



JOHNSON & JOHNSON,  
Opposer,

-versus-

PLATINUM PHARMACEUTICALS (PVT) LTD.,  
Respondent-Applicant.

x-----x

}  
} IPC No. 14-2011-00008  
} Opposition to:  
} Appln. Serial No. 4-2010-500625  
} Date Filed: 06 May 2010  
} TM: "MOTILUX"  
}

### NOTICE OF DECISION

**ROMULO MABANTA BUENAVENTURA  
SAYOC & DE LOS ANGELES**

Counsel for Opposer  
21<sup>st</sup> Floor Philam Life Building  
Paseo de Roxas, Makati City

**A.Q. ANCHETA & ASSOCIATES**

Counsel for the Respondent-Applicant  
Suites 1008-1010 Paragon Plaza  
EDSA corner Reliance Street  
Mandaluyong City

### GREETINGS:

Please be informed that Decision No. 2014 - 04 dated January 10, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 10, 2014.

For the Director:

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



JOHNSON & JOHNSON,  
Opposer,

-versus-

PLATINUM PHARMACEUTICALS  
(PVT) LTD.,  
Respondent-Applicant.

x ----- x

IPC No. 14-2011-00008

Opposition to:

Appln. Serial No. 4-2010-500625

Date Filed : 06 May 2010

Trademark: "MOTILUX"

Decision No. 2014 - 04

### DECISION

JOHNSON & JOHNSON, (Opposer"<sup>1</sup>), filed an opposition to Trademark Application No. 4-2010-500625. The application, filed by PLATINUM PHARMACEUTICALS (PVT) LTD. (Respondent-Applicant"<sup>2</sup>), covers the mark "MOTILUX" for use on goods under class 5<sup>3</sup> for pharmaceutical preparations for the treatment of symptomatic treatment of the dyspeptic symptom complex which is often associated with delayed gastric emptying or gastro-oesophageal reflux and oesophagitis; epigastric sense of fullness, feeling of abdominal distention, upper abdominal pain, eructation, flatulence, heartburn, also used in the treatment of nausea and vomiting.<sup>4</sup>

The Opposer interposes the following grounds for opposition:

"1. The trademark MOTILUX being applied for by Respondent-Applicant is confusingly similar to Opposer's trademark MOTILIUM, as to be likely, when applied to or used in connection with the similar goods of Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public.

"2. The registration of the trademark MOTILUX in the name of the Respondent-Applicant will violate Section 123.1 subparagraphs (d) and (e) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines and Section 6bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and the U.S.A. are signatories.

"3. The registration and use by Respondent-Applicant of the trademark MOTILUX will diminish the distinctiveness and dilute the goodwill of Opposer's MOTILIUM trademark.

"4. The registration of the trademark MOTILUX in the name of Respondent-Applicant is contrary to other provisions of the Intellectual Property Code of the Philippines."

<sup>1</sup> A corporation organized and existing under and by virtue of the laws of the State of New Jersey, U.S.A., with business address at One Johnson & Johnson Plaza, New Brunswick, New Jersey, 08933-7001 USA.

<sup>2</sup> A corporation with business address at A-20, North Western Industrial Zone Bin Qasim, Karachi-75020.

<sup>3</sup> 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.

<sup>4</sup> The application was published in the Intellectual Property Office Official Gazette, officially released for circulation on 13 September 2010.

The facts are as follows:

“1. Opposer is the owner of and/or registrant/applicant of the MOTILIUM trademark in many trademark registries around the world for anti-emetic preparation in class 5.

By virtue of Opposer’s registration of the MOTILIUM trademark in the Philippines and its prior registration, ownership and use of this trademark around the world, said trademark has therefore become distinctive of Opposer’s goods and business.

“2. The application for registration of the trademark MOTILUX by the Respondent-Applicant for use on similar if not identical goods under international class 5 will deceive and/or confuse purchasers into believing that Respondent-Applicant’s goods bearing the trademark MOTILUX emanate from or are under the sponsorship of Opposer. Especially so because Opposer’s drug carrying the mark MOTILUX is sold over-the counter. Respondent-Applicant will be able to trade on Opposer’s goodwill.

“3. The allowance of Application Serial No. 4-2010-500625 in the name of Respondent-Applicant will be violative of the treaty obligations of the Philippines under the Paris Convention for the Protection of Industrial Property of which the Philippines and U.S.A. are member-states.”

The Opposer’s evidence consists of the following

1. Exhibit “1” - Affidavit with schedule of details of Motilium’s worldwide registrations and pending applications;
2. Exhibit “2” - Photocopies of Motilium trademark registrations issued by various international trademark offices;
3. Exhibit “3” - Certified true copy of Certificate of Renewal of Trademark Registration No. 0396954;
4. Exhibit “5” - Samples of print brochures and advertisements; and,
5. Exhibit “6” - Print-out of websites advertising and selling Motilium.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 02 March 2011. 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 MOTILUX?

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 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.<sup>5</sup>

Thus, Sec. 123.1 (d) of R.A. No. 8293, also 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

<sup>5</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No., 115508, 19 Nov. 1999.

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 the subject trademark application on 06 May 2010, the Opposer has already an existing Philippine trademark registration for the mark MOTILIUM on 27 June 2008, and was renewed until 27 June 2018 covering class 05 of the International Classification of Goods for anti-emetic preparation.<sup>6</sup>

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

**MOTILIUM**

**MOTILUX**

Opposer's Trademark

Respondents-Applicants' Trademark

This Bureau finds the competing marks confusingly similar. The features or parts of the competing marks that draw the eyes and ears are the identical syllables "MO" and "TI"; and the letters L and U, which are dominant in the marks. The difference between the competing marks are the letters I which produces no distinction when spoken; and the ending letter X which appears insignificant and insufficient to confer a character that the two marks are not confusingly similar.

Also, considering the goods carried by the contending marks, there is no doubt that the indicated goods in the Opposer's Registration Certificate for Motilium under Class 05, i.e. "anti-emetic preparation", a medication that relieves nausea and vomiting<sup>7</sup> is also among the goods covered by Respondent-Applicant's application for the subject mark Motilux.<sup>8</sup> As such, the consumers will have the impression that these products originate from a single source or origin or they are associated with one another. The likelihood of confusion therefore, would even subsist not only on the purchaser's perception of the goods but on the origin thereof as held by the Supreme Court.<sup>9</sup>

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. Hence, 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.

---

<sup>6</sup> Exhibit "3" of Opposer.

<sup>7</sup> The Free Dictionary, available at <http://medical-dictionary.thefreedictionary.com/Anti-emetic>. (last accessed 10 January 2014)

<sup>8</sup> Filewrapper records.

<sup>9</sup> Converse Rubber Corporation v. Universal Rubber Products, Inc., et. al. G.R. No. 27906, 08 January 1987.

It is stressed that the laws on Trademarks and Tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing other's business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another.<sup>10</sup>

The Respondent-Applicant in the instant opposition was given the opportunity to explain its side and to defend its trademark application. However, it failed to do so.

Accordingly, 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. 4-2010-500625 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 10 January 2014.

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

---

<sup>10</sup> See Baltimore Bedding Corp. V. Moses, 182 and 229, 34A (2d) 338.