

BIOMEDIS, INC.,	}	IPC No. 14-2008-00045
<i>Opposer,</i>	}	Case Filed : 19 February 2008
	}	Opposition to:
- <i>vs-</i>	}	
	}	Appl'n. Serial No. : 4-2006-011847
	}	Date Filed : 31 October 2006
VERHEILEN PHARMACEUTICALS, INC.,	}	Trademark : "QINOFLOX"
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2008-188

## DECISION

This is an opposition to the registration of the mark "QINOFLOX" bearing application Serial No. 4-2006-011847 filed on 31 October 2006 covering the goods "drugs antibacterial" falling under class 5 of the International Classification of goods which application was published for opposition on page four (4) of the Intellectual Property Philippines (IPP) Electronic Gazette (E-Gazette), which was officially released on 21 December 2007.

The Opposer in the instant case is "BIOMEDIS, INC." a corporation duly organized and existing under and by virtue of the laws of the Philippines with principal office located at 750 Shaw Boulevard, Mandaluyong City.

On the other hand, the Respondent-Applicant is "VERHEILEN PHARMACEUTICALS, INC." with principal office at 2204-C West Tektite Tower, Philippine Stock Exchange Center, Ortigas Center, Pasig City.

The grounds of the opposition are as follows:

- "1. The trademark "QINOFLOX" so resembles "INOFLOX" trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark "QINOFLOX". The trademark "QINOFLOX", which is owned by Respondent-Applicant, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark "QINOFLOX" is applied for the same class of goods as that of trademark "INOFLOX", i.e. Class (5); antibacterial medicine preparation/antibiotic.
  
- "2. The registration of the trademark "QINOFLOX" in the name of the Respondent-Applicant will violate Section 123 of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", 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 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;"

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.

- “3. Respondent-Applicant’s use and registration of the trademark “QINOFLOX” will diminish the distinctiveness and dilute the goodwill of Opposer’s trademark “INOFLOX”.

Opposer in support of its opposition relied on the following facts:

- “1. Opposer, the registered owner of the trademark “INOFLOX”, is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark “INOFLOX” was filed with the Intellectual Property Office on 25 January 1989 by Opposer and was approved for registration by this Honorable Office on 18 July 1990 and valid for a period of twenty (20) years. Hence, Opposer’s registration of the “INOFLOX” trademark subsist and remains valid to date. Attached are copies Certificate of Registration Number 48600 dated 18 July 1990 marked as Annex “B”.
- “2. The trademark “INOFLOX” has been extensively used in commerce in the Philippines.
- “3. Opposer dutifully filed Affidavits of Use pursuant to the requirement of law, to maintain the registration of “INOFLOX” in force and effect. Copies of the affidavit of Use filed by Opposer are hereto attached as Annexes “C”, “D” and “E”.
- “4. A sample of product label bearing the trademark “INOFLOX” actually used in commerce is hereto attached as Annex “F”.
- “5. No less than the Intercontinental Marketing Services (IMS) itself, the world’s leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledge and listed the brand “INOFLOX” as the leading brand in the Philippines in the category of “antibiotic” in terms of market share and sales performance. (Attached is a copy of the certification and sales performance marked as Annex “G”.)
- “6. In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, we registered the products with the Bureau of Food and Drugs (BFAD). A copy of the Certificate of Product Registration issued by the BFAD for the mark “INOFLOX” is hereto attached as Annex “H”.
- “7. There is no doubt that by the virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark “INOFLOX”, and the fact that they are well-known pharmaceutical information provider, the Opposer has acquired an exclusive ownership over the “INOFLOX” marks to the exclusion of others.
- “8. “QINOFLOX” is confusingly similar to “INOFLOX”.

Opposer submitted the following in support of its opposition.

