



MYRA PHARMACEUTICALS, INC.,
Opposer,

-versus-

PT. INDOCARE CITRAPASIFIC,
Respondent-Applicant.

X-----X

} IPC No. 14-2011-00445
} Opposition to:
} Appln. Serial No. 4-2010-007572
} Date Filed: 12 July 2010
} TM: "MAX-C 500"
}
}
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 55 dated April 03, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 03, 2013.

For the Director:


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



MYRA PHARMACEUTICALS, INC.,
Opposer,

IPC No. 14-2011-00445
Case Filed: 30 September 2011

-versus-

Opposition to:
Appln. Serial No. : 4-2010-007572
Date Filed: 12 July 2010

PT. INDOCARE CITRAPASIFIC,
Respondent-Applicant.

TM: "MAX-C 500"

x-----x

Decision No. 2013- 55

DECISION

MYRA PHARMACEUTICALS, INC. ("Opposer")¹ filed on 30 September 2011 an Opposition to Trademark Application Serial No. 4-2010-007572. The application, filed by PT. INDOCARE CITRAPASIFIC ("Respondent-Applicant")², covers the mark MAX-C 500 for use on "vitamins, mineral food and water supplement, nutritional additives, esters, royal jelly, dietetic food and dietetic beverages adapted for medicinal purposes, cod liver oil, medicinal drinks, traditional medicines, tonic/medicinal herbs, medicinal teas, herbs teas, food for babies, absorbent cotton, adhesive band, adhesive plaster, hygienic bandages, menstruation bandages, bandages for dressing, plasters, air freshening preparation, balms, cachets, pills, tablets; all for medicinal/pharmaceutical purposes" under Class 5 of the International Classification of Goods and Services.³

The Opposer alleges, among other things the following:

1. The mark applied for registration by the Respondent-Applicant so resembles the trademark "MAX" owned and registered in favor of by the Opposer prior to the publication of the subject trademark application;
2. The registration and use of the mark "MAX-C" will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that "MAX-C" is applied for the same class and goods as that of

¹ A domestic corporation duly organized and existing under the laws of the Philippines, with principal business address at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

² With principal business address at Komplek Perkantoran Taman Meruya, Blok N 21-26, Meruya Utara, Kembangan, Jakarta 11620, Indonesia.

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.

Opposer's trademark "MAX", i.e. Class 05 of the International Classification of Goods as Vitamins and Food Supplement; and

3. The registration of the mark "MAX-C" in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides, in part, 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;

(Emphasis supplied)

The Opposer's evidence consists of the following:

1. Exhibit "A" to "A-1" – Copies of the pertinent pages of the IPO E-Gazette;
2. Exhibit "B" – Certified true copy of the Certificate of Reg. No. 4-2007-007139 for the trademark MAX;
3. Exhibit "C" – Certified true copy of Declaration of Actual Use;
4. Exhibit "D" – Sample product label bearing the trademark MAX;
5. Exhibit "E" – Copy of the Certification and sales performance; and
6. Exhibit "F" – Certificate of Product Registration issued by the BFAD.

On 25 January 2012, the Respondent-Applicant filed its Verified Answer admitting some of the allegations and denied all the material allegations of the opposition and argued that the mark MAX-C 500 of the Respondent-Applicant is not confusingly similar with the mark of the Opposer MAX. The Respondent-Applicant's evidence consists of the following:

1. Exhibit "1" – Printout of the registration details of "MAX-C 500" with the *Direktorat Jenderal Hak Kekayaan Intelektual* of the Republic of Indonesia downloaded from its official website at <http://penelusuranmerek.dgip.go.id/en/detail.php?aplnumber='R00-2005003707>;
2. Exhibit "2" – A photograph of MAX-C 500 product label;
3. Exhibit "3" – Certified copy of purchase order of MAX-C 500 food supplements dated 13 January 2011;
4. Exhibit "3-A" – Certified copy of purchase order of MAX-C 500 food supplements dated 03 March 2011;

