



BIOFEMME, INC.,
Opposer,

-versus-

EON PHARMATEK, INC.,
Respondent-Applicant.

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} IPC No. 14-2011-00398
} Opposition to:
} Appln. Serial No. 4-2011-01550
} Date filed: 11 Feb. 2011
} TM: "TREOMYCIN"
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}
}

NOTICE OF DECISION

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EON PHARMATEK, INC..
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GREETINGS:

Please be informed that Decision No. 2012 – 213 dated October 25, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 25, 2012.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



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- versus -

EON PHARMATEK, INC.,
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IPC No. 14-2011-00398
Opposition to:

Appln. Serial No. 4-2011-01550
(Filing Date: 11 Feb. 2011)
TM: "TREOMYCIN"

Decision No. 2012- 2/3

DECISION

BIOFEMME, INC. ("Opposer")¹ filed on 24 August 2011 an opposition to Trademark Application No. 4-2011-01550. The application, filed by EON PHARMATEK, INC. ("Respondent-Applicant")², covers the mark "TREOMYCIN" for use on "*pharmaceuticals-antibacterial table*" under class 5 of the International Classification of goods³.

The Opposer alleges, among other things, that TREOMYCIN is confusingly similar to its registered mark TRIMYCIN. According to the Opposer, the registration of TREOMYCIN in favor of the Respondent-Registrant violates Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). To support its opposition, the Opposer submitted⁴ as evidence a print out of page 2 of the "IPO E-Gazette" released on 25 July 2011, and documents pertaining to the mark TRIMYCIN, particularly, copies of Cert. of Reg. No. 34979, Deed of Assignment, Cert. of Renewal Registration, Affidavit of Use, sample of product labels, and Cert. of Product Registration issued by the Bureau of Food and Drugs.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant. The Respondent-Applicant filed a motion for extension of time to file Answer which was granted through Order No. 2011-1596 issued by the Hearing Officer on 22 November 2011. Although the Respondent-Applicant was given until 13 December 2011 to file the Answer, it failed to do so. The Hearing Officer issued on 20 July 2012 Order No. 2012-1023 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant be allowed to register the mark TREOMYCIN?

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 IP Code provides that a mark cannot be registered if its is identical with a registered mark belonging to a different proprietor or

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

² A domestic corporation with principal address at Unit 703, AIC Burgundy Empire Tower, ADB Avenue, Ortigas Center, Pasig City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

⁴ Marked as Annexes "A" to "I", inclusive.

⁵ See *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

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.

Records show that at the time the Respondent-Applicant filed its trademark application on 11 February 2011, the Opposer already has an existing trademark registration for TRIMYCIN under Reg. No. 34979 issued on 17 December 1985. The Opposer's trademark registration indicates that the mark is for use on goods "*topical treatment of infectious skin diseases*" under class 5. The Opposer's goods therefore is closely related, if not similar, to those covered by the Respondent-Applicant's trademark application, i.e. "*pharmaceuticals-antibacterial tablet*".

But do the marks, shown below, resemble each other that confusion, even deception, is likely to occur?

TRIMYCIN

Treomycin

Unlike in the mark applied for registration by the Respondent-Applicant, all the letters in the Opposer's mark are in the upper case. This notwithstanding, the marks are still confusingly similar. Both feature the syllables "MYCIN". TREO and TRI connote the same idea which is the number three (3). The sound when TREO is pronounced is almost undistinguishable from the TRI's. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or 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 other⁶. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁷.

Succinctly, because the Respondent-Applicant will use or uses the mark TREOMYCIN on goods that are similar and/or closely related to those covered by the Opposer's registered trademark, the changes in the spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. There is the likelihood that information, assessment, perception or impression about TREOMYCIN products delivered and conveyed through words and sounds and received by the ears may unfairly cast upon or attributed to the TRIMYCIN products and the Opposer, and *vice-versa*.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁸ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁹

⁶ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217.

⁷ *Emerald Garment Manufacturing Corp. v. Court of Appeals*, G.R. No. 100098, 29 Dec. 1995.

⁸ *American Wire and Cable Co. v. Director of Patents et al*, (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

⁹ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al*, G.R. No. L-27906, 08 Jan. 1987.

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant Opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2011-01550 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 25 October 2012.



ATTY. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs