

PT. DEXA MEDICA,	}	IPC NO. 14-2008-00149
<i>Opposer,</i>	}	Case Filed: 07 July 2008
	}	
	}	Opposition to:
	}	
	}	Appl'n. Serial No. 4-2007-011955
-versus-	}	Date Filed: 25 Oct. 2007
	}	TM: "DEXA"
	}	
HEALTH SAVER PHARMA, INC.,	}	
<i>Respondent-Applicant.</i>	}	Decision No. 2009-87
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## DECISION

This is a VERIFIED NOTICE OF OPPOSITION filed by Opposer PT. Dexa Medica to the application for registration of the mark "DEXA" bearing the Application Serial No. 4-2007-011955 filed on October 25, 2007 by respondent-applicant Health Saver Pharma, Inc. for goods under Class 05, namely, "Dexamethasone preparations," which application was published for opposition in the Intellectual Property Philippines (IP Philippines) E-Gazette, No. that was officially released for circulation on March 07, 2008.

Opposer is a foreign corporation duly organized and existing under the laws of Indonesia with a principal office address at Jalan Letjen, Bambang Utoyo 138, Palembang 30114, Indonesia. Respondent-Applicant is a domestic corporation duly organized and existing under the laws of the Republic of the Philippines with business address at 132 San Francisco St., Mandaluyong City.

The facts of the case are as follows:

"1. Opposer is a foreign corporation duly organized and existing under the laws of Indonesia, a country which is a member of international conventions relating to intellectual property rights or repression of unfair competition to which the Philippines is also a party, such as the Paris Convention on Industrial Property and the Agreement on Trade-Related Aspects of Industrial Property Rights, and extends reciprocal rights to Philippine nationals by law. Opposer's principal office address is at Jalan Letjen, Bambang Utoyo 138, Palembang 30114, Indonesia. Moreover, Opposer is engaged in business in the Philippines and was issued a License to Transact Business in the Philippines by the Securities and Exchange Commission ("SEC") on 16 April 2004.

"2. Respondent-Applicant is a domestic corporation duly organized and existing under the laws of the Republic of the Philippines with business address at 132 San Francisco Street, Mandaluyong City. Respondent-Applicant may be served with summons, orders and other processes of this Honorable Office through its agent-of-record. Ms. Ofelia A. Natividad, with address at No. 24 Sikap Street, Apartment C. Boni Avenue, Mandaluyong City.

"3. On 25 October 2007, Respondent-Applicant filed an application for registration of the mark "DEXA" which application was designated as Application Serial No. 4-2007-011955. Respondent-Applicant's application was published in the Intellectual Property Office (IPO) e-Gazette on 07 March 2008.

"4. On 08 April 2008, Opposer filed with the Honorable Office an Ex-Parte Motion for Extension of Time to File Notice of Opposition, requesting that it be granted until 06 May 2008 to file a Notice of Opposition to Respondent-

Applicant's application. The Honorable Office issued Order No. 2008-604 dated 23 April 2008, granting Opposer until 06 May 2008 to file its Notice of Opposition.

"5. On 06 May 2008, Opposer filed with the Honorable Office a second Ex-Parte Motion for Extension of Time to File Notice of Opposition of even date, requesting that it be granted until 05 June 2008 to file a Notice of Opposition. The Honorable Office issued Order No. 2008-731 dated 12 May 2008 giving Opposer until 05 June 2008 to file its Notice of Opposition.

"6. Considering that the Honorable Office issued a notice that it shall be closed from 04 to 06 June 2008 and that documents due on said dates shall be received on the next working day, and since 09 June 2008 was declared a national holiday, Opposer filed on 10 June 2008 with the Honorable Office a third Ex-Parte Motion for Extension of Time to File Notice of Opposition of even date, requesting that it be granted until 05 July 2008 to file a Notice of Opposition. The Honorable Bureau issued Order No. 2008-850 dated 16 June 2008 giving Opposer until 05 July 2008 to file its Notice of Opposition. Since 05 July 2008 is a Saturday, Opposer has the following business day, or until 07 July 2008, to file the instant verified Notice of Opposition.

"7. Opposer is the true owner of the mark "DEXA MEDICA & DEVICE" which is covered by Philippine Trademark Registration No. 4-2006-005031 for goods under International Class 5, namely "immunomodulator, pharmaceutical preparation which is classified as corticosteroid, pharmaceutical preparation for respiratory system, pharmaceutical preparations for the treatment of nausea and vomiting, pharmaceutical preparations for the treatment of nausea and vomiting, pharmaceutical preparation which is classified as cephalosporin's fourth generation, pharmaceutical preparations which is classified as non-steroidal anti-inflammatory," and Philippine Trademark Registration No. 4-2006-005032 in International Class 35 for "Marketing."