Annex	Description
Annex “B”	Copies of Certificate of Registration No. 48600 dated 18 July 1990 for the mark

	"INOFLOX"
Annexes "C", "D" and "E"	Copies of Affidavit of Use filed by Opposer for the mark "INOFLOX"
Annex "F"	Sample of product label bearing the mark "INOFLOX"
Annex "G"	Copy of Certification and sales performance
Annex "H"	Certificate of Product Registration issued by the BFAD

On June 4, 2008, Respondent-Applicant filed its Verified Answer and denied all the material allegations of the opposition and further alleged the following as its affirmative and negative defenses:

- "1. At the outset, Respondent-Applicant respectfully manifest that it has assigned to Farma Iberica, Inc., a sister company, all the rights, title and interests in and to the above-mentioned trademark together with the goodwill of the business that has accrued thereon. Both Respondent-Applicant and Farma Iberica, Inc. are engaged in the business of distribution and sale of pharmaceutical products.  
  
A photocopy of the pertinent Assignment of Trademark and of Application for Registration of Trademark is hereto attached and made an integral part hereof as Annex "1".
- "2. Be that as it may, Respondent-Applicant asserts that the subject mark "QINOFLOX" is not identical nor confusingly similar to Opposer's registered mark "INOFLOX".
- "3. Neither will the mark "QINOFLOX" likely cause confusion, mistake or deception on the part of the purchaser's vis-à-vis the Opposer's mark "INOFLOX"
- "4. Foremost, it is not correct for Opposer to say that marks "QINOFLOX" and "INOFLOX" are phonetically the same.
- "5. Obviously, both are not pronounced the same simply because the mark "QINOFLOX" has the letter Q as its first letter while "INOFLOX" starts with the letter "I". Phonetically, Q is pronounced as "ki" while the letter "I" is pronounced as "i". Thus, by merely pronouncing the two (2) marks, it can hardly be said that they will provoke confusion, as to mistake one for the other.
- "6. The two (2) marks are, therefore, not phonetically the same.
- "7. Neither are "QINOFLOX" and "INOFLOX" identical in appearance in view of the fact that the former mark starts with the prominent letter "Q" which can clearly be distinguished from the letter "I", which in turn, is the beginning the letter of the mark "Inoflox".
- "8. Furthermore, the word "oflox" as appearing in the marks Qinoflox and Inoflox is basically a component of the product name "ciprofloxacin" and "ofloxacin" which Farma Iberica, Inc., (formerly promoted by Respondent-Applicant Verheilen Pharmaceuticals, Inc.) and Opposer are, respectively, selling and promoting. It is, therefore, submitted that the term "oflox" is generic and descriptive of the subject products and is open for

appropriation by everyone. It can, therefore, be the proper subject of a trademark by the simple addition of a prefix, word or phrase, as in the case of Qinoflox subject of this case.

Respondent-Applicant submitted the following in support of its application subject of the instant opposition.

Annexes	Description
Annex "1"	Assignment of Trademark Application for the mark "QINOFLOX"
Annex "2"	Affidavit of Ria May Logramonte
Annex "2-a"	Comparison between Ofloxacin and Ciprofloxacin.
Annex "3"	Certificate of Product Registration issued by BFAD for the brand name "QINOFLOX"
Annex "4"	Sample label of the mark "QINOFLOX"
Annex "5"	Copy containing "QINOFLOX"
Annex "6"	Another label sample containing the mark "QINOFLOX"
Annex "7"	Box for the mark "QINOFLOX"
Annex "8"	Tablet label for the mark "QINOFLOX"
Annex "9"	Another tablet for the mark "INOFLOX"
Annex "10"	Box for the mark "INOFLOX"

The only issue to be resolved in the instant opposition is:



WHETHER OR NOT THE MARK "QINOFLOX" OF RESPONDENT-APPLICANT IS CONFUSINGLY SIMILAR WITH THE MARK "INOFLOX" OF THE OPPOSER.

The applicable provision of the law is Section 123.1 (d) of Republic Act No. 8293, which provides:

"Sec. 123. *Registrability* – 123.1 *A mark cannot be registered if it:*

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

The contending trademarks of the parties are reproduced below for comparison and scrutiny.

