



GLAXO SMITHKLINE PHILIPPINES, INC.,
Opposer,

-versus-

NUTRAMEDICA, INC.,
Respondent- Applicant.

x-----x

}
} IPC No. 14-2012-00118
} Opposition to:
} Appln. Serial No. 4-2011-750065
} Date filed: 16 August 2011
} TM: "AMBROMAX"
}
}
}
}

NOTICE OF DECISION

ORTEGA, BACORRO, ODULIO, CALMA AND CARBONELL
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NUTRAMEDICA, INC.
Respondent-Applicant
No. 35 Scout Lozano St.
Brgy. Laging Handa, Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 227 dated November 22, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 22, 2013.

For the Director:

Edwin Danilo A. Dating
Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



GLAXO SMITHKLINE PHILIPPINES, INC.	}	IPC No. 14-2012-00118
Opposer,	}	Opposition to:
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-versus-	}	Appln. Serial No. 4-2011-750065
	}	Date Filed : 16 August 2011
NUTRAMEDICA, INC.,	}	Trademark: "AMBROMAX"
Respondent-Applicant.	}	
x ----- x	x	Decision No. 2013 - <u>227</u>

DECISION

GLAXO SMITHKLINE PHILIPPINES ("Opposer")¹, filed on 11 May 2012 an opposition to Trademark Application No. 4-2011-750065. The application, filed by NUTRAMEDICA, INC. ("Respondent-Applicant")², covers the mark "AMBROMAX" for use on goods under class 5³ for Mucolytic Agent.⁴

The Opposer interposes the following grounds for opposition:

- "1. The trademark AMBROMAX which respondent seeks to register in respect of 'Mucolytic agent' in class 5 nearly resembles opposer's trademark AMBROLEX, registered in the Philippines under Registration No. 4-1998-009207 with respect to 'Mucolytic Infant Drop' in class 5 as to be likely to deceive or cause confusion.
- "2. The confusing similarity between the trademark AMBROMAX and opposer's trademark AMBROLEX, aggravated by the similarity in their designated goods, will likely mislead the public into believing that respondent-applicant's products under the trademark AMBROMAX originated from oppose, or conversely, that opposer's products under the trademark AMBROLEX emanated from respondent-applicant.
- "3. AMBROLEX has been known to the Philippine public as early as June 1998 for Expectorants that oppose has since then been selling, distributing and promoting.
- "4. Being in the same industry as oppose, respondent-applicant should have known better than to adopt AMBROMAX as a trademark when oppose has already registered, almost ten (10) years ago, the trademark AMBROLEX in respect of class 5 goods.
- "5. The confusion that will result from respondent-applicant's use of AMBROMAX despite opposer's prior use and registration of AMBROLEX will certainly cause damage and prejudice to the latter, whose fame and reputation in the pharmaceutical industry is indisputable."

¹ A corporation duly organized under the laws of the Philippines, with principal place of business at 2266 Chino Roces Avenue, Makati City, Philippines.
² With office address at No. 35 Scout Lozano St., Brgy. Laging Handa, Quezon City, Philippines.
³ The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.
⁴ The application was published in the Intellectual Property Office Official Gazette, officially released for circulation on 13 February 2012.

The facts are provided as follows:

"7. Opposer is the owner, first user, original adopter, and registrant of the trademark AMBROLEX.

7.1 Opposer owns Philippine Trademark Registration No. 4-1998-002307 for AMBROLEX which was issued on 10 May 2002 and is valid until 10 May 2012.

7.2 The goods covered by the registration are "Mucolytic Infant Drop" in class 5. A certified copy of Registration No. 4-1998-002307 will form part of opposer's evidence.

7.3 Opposer first used AMBROLEX in the Philippines in June 1998.

7.4 Opposer also owns Philippine Trademark Registration No. 4-1999-007450 for AMBROLEX OD which was issued on 16 June 2006 and is valid until 16 June 2016. A Declaration of Actual Use was filed by opposer for AMBROLEX OD on March 21, 2012.