"8. Opposer believes that it will be damaged by the registration of Trademark Application No. 4-2007-011955 for the mark "DEXA".

The grounds for opposition are as follows:

8.1 The mark "DEXA" cannot be registered because it is confusingly similar to the registered mark "DEXA MEDICA & DEVICE" owned by Opposer which is being used for similar or closely related goods.

8.2 The mark "DEXA" cannot be registered in the Philippines because it infringes on the Opposer's trade name "PT. DEXA MEDICA".

8.3 The mark "DEXA" cannot be registered in the Philippines because it is similar to "DEXA MEDICA & SERVICE" owned by Opposer, which mark is not only registered in the Philippines but is also well-known internationally and locally.

8.4 The registration of the mark "DEXA" will gravely reduce the distinctiveness of the mark "DEXA MEDICA & DEVICE" and dilute Opposer's goodwill over said mark.

Opposer makes the following allegations to support the grounds for opposition:

"9. The mark "DEXA" cannot be registered because it is confusingly similar to Opposer's registered mark DEXA MEDICA & DEVICE which is being used for similar or closely related goods.

9.1 Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines (the "IP Code") provides that:

123.1. A mark cannot be registered if it:

X X X X

(d) 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, 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;

9.2 Indeed, the mark "DEXA"; (1) has a later filing date than Opposer's mark "DEXAMEDICA & DEVICE;" (2) is identical with or is confusingly similar to "DEXAMEDICA & DEVICE;" (3) is being/intended to be used on the same goods or closely-related goods as to be likely to deceive or cause confusion.

9.3 Respondent-Applicant's Philippine trademark application for "DEXA" was filed only on 25 October 2007, while Opposer filed its trademark applications for "DEXAMEDICA & DEVICE" on 11 May 2006, or more than a year before Respondent-Applicant filed its application for "DEXA". Opposer's mark "DEXAMEDICA & DEVICE" for Class 5 was registered in the Philippines on 09 April 2007 while its mark "DEXA MEDICA & DEVICE" for Class 35 was registered on 26 March 2007.

9.4 Moreover, there is no doubt that the marks "DEXA" and "DEXA MEDICA & DEVICE" are identical or confusingly similar.

9.4.1 The word "DEXA" is the dominant feature of Opposer's mark. Indeed, the word "DEXA" in the Opposer's mark is placed in between a triangular device and the word "Medica", placing the focus on the word "DEXA". Moreover, "DEXA" is printed in a lighter shade with letters that merely outline the word "Medica". Consequently, the unwary eye will confuse both marks because the dominant feature of both marks is the word "DEXA".

9.4.2 There is also confusion aurally considering that Opposer's mark consists only of two words "DEXA" and "MEDICA". Since "MEDICA" is commonly associated with goods covered by both marks, i.e., pharmaceuticals preparation, the distinguishing element of Opposer's mark is the word "DEXA". As a result, the public will very likely confuse Respondent-Applicant's goods bearing "DEXA" as the same as those of Opposer's.

9.5 In *McDonald's Corporation v. L.C. Big Mak Burger, Inc.*, 437 SCRA 10 (2004), the Supreme Court enunciated that the similarities in the marks are measured in terms of dominancy test:

“This Court, however, has relied on the dominancy test rather the holistic test. The dominancy test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under dominancy test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets and market segments.

Thus, in the 1954 case of *Co Tiong Sa v. Director of Patens*, the Court rules:

xxx It has been consistently held that the question of infringement of a trademark is to be determined by the test of dominancy. Similarity in size, form and color, while relevant, is not conclusive. If the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. (*G. Heilman Brewing Co. v. Independent Brewing Co.* 191 F., 489, 495, citing *Eagle White Lead Co. v. Pflugh* (CC) 180 fed 578). The question at issue in cases of infringement of trademarks is whether the use of the marks involved would be likely to cause confusion or mistakes in the mind of the public to deceive purchasers. (*Auburn Rubber Corporation v. Hanover Rubber Co.*, 107 F. 2d 588; xxx)

The Court reiterated the dominancy test in *Lim Hoa v. Director of Patent, Philippine Nut Industry, Inc., v. Universal Rubber Products, Inc. and Asia Brewery, Inc. v. Court of Appeals.*” [Emphasis supplied.]

