

BIOFARMA,	)	INTER PARTES CASE NO. 3327
Opposer,	)	
	)	OPPOSITION TO:
	)	
	)	Application Serial No. 60255
	)	Filed : October 24, 1986
	)	Applicant : A. Nattermann &
- versus -	)	Cie GmbH
	)	Trademark : NATRICIN
	)	Used on : Medicines to
	)	treat tuberculosis
	)	
	)	<u>DECISION NO. 94-39 (TM)</u>
	)	
A. NATTERMANN & CIE, GMBH,	)	October 25, 1994
Respondent-Applicant.)	)	
x-----x	)	

DECISION

This pertains to an opposition filed by BIOFARMA, a corporation duly organized under the laws of France, with registered offices at 22 rue Garnier, 92200 Neuilly-sur-Seine, against application for registration of the trademark "NATRICIN" used on medicines to treat tuberculosis filed on October 24, 1986 under Serial No. 60255 in the name of A. Nattermann and Cie, GmbH, which application was published in the Bureau of Patents, Trademarks Official Gazette issue of December 20, 1988 and released for circulation on the same day.

The herein Respondent-applicant, a NATTERMANN & Cie, GmbH, is a German Corporation with business address at Nattermann Allee 1, 5000 Koln 30, Federal Republic of Germany.

The grounds for the opposition to the registration of the mark "NATRICIN" are as follows:

"1. Applicant is not entitled to register the trademark NATRICIN which is an imitation of and confusingly similar to Opposer's trademark NATRILIX, which has been used in commerce and registered in the Philippines and other parts of the world long before Applicant's date of adoption and use of NATRICIN. Opposer's NATRILIX trademark is registered in the Philippines under Regn. No. 32982 issued on February 2, 1984, which is still valid and subsisting. Applicant's use of his above mentioned trademark which is an imitation of and confusingly similar to Opposer's trademark is likely to cause confusion or mistake on the part of the purchasing public.

2. The registration of the trademark NATRICIN by applicant will violate Section 37 of Republic Act No. 166, as amended, and Section 6bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and France are parties.

3. The registration of and use by Applicant of the trademark NATRICIN will diminish the distinctiveness and dilute the goodwill of Opposer's NATRILIX trademark which it originated and which it has been using on pharmaceutical products for many years before Applicant's adoption and use of NATRICIN.

4. The registration of the trademark NATRICIN in the name of the Applicant will contravene other provisions of Republic Act No. 166, as amended."

To support this opposition, opposer relies on the following facts:

“1. Opposer is the owner of the following trademark:

<u>MARK</u>	<u>BPTTT REGN. NO.</u>
1. NATRILIX	32982

and is the prior user and registered owner of the NATRILIX trademark for pharmaceutical products in France and elsewhere.

2. Applicant’s goods and those of Opposer are identical or are related. The registration and use of an identical mark by Applicant on its goods are likely to confuse or deceive the purchasing public into believing that the goods of Applicant are made by, originate from or are under the sponsorship of Opposer. Applicant obviously intends to trade, and is trading on, Opposer’s goodwill.

3. Opposer is the originator and first user of the NATRILIX trademark in the Philippines and elsewhere, which the purchasing public have associated and identified with the Opposer.

4. Opposer’s NATRILIX trademark is an internationally well-known trademark. Opposer has been extensively using, in France and elsewhere, the NATRILIX trademark on pharmaceutical products. Opposer has also registered and continuously used the NATRILIX trademark in several countries of the world.

5. The registration and use of the NATRICIN trademark by other persons like Applicant will certainly dilute and diminish the distinctiveness of Opposer’s internationally well-known NATRILIX trademark registered in its name in several countries of the world.

6. Applicant has misrepresented that the NATRICIN trademark is registered in Germany under Regn. No. 1,110,963 issued on September 9, 1987 when in truth its application has been opposed by Opposer and no registration has as yet been issued.”

On February 13, 1989, A. Nattermann & Cie, GmbH, the herein Respondent-Applicant filed its Answer denying the material allegations in the Opposition.

The issues having been joined, this Office called this case for pre-trial. Failing to reach amicable settlement, the parties went into trial, adduced testimonial and documentary evidences and, together with their respective memoranda, submitted the case for decision.

The issue in this case is whether or not confusing similarity between the Respondent-Applicant’s trademark “NATRICIN” is confusingly similar with Opposer’s trademark “NATRILIX”. The applicable provision is Section 4(d) of R.A. No. 166 as amended which provides:

“Sec. 4. Registration of trademark, tradenames and service marks on the principal register. There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. The owner of a trademark, tradename or service mark used to distinguish his goods, business, or services from the goods, business or services of others shall have the right to register the same of the principal register unless it:

xxx

(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark tradename previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers”.

In resolving whether or not “NATRICIN” is confusingly similar with “NATRILIX”, the ruling of the Supreme Court in the case “Bristol Myers Company”, Petitioner vs. The Director of Patents and United American Pharmaceuticals, Inc. Respondent [17 SCRA] is instructive. The court stated:

“For though the words “BIOFERIN” and “BUFFERIN” have the same suffix and similar sounding prefixes, they appear in their respective labels with strikingly different backgrounds and surroundings, as to color, size, and design. Furthermore, the product covered by “BIOFERIN” is expressly stated as DISPENSABLE only upon DOCTORS PRESCRIPTION, while that of “BUFFERIN” does not require the same. The chances of the consumer being confused into purchasing one for the other therefore are the more rendered negligible.

One important factor to consider is the class of purchasers of the products in question.

xxx regard too should be given to the class of persons who buy the particular product and the circumstances ordinarily attendant to its acquisition. The medicinal preparation clothed with the trademarks in question, as unlike articles of everyday use such as candies, ice cream, milk, softdrinks and the like which may be freely obtained by anyone, anytime, anywhere.” (Etepha vs. Director of Patents et.al., Supra at p. 501)

It must be noted that both Respondent’s and Opposer’s products or goods are to be dispensed upon medical prescription. 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 druggist verifies the medicine sold. The margin of error in the acquisition of one for the other is quite remote.

The Supreme Court has consistently held that in cases requiring a prescription of a doctor before a product could be purchased, the possibility of confusion by the purchaser is quite remote, and consequently, could not cause confusion or mistake or to deceive purchasers. (Etepha vs. Director of Patents, et.al. Supra; Bristol Myers Co. vs. Director of Patents, 17 SCRA 129, Mead Johnson & Co. vs. N.V.J. Van Dorp, Ltd., 7 SCRA 166 American Cyanamid Co. vs. Director of Patents, 76 SCRA 568)

In the case at bar, the two competing marks, “NATRICIN” for the Respondent and “NATRILIX” for the Opposer, have been in common the prefix “NATRI”. They however differ in their suffixes. Further, the goods or products covered by Respondent’s mark pertains to medicine to treat tuberculosis and that of Opposer pertains to pharmaceutical preparation for anti-hypertensive products with diuretic activity. Moreover, both products are made available only in the drugstores and generally dispensed by doctor’s prescription.

WHEREFORE, it is concluded that the Respondent-Applicant’s mark does not resemble Opposer’s mark as to likely when applied to the goods of the parties to cause confusion or mistake or deceive purchasers, hence, this case is DISMISSED. Accordingly, Application Serial

No. 60255 for the trademark "NATRICIN" filed on October 24, 1986 by A. Nattermann & Cie GmbH, Respondent-Applicant, is hereby GIVEN DUE COURSE.

Let the filewrapper of this case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision. Likewise, let a copy of this Decision be furnished the Trademark Examining Division for information and to update its record.

SO ORDERED.

IGNACIO S. SAPALO  
Director