



MERCK KgaA.,
Opposer,

-versus-

MEGA LIFESCIENCES LIMITED,
Respondent –Applicant.

}
} IPC No. 14-2011-00003
} Opposition to:
} Appln. Serial No. 4-2010-001058
} Date Filed: 29 January 2010
} TM: "FLEXSA"
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NOTICE OF DECISION

BUCOY POBLADOR & ASSOCIATES

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GREETINGS:

Please be informed that Decision No. 2014 - 93 dated March 31, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 31, 2014.

For the Director:


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



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MEGA LIFESCIENCES LIMITED,
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}Opposition to:
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}Date filed :29 January 2010
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}Trademark: FLEXSA
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}Decision No. 2014- 93

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DECISION

MERCK KgaA (Opposer)¹ filed on 3 January 2011 an opposition to Trademark Application Serial No. 4-2010-001058. The application, filed by MEGA LIFESCIENCES LIMITED (Respondent-Applicant)², covers the mark “FLEXSA”, for use on “dietary supplement containing glucosamine sulphate as active ingredients in tablet and capsule form for human consumption” under Class 05 of the International Classification of Goods³.

The Opposer relies on the following grounds in support of its Opposition:

“1. The mark ‘FLEXSA’ which Respondent-Applicant seeks to register so resembles –phonetically and visually Opposer’s registered trademark FLEXAGIL covered under Registration No. 4-2008- 004539 issued on 13 October 2008 which when applied to or used in connection with the goods covered by the application under opposition, will likely cause confusion, mistake and deception on the part of the purchasing public.

“2. Further, the trademark application for ‘FLEXSA’ seeks to cover goods that relate to a type of disorder similarly addressed by the goods covered by Opposer’s registered trademark ‘FLEXAGIL’.

“3. It can be concluded that the goods covered by Respondent-Applicant’s trademark application (‘dietary supplement containing glucosamine sulphate’) are competing with those of Opposer’s goods (‘pharmaceutical preparations for the treatment of musculo-skeletal disorder’). This is because the active ingredient in

¹ A German corporation, with business address at Frankfurter Strabe 250, 64271, Darmstadt, Germany

² A corporation domiciled in Thailand, with address at 384 SOI 6, Pattana 3 Road, Bangpoo Industrial Estate, Samutprakarn Province, 10280, Thailand (with local address at Mega Lifesciences Pty. Ltd, Unit 4B 4/F Eurovilla 2, 118 V.A. Rufino St., Legaspi Village, Makati City)

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

Respondent-Applicant's proposed dietary supplement, viz glucosamine sulphate is commonly used for the treatment of arthritis. The latter (arthritis) in turn is classified under the broad category of MSK or musculoskeletal disorders.

"4. Thus, not only are the two marks 'FLEXSA' and 'FLEXAGIL' confusingly similar, they likewise cover competing goods that addresses the same disorder.

"5. The registration of the mark 'FLEXSA' in the name of the Respondent-Applicant will be violative of the Section 123.1 (d) of Republic Act 8293.

"6. Thus, prescinding from the foregoing quoted provision, any mark that is identical with a registered mark belonging to a different person or legal entity should be denied registration in respect of similar or related goods; or, if the mark applied for registration nearly resembles such registered mark, that confusion or deception in the mind of the buying public will likely ensue.

"7. Respondent-Applicant's use and registration of the mark 'FLEXSA' will diminish the distinctiveness and dilute the goodwill of Opposer's registered trademark 'FLEXAGIL'".

According to the Opposer:

"1. Opposer is a German corporation with general partners engaged in the business of manufacturing and distributing pharmaceutical products and preparations classified under International Class 05 of the Nice Classification.

"2. Opposer is the registered owner on the Philippines of the trademark "FLEXAGIL" covered under Registration No. 4-2008-004539 issued on 13 October 2008, registered in International Classes 05, 29 and 30.

"3. Opposer's Philippine Trademark Registration No. 4-2008-004539 has not been abandoned and is currently in full force and effect. By virtue of said registration, Opposer has acquired ownership over the mark "FLEXAGIL" to the exclusion of others, conformably with the law.

