BIOFEMME, INC.,	}	**IPC No. 14-2009-00081**
Opposer,	}	Opposition to:
	}	
	}	
- versus -	}	Appln. Ser. No. 4-2007-009205
	}	Date Filed: 23 August 2007
	}	
GETZ BROS. PHILIPPINES, INC.,	}	
Respondent-Applicant.	}	Trademark: **ETIDOXIN**
x----------x		Decision No. 2012 - 31

DECISION

BIOFEMME, INC.[1] ("Opposer") filed on 17 March 2009 a Verified Opposition to Trademark Application No. 4-2007-009205. The application, filed by GETZ BROS. PHILIPPINES, INC.[2] ("Respondent-Applicant"), covers the mark ETIDOXIN used for goods under Class 05[3], particularly, *"pharmaceutical product used for the treatment of genito-urinary tract, gastro-intestinal tract, skin and soft tissue infections; treatment of lymphogranuloma venerem, osteomyelitis, thrombophlebitis and gonorhea"*. The subject trademark application was published in the "IPO E-Gazette" on 16 January 2009.

The Opposer alleges the following:

> "1. The trademark ETIDOXIN so resembles DOXIN trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark ETIDOXIN. The trademark ETIDOXIN, which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark ETIDOXIN is applied for the same class of goods as that of trademark DOXIN, *i. e.* Class 5;
>
> "2. The registration of the trademark ETIDOXIN in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", which provides, in part, that a mark cannot be registered if it:

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1 A corporation duly organized and existing under the laws of the Philippines with principal office located at 2nd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

2 A domestic corporation with principal office address at 5th Floor Ortigas Building, Ortigas Avenue, Pasig City.

3 Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

x x x

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

The Opposer's evidence consists of the following:

1. Exhibit "A" - Print-out of list of Trademarks Published for Opposition released on 16 January 2009;

2. Exhibit "B" - Certified true copy of Certificate of Registration No. 27144 for the mark DOXIN registered on 15 March 1979;

3. Exhibit "C" - Certified true copy of Certificate of Renewal of Registration No. 27144 for the mark DOXIN;

4. Exhibit "D" - Certified true copy of Petition for Renewal of Registration No. 27144 for the mark DOXIN;

5. Exhibit "E" - Certified true copy of the Assignment of Registered Trademark filed on 12 January 2009;

6. Exhibit "F" - Certified true copy of Affidavit of Use for Fifth Anniversary filed on 26 March 1984;

7. Exhibit "G" - Certified true copy of Affidavit of Use for Tenth Anniversary filed on 26 April 1989;

8. Exhibit "H" - Certified true copy of Affidavit of Use for Fifteenth Anniversary filed on 05 April 1994;

9. Exhibit "I" - Certified true copy of Affidavit of Use for 5th Anniversary filed on 13 April 2004;

10. Exhibit "J" - Sample of product label bearing the trademark DOXIN;

11. Exhibit "K" - Certified true copy of Certificate of Product Registration issued by the BFAD for the mark DOXIN;

12. Exhibit "L" - Certification issued by Intercontinental Marketing Services (IMS) dated 08 October 2008.

This Bureau issued a Notice to Answer and served a copy thereof

upon the Respondent-Applicant on 22 April 2009. The Respondent-Applicant, however, did not file an Answer despite receipt of the notice. Thus, this Bureau, pursuant to Section 11[4] of Office Order No. 79, issued an Order dated 09 February 2011 submitting the case for decision on the basis of the opposition, affidavits of witnesses and evidence submitted by the Opposer.

Should the Respondent-Applicant's trademark application be allowed?

It is emphasized that 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 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.[5]

Thus, Sec. 123.1 (d) of the Intellectual Property Code ("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;

Records and evidence show that at the time the Respondent-Applicant filed its trademark application on 23 August 2007, the Opposer's sister company and predecessor-in-interest, THERAPHARMA, INC., already has an existing trademark registration for the mark DOXIN issued by the then Philippine Patent Office as early as 15 March 1979[6]. The said trademark registration has been renewed[7] for another ten (10) years from 15 March 1999 until it was assigned[8] to herein Opposer on 17

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[4] Section 11. *Effect of failure to file Answer* – In case the respondent fails to file an answer, or if the answer is filed out of time, 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 petitioner or opposer.