5. Exhibit "3-B" – Certified copy of purchase order of MAX-C 500 food supplements dated 26 April 2011;
6. Exhibit "3-C" – Certified copy of purchase order of MAX-C 500 food supplements dated 27 May 2011;
7. Exhibit "3-D" – Certified copy of purchase order of MAX-C 500 food supplements dated 29 June 2011;
8. Exhibit "3-E" – Certified copy of purchase order of MAX-C 500 food supplements dated 17 November 2011;
9. Exhibit "3-F" – Certified copy of purchase order of MAX-C 500 food supplements dated 28 November 2011;
10. Exhibit "3-G" – Certified copy of purchase order of MAX-C 500 food supplements dated 29 November 2011;
11. Exhibit "3-H" – Certified copy of purchase order of MAX-C 500 food supplements dated 29 November 2011;
12. Exhibit "4" – Acknowledgement receipt of PT. Indocare's trademark application with the Intellectual Property Office (IPO);
13. Exhibit "5" – Printout of trademark application of Indocare as published in the IPO E-Gazette;
14. Exhibit "6" – Printout of the trademark application details of "MAX-C 500" as downloaded from the IPO Online Trademark Search;
15. Exhibit "7" – Printout of the registration details of "MAX" as downloaded from the IPO Online Trademark Search;
16. Exhibit "8" – Printout of the registration details of "OB MAX" as downloaded from the IPO Online Trademark Search;
17. Exhibit "9" – Printout of the registration details of "MAX-C" as downloaded from the IPO Online Trademark Search;
18. Exhibit "10" – Printout of the registration details of "SPECTRUM MAX" as downloaded from the IPO Online Trademark Search;
19. Exhibit "11" – Printout of the registration details of "POLICOSANOL MAX" as downloaded from the IPO Online Trademark Search;
20. Exhibit "12" – Certified copy of the *Registrability Report* dated 21 September 2007, where the Bureau of Trademarks initially rejected Myra's trademark application for "MAX" for being confusingly similar to "MAX-C";
21. Exhibit "13" – Certified copy of Opposer's Response to the *Registrability Report* dated 10 October 2007;
22. Exhibit "14" – Printout of the registration details of "REVICON" as downloaded from the IPO Online Trademark Search;
23. Exhibit "15" – A sample product label of REVICON Forte tablets; and
24. Exhibit "16" – Notarized and legalized Affidavit of Drs. Ridwan Salim, MBA, President Director of PT. Indocare Citrapasific.

This case was referred to mediation pursuant to Office Order No. 154, s. 2010 (IPOPPL Rules on Mediation). On 04 June 2012, the Alternative Dispute Resolution

Services submitted a Mediator's Report stating, among other things, that the parties failed to settle their dispute.

Accordingly, the preliminary conference was conducted and terminated on 28 August 2012. Then after, on 06 September 2012, the Respondent-Applicant filed its position paper while the Opposer did so the next day (07 September 2012).

Should the Respondent-Applicant's trademark application be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owner 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 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 products.⁴

In this regard, Section 123.1 (d) of the 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 is 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 12 July 2010, the Opposer already has existing trademark registration for the mark MAX bearing Reg. No. 4-2007-007139 issued on 18 February 2008 for goods multivitamin, food supplement, pharmaceutical preparation under Class 5 of the International Classification of Goods. The goods covered by the said registration are similar and/or closely related to the goods or services indicated by the Respondent-Applicant in its trademark application particularly Class 5.

Also, a comparison of the contending marks shows that these marks are practically identical, as depicted below:

Max

Opposer's Mark

**MAX-C
500**

Respondent-Applicant's Mark

The feature or part, which is common to the competing marks and which immediately draws the eyes and ears is the word MAX. It is the dominant feature of the

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999

Opposer's mark. The only difference between the two (2) is the addition of the letter "C" and the numerical no. 500 in the Respondent-Applicant's mark. The additional features will not diminish the likelihood of the occurrence of mistake, confusion or even deception. When the marks are pronounced, the sound that will be uttered is the word MAX, hence, the other matter's is insignificant. The conclusion created by the use of the same word as the primary element in a trademark is not counteracted by the addition of another term.⁵ Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenious 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

Thus, because the Respondent-Applicant will use its mark on goods and services that are similar and/or closely related to those covered by the Opposer's registered trademark, the likelihood of the occurrence of mistake, confusion or even deceit cannot be avoided. Consumers will likely assume that the Respondent-Applicant's mark is just a variation of the Opposer's and/or the goods and services originate or provided by one party alone, or the parties are connected or associated with one another. The letter "C" and the number "500" only creates an impression that MAX-C 500 product is just a variation of the Opposer's.

Succinctly, the confusion or mistake would subsist not only on 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 ordinarily prudent purchaser would be induced to purchase one product in the belief that 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.

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 and designs available, the Respondent-Applicant had to

⁵ Ref: Continental Connector Corp., v. Continental Specialties Corp., 207 USPQ 60.

⁶ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207.

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.⁷

It is stressed that the Law 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 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.

WHEREFORE, premises considered, the opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-007572 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate actions.

SO ORDERED.

Taguig City, 03 April 2013.



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



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⁷ American Wire and Cable Company v. Director of Patents, G.R. No. L-26557, 18 February 1970.