

WEST PHARMACEUTICALS, INC.,
Opposer,

- versus -

GX INTERNATIONAL, INC.
Respondent-Applicant.
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IPC NO. 14-2008-00060
Opposition to:
Appln. Serial No. 4-2007-012358
Date Filed: November 8, 2007
Trademark: "FLOXIN"
Class 5: pharmaceutical products

Decision No. 2009-98

DECISION

For decision is the Notice of Opposition filed by Westmont Pharmaceuticals, Inc., (hereinafter referred to as Opposer), a corporation organized and existing under the laws of the Philippines, with address at 4th Floor Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City against Application Serial No. 4-2007-012358 for the mark FLOXIN covering goods under class 5, namely: "pharmaceutical products particularly antibiotics, oral hypoglycemic agent, receptor antagonist, non-steroidal, anti-asthma, proton pump inhibitor, analgesic/antipyretic, expectorant, mucolytic, multivitamins and anti-thrombotic" filed by GX International Inc., (hereinafter referred to as respondent-applicant), a domestic corporation with address at Alpap II Bldg., Trade corner Investment Street, Madrigal Business Park, Alabang, Muntinlupa City.

The grounds for the opposition are as follows:

1. The trademark "FLOXIN" so resembles "STAFLOXIN" trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark "FLOXIN". The trademark "FLOXIN", which is owned by the Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering, that the opposed trademark "FLOXIN" is applied for the same class of goods as that of trademark "STAFLOXIN", Le., Class (5) which includes anti-bacterial and anti-biotics medicinal preparation.
2. The registration of the trademark "FLOXIN" in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the "Intellectual Property Code", 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 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"

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 is applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

3. Respondent's use and registration of the trademark "FLOXIN" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "STAFLOXIN".

In support of the opposition, oppose submitted the following evidence:

ANNEX

"A"

"B"


DESCRIPTION

List of published marks

Certificate of Registration No. 4-1996-98182

“C”	Declaration of Use
“D”	Affidavit of Use
“E”	Sample Product label
“F”	Certification by IMS Health Philippines, Inc.
“G”	Certificate of Product Registration

The Notice to Answer dated April 10, 2008 was received on May 6, 2008, but no Answer was filed. The issue is whether the mark FLOXIN is registrable and whether it is confusingly similar to the mark STAFLOXIN. The marks of the parties are reproduced below for comparison:

Opposer's mark	Respondent-Applicant's mark
Stafloxin	

The Intellectual Property Code States:

(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”

Evidence shows that opposer's mark STAFLOXIN has been previously registered on January 2, 2001 under Certificate of Registration No. 4-1996-98182 (Annex “B”) for the goods under class 5 covering “Antibacterial medicinal preparation”. Considering that respondent-applicant intends to apply its mark for goods also under class 5, it should be determined whether the marks are confusingly similar.

The Supreme Court in Mighty Corporation and La Campana Fabrica de Tabaco, Inc. vs. E. & J. Gallo Winery and the Andresons Group, Inc., G.R. No. 154342. July 14, 2004 held:

“Jurisprudence has developed two tests in determining similarity and likelihood of confusion in trademark resemblance:

- (a) the Dominancy Test applied in Asia Brewery, Inc. vs. Court of Appeals and other cases and
- (b) the Holistic or Totality Test used in Del Monte Corporation vs. Court of Appeals and its preceding cases.

The Dominancy Test focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception, and thus infringement. If the competing trademark contains the main, essential or dominant features of another, and confusion or 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. The question is whether the use of the marks involved is likely to cause confusion or mistake in the mind of the public or deceive purchasers.”

Again, the Supreme Court in McDonald's Corporation v. L.C. Big Mak Burger, Inc., G.R. No. 143993, 18 August 2004 applied the dominancy test where it held:

“The test of dominancy is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the “colorable imitation of a registered mark xxx or a dominant feature thereof.”

Applying the dominancy test, the Court finds that respondents’ use of the “Big Mak” mark results in likelihood of confusion. First, “Big Mak” sounds exactly the same as “Big Mac”. Second, the first word in “Big Mak” is exactly the same as the first word in “Big Mac”. Third, the first two letters in “Mak” are the same as the first two letters in “Mac”. Fourth, the last letter in “Mak” while a “K” sounds the same as “c” in spelling, thus “Caloocan” is spelled “Kaloocan”. (Underscoring supplied)

In *American Wire & Cable Co. vs. Director of Patents*, 31 SCRA 544, the Supreme Court held:

“In fact, even their similarity in sound is taken into consideration, where the marks refer to merchandise of the same descriptive properties, for the reason that trade idem sonans constitutes violation of trade mark patents”, the law provides that a mark cannot be registered.

In the case at bar, it is observed that respondent-applicant’s mark constitutes the suffix of the opposer’s mark, FLOXIN. The only difference between the deletion by the respondent-applicant of the prefix STA. Yet, the two marks have six identical literal elements. When the two marks are pronounced, the words sound the similar. It is not far-fetched that confusion is likely to occur considering the similarity of the marks. In the case of *Co Tiong Sa v. Director of Patents* [G.R. No. L-5378. May 24, 1954.], the Supreme Court explains:

“Far from all we see or hear casually is retained sufficiently clearly or insufficient detail for us to get a lasting impression of it which we can remember when we encounter the mark again. The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must depend entirely on the ear.xxx

The average buyer usually seeks a sign, some special, easily remembered earmarks of the brand he has in mind. It may be the color, sound, design, or a peculiar shape or name. Once his eyes see that or his ear hears it, he is satisfied. An unfair competitor need not copy the entire mark to accomplish his fraudulent purpose. It is enough if he takes the one feature which the average buyer is likely to remember. (Nims, *The Law of Unfair Competition and Trademarks*, 4th ed., Vol. 2, pp. 678-679).”

WHEREFORE, premises considered the OPPOSITION filed by opposer, Westmont Pharmaceuticals, Inc. is, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 4-2007-012358 for the mark FLOXIN for goods covering class 5 namely “pharmaceutical products particularly antibiotics, oral hypoglycemic agent, receptor antagonist, non-steroidal, anti-asthma, proton pump inhibitor, analgesic/antipyretic, expectorant, mucolytic, multi-vitamins and anti-thrombotic” filed by respondent-applicant, GX International, Inc. is, as it is, hereby REJECTED.

Let the filewrapper of “FLOXIN”, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, 25 August 2009.

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