[5] *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

[6] Exhibit "B" - Certificate of Registration No. 27144 for the mark DOXIN.

[7] Exhibit "C" - Certificate of Renewal of Registration No. 27144 for the mark DOXIN.

[8] Exhibit "E" - Assignment of Registered Trademark filed on 12 January 2009.

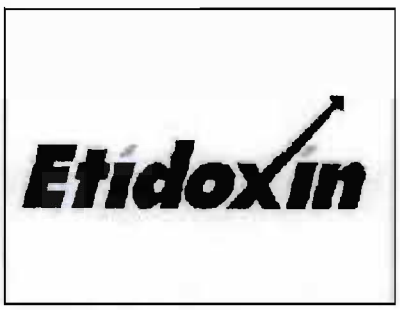
December 2008.

The questions now are: Are the marks identical and used on the same or closely related goods or services? Or, do they resemble each other that deception or confusion is likely to occur?

In determining whether two (2) or more marks are confusingly similar, the law does not require actual confusion, it being sufficient that confusion is likely to occur.[9]

The competing marks are reproduced below for comparison:

Opposer's mark



Respondent-Applicant's mark

The feature in the Respondent-Applicant's mark that immediately draws the eyes and ears is the term "DOXIN". Although it is printed in italics bold letters and uses a different font style, confusion is still likely to occur since the prominent term in Respondent-Applicant's mark is part and parcel of the Opposer's mark DOXIN.

Also, the addition of the letters "E-T-I" in the Respondent-Applicant's mark is inconsequential. It is stressed that the conclusion (of similarity) created by the use of the same word as the primary element in a trademark is not counteracted by the addition of another term. By analogy, confusion cannot also be avoided by merely dropping, adding or changing one of the letters of a registered mark.[10] Confusing similarity exists when there is such a close of 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.[11] The copycat need not copy the entire mark, but it is enough that he takes one feature which the average buyer is likely to remember.[12] Indeed, if the Respondent-Applicant really

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[9] *Philips Export B. V., et. al. v. Court of Appeals, et. al.*, G. R. No. 96161, 21 February 1992.
[10] *Continental Connector Corp. v. Continental Specialties Corp.*, 207 USPQ.
[11] *Societe Des Produits Nestle, S. A. v. Court of Appeals*, G. R. No. 112012, April 4, 2001.
[12] Ref. *Nims, The Law of Unfair Competition and Trademarks*, 4th Ed. Vol. 2, pp. 678-679.

intended to distinguish its mark, it has a wide field of selection where it could add the letters "E-T-I" other than that of the word "DOXIN" which was already appropriated by the Opposer as early as 1975.

This Bureau noted that the Opposer's mark is used on *"antibiotic pharmaceutical preparation"*. On the other hand, the Respondent-Applicant's mark covers *"pharmaceutical product used for the treatment of genito-urinary tract, gastro-intestinal tract, skin and soft tissue infections; treatment of lymphogranuloma venerem, osteomyelitis, thrombophlebitis and gonorhea"*. Relative thereto, it was held that "goods are related when they belong to the same class or have the same attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores".[13]

Obviously, the goods covered by the marks are related not only because they belong to the same class, *i.e.* Class 05, covering pharmaceutical preparations but also because they serve the same purpose. The Opposer's antibiotic preparation which is basically used to treat infections are wide enough to include that of the Respondent-Applicant's goods for the treatment of skin and soft tissue infections.

The Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code, and therefore, should not be allowed.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED.** Let the filewrapper of Trademark Application No. 4-2007-009205, together with a copy of this Decision, be returned to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Taguig City, 17 February 2012.

Atty. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

[13] *ESSO Standard Eastern, Inc. v. Court of Appeals, et. al.*, 201 Phil 803.