

L.R. IMPERIAL, INC.,	}	IPC No. 14-2005-00080
Opposer	}	Opposition to:
	}	Ser. No. 4-1997-119454
-versus-	}	Date Filed: April 4, 1997
	}	TM: "FLEXIN"
	}	
MUNDI PHARMA AG,	}	
Respondent-Applicant,	}	Decision No. 2006-37
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DECISION

This case pertains to the Notice of Opposition filed by L.R. Imperial, Inc. (L.R. for brevity) against the application for registration of the trademark "FLEXIN" with Application Serial No. 4-1997-119454 dated April 4, 1997 for "Pharmaceutical preparations for human use specifically for the treatment of inflammation caused by rheumatism. Arthritis, osteoarthritis and similar muscular-skeletal disorders" in Class 5 by Mundi Pharma AG ("Mundi" for brevity).

Opposer LR is a corporation duly organized and existing under the laws of the Philippines with business address at 2nd Floor Bonaventure Plaza, Greenhills, San Juan, Metro Manila while respondent-applicant Mundi is a corporation duly organized and existing under the laws of Switzerland with address at St. Alban-Rheinweg 74, 4006 Basel, Switzerland represented by its resident agent Poblador Azada and Bucoy Law Office.

Believing that it will be damaged by the registration of the said trademark, opposer filed its verified Notice of Opposition dated June 30, 2005 based on the following grounds:

1. Respondent-applicant's mark "FLEXIN" resembles the registered mark "PREXIN" that the former mark, when applied to or used in connection with the goods of respondent-applicant, will likely cause confusion, mistake and deception on the part of the purchasing public;
2. The registration of the mark "FLEXIN" in respondent-applicant's name will violate Sec. 123, Paragraph (d) of the Intellectual Property Code which 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: (i) the same goods or services; (ii) closely related goods or services; or (iii) if it merely resembles such a mark as to be likely to deceive or cause confusion; and
3. Respondent-applicant's use and registration of the trademark "FLEXIN" will diminish the distinctiveness and dilute the goodwill of opposer's mark "PREXIN".

Opposer relied on the following allegations to support the opposition:

1. Opposer is engaged in the sale and distribution of a wide range of pharmaceutical products;
2. The mark "PREXIN" has been extensively used by opposer in commerce in the Philippines since September 17, 1986;
3. Opposer filed its renewal and Affidavits of Use for the 5th, 10th and 15th years of use of said mark to maintain it in force and effect and the mark, thus, subsists to this date;
4. By virtue of Certificate of Renewal of registration No. 28493, opposer has acquired exclusive ownership over the mark "PREXIN" to the exclusion of all others;

5. The marks "PREXIN" and "FLEXIN" are practically identical marks in sound and appearance that they leave the same commercial impression upon the public;
6. The registration in the same class (Class 5) of goods and use of respondent-applicant's confusingly similar mark on its goods will enable respondent-applicant to benefit from opposer's reputation, goodwill and advertising, and will tend to deceive and/or confuse the public into believing that respondent-applicant is in any way connected with opposer;
7. By virtue of opposer's prior and continued use of the mark "PREXIN" has become well-known and has established valuable goodwill among medical professionals and consumers; and
8. Opposer's interests are likely to be damaged by the registration and use of respondent-applicant's mark "FLEXIN".

Respondent-applicant was granted time until September 9, 2005 to file its Answer but failed to do so. Hence, it was deemed to have waived the filing of its Answer. Opposer filed and completed within the reglementary period its documentary evidences. The case was thereafter deemed submitted for decision.

The issues to be resolved in this case are:

- (a) Whether or not respondent-applicant's mark "FLEXIN" is identical and/or confusingly similar to opposer's mark "PREXIN";
- (b) Whether or not respondent-applicant has the right to register the mark "FLEXIN" for pharmaceutical preparations for human use, specifically for the treatment of inflammation caused by rheumatism, arthritis, osteoarthritis, and similar muscular-skeletal disorders in Class 5.

As to the first issue, this Bureau holds that respondent-applicant's "FLEXIN" is confusingly similar to opposer's "PREXIN".

The Supreme Court held in *Societe Des Produits Nestle, S.A. v. Court of Appeals*, G.R. No. 112012, April 4, 2001 that:

"In ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set of rules can be deduced. Each case must be decided on its own merits. In *Esso Standard, Inc. v. Court of Appeals*, the Supreme court ruled that the likelihood of confusion is a relative concept; to be determined only confusion is a relative concept; to be determined only according to the particular, and sometimes peculiar circumstances of each case."

The goods of the parties covered by the competing marks show that they fall under the same classification, which is Class 5. Opposer's and respondent-applicant's goods covered by the marks PREXIN and FLEXIN serve the same purpose and flow through the same channel of trade; hence, they are considered as RELATED GOODS (Underscoring supplied).

The marks "PREXIN" and "FLEXIN" have the following similarities in spelling: Both composed of six (6) letters with two (2) syllables. The only difference in the spelling lies in the prefix "PRE" in "PREXIN" and "FLE" in "FLEXIN". Also, both marks have almost the same cadence when spoken. Although there is a difference between the 2 marks "PREXIN" is written in lowercase letters except for the letter "P" while "FLEXIN" is written in uppercase letters, this difference is only minor and will not avoid the inescapable conclusion that consumers maybe mistaken or deceived when both marks are used simultaneously on relayed goods, especially in the light of the fact that "f" can be mistakenly pronounced as "p" or vice versa.

IN VIEW OF THE FOREGOING, this Bureau concludes that there is confusing similarity between the two competing marks. Accordingly, the Notice of Opposition is, as it is, hereby SUSTAINED. Consequently, Application Serial No. 4-1997-119454 dated April 4, 1997 for “pharmaceutical preparations for human use specifically for the treatment of inflammation caused by rheumatism, arthritis, osteoarthritis and similar muscular-skeletal disorders is hereby REJECTED.

Let the filewrapper of FLEXIN subject matter of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau (AFHRDSB) for appropriate action in accordance with this Decision with a COPY furnished the Bureau of Trademarks (BOT) for information and to update its record.

SO ORDERED.

Makati City, May 23, 2006.

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