9.6 The striking similarity of the two marks buttresses the fact that confusion will surely ensue. The fact that Opposer’s mark consists of the words “DEXA” and “MEDICA”, with a device, does not detract from the confusion caused by the dominating presence of “DEXA” in both marks.

9.7 The word “DEXA” does not have any relation with the goods covered by Opposer’s application. Clearly, the Opposer’s choice of the word “DEXA” is arbitrary since “DEXA” neither suggests nor describes any quality or characteristic of the goods covered by the Opposer’s registration. It is therefore interesting to ask why of all the limitless names in the world, Respondent-Applicant has chosen to use “DEXA” for its own goods. It could have chosen other names or created its own but it perplexingly chose to use a name which is identical to Opposer’s mark. This observation leads to the “conclusion that Respondent-Applicant’s intention in using “DEXA” is to underhandedly avail itself of the fame and goodwill of Opposer’s mark “DEXA MEDICA & DEVICE.”

9.8 The identity of the competing marks would certainly cause confusion considering that Respondent-Applicant's use of the mark on their goods would indicate a close connection with identical or closely-related goods that are being manufactured and sold by Opposer on which the mark "DEXA MEDICA & DEVICE" is being used.

9.8.1 Under Section 123.1 (d) of the IP Code, a mark cannot be registered if it is identical to a mark with an earlier filing or priority date in respect of the same goods or closely-related goods or if it nearly resembles a mark as to be likely to deceive or cause confusion. The goods covered by Respondent-Applicant's trademark application for "DEXA MEDICA & DEVICE" are "dexamethasone preparations" under International Class 05. On the other hand, Opposer's Philippine trademark Registration No. 4-2006-005031 covers goods also under International Class 05, namely immunomodulator, pharmaceutical preparation which is classified as corticosteroid, pharmaceutical preparations for the treatment of nausea and vomiting, pharmaceutical preparation which is classified as cephalosporin's fourth generation, pharmaceutical preparations which is classified as non-steroidal anti-inflammatory." Dexamethasone is a steroid hormone that acts as an anti-inflammatory and immunosuppressant.

9.8.2 Since Respondent-Applicant's application covers goods that are closely-related to those that are registered under Opposer's mark, confusion will clearly ensue as the competing marks look and sound the same. The likelihood of purchasers to associate the goods of Opposer and Respondent-Applicant to a common origin is highly likely to occur. Both from the standpoint of priority of use and for the protection of the buying public and, of course, Opposer's right to the mark "DEXA MEDICA & DEVICE", it becomes manifest that the registration of "DEXA" should be denied.

9.8.3 Considering that the two marks are confusingly similar, the unwary public will be most definitely misled into thinking that the products of Respondent-Applicant are manufactured and/or endorsed by Opposer herein which should not be allowed. In view thereof, Respondent-Applicant's trademark application should be denied registration.

"10. Further, Opposer's mark "DEXA MEDICA & DEVICE" cannot be registered for infringing on Opposer's trade name "PT DEXA MEDICA".

10.1 Under Section 165.2 (a) and (b) of the IP Code, trade names shall be protected even prior to or without its registration, including against subsequent use of the same by third party where such use will likely mislead the public, to wit:

*"165.2.(a) Notwithstanding any laws or regulations providing for any obligations to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.*

*(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or*

*collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.” [Emphasis provided.]*

10.2 On 02 June 2004, the Department of Trade and Industry (DTI) issued a Certificate of Business Name Registration in favor of the Opposer, certifying that Opposer’s business name “DEXA MEDICA-REPRESENTATIVE OFFICE” is registered with the DTI, and that the same is valid from 02 June 2004 to 02 June 2009.

10.3 On 16 April 2004, the Securities and Exchange Commission issued a License to Transact Business in the Philippines in favor of the Opposer. It is undisputable that Opposer has used “DEXA MEDICA” as trade name long before the Respondent-Applicant filed its application for “DEXA” I 2007, or at for at least three (3) years prior to such filing of application. Under Section 165.2 (b) of the IP Code, it is clear that Respondent-Applicant committed an unlawful act when it subsequently used “DEXA” as a mark, when the same is identical with the Opposer’s trade name “DEXA MEDICA”.

10.4 On various Certificates of Product Registration issued by the Bureau of Food and Drugs of the Department of Health on drugs manufactured by the Opposer, it is clearly indicated that the Opposer carries on its trade by its name “PT. DEXA MEDICA”.

