



BIOFEMME, INC.,
Opposer,

-versus-

MEDHAUS PHARMA, INC.,
Respondent-Applicant.

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} IPC No. 14-2010-00010
} Opposition to:
} Appln. Serial No. 4-2009-005445
} Date Filed: 02 June 2009
} TM: "CALCIMED"

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for the Opposer
66 United Street
Mandaluyong City

ARLENE C. BALBERDE
For Respondent-Applicant
No. 139 K 1st Street, Kamuning
Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 212 dated October 30, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 30, 2013.

For the Director:


Atty. EDWIN DANILO A. DALING
Director III
Bureau of Legal Affairs



BIOFEMME, INC.,

Opposer,

IPC NO. 14-2010-000010

Opposition to:

-versus-

Appln. Ser. No. 4-2009-005445

(Filing Date: 02 June 2009)

TM: "CALCIMED"

MEDHAUS PHARMA, INC.,

Respondent-Applicant.

X-----X

Decision No. 2013- 212

DECISION

BIOFEMME, INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2009-005445. The application, filed by MEDHAUS PHARMA, INC. ("Respondent-Applicant")², covers the mark "CALCIMED" for use on "*pharmaceutical product-vitamin*" under Class 5 of the International Classification of goods.³

The Opposer alleges among other things that it is the owner of the trademark "CALCIUMADE" which is already registered in the Philippines. According to the Opposer, CALCIMED is confusingly similar to CALCIUMADE and its registration will violate Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). The Opposer also alleges that the Respondent-Applicant's use and registration of CALCIMED will diminish the distinctiveness and dilute the goodwill of the mark CALCIUMADE. To support its opposition, the Opposer submitted as evidence the following:

1. printout of the "IPO E-Gazette", with releasing date of 12 October 2009, publishing for opposition trademark applications including the Respondent-Applicant's;
2. copy of Certificate of Reg. No. 4-1998-006707 for the mark CALCIUMADE;
3. Deed of Assignment involving Trademark Reg. No. 4-1998-006707;
4. Affidavit of Use of the mark CALCIUMADE;
5. sample product label; and
6. copy of the certificate of product registration issued by the Bureau of Food and Drugs.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 24 February 2010. On 03 February 2011, the Hearing Officer issued Order No. 2011-188 stating, among other things, that due to the failure of the Respondent-Applicant to file its Answer within the prescribed period, said party is declared to have waived its right to file the Answer, and the case is deemed submitted for decision.

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

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, Metro Manila.

² A domestic corporation with principal office address at 139 KIST St., Kamuning, Quezon City, Metro Manila.

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 "F".

It is emphasized that the essence of trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; 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 to 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 product⁵. Thus, Sec. 123.1(d) of the 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 earlier filing or priority date, in respect of the same goods or services or closely related goods or services or it nearly resembles such, mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its trademark application on 02 June 2009, the Opposer has an existing trademark registration for CALCIUMADE for use on "*a preparation for a high-calcium drink*" under Class 5 (Reg. No. 4-1998-006707). The goods covered by the Opposer's trademark registration are similar to the goods indicated in the Respondent-Applicant's trademark application.

But, are the competing marks resemble each other, such that confusion, or even deception, is likely to occur?

The Opposer's mark CALCIUMADE contains the word "*calcium*" which is essentially the goods or product covered by its trademark registration. With respect to the mark applied for registration by the Respondent-Applicant, it is obvious that it is also derived from the word "*calcium*". The first two syllables, "CALCI", is just an abbreviated form of "*calcium*"; even a common prefix, for goods/products where "*calcium*" is an ingredient.

It must be emphasized that this Bureau cannot sustain the opposition on the basis that the marks contain the word "CALCIUM" or "CALCI". To do so would have the unintended effect of giving the Opposer exclusive right to the word "*calcium*", which is the generic name for or descriptive of calcium based goods/products.

Nevertheless, this Bureau still finds that the Respondent-Applicant's trademark application should not be allowed. With a creative flair in appending the letters "ADE" to "CALCIUM", the Opposer's mark became sufficiently distinctive to be considered registrable although as a suggestive mark. What the Respondent-Applicant did on the other hand, is to add the letters "MED" to "CALCI" resulting in the mark CALCIMED. CALCIMED, however, deceptively looks and sounds like the Opposer's registered mark CALCIUMADE. The eyes and ears would have a hard time distinguishing one mark from the other. Confusion, even deception, is likely as the competing marks are used on similar goods. Worse, information, assessment, perception or impression, whether good or positive, on the goods sold by the Respondent-Applicant may unfairly be cast upon or attributed to the Opposer.

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

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 115508, 19 Nov. 1999.

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

distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁷.

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

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.

It is very difficult to understand and highly improbable if the circumstance was purely coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters available, the Respondent-Applicant had come up with a mark identical or so nearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.¹⁰

WHEREFORE, premises considered, the Opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-005445 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 30 October 2013.


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

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.

¹⁰ *American Wire and Cable Co. v. Director of Patents, et. al, supra*.