BIOMEDIS INC., Opposer, **-versus-** **AMBICA INTERNATIONAL TRADING CORPORATION,** Respondent-Applicant.	}	**IPC No. 14-2010-00289** Opposition to: Appln. Serial No. 4-2010-007403 Filing Date: 08 July 2010 **TM: "GENOFLOX"**

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NOTICE OF DECISION

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AMBICA INTERNATIONAL TRADING CORPORATION
Counsel for Respondent-Applicant
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GREETINGS:

Please be informed that Decision No. 2013 - 15 dated January 24, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 24, 2013.

For the Director:

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

BIOMEDIS INC.,
Opposer,

- versus -

AMBICA INTERNATIONALTRADING CORPORATION,
Respondent-Applicant.
x----------x

IPC No. 14-2010-00289
Opposition to:

Appln. Serial No. 4-2010-007403
(Filing Date: 08 July 2010)
TM: "GENOFLOX"

Decision No. 2013- 15

DECISION

BIOMEDIS INC., ("Opposer")[1] filed on 25 November 2010 an opposition to Trademark Application Serial No. 4-2010-007403. The application, filed by AMBICA INTERNATIONAL TRADING CORP. ("Respondent-Applicant")[2], covers the mark "GENOFLOX" for use on "*pharmaceutical products namely antibacterial*" under Class 5 of the International Classification of Goods.[3]

The Opposer alleges, among other things, that the mark GENOFLOX so resembles its already registered trademark "INOFLOX". According to the Opposer, confusion, mistake and deception is likely because the Respondent-Applicant's trademark application indicates the same class and goods covered by the registration for the mark INOFLOX. The Opposer, thus, contends that the registration of GENOFLOX will violate Sec.123.1 of Rep. Act No.8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

To support its opposition, the Opposer submitted as evidence a print out of the pertinent page of the "IPO E-Gazette" which shows the publication of the Respondent-Applicant's mark on 26 October 2010, and documents relating to the mark INOFLOX, particularly: a certified true copy of Cert. of Reg. No. 48600, petition for renewal of trademark registration, certified true copy of affidavits of use, sample product label, certification and sales performance, and 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 10 February 2011. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant trademark application be allowed?

It is emphasized that the essence of the 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

1 A domestic corporation duly organized and existing under the laws of the Philippines, with office address at 108 Roda Street, Legaspi Village, Makati City Philippines
2 With office address at 9 Amsterdam Extension, Merville Park. Subdivision, Paranaque City, Philippines
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 Exhibits "A" to "G", inclusive.

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 article as his product[5]. Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it is 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 mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 08 July 2010, the Opposer has already an existing registration for the mark INOFLOX (Reg. No. 48600, issued on 18 July 1990) covering "*bacterial preparations*" under Class 5. The Respondent-Applicant's application indicates the same or related pharmaceutical goods, i.e. "*anti-bacterial*".

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

Inoflox	GENOFLOX
Opposer's mark	*Respondent-applicant's mark*

Both marks contain the suffix "FLOX". In this regard, the Trademark Registry, the contents of which this Bureau may take cognizance of via judicial notice, shows that not a few applied and registered marks with the suffix "FLOX", for use on pharmaceutical products. This shows that the use of the suffix "FLOX" as a trademark or a part thereof is obviously common in the pharmaceutical industry and practically, with no distinctive property of its own. Thus, in order to determine whether two marks with common suffix "FLOX" are confusingly similar, the inquiry should reach out to the other features appearing in the marks.

In the Opposer's mark, the suffix "FLOX" is preceded by the syllables "INO". On the other hand, the Respondent-Applicant's applied mark starts with the syllables "GENO". The two marks therefore are identical as to the last six (6) letters or last two syllables, i.e. "NOFLOX". Also, pronouncing "GENOFLOX" and "INOFLOX" produces similar sounds which make it not easy for one to distinguish one mark from the other. 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, however, 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 other[6]. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details

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5 *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No.114508, 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.

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 article[7].

Succinctly, because the Respondent-Applicant will use or uses the mark GENOFLOX 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 GENOFLOX products delivered and conveyed through words and sounds and received by the ears may unfairly cast upon or attributed to the INOFLOX 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]

> 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 opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2010-007403 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 24 January 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.