10.5 In fact, Opposer, using the trade name “PT. DEXA MEDICA” as trade name long before the Respondent-Applicant filed its application for “DEXA” in 2007, or at for at least three (3) years prior to such filing of application.

10.6 Opposer has also extensively advertised its goods in the Philippines.

10.7 It is indisputable that Opposer has used “DEXA MEDICA” as trade name long before the Respondent-Applicant filed its application for “DEXA” in 2007, or at for at least three (3) years prior to such filing of application.

10.8 Even if the Opposer’s trade name “DEXA MEDICA” had not been registered with the appropriate government agencies, it is still entitled to protection by virtue of Section 165.2 (a) of the IP Code.

10.9 Under Section 165.2 (b) of the IP Code, it is clear that Respondent-Applicant committed an unlawful act when it subsequently used “DEXA” as a mark, when the same is identical with the Opposer’s trade name “DEXA MEDICA”.

“11. Moreover, under Section 123.1 (f) of the IP Code, a mark cannot be registered if it is identical with or confusingly similar to a well-known mark which is registered in the Philippines, even with respect to goods or services which are not similar to those with respect to which registration is applied for, to wit:

*“123.1. A mark cannot be registered if it:*

*XXX*

*(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in*

*accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mar:” Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use” [Emphasis Supplied]*

11.1 The mark “DEXA MEDICA & DEVICE” is well known internationally and in the Philippines. It has also been registered/applied for in the name of Opposer in various jurisdictions, including the following:

Country	Registration No.	Date Registered
Singapore	T06/07765ED	26 April 2006
Hong Kong	300607310	25 March 2006
Thailand	Kor. 269137	09 February 2007
Myanmar	3888/2006	19 June 2006
Philippines	4-2006-005032; 4-2006-005031	26 March 2007
Indonesia	D002006028940	04 September 2006
Indonesia	J002006028941	04 September 2006
Malaysia	06007306 Application No.)	03 May 2006 (Date Filed)
Nigeria	TP161495 (Application No.)	02 November 2006 (Date Filed)
Nigeria	TP161496 (Application No.)	22 June 2006 (Date Filed)
Sri Lanka	132543 (Application No.)	26 May 2006 (Date Filed)

11.2 Opposer has made substantial investments in advertising products bearing the “DEXA MEDICA & DEVICE” mark worldwide.

11.2.1 In 2005 alone, Opposer has spent at least Rp. 343,983,332.00 (approximately P1, 694,545.37) in advertisements through print, radio and television, showing the mark “DEXA MEDICA & DEVICE”.

11.2.2 In 2006, Opposer has even increased its expenditure on advertisements to at least Rp. 1,817,073,140.00 (approximately P8, 951,343.22).

11.2.3 Opposer’s world-wide use of “DEXA MEDICA & DEVICE” is further evidence by its various drug registrations and licenses obtained from other jurisdictions.

11.3 The mark “DEXA MEDICA & DEVICE” is internationally well-known by reason of the Opposer’s continuous use thereof worldwide and the numerous registrations that Opposer has obtained for said mark worldwide. By reason of Opposer’s exclusive, continuous and uninterrupted use of the mark “DEXA MEDICA & DEVICE”, Opposer has established worldwide goodwill over the said marks such that they have acquired or obtained international recognition as belonging to one owner or such, i.e., Opposer.

11.4 As a consequence of Opposer’s extensive use, sales, advertising and promotion of the mark for decades throughout various countries in the world the mark “DEXA MEDICA & DEVICE”, has become popular

among consumers and has achieved a vast and unparalleled public recognition/awareness and positive reputation in the international plane, and, this, has become an internationally well-known mark.

11.5 In the Philippines, some of the Opposer's products are sold through the Opposer's authorized distributor. Getz Bros Philippines, Inc. ("Getz Bros"), with address at 5/F Ortigas Building, Ortigas Avenue, Pasig City.

11.6 As previously discussed, Opposer has registered its well-known mark "DEXA MEDICA & DEVICE" in the Philippines on 09 April 2007. Thus, Opposer is entitled to the protection under Section 123.1(f) of the IP Code and Respondent-Applicant cannot register Opposer's mark.

"12. The registration of the mark "DEXA" will dilute Opposer's well-known mark "DEXA MEDICA & DEVICE"

12.1 The owner of a famous mark shall be entitled to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution. Dilution is the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of competition between the owner of the famous mark and other parties or the likelihood of confusion, mistake or deception.

