudence on the matter (see *Mead Johnson & Co. vs. N.V.J van Dorp, Ltd.*, 7 SCRA 768; *Etepha vs. Director of Patents*, 16 SCRA 495; *Brisol Myers Co. vs. Director of Patents*, 17 SCRA 128; *American Cyanamid Co. vs. Director of Patents*, 76 SCRA 568).

The observation made by the Supreme Court in the *Etepha* case is noteworthy. Thus:

“In the solution of a trademark infringement problem, regard too should be given to the class of persons who buy the particular product and the circumstance ordinarily attendant to its acquisition. The medicinal preparations, clothed with the trademarks in question, are unlike articles of everyday use such as candies, ice cream, milk, soft drinks and the like which may be freely obtained by anyone, anytime, anywhere. Petitioner’s and respondent’s products are to be dispensed upon medical prescription. The respective labels say so. An intending buyer must have to go first to a licensed doctor of medicine: he receives instructions as to what to purchase; he reads the doctor’s prescription; he knows what he is to buy. He is not of the incautious, unwary, unobservant or unsuspecting type; he examines the product sold to him, he checks to find out whether it conforms to the medical prescription. The common trade channel is the pharmacy or the drugstore. Similarly, the pharmacist or drugstore verifies the medicine sold. The margin error in the acquisition of one for the other is quite remote.”
(Underscoring supplied)

In support of the aforesaid argument, Opposer reasoned out that lots of physicians have illegible hand writing in writing out prescriptions, and if a pharmacist misreads a name he may fill out the prescription a different drug. This Bureau finds such reason to be without merit. To reiterate, although the subject trademarks are similar in 6 letters, they are also dissimilar in the number of letters and syllables, and prefixes.

Moreover, in writing prescriptions, physicians write not only the brand names but also the dosage forms and daily dosage of the drugs (Exhs. “8” and “9”). Since “*PEDIAMOX*” is sold

either in suspension or injectable form, while "DIAMOX" is in tablet form, mistake or error in filling out the prescription is remote.

The above-discussed mistake or error is further prevented by the use of generic names in writing prescriptions, which use is mandatorily required under Section 6(b) of the Generic Act of 1988 which provides as follows: "All medical, dental, and veterinary practitioners, including private practitioners, shall write prescriptions using the generic name. The brand name may be included if so desired." And violation of this provision is penalized under Section 12 of said law.

Opposer also reasoned out that prescription drugs are sometimes sold over-the-counter or without prescription, and this circumstance increases the risks that the "DIAMOX" and "PEDIAMOX" products be interchanged. This reasoning is likewise unmeritorious. As previously discussed, said products are different from each other in medical purpose or use, and purchasers are not unfamiliar with the "PEDIAMOX" products.

Moreover, the Supreme Court has ruled that:

"We concede the possibility that buyers might be able to obtain Pertussin or Atussin without prescription. When this happens, then the buyer must be one thoroughly familiar with what he intends to get, else he would not have the temerity to ask for a medicine specifically needed to cure a given ailment. In which case, the more improbable it will be to palm off one for the other. For a person who purchases with open eyes is hardly the man to deceive." (Etepha vs. Director of Patents, supra)

"although oppositor avers that some drugstores sell "BIOFERIN" without asking for a doctor's prescription, the same if true would be an irregularity not attributable to the applicant, who has already clearly stated the requirement of a doctor's prescription upon the face of the label of its product." (Bristol Myers Company vs. Director of Patents, supra; underscoring supplied)

In view of the foregoing, this Bureau holds that no confusing similarity exists between the subject trademarks. Consequently, the registration and use of the trademark DECISION NO. 88-114 will not diminish the distinctiveness and dilute the goodwill of Opposer's trademark "DIAMOX"

WHEREFORE, the Opposition is DISMISSED; Application Serial No. 51379 is given due course.

Let the records of this case be remanded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director