	
Opposer's mark	Respondent-Applicant's mark

The Bureau of Legal Affairs observes that both trademarks composed of three (3) syllables each. All the letters composing the Opposer's mark "INOFLOX" are practically contained / or present in the Respondent-Applicant's mark "QINOFLOX". The only distinction between the two marks is the presence of the letter "Q" in the Respondent-Applicant's mark, however, when pronounce, they are almost the same.

It is truly difficult to understand why the Respondent-Applicant used as its trademark the entire mark of the Opposer, all the six (6) letters therein and just adding the letter "Q" in its trademark.

The question of infringement of trademarks is to be determined by the test of dominancy. The dissimilarity in size, form and color of the label and the place where applied are not conclusive. Duplication or exact imitation is not necessary nor it is necessary that the infringing label should suggest an effort to imitate (Operators, Inc., vs. Director of Patents, et. al., [G.R. No. L-17901, 29 October 1965]).

Confusion is likely between trademarks only if their over-all presentation in any of the particulars of sound, appearance or meaning are such as would lead the purchasing into believing that the products to which the marks are applied emanated from the same source.

It is worthy to note that the Opposer's trademark "INOFLOX" has been registered with the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) now the Intellectual Property Philippines (IPP), bearing Registration No. 48600 issued on July 18, 1990 covering the goods "broad spectrum bacterial preparations" falling under Class 5 of the International Classification of goods (Annex "B"). The Affidavit of Use of the said registration were duly filed (Annexes "C", "D" and "E").

Section 138 of Republic Act No. 8293, provides:

"Section 138. *Certificates of Registration.* – A certificate of registration of a mark shall be *prima facie* evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate."

Comparison of the contending trademarks clearly show that they are almost the same or identical. The only distinction is the presence of the letter "Q" in the Respondent-Applicant's mark and all others are the same particularly the composition of the letters, the *spelling* and *pronunciation*.

In the case at bar, and considering that the contending trademarks are almost identical or the same, the Bureau of Legal Affairs finds and so hold that the two trademarks are confusingly similar to each other. The near resemblance or confusing fact that both trademarks are used on identical goods falling under class 5 of the international classification of goods.

With the finding of this Bureau to the effect that the Respondent-Applicant's trademark is almost identical or at the very least, confusingly similar to the registered trademark of the Opposer, the approval of the application in question becomes contrary to Section 123.1 (d) of

Republic Act No. 8293. Likelihood of confusion on the part of the public is bound to occur, as well as confusion of source or origin.

In the case of Philippine Nut Industry, Inc., vs. Standard Brands, Inc., (65 SCRA 575) the Supreme Court ruled that:

“There is infringement of trademarks when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity. Whether or not a trademark causes confusion and is likely to deceive the public is a question of fact which is to be resolved by applying the “*test of dominancy*”, meaning, if the competing trademarks contains the main or essential or dominant features of another by reason of which confusion or deception are likely to result, then infringement takes place; that duplication or imitation is not necessary, a similarity in the dominant features of the trademark would be sufficient.”

Likewise, in connection with the use of confusing similarity or identical mark, both foreign authority and our Supreme Court on several occasions ruled thus:

“Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty on the English language or paucity of signs, symbols, numerals etc., as to justify one who really wishes to distinguish his products from those of all others entering the twilight zone of a field already appropriated by another.” (Weco Products Co., vs. Milton Ray Co., 143 F2d 985, 32 C.C.P.A. Patents 1214)

WHEREFORE, with all the foregoing, the opposition is, as it is hereby SUSTAINED. Consequently, trademark Application No. 4-2006-011847 filed by VERHEILEN PHARMACEUTICALS, INC., on October 31, 2006 for the trademark “QINOFLOX” is, as it is hereby REJECTED.

Let the file wrapper of the trademark “QINOFLOX” subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 29 October 2008.

ESTRELLITA BELTRAN-ABELARDO  
Director Bureau of Legal Affairs  
Intellectual Property Office