12.2 As discussed above, it is indisputable that "DEXA MEDICA & DEVICE" has attained popularity and fame for its goods in both domestic and international markets. Such fame is attributable to Opposer's goodwill and reputation for high-quality and innovative pharmaceutical goods. It is illustrated by Opposer's various trademark product registrations and licenses worldwide. The numerous awards received by the Opposer has strengthened its goodwill over the trade name "DEXA MEDICA".

12.3 The distinctiveness of the Opposer's goods is elucidated in the association of the word "DEXA MEDICA & DEVICE" to goods sold by Opposer in ordinary parlance. "DEXA MEDICA & DEVICE" has attained popularity for the distinctiveness of its goods and the quality that it offers. Indubitably, the exclusivity distinction of the mark, its quality-image or reputation as well as the extent of its use worldwide would only attest to the distinctiveness of the mark "DEXA MEDICA & DEVICE".

12.4 The filing by Respondent-Applicant of the trademark application for "DEXA" began only after seeing the popularity of the mark "DEXA MEDICA & DEVICE". As enunciated in the discussions above, as early as 20 February 2003, the Opposer has used the mark "DEXA MEDICA & DEVICE" and trade name "PT. DEXA MEDICA" in the Philippines. Respondent-Applicant filed its trademark application on 25 October 2007, or more than three (3) years after the Opposer has started using "DEXA MEDICA & DEVICE" in the Philippines and more than a year after Opposer has filed with the IPO its application for "DEXA MEDICA & DEVICE". Clearly, Respondent-Applicant only conceptualized its mark recently, thus intending to ride on the popularity of "DEXA MEDICA & DEVICE" which Opposer has laboriously and painstakingly built.

12.5 The use of the mark "DEXA" will seriously dilute the Opposer's "DEXA MEDICA & DEVICE" mark. Respondent-Applicant's attempt to attach its mark "DEXA" to Opposer's "DEXA MEDICA & DEVICE" will



tarnish the reputation and distinctiveness that the latter's goods have attained. It will blur the image of the Opposer's products and diminish its value by the junior use of Respondent-Applicant, the likelihood of the confusion between Opposer and Respondent-Applicant's goods and the likely imprint on the public's mind since Opposer and Respondent-Applicant's goods are similar and closely related.

"13. The registration of the mark "DEXA" in the name of Respondent-Applicant's would not only violate the intellectual property rights of the Opposer, but will also cause Respondent-Applicant to unfairly benefit from, and free-ride on the business reputation and goodwill of Opposer over its mark "DEXA MEDICA & DEVICE" thereby causing irreparable injury to Opposer.

"14. The foregoing clearly shows that Opposer has a valid and legitimate claim for the use of its mark "DEXA MEDICA & DEVICE" which it developed and has marketed not only in the Philippines but worldwide throughout the years. Opposer's right stems from the fact that it was the first to file and register the mark "DEXA MEDICA & DEVICE" in the Philippines for use on goods that are similar or identical to the goods being applied for by Respondent-Applicant. Moreover, Opposer's long, exclusive and uninterrupted use of the mark "DEXA MEDICA & DEVICE" has caused the same to be well-known internationally and locally. In view thereof, Application No. 4-2007-011955 for the mark "DEXA" in the name HEALTH SAVER PHARMA, INC. should be denied.

A Notice to Answer was issued to and received by respondent-applicant on 29 October 2008. However, despite of having received the notice, respondent-applicant failed to file its answer. Therefore, due to its failure to file an answer within the reglementary period, it is deemed to have waived its right to file the same and the case shall be decided on the basis of the petition or opposition, the affidavits of the witnesses and the documentary evidence submitted by the opposer in accordance with Section 11 of the Regulation On Inter Partes Proceedings.

Considering that the case is mandatorily covered by the Summary Rules under Office Order No. 79, this Bureau required the parties through their respective counsel to submit their respective position papers but both parties failed to submit the same.

The issued to be resolved are as follows:

1. Whether the subject mark, "DEXA", is confusingly similar to Opposer's mark "DEXA MEDICA & DEVICE"; and
2. Whether Respondent-Applicant is entitled to the registration of the mark "DEXA".

Respondent-Applicant's mark "DEXA" is depicted below as follows:



**DEXA**

Meanwhile, Opposer's mark "DEXA MEDICA & DEVICE" is depicted below as follows:



After a careful examination of both marks, this Bureau finds that respondent-applicant's mark "DEXA" is confusingly similar with opposer's mark "DEXA MEDICA".

