



MYRA PHARMACEUTICALS, INC.,
Opposer,

-versus-

CENTER FOR TRADITIONAL AND
ALTERNATIVE MEDICINE,
Respondent-Applicant.

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} IPC No. 14-2011-00456
} Opposition to:
} Appln. Serial No. 4-2011-006665
} Date filed: 08 June 2011
} TM: "XAN MAX"
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}
}
}
}

NOTICE OF DECISION

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Mandaluyong City

**CENTER FOR TRADITIONAL AND
ALTERNATIVE MEDICINE**
Respondent-Applicant
2nd Floor, JY Square Lahug
Cebu City

GREETINGS:

Please be informed that Decision No. 2013 - 02 dated January 02, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 02, 2013.

For the Director:


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



MYRA PHARMACEUTICALS, INC.,
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- versus -

CENTER FOR TRADITIONAL AND
ALTERNATIVE MEDICINE,
Respondent-Applicant.

IPC No. 14-2011-00456

Opposition to:

Appln. Serial No. 4-2011-006665

Date Filed: 08 June 2011

Trademark: XAN MAX

Decision No. 2013 - 02

DECISION

MYRA PHARMACEUTICALS, INC., ("Opposer")¹ filed on 12 October 2011 a Verified Opposition to Trademark Application Serial No. 4-2011-006665. The application, filed by CENTER FOR TRADITIONAL AND ALTERNATIVE MEDICINE ("Respondent-Applicant")², covers the mark 'XAN MAX' for use on "*food supplement*" under Class 5 of the International Classification of goods and services.³

The Opposer alleges, among other things, the following:

"1. The trademark XAN MAX so resembles MAX trademark owned by Opposer, which was applied for registration with this Honorable Office prior to the application of the mark MAX. The trademark MAX, which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark XAN MAX is applied for the same class of goods as that of trademark MAX, i.e. Class 5;

"2. The registration of the trademark XAN MAX in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines x x x;

"3. Respondent's use and registration of the trademark XAN MAX will diminish the distinctiveness of Opposer's trademark MAX."

The Opposer's evidence consists of page three (3) of the IPO E-Gazette officially released on 12 September 2011, copy of the Certificate of Registration No. 4-2007-007139, copy of the Declaration of Actual Use, sample of product label bearing the trademark

- 1 A corporation duly organized and existing under the laws of the Philippines with principal office located at 4th Floor Bonaventure Plaza, Ortigas Avenue, San Juan City.
- 2 A domestic corporation with principal office address at 2nd Floor, JY Square Lahug, Cebu City.
- 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.

MAX actually used in commerce, and copy of the Certificate of Product Registration issued by the BFAD for the mark MAX⁴.

This Bureau issued a Notice to Answer and served upon the Respondent-Applicant on 09 November 2011. The Respondent-Applicant, however, did not file its Answer. Hence, the instant case is considered submitted for decision based on the opposition and evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the trademark XAN MAX?

The Opposer anchors its opposition on Sec. 123.1 (d) of R. A. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), which provides that 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 at the time the Respondent-Applicant filed its trademark application on 08 June 2011, the Opposer already has an existing registration for the trademark MAX issued on 18 February 2008, covering goods falling under Class 05, namely, "*multivitamins/food supplement pharmaceutical preparation*". The good indicated in the Respondent-Applicant's trademark application is, therefore, similar and/or closely related to those covered by the Opposer's trademark registration.

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

Max

Opposer's mark

Xan Max

Respondent-Applicant's mark

This Bureau noticed that the Opposer's mark MAX is one of the components of the Respondent-Applicant's XAN MAX mark, which is exactly the same in spelling, pronunciation as well as in composition. The rule is that the use of only one of the words comprising a trademark may be sufficient to constitute an infringement, and it is not necessary to this end that all the words of the composite mark be appropriated.⁵

⁴ Marked as Annexes "A" to "E".

⁵ E. Spinner & Co. v. Neuss Hesslein 54 Phil 224.

The only difference between the competing marks is the presence of the word "XAN" added in the Respondent-Applicant's mark, which is inconsequential because the marks still obviously look and sound alike. In this regard, confusion cannot be avoided by merely dropping, adding or changing one 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.⁶ The conclusion (of similarity) created by the use of the same word as the primary element in a trademark is not counteracted by the addition of another term.⁷

In this regard, the addition of the word "Xan" in the Respondent-Applicant's mark failed to give the same a character that is sufficiently distinct from that of the Opposer's. Consumers may even assume that one mark is just a variation of the other and there is a connection or association between the two marks and/or between the contending parties themselves, when in fact there is none.

The competing marks as belonging to two (2) different proprietors should not be allowed to co-exist. 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

It is inconceivable for the Respondent-Applicant to have come up with the mark or included in its mark the word "MAX" without having been inspired by or motivated by an intention to imitate the Opposer's mark. It is highly improbable for another person to come up with an identical or nearly identical mark, for use on the same or closely related goods purely by coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters that are available, the Respondent-Applicant had 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.⁹ It is stressed that the Respondent-Applicant was given opportunity to explain its side and defend its trademark application. However, it failed or chose not to do so.

Accordingly, the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

6 *Societe Des Produits NESTE, S.A. v. Court of Appeals*, G.R. No. 11202, 04 April 2001, 356 SCRA 207, 2017.

7 *Continental Connector Corp. v. Continental Specialties Corp.* 207 USPQ 60.

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

9 See *American Wire and Cable Co. v. Director of Patents et.al* SCRA 54H G.R. No. L-26557 18 February 1970.

WHEREFORE, premises considered, the opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-006665, together with a copy of this Decision, be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 02 January 2013.



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

