



MERCK SHARP & DOHME CORP.,
Opposer,

-versus-

ATTY. AMBROSIO V. PADILLA III,
Respondent-Applicant.

x-----x

}
} IPC No. 14-2013-00109
} Opposition to:
} Appln. Serial No. 4-2012-011401
} Date filed: 17 September 2012
} TM: "FOMAX"
}
}
}

NOTICE OF DECISION

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ATTY. AMBROSIO V. PADILLA III
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Unit 1001, 88 Corporate Center
Sedeno corner Valero Streets
Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 186 dated October 08, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 08, 2013.

For the Director:

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



MERCK SHARP & DOHME CORP.,	}	IPC No. 14-2013-00109
Opposer,	}	Opposition to:
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- versus -	}	Appln. Serial No. 4-2012-011401
	}	Date Filed: 17 September 2012
ATTY. AMBROSIO V. PADILLA III,	}	
Respondent-Applicant.	}	Trademark: FOMAX
x-----x		Decision No. 2013 - <u>186</u>

DECISION

MERCK SHARP & DOHME CORP.¹ ("Opposer") filed on 14 May 2013 a Verified Notice of Opposition to Trademark Application No. 4-2012-011401. The application, filed by Atty. AMBROSIO V. PADILLA III² ("Respondent-Applicant"), covers the mark FOMAX for use on "*pharmaceutical product for the treatment of osteoporosis in men and prevention of osteoporosis in post-menopausal women*" under Class 5 of the International Classification of goods³.

The Opposer alleges the following:

"1. Opposer is the prior user and registered owner in the Philippines of the mark FOSAMAX for "pharmaceutical preparations for the treatment and prevention of bone diseases" in Class 05 under Registration No. 59526 issued by the IPO on November 7, 1994.

"2. Respondent-Applicant's FOMAX mark, on the other hand, is identical to or closely resembles Opposer's FOSAMAX mark as to be likely, when applied to or used in connection with the goods of the Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public by misleading them into thinking that Respondent's goods either come from Opposer or are sponsored or licensed by it.

"3. Respondent's adoption of the confusingly identical or similar trademark FOMAX for its goods in Class 05 is likely to indicate a connection between such goods and those of Opposer. Without a doubt, Respondent's use, adoption and registration of the FOMAX mark will mislead the public into believing that the goods bearing the said trademark originate from, or are licensed or sponsored by Opposer, which is the owner and originator of the FOSAMAX mark, and not to mention the source and manufacturer of quality goods/products bearing the mark FOSAMAX. Also, because of the similar visual and aural impressions, created by the marks, consumers are likely to make the mistake of buying Respondent's products even if they

1 A corporation duly organized under the laws of the State of New Jersey, United States, with principal office at One Merck Drive, Whitehouse Station, New Jersey, 08889, U.S.A.

2 Appears to be an individual, with office address at Unit 1001, 88 Corporate Center, Sedenon corner Valero Streets, Salcedo Village, Makati City, Philippines.

3 Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

meant to buy Opposer's products.

"4. The registration and use by Respondent-Applicant of the FOMAX mark in relation to the goods in Class 05 will diminish the distinctiveness and dilute the goodwill of Opposer's FOSAMAX mark.

"5. To reiterate, Opposer is the first user of the FOSAMAX mark in Philippine commerce and elsewhere, having first utilized the same since 1997 through long and uninterrupted use and widespread advertising, the FOSAMAX mark has come to be associated with Opposer throughout the world and in the Philippines, particularly in relation to pharmaceutical products, which are classified under Class 05.

"6. A side-by-side comparison of the marks clearly show that Respondent-Applicant's mark FOMAX and Opposer's FOSAMAX mark have the same dominant feature - that is, both marks contain the letters/syllables "FO" and "MAX". Respondent-Applicant's mark FOMAX differentiates itself from Opposer's FOSAMAX by merely omitting the second syllable "SA". Respondent-Applicant's FOMAX mark therefore creates a similar, if not identical, overall commercial impression to that of Opposer's FOSAMAX mark.

"7. Moreover, the goods in connection with which the FOMAX mark are sought to be registered are identical, similar to or closely related with the goods for which Opposer's FOSAMAX mark is used and registered. Indeed, Respondent-Applicant intends to use the FOMAX mark for "pharmaceutical product for the treatment of osteoporosis in men and prevention of osteoporosis in post-menopausal women", whereas the FOSAMAX mark is for "pharmaceutical preparations for the treatment and prevention of bone diseases". As such, the registration and use of a confusingly similar mark by the Respondent-Applicant will likely deceive and/or confuse purchasers into believing that the Respondent-Applicant's products emanate from or are manufactured or distributed under the sponsorship of Opposer.