"8. AMBROLEX was first registered on 17 November 2004 in Thailand. A certified copy of Thailand Certificate of Registration No. KOR219996 will form part of opposer's evidence.

"9. Opposer, through its subsidiaries/affiliates, invests heavily in promoting the trademark AMBROLEX in the Philippines and in Thailand, making the trademark well-known in both countries. x x x

"10. The products designated by AMBROLEX are sold in various drugstores such as Mercury Drug, South Star Drug, Rose Pharmacy and Manson Drug. They are likewise sold in Thailand. x x x

"11. In the Philippines, the mark AMBROLEX is the subject of valid and existing Certificates of Product Registrations (CPR) issued by the Food and Drug Administration (FDA) of the Philippines for mucolytic infant drop. x x x

The Opposer's evidence consists of the following:

1. Exhibit "A" - Affidavit of Mae Simonette Dizon-Corona;
2. Exhibit "A-1" - Downloaded copy of trademark registration details of AMBROLEX;
3. Exhibit "A-2" - Downloaded copy of trademark registration details of AMBROLEX OD;
4. Exhibit "A-3"-Photocopy of Certificate of Registration No. 478/2555 for AMBROLEX;
5. Exhibits "A-4"- AMBROLEX actual packaging from the Philippines (7.5mg/ml oral drops; 15 mg/5 ml pediatric syrup; 30 mg tablet; 30 mg/5 ml syrup, and AMBROLEX OD actual packaging from the Philippines (75 mg sustained release capsule);
6. Exhibit "A-5"- Sample advertisements and promotional materials distributed in the Philippines;
7. Exhibit "A-6" - Sample promotional materials from Thailand;
8. Exhibit "A-7" - Photocopy of Sales Invoice from Thailand, Philippines; and,
9. Exhibit "A-8" - Photocopy of AMBROLEX actual packaging from Thailand.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 28 June 2012. Respondent-Applicant however, did not file an answer. Thus, the Respondent-Applicant was declared in default and the case deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark AMBROMAX?

The instant opposition is anchored on Section 123.1 paragraph (d) of the IP Code which 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 mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 16 August 2011, the Opposer has already an existing trademark registration for the mark AMBROLEX bearing Registration No. 4-1998-002307 issued on 10 May 2002. This registration covers 'Mucolytic Infant Drop' under Class 5. Hence, the competing marks are used on similar or closely goods.

Nevertheless, it is unlikely that the coexistence of the marks will cause confusion, much less deception, among the public. The competing marks are reproduced as follows:

Ambrolex

Opposer's mark

Ambromax

Respondent-Applicant's mark

The only similarity between the marks is the prefix AMBRO. It appears that, and was in fact mentioned in the instant opposition,⁵ that the word AMBRO is derived from the generic name AMBROXOL HCL, which is a common ingredient in the Opposer and Respondent-Applicant's pharmaceutical products. A trademark that begins with the prefix AMBRO and is used as mucolytic drug/preparation is, therefore, a suggestive mark, which is a weak mark. The mark or brand name itself gives away or tells the consumers the goods or services, and/or the kind, nature, use of purpose thereof.

Succintly, what easily comes to the mind when one sees or hears a mark or brand name for mucolytic drugs of which the prefix AMBRO is a part of, is the very concept or idea of the goods. What will set apart or distinguish such mark from another mark which also includes the same prefix used for the same treatment, are letters and/or syllables that follows AMBRO. In this instant case, it is very unlikely that a consumer will be mislead or confused into believing that the Respondent-Applicant's goods came or originated from or connected to or associated with the Opposer's. The Respondent-Applicant's mark ends with the letters or syllables "MAX" which are different, visually and aurally, from "LEX" in the Opposer's mark.

⁵ Opposition, paragraph 1.4, pp. 3.

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 or 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.⁶

Moreover, taking into account that the only similarity between the competing marks is the prefix AMBRO, sustaining the instant opposition would have the unintended effect of giving the Opposer the exclusive right to use AMBRO, which evidently and sufficiently describes the pharmaceutical goods involved, i.e. analgesics.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-750065 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 22 November 2013.



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

⁶ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.