



PEDIATRICA INC.,
Opposer,

-versus-

PHARMA-REX INCORPORATED,
Respondent-Applicant.

X-----X

}
} IPC No. 14-2012-00240
} Opposition to:
} Appln. Serial No. 4-2011-012037
} Date filed: 06 October 2011
} TM: "NAPOREX"
}

NOTICE OF DECISION

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66 United Street
Mandaluyong City

PHARMA-REX INC.,
Respondent-Applicant
137 Yakal Street
San Antonio Village
Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 04 dated January 09, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 09, 2013.

For the Director:


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



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|--------------------------|---|---------------------------------|
| PEDIATRICA, INC., | } | IPC No. 14-2012-00240 |
| Opposer, | } | Opposition to: |
| | } | |
| - versus - | } | Appln. Serial No. 4-2011-012037 |
| | } | Date Filed: 06 October 2011 |
| PHARMA-REX INCORPORATED, | } | |
| Respondent-Applicant. | } | Trademark: NAPOREX |
| x-----x | x | Decision No. 2013 - <u>04</u> |

DECISION

PEDIATRICA, INC. ("Opposer")¹ filed on 15 May 2012 a Verified Opposition to Trademark Application Serial No. 4-2011-012037. The application, filed by PHARMA-REX INCORPORATED, ("Respondent-Applicant")² covers the mark **NAPOREX** for use on *"musculoskeletal and joint disorders namely, ankylosing spondylitis, osteoarthritis, and rheumatoid arthritis namely, juvenile idiopathic arthritis; dysmenorrheal, headache including migraine, postoperative pain, soft tissue disorders, acute gout and to reduce fever"* under Class 05 of the International Classification of Goods³.

The Opposer alleges, among other things, the following:

"1. The trademark **NAPOREX** so resembles **NAPREX** trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark **NAPOREX**. The trademark **NAPOREX**, which is owned by Respondent-Applicant, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark **NAPOREX** is applied for the same class of goods as that of trademark **NAPREX**, i.e. Class 5;

"2. The registration of the trademark **NAPOREX** in the name of the Respondent-Applicant will violate Section 123 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, which provides, in part, that a mark cannot be registered if it:

x x x

Under the above-quoted provision, any mark which is similar to a registered mark shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result;

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at 3rd Floor, Bonaventure Plaza, Greenhills, San Juan City.

² A domestic corporation with principal address at 137 Yakal St., San Antonio Village, Makati City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

"3. Respondent-Applicant's use and registration of the trademark NAPOREX will diminish the distinctiveness and dilute the goodwill of Opposer's trademark NAPREX."

The Opposer's evidence consists of the copy of the IPO E-Gazette released on 16 April 2012 where the opposed mark was published, copies of Certificates of Registration for the trademark NAPREX, copies of the Affidavits of Use filed by Opposer, sample of product label bearing the trademark NAPREX actually used in commerce, and copy of the Certificate of Product Registration issued by the BFAD for the mark NAPREX⁴.

This Bureau issued a Notice to Answer and served upon the Respondent-Applicant on 11 June 2012. The Respondent-Applicant, however, did not file its Answer.

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 the 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.⁵ 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 and services, or 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 06 October 2011, the Opposer already has an existing Trademark Registration (No. 27231) issued on 15 March 1979 for the mark NAPREX used for "*acetaminophen preparation*", a class of drugs called analgesics (pain relievers) and antipyretics (fever reducers)⁶. The Opposer's registration, therefore, covers goods that is similar or closely related to those cited in the Respondent-Applicant's application, particularly, for *dysmenorrheal, headache including migraine, postoperative pain, soft tissue disorders, acute gout and to reduce fever*".

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

⁴Marked as Annexes "A" to "I".

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

⁶Source: See www.medicinenet.com/acetaminophen

Naprex

Opposer's Mark

Naporex

Respondent-Applicant's Mark

This Bureau noticed that the competing marks are confusingly similar to each other. The only difference between the two is the presence of the letter "O" in the Respondent-Applicant's mark, which distinction did little in conferring upon the Respondent-Applicant's mark a character that would make it clearly distinct from the Opposer's. In this regard, it is stressed that 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 ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchasers as to cause him to purchase the one supposing it to be the other.

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.⁷ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁸

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.

It is inconceivable for the Respondent-Applicant to have come up with the mark NAPOREX without having been inspired by or motivated by an intention to imitate the

⁷ See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

⁸ See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

mark NAPREX. It is highly improvable for another person to come up with an identical or nearly identical mark for use on the same or 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 available, the Respondent-Applicant had come up with a mark identical or so nearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁹

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 opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-012037 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 January 2013.


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



⁹ See *American Wire and Cable Co. v. Director of Patents et.al.* (31 SCRA 544) G.R. No. L-26557, 18 February 1970.