

BEECHAM GROUP, PLC,

IPC NO. 14-2009-00244

Opposer,  
-versus-

Opposition to:  
App. Ser. No. 4-2008-006841  
(Filing Date: 11 June 2008)

D.B. MANIX INTERNATIONAL CORP.,  
Respondent-Applicant.

TM: "AUGIMOX"

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Decision No.2011-52

## DECISION

BEECHAM GROUP, PLC ("Opposer") filed an opposition to Trademark Application Serial No. 4-2008-006841. The application, filed on 11 June 2008 by D.B. MANIX INTERNATIONAL CORP. ("Respondent-Applicant"), covers the mark "AUGIMOX" for use on "*pharmaceutical products, namely as antibacterial*", under Class 5. The Opposer alleges the following:

1. The trademark AUGIMOX nearly resembles Opposer's trademark AUGMENTIN, owned by Opposer registered under Registration No. 053189 issued on August 7, 1992, for class 05 goods, particularly 'antibiotic and anti-infective preparations and substances,' as to be likely to deceive or to cause confusion.
2. According to the Intellectual Property Code (IPC) a mark cannot be registered if it is identical with a mark, with an earlier filing date, belonging to a different proprietor.
3. The trademark AUGIMOX is phonetically and visually similar with Opposer's trademark AUGMENTIN, in terms of pronunciation, spelling, and overall impression, sufficient to deceive or to cause confusion.

3.1 Primarily, the two trademarks have the same prefix 'AUG' which is the more dominant and most distinctive feature of the trademark. This is especially given the fact that people are more likely to remember the first syllable of a trademark and to slur or trail off when pronouncing the ends of the words so that only the first part is more recognizable to health care professionals administering pharmaceutical products.

3.2 Furthermore, 'AUG' is a trademark prefix rarely registered for pharmaceutical products in class 5, so it is more likely to be feature most easily remembered by consumers and health care professionals.

3.3 In addition, both AUGIMOX and AUGMENTIN consist of three syllables.

3.4 Also, the trademark AUGIMOX designates the same class 05 goods, particularly for antibacterial, or anti-infective pharmaceutical preparations identical to the goods designated by the Opposer's AUGMENTIN.

3.5 Lastly, Opposer's trademark AUGMENTIN, the application for which was filed on December 13, 1989, enjoys nineteen (19) years of priority and seniority over Respondent-Applicant's Trademark Application No. 4-2005-009692, which was filed on June 11, 2008. Opposer's Trademark Application Serial No. 053189 on August 7, 1992.

4. It is clear from the foregoing that the resemblance and similarities between opposer's trademark and the trademark used by Respondent-Applicant is such that is likely to deceive or to cause confusion to the public.

5. Due to the resemblance between the AUGIMOX trademark and the AUGMENTIN trademark as well as the similarity of the goods that they respectively designate, Respondent-Applicant's use of the trademark AUGIMOX is likely to mislead the public into believing that its goods originated from trademark Opposer, or that Opposer's came from the Respondent-Applicant. Respondent-Applicant's use of the trademark AUGIMOX will falsely and misleadingly suggest a connection between it and its goods, on the one hand, and the Opposer and Opposer's goods bearing the trademark AUGMENTIN on the other hand.

Hence, under 123 (d) (iii) of the IPC, the trademark 'AUGIMOX' cannot be registered.

6. Opposer's trademark is well-known internationally and in the Philippines. Section 123 (e) of the code states that a trademark which is confusingly similar to an internationally well-known mark cannot be registered.

7. Respondent-Applicant's use and attempted registration of the trademark AUGIMOX is done in bad faith, with manifest intention to ride on the popularity and goodwill of the Opposer's trademark AUGMENTIN. Opposer's trademark AUGMENTIN has been known and used by the public for an antibacterial product particularly for co-amoxiclav since 1991. Thus, it is highly suspect for Respondent-Applicant not to have seen or heard of opposer's AUGMENTIN mark.

8. Given the foregoing, there is no doubt that the interests of the Opposer, as the registered owner of the mark AUGMENTIN and as a well-recognized leader in the pharmaceutical industry, will be damaged and prejudiced by the continued use and adoption by Respondent-Applicant of the trademark AUGIMOX.