"8. Given the prior use and registration of Opposer's FOSAMAX mark in the Philippines, there is no clear reason for Respondent-Applicant to have adopted the FOMAX mark for its goods, other than to trade on the goodwill and strong recognition of the FOSAMAX mark, thereby misleading the public into believing that its identical or similar goods bearing the FOMAX mark originate from, or are licensed or sponsored by the Opposer, which has been identified in the trade and by consumers as the exclusive source of Class 05 goods bearing the FOSAMAX mark. It is clear that Respondent-Applicant's adoption of the FOMAX mark for its own preparations will result in capitalization on the popularity and brand recall of the Opposer's FOSAMAX mark. In this sense, the registration and use of FOMAX will give undue trade advantage to the Respondent-Applicant at the expense and to the prejudice of the Opposer.

"9. Moreover, the approval of Respondent-Applicant's FOMAX mark will likely be based on the representation that it is the originator, true

owner and first user of the trademark, which was in fact merely a copy or close derivative from Opposer's prior registered trademark FOSAMAX. Opposer and its predecessors-in-interest, are the first users of FOSAMAX in Philippine commerce and elsewhere, having utilized the same in the Philippines and around the world for almost two decades now. Respondent-Applicant's use of a confusingly similar mark as the brand name for its goods is likely to cause consumer confusion as to the origin of said goods.

"10. Respondent-Applicant's use of the confusingly similar or identical FOMAX mark is contrary to the provisions of Section 123(d) of the IP Code, which states 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: (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."

To support its opposition, the Opposer submitted as evidence the original verified, notarized and legalized notice of opposition⁴, original notarized and legalized evidentiary affidavit of Opposer's witness⁵ with supporting evidence⁶, and original notarized and legalized power of attorney in favor of Opposer's authorized signatory⁷.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 04 June 2013. The Respondent-Applicant, however, did not file his Answer. Hence, this Bureau issued Order No. 2013-1252 dated 12 September 2013 declaring the Respondent-Applicant in default and requiring the latter to submit within ten (10) days from receipt of the Order the originals or certified true copies of the affidavits and documentary evidence, if necessary.

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

The essence of trademark registration is to give protection to the owners of 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 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.⁸ Thus, Section 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 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 a mark as to be likely to deceive or cause confusion.

4 Marked Annex "A".

5 Marked Annex "B".

6 Marked as Exhibits "A" to "C".

7 Marked as Annex "C".

8 See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, November 19, 1999.

In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 17 September 2012, the Opposer has an existing registration for the trademark FOSAMAX under Registration No. 59526 issued on 07 November 1994. The Respondent-Applicant's trademark application indicates that the mark is for use on goods "*pharmaceutical product for the treatment of osteoporosis in men and prevention of osteoporosis in post-menopausal women*" under Class 5 which is similar or closely related to the goods covered by the Opposer's registration, namely, "*pharmaceutical preparations for the treatment and prevention of bone diseases*" also under Class 5.

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

The marks are depicted below:

FOSAMAX

Opposer's Mark

Fomax

Respondent-Applicant's Mark

The only difference between the contending marks is the presence of the middle syllable /SA/ in the Opposer's mark. This slight difference in the spellings is inconsequential to the effect on the eyes and ears, and memory. In this regard, what gives the Opposer's mark a distinctive character that appeals to the eyes and ears are the first and last syllables /FO/ and /MAX/ which is the mark sought to be registered by the Respondent-Applicant. Also, both marks are word marks in plain letterings without any unique device or design thus, compounding the possibility of confusion.

Confusion cannot be avoided by merely dropping, adding or changing some of the 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.⁹ 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 overall 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.¹⁰

Succinctly, because the Respondent-Applicant will use or uses the mark practically for the treatment and prevention of osteoporosis, this may be included in the goods or products that are covered by the Opposer's registered trademark. The changes

⁹ *Societe Des Produits Nestle, S. A. v. Court of Appeals*, G. R. No. 112012, April 4, 2001.

¹⁰ *Emerald Garment Manufacturing Corp. v. Court of Appeals*, G. R. No. 100098, December 29, 1995.

in the spelling therefore did not diminish the likelihood of the occurrence of mistake, confusion or even deception.

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.¹¹ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held held by the Supreme Court.¹²

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 instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-011401, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 08 October 2013.


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

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¹¹ *American Wire and Cable Co. v. Director of Patents, et. al.*, G. R. No. L-26557, February 18, 1970.

¹² *Converse Rubber Corporation v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, January 8, 1987.