There is no doubt that the marks "DEXA" and "DEXA MEDICA & DEVICE" are confusingly similar. The word "DEXA" is the dominant feature of opposer's mark. The word "DEXA" in the opposer's mark is placed in between a triangular device and the word "Medica", placing the focus on the word "DEXA". Moreover, "Medica" is printed in a lighter shade with letters that merely outline the word "Medica". Consequently, the unwary eye will confuse both marks because the dominant feature of both marks is the word "DEXA".

The dominant feature of both marks is the word "DEXA" which is similarly spelled and pronounced for both marks based on the Dominancy Test which focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion (*McDonald's Corporation v. L.C. Big Mak, Inc.*, G.R. No. 143993, August 18, 2004). The dominant word "DEXA" gives the same visual and aural impression to the public's mind in the light of the goods to which they are used respectively by opposer and respondent-applicant (*McDonald's Corporation v. MacJoy Fastfood Corporation*, G.R. No. 166115, February 2, 2007; *McDonalds Corporation v. L.C. Big Mak, Inc.*, *supra*). Similarity in size, form and color, while relevant, is not conclusive. Neither duplication/imitation, or the fact that the infringing label suggests an effort to emulate, is necessary. The competing marks need only to contain the main, essential or dominant features of another; and that confusion and deception are likely. Colorable imitation does not mean such similitude as amounts to identity. Nor does it require that all the details be literally copied. Colorable imitation refers to such similarity in form, content, words, sound, meaning, special arrangement, or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely mislead or confuse persons in the ordinary course of purchasing the genuine article. (*Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft*, G.R. No. L-19906, April 30, 1969; *Lim Hoa v. Director of Patents*, G.R. No. L-8072, October 31, 1956; *Co Tiong Sa v. Director of Patents, et al.*, G.R. No. L-5378, May 24, 1954).

As to the first issue, thus, this Bureau rules in affirmative.

Moreover, Opposer's goods under Class 05 are "immunomodulator, pharmaceutical preparation which is classified as corticosteroid, pharmaceutical preparations for the treatment of nausea and vomiting, pharmaceutical preparation which is classified as cephalosporin's fourth generation, pharmaceutical preparations which is classified as non-steroidal anti-inflammatory." "Immunomodulator" is defined as a chemical agent that modifies the immune response or the functioning of the immune system. "Corticosteroid" is defined as any of a class of steroids occurring in nature especially as a product of the adrenal cortex. "Cephalosporins" is defined as any of a group of widely used broad-spectrum antibiotics. (Dictionary.Com) Meanwhile "dexamethasone" is defined as a crystalline, water-soluble steroid, C<sub>22</sub>H<sub>29</sub>FO<sub>5</sub>, used in the treatment of certain allergic or inflammatory conditions, as rheumatoid arthritis, bronchial asthma, or dermatoses (Dictionary.Com). It is a "synthetic glucocorticoid used primarily in the treatment of inflammatory disorders" (Dictionary.Com).

Hence, opposer's and respondent-applicant's respective pharmaceutical preparations are similar and related. These are essentially anti-inflammatory agents used to treat inflammatory conditions of the body such as arthritis, asthma, and bacteria infections.

Furthermore, it is noted that opposer already has a registration for its mark "DEXAMEDICA & DEVICE", with Registration No. 4-2006-005031 issued on April 09, 2007 for Class 05 goods as earlier mentioned.

In this regard, Section 123.1 (d) of the IP Code provides that a mark cannot be registered if it:

(d) 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, 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; (Underscoring Supplied.)

As discussed earlier, opposer's and respondent-applicant's respective marks are confusingly similar. Likelihood of confusion is heightened by the fact that said goods belong to the same class, and are similar and related. In view hereof vis-à-vis section 123.1 (d) of the IP Code, opposer has a better right to the mark DEXA.

As to the second issue, this Bureau rules in the negative.

WHEREFORE, the VERIFIED NOTICE OF OPPOSITION is, as it is, hereby SUSTAINED. Consequently, Application Serial No. 4-2007-011955 filed on 25 October 2007 by respondent-applicant Health Saver Pharma, Inc. for goods under Class 05, namely, "Dexamethasone preparations," is, as it is hereby, REJECTED.

Let the filewrapper of this case be forwarded to the Bureau of Trademarks for appropriate action with this decision.

SO ORDERED.

Makati City, 02 June 2009.

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