The Opposer's evidence consists of the following:

1. Exh. "A"- Authenticated Affidavit of Opposer's witness, David Butler;
2. Exh. "A-1"- Certified copy of Phil. Reg. No. 053189 for AUGMENTIN;
3. Exh. "A-2"- List of the Opposer's registrations for AUGMENTIN worldwide;
4. Exh. "A-3"- Photo of the AUGMENTIN product packaging as sold in China;
5. Exh. "A-3a"- Photo of the AUGMENTIN product packaging as sold in Singapore;
6. Exh. "A-3b"- Photo of the AUGMENTIN product packaging as sold in the United Kingdom;
7. Exh. "A-3c"- Photo of the AUGMENTIN product packaging as sold in Italy;
8. Exh. "A-3d"- Photo of a package insert for the product AUGMENTIN as sold in Malaysia;
9. Exh. "A-3e"- Sample of package inserts and product packaging for AUGMENTIN as sold in the Philippines;
10. Exh. "A-4"- Copy of a promotional material for AUGMENTIN product in table and syrup form;
11. Exh. "A-5"- Copy of the article Optimizing Therapeutic Choices in Respiratory Tract Infections presented in the 6<sup>th</sup> International Symposium on Antimicrobial Agents and Resistance;

12. Exh. "A-5a"- Copy of the article Amoxicillin/clauvanate prophylaxis in gynecologic surgery by O. Triolo, A Manusco and F. Patiano published in the International Journal of Gynecology and Obstetrics;
13. Exh. "A-6"- Certified copy of the decision rendered in IPC No. 14-2007-00057 (Decision No. 2007-141) entitled BEECHAM GROUP, P.L.C. vs. Aldril Pharmaceuticals Inc.;
14. Exh. "A-7"- Certified copy of the decision rendered in IPC No. 14-2005-00062 (Decision No. 2006-76) entitled Beecham Group, P.L.C. vs. Korea United Pharm, Inc.;
15. Exh. "A-8"- Copy of the English translation of the decision rendered by the Trademarks Department of Switzerland in Opposition Proceedings No. 7527 between Beecham Group, P.L.C and Lagap SA;
16. Exh. "B"- Affidavit of Opposer's Witness Mr. Marc Anthony C. Cox certified by the IPO to be true copy of the one on file in IPV No. 10-2009-00006;
17. Exh. "B-1"-List of Opposer's registration for AUGMENTIN worldwide;
18. Exh. "B-2"- Copy of the Italy Reg. Cert. No.361259;
19. Exh. "B-2-a"- Copy of the Italy Reg. Cert. No. 00833602;
20. Exh. "B-2-b"- Copy of the Austria Reg. Cert. No. 103639;
21. Exh. "B-2-c"- Copy of the Singapore Reg. Cert. No. T89/05932B;
22. Exh. "B-2-d"- Copy of the Malaysia Reg. Cert. No. 20218;
23. Exh. "B-2-e"- Copy of the Ireland Reg. Cert. No. 92790;
24. Exh. "B-2-f"- Copy of the Ireland Reg. Cert. No. 147887;
25. Exh. "B-2-g"- Copy of the U.K. Reg. Cert. No. H073848;
26. Exh. "B-2-h"- Copy of the France Reg. Cert. No. 146618;
27. Exh. "B-2-i"- Copy of the Germany Reg. Cert. No. DD 642247;
28. Exh. "B-2-j"- Copy of the Croatia Reg. Cert. No. Z941100;
29. Exh. "B-2-k"- Copy of the Denmark Reg. Cert. No. VR 1968 00783;
30. Exh. "B-2-l"- Copy of the Korea Reg. Cert. No. 0268802;
31. Exh. "B-2-m"- Copy of the Korea Reg. Cert. No. 0264502;
32. Exh. "B-2-n"- Copy of the Korea Reg. Cert. No. 0571892;
33. Exh. "B-2-o"- Copy of the Bahrain Reg. Cert. No. 5251;
34. Exh. "B-2-p"- Copy of the Norway Reg. Cert. No. 72324;
35. Exh. "B-2-q"- Copy of the Japan Reg. Cert. No. 150507;

