



AMBROSIO V. PADILLA III,  
Opposer,

-versus-

JF DRAF PHARMACEUTICALS CORPORATION,  
Respondent- Applicant.

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} IPC No. 14-2012-00218  
} Opposition to:  
} Appln. Serial No. 4-2011-014084  
} Date filed: 24 November 2011  
} TM: "APIDEN"  
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}  
}  
}

### NOTICE OF DECISION

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**GREETINGS:**

Please be informed that Decision No. 2013 - 129 dated July 10, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 10, 2013.

For the Director:

  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



**AMBROSIO V. PADILLA III,**  
Opposer,

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**JF DRAF PHARMACEUTICALS  
CORPORATION,**  
Respondent-Applicant.

x-----x

**IPC NO. 14-2012-00218**

Opposition to:

Appln. Ser. No. 4-2011-014084

Date Filed: 24 November 2011

Class: 5

Trademark: **APIDEN**

Decision No. 2013 - 129

## DECISION

Ambrosio V. Padilla, III, of legal age, Filipino, ("Opposer") with office address at Unit 1001, 88 Corporate Center, Seden corner Valero Streets, Salcedo Village, Makati City filed on 1 June 2012 a Verified Opposition to Trademark Application No. 4-2011-014084. The application, filed by JF DRAF PHARMACEUTICALS CORPORATION<sup>1</sup> ("Respondent-Applicant") covers the mark APIDEN for use on "*pharmaceutical drug Antiparkinsonism*" under Class 05 of the International Classification of goods<sup>2</sup>.

The Opposer alleges that the trademark APIDEN resembles that of AKIDIN which is owned by the Opposer and which was registered with the Intellectual Property Office ("IPO") prior to the publication for opposition of the mark APIDEN. Opposer also alleges that he is the first to use, adopt and register the mark AKIDIN in the Philippines and APIDEN will likely cause confusion, mistake and deception on the part of the purchasing public. Both marks cover goods falling under Class 05 for the treatment of parkinsonism. Opposer alleges that the registration of APIDEN will violate Sec. 123.1 (d) of the Intellectual Property Code of the Philippines ("IP Code") as APIDEN is visually and phonetically similar to the Opposer's mark and thus, AKIDIN is confusingly similar to Opposer's registered mark when used for identical goods.

The Opposer's evidence consists of a certified true copy of the Trademark Application of Respondent-Applicant, Opposer's application for

<sup>1</sup> A domestic corporation with principal office at Suite 407 Greenhills Mansion, 37 Annapolis St., Northeast Greenhills, San Juan, Metro Manila.

<sup>2</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of goods and services for the Purpose of the Registration of Marks concluded in 1957.

similar marks under Class 5, namely ARIN and ABDIN, samples of medicines bearing AKIDIN trademark, certified true copy of Certificate of Registration No. 4-2009-012253 for AKIDIN, sales report, affidavit of Mr. Michael S. Vasallo, the Chief Operating Officer of MEDCHOICE, samples of corporate giveaway and stationary, list of clients and customers, photos of tradeshow booths bearing AKIDIN trademark<sup>3</sup>.

The Respondent-Applicant filed its Answer on 19 July 2012 stating mistake and confusion is unlikely because of the difference in pronunciation and spelling that 'K' is pronounced differently with 'P' and the last syllable of AKIDIN is 'DIN' while the Respondent-Applicant's trademark ends in 'DEN'. According to the Respondent-Applicant, aside from the glaring dissimilarities and discrepancies in the lettering of the competing marks, the products do not serve the same purpose in that APIDEN consists of 'pharmaceutical drug- antiparkinsonism' while AKIDIN is 'for the treatment of parkinsonism and alleviation of extrapyramidal syndrome by drugs like phenothiazines'. Also, the Generics Law<sup>4</sup> militate against the argument of confusion because medical practitioners are required to write prescriptions using the generic name of the drug and if he prefers a certain product, he may add a brand name in the prescription.

The preliminary conference was conducted and terminated on 8 January 2013. The Opposer filed its position paper on 18 January 2013 while the Respondent-Applicant filed its position paper on 18 January 2013.

Should the Respondent-Applicant be allowed to register the mark APIDEN? The marks are reproduced below for perusal.

**Akidin**

Opposer's mark

**Apiden**

Respondent-Applicant's mark

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.<sup>5</sup> Thus, Sec. 123.1 (d) of R. A. No. 8293, also

<sup>3</sup> Marked as Exhibits "B" to "J".

<sup>4</sup> R.A. 6675, September 13, 1988

<sup>5</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.



known as The Intellectual Property Code of the Philippines ("IP Code") 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 the same goods or services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 24 November 2011, the Opposer already has an existing registration for the trademark AKIDIN issued on 20 May 2010, covering goods falling under Class 05, namely, "*for medicine (Pharma) specifically for the treatment of parkinsonism and alleviation of extrapyramidal syndrome by drugs like phenothiazines*". The goods indicated in the Respondent-Applicant's trademark application are, therefore, similar and/or closely related to those covered by the Opposer's trademark registration.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

Scrutinizing the composition of the trademarks involved in this case, it is observed that both marks, APIDEN and AKIDIN, after excluding the portions coined from the generic term BIPERIDEN contain two (1) syllables consisting of two letters, 'AK' and 'AP'. Although Opposer used the letter 'i' in the last two syllables while the Respondent-Applicant used 'e', both suffixes sound the same or similar to the last portion of the generic term, BIPERIDEN. Opposer used 'idin' while respondent-applicant used 'iden' which terms are *idem sonans*. What remains to be examined is the first syllable 'AK' and 'AP'. Both marks start with "A" but differ in the succeeding letter with the last two syllables coined from the generic term of the pharmaceutical drug it represents.

Although not entirely the same, there are no appreciable disparities between the two marks so as to avoid the likelihood of confusing one for the other. While not all the letters are the same, phonetically, there is a possibility that confusion would likely to occur. Moreover, although the Opposer's product includes a description that the drug alleviates extrapyramidal syndrome, however, the purpose of such pharmaceutical drug remains the same – treatment of parkinsonism.

It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.<sup>6</sup>

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<sup>6</sup> Del Monte Corporation et. al. v. Court of Appeals, GR No. 78325, 25 January 1990.

In conclusion, the Respondent-Applicant's trademark application is proscribed by Section 123.1 (d) of the IP Code.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-014084, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 10 July 2013.

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