"4. Opposer's aforementioned registered trademark "FLEXAGIL," and the mark "FLEXSA" that the Respondent-Applicant seeks to register, are practically identical in sound and appearance, "FLEXA-" being the dominant feature of both marks. Given the further fact that they cover practically the same goods, both marks leave the same commercial impression upon the purchasing public.

"5. The mark "FLEXSA" that Respondent-Applicant seeks to register is confusingly similar to Opposer's registered trademark "FLEXAGIL" and is likely to cause confusion of goods (product confusion) and/or, at the very least, confusion of business (source or origin).

The Opposer submitted as evidence the following:

1. Copy of Certificate of Registration No. 4-2008-004539 issued on 13 October 2008 for the mark "FLEXAGIL";
2. Notarized and authenticated Special Power of Attorney dated 6 December 2010;
3. Notarized and authenticated Secretary's Certificate dated 6 December 2010;
4. Notarized and authenticated Affidavit of Dr. Friederike Rotsch and Mr. Thomas Zens dated 6 December 2010;
5. Print-out of status of application for registration of the mark FLEXSA;
6. Downloaded page of Medline Plus Trusted Health Information for You about glucosamine sulfate at <http://www.nlm.nih.gov/medlineplus/druginfo/natural/807.html>;
7. Downloaded page of Canadian Institutes of Health Research about arthritis at <http://www.cihr-irsc.gc.ca/e/11196.html>.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 24 June 2011. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 13 January 2012 Order No. 2012-108 declaring the Respondent-Applicant in default.

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

Sec. 123.1. Registrability. A mark cannot be registered if it:

- (d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
 - (i) the same goods or services; or
 - (ii) closely related goods or services; or
 - (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that when the Respondent-Applicant filed its application on 29 January 2010, the Opposer already has an existing registration for the trademark FLEXAGIL⁵ issued on 18 April 2008 covering goods under Class 05 namely, "pharmaceutical preparations for the treatment of disorders of the muscle-skeletal system of the human body"; Class 30, namely "dietetic preparations or food supplements (not for medical use as far as Class 30); Class 29, namely "dietetic preparations or food supplements (not for medical use as far as Class 29). The Respondent-Applicant's trademark application therefore indicates goods that are similar and/or closely related to those covered by the Opposer's trademark registration. The Respondent-Applicant uses

⁴ Exhibits "A" to "E"

⁵ Annex "A"; Exhibit "B"

its mark on goods that are similar or closely related to the Opposer's, particularly, dietary supplements containing glucosamine sulphate which are used for the treatment of musculo-skeletal system disorders of the human body such as arthritis, which flow through the same channels of trade.

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



Opposer's mark



Respondent-Applicant's mark

The Respondent-Applicant's mark "FLEXSA", when pronounced, sounds the same as the first two syllables of the Opposer's mark. Even if the Respondent-Applicant's trademark includes the letter "S", it is still a phonetic equivalent of the Opposer's trademark. The only difference is the suffix "GIL" appended to the letters FLEXA in the Opposer's mark. The Respondent-Applicant has a stylized X, yet, the competing marks are depicted in block style of lettering. Visually and aurally, the competing marks are confusingly similar.

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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.⁶

The public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different

⁶ *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

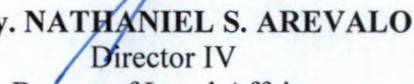
proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing 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.⁷

The Respondent-Applicant despite the opportunity given, did not file an Answer to defend its trademark application and to explain how it arrived at using the mark FLEXSA which is confusingly similar to that of the Opposer's FLEXAGIL. Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁸

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-001058 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 March 2014.


Atty. **NATHANIEL S. AREVALO**
Director IV
Bureau of Legal Affairs

⁷ *Pribhdas J. Mūpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents*, *supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

⁸ *American Wire & Cable Company v. Director of Patents*, G. R. No. L-26557, 18 February 1970.