36. Exh. "B-2-r"- Copy of the India Reg. Cert. No. 35468715;
37. Exh. "B-2-s"- Copy of the Brazil Reg. Cert. No. 83500;
38. Exh. "B-2-t"- Copy of the New Zealand Reg. Cert. No. 83500;
39. Exh. "B-2-u"- Copy of the Australia Reg. Cert. No. A517810;
40. Exh. "B-2-v"- Copy of the Puerto Rico Reg. Cert. No. 28911;
41. Exh. "B-2-w"- Copy of the Laos Reg. Cert. No. 6571;
42. Exh. "B-2-x"- Certification of the Vice-Consul of the Philippines in Laos as to the authenticity of the Laos trademark Reg. Cert. No. 6571;
43. Exh. "B-2-y"- Copy of the China Reg. Cert. No. 258590;
44. Exh. "B-2-z"- Copy of the U.S. Reg. Cert. No. 1111669;
45. Exh. "B-3"- Affidavit of Carolann M. O'Donovan the Senior Trademark Watch Specialist of Thomson CompuMark;
46. Exh. "B-4"- Copy of the decision in IPC No. 14-2005-00062 (Decision No. 2006-76) entitled Beecham Group, P.L.C vs. Korea United Pharm, Inc.;
47. Exh. "B-5"- Copy of the decision rendered by the Director-General of the IPO on appeal by Korea United Pharm, Inc. in IPC No. 14-2005-00062 (Appeal No. 14-06-25);
48. Exh. "B-6"- Copy of the decision rendered in IPC No. 14-2007-00057 (Decision No. 2007-131) Entitled BEECHAM GROUP, P.L.C. vs. Aldril Pharmaceuticals Inc.;
49. Exh. "B-7"- Affidavit of Alvaro Correa Ordonez, managing partner of Bogota Baker & McKenzie and the decision of the Columbia Ministry of Justice (Res. No. 24118) case filed No. 92.360.277 between Beecham Inc and Jose Edison Suarez;
50. Exh. "B-7a"- Copy of the sworn declaration of Doctor Esthela Guerrero Duarte, quality manager and legal representative of "Estudio Juridico de Propiedad Intelectual Julio C. Guerrero B. S.A.";
51. Exh. "B-7b"- Certified English translation of the sworn declaration of Dr. Esthela Guerrero;
52. Exh. "B-8"- Copy of the survey conducted by TNS Trends on the distinctiveness of AUGMENTIN in 2006; and
53. Exh. "B-9"- Copy of the survey conducted by TNS Trends on the distinctiveness of AUGMENTIN in 2008.

The Bureau issued on 23 October 2009 a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 04 November 2009. The Respondent-Applicant, however, failed to file an Answer. Accordingly, this Bureau issued on 17 February 2010 Order No. 2010-254 stating, among other things, that the Respondent-Applicant has waived its right to file an Answer and evidence, and that the case is deemed submitted for decision on the basis of the opposition and the evidence by the Opposer.

Should the Respondent-Applicant be allowed to register the mark AUGIMOX?

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 the 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.

Thus, Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("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 or if it nearly resembles such mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 11 June 2008, the Opposer has an existing trademark registration for the mark AUGMENTIN under Reg. No. 53189, dated 07 August 1992. This registration covers "*antibiotic and anti-infective preparation and substances*", pharmaceutical products or goods that are similar or closely related to those indicated in the Respondent-Applicant's trademark application.

This Bureau finds that AUGMENTIN is a highly distinctive mark as applied to the Opposer's products. It is a fanciful mark or one that has been invented by the owner for the sole purpose of functioning as a trademark, originally having no meaning but through the efforts of the trademark owners has become distinctive symbols of the products. It bears no logical relation to the actual characteristics of the product it represents. If one divides a fanciful mark into parts, he would not find a portion thereof that describes the product or contains a word or phrase that connotes a genus of the product. Significantly, the Opposer submitted as evidence among other things, a copy of the decision of the Director General in IPC No. 14-2005-00062 (Appeal No. 14-06-25). In said case, which involved the Opposer herein as a party-litigant, the Director General held that the mark AUGMENTIN is a highly distinctive mark as applied to its goods and products.

It is emphasized that when a trademark is fanciful and thus highly distinctive, very remote is the possibility that two or more persons or entities would accidentally create and adopt trademarks that are identical to or resemble those of the others, more so if they are engaged in the same business or industry and that the marks are used on the same or closely related goods.

In this regard, the first syllable in the Opposer's mark –"AUG"– is duplicated in the Respondent-Applicant's. Even the position of the letter "M" in AUGIMOX approximates the location of the same letter in AUGMENTIN. Because AUGMENTIN is a unique and highly distinctive mark used for antibiotics and anti-infectious pharmaceutical products, the consumers will likely assume or be mistaken that since both marks start with the syllable AUG coupled with the prominent position of the letter "M" therein, and used in similar pharmaceutical products, one is just a variation of the other and that the manufacturer for the goods are one and the same, or the respective manufacturers are associated or connected to one another.

It is stressed in the confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. 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 as to cause him to purchase the one supposing it to be the other. To constitute an infringement of an existing trademark patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake, it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it. Corollary, the law does not require actual confusion, it being sufficient that the confusion is likely to occur. The likelihood of confusion would then subsist not only on the public's perception of services but on the origins thereof. Also, the consumers are likely to think that there is a connection between the parties' respective businesses and goods, or there is only one originator or provider thereof. An undue

and unfair advantage therefore is acquired by one party as consumers would likely equate the quality of its products with that of the other.

This Bureau finds that it is incredible that the Respondent-Applicant came up with a mark that is likely to cause confusion or deception on pure coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.

WHEREFORE, premises considered the instant opposition is hereby SUSTAINED. Let the file wrapper of Trademark Application Serial No. 4-2008-006841 be returned, together with a copy of this decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 June 2011.

NATHANIEL AREVALO  
Director, Bureau of Legal Affairs  
Intellectual Property Office