



UNITED LIFE SCIENCES PTY. LTD.,
Opposer,

-versus-

GLAXOSMITHKLINE TRADING
SERVICES LIMITED,
Respondent- Applicant.

}
} IPC No. 14-2013-00027
} Opposition to:
} Appln. Serial No. 4-2012-502060
} Date Filed: 09 August 2012
} TM: "SYNEDEX"
}
}
}
}
}
}
}
}
}
}
}

X-----X

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for the Opposer
No. 66 United Street
Mandaluyong City

ORTEGA BACORRO ODULIO CALMA & CARBONELL
Counsel for Respondent-Applicant
5th & 6th Floors ALPAP I Building
140 L.P. Leviste Street, Salcedo Village
Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 180 dated September 16, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 16, 2013.

For the Director:


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



UNITED LIFE SCIENCES PTY. LTD.,	}	IPC No. 14-2013-00027
Opposer,	}	Opposition to:
	}	
- versus -	}	Appln. Serial No. 4-2012-502060
	}	Date Filed: 09 August 2012
GLAXOSMITHKLINE TRADING	}	
SERVICES LIMITED,	}	Trademark: SYNEDEX
Respondent-Applicant.	}	
x-----x		Decision No. 2013 - <u>160</u>

DECISION

UNITED LIFE SCIENCES PTY. LTD.¹ ("Opposer") filed on 07 February 2013 a Verified Notice of Opposition to Trademark Application No. 4-2012-502060. The application, filed by GLAXOSMITHKLINE TRADING SERVICES LIMITED² ("Respondent-Applicant"), covers the mark SYNEDEX for use on "*pharmaceutical preparations and substances*" under Class 5 of the International Classification of goods³.

The Opposer alleges the following:

"7. The mark SYNEDEX applied for by Respondent-Applicant so resembles the trademark SYNEX owned by Opposer and duly registered with this Honorable Bureau prior to the publication of the application for the mark SYNEDEX.

"8. The mark SYNEDEX will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark SYNEDEX is applied for the same class and goods as that of Opposer's trademark SYNEX, *i.e.* Class 05 of the International Classification of Goods for pharmaceutical preparations and substances.

"9. The registration of the mark SYNEDEX 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

1 A corporation duly organized and existing under the laws of Singapore, with office address at No. 1, Sophia Road, #08-01/04, Peace Center, Singapore.

2 Appears to be a foreign corporation, with office address at 6900 Cork Airport Business Park, Kinsale, Cork, Ireland.

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.

(iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion; (Emphasis supplied)

"10. 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."

To support its opposition, the Opposer submitted as evidence a copy of the pertinent page of the IPO E-Gazette⁴ and a certified true copy of the Certificate of Registration No. 4-2011-007913 for the trademark SYNEX⁵.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 28 February 2013. Upon proper motion and payment of the applicable fees, the Respondent-Applicant was granted by this Bureau an extension of thirty (30) days or until 29 April 2013 within which to file its Verified Answer. The Respondent-Applicant, however, did not file the Answer.

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

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.⁶ 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.

In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 09 August 2012, the Opposer has an existing registration for the trademark SYNEX under Registration No. 4-2011-007913 issued on 24 November 2011. The Respondent-Applicant's trademark application indicates that the mark is for use on goods "*pharmaceutical preparations and substances*" under Class 5 which is similar or closely related to the goods covered by the Opposer's registration, namely, "*pharmaceutical preparations and dietary supplements*" also under Class 5.

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

4 Exhibit "A".

5 Exhibit "B".

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

The marks are depicted below:

SYNEX

Opposer's Mark

SYNEDEX

Respondent-Applicant's Mark

Obviously, the Respondent-Applicant's SYNEDEX includes the five (5) letters S, Y, N, E and X comprising the Opposer's mark. The slight difference in the spellings by the addition of the middle letters "E" and "D" in the Respondent-Applicant's is inconsequential to the effect on the eyes and ears, and memory. This, in addition to the fact, that both marks are word marks in plain letterings without any unique device or design.

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.⁷ 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.⁸

Succinctly, because the Respondent-Applicant will use or uses the mark on "*pharmaceutical preparations and substances*", this could include goods or products that are covered by the Opposer's registered trademark. The changes 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.⁹ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as

⁷ *Societe Des Produits Nestle, S. A. v. Court of Appeals*, G. R. No. 112012, April 4, 2001.

⁸ *Emerald Garment Manufacturing Corp. v. Court of Appeals*, G. R. No. 100098, December 29, 1995.

⁹ *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

held held by the Supreme Court:¹⁰

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. 4-2012-502060, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 September 2013.



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

/maane.ipc14-2013-00027

¹⁰ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.