



BIOFEMME, INC.,
Opposer,

-versus-

SKPD JEN INCORPORATED,
Respondent-Applicant.

}
} IPC No. 14-2011-00060
} Opposition to:
} Appln No. 4-2010-010111
} Date filed: 16 September 2010
} TM: "TRYMERIN"
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 297 dated November 11, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 11, 2014.

For the Director:


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



BIOFEMME, INC., } **IPC NO. 14-2011-00060**
Opposer, } Opposition to:
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-versus- } Appln. Ser. No. 4-2010-010111
 } Date Filed: 16 September 2010
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SKPD JEN INCORPORATED, } Trademark: "TRYMERIN"
Respondent-Applicant. }
x-----x } Decision No. 2014- 297

DECISION

BIOFEMME, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2010-010111. The application, filed by SKPD JEN INCORPORATED (Respondent-Applicant)², covers the mark "TRYMERIN", for use on "quinolones, sulfonamide, cotrimazole preparations" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"1. The trademark 'TRYMERIN' so resembles 'TRIMYCIN' trademark owned by Opposer, registered with the Honorable Office prior to the publication for opposition of the mark 'TRYMERIN'. The trademark 'TRYMERIN', 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 'TRYMERIN', is applied for the same class of goods as that of trademark 'TRIMYCIN', i.e. Class (5).

"2. The registration of the trademark 'TRYMERIN' 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, 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 domestic corporation duly organized and existing under Philippine laws with principal address at 2nd Floor, Bonaventure Plaza, Greenhills, San Juan City, Philippines

² A domestic corporation with address at 1165 C & D, Brgy. Sta. Cruz, Quezon Avenue, Quezon City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

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

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.

“3. Respondent’s use and registration of the trademark ‘TRYMERIN’ will diminish the distinctiveness and dilute the goodwill of Opposer’s trademark ‘TRIMYCIN’.

The Opposer also alleges, among others, the following facts:

“4. Opposer the registered owner of the trademark ‘TRIMYCIN’, is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark ‘TRIMYCIN’ was originally filed with the Philippine Patent Office by Opposer’s sister company, United American Pharmaceuticals, Inc. (‘UAP’) on 3 October 1979 and was approved for registration on 17 December 1985, valid for a period of twenty (20) years. xxx

“5. The trademark ‘TRYMICIN’ has been extensively used in commerce in the Philippines.

“5.1 Opposer dutifully filed Affidavits of Use pursuant to the requirement of law, to maintain the registration of ‘TRIMYCIN’ in force and effect.

“5.2 A sample of product label bearing the trademark ‘TRIMYCIN’ actually used in commerce is hereto attached.

“5.3 In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, we registered the products with the Food and Drugs Administration (formerly BFAD).

“6. There is no doubt that by virtue of the prior filing and registration of the mark ‘TRIMYCIN’, the Opposer has acquired an exclusive ownership over the ‘TRIMYCIN’ mark to the exclusion of all others.

“7. ‘TRYMERIN’ is confusingly similar to ‘TRIMYCIN’.xxx”

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of IPO e-Gazette showing the Respondent-Applicant’s trademark application;
2. Copy of Certificate of Registration No. 34979 dated 17 December 1985 for the mark “TRIMYCIN”;

3. Copy of Assignment Of Registered Trademark dated 6 June 2005;
4. Copies of Affidavits of Use in 1990, 1996 and 2005;
5. Sample product label of "TRIMYCIN"; and
6. Copy of Certificate of Product Registration issued by the Food and Drugs Authority dated 30 March 2010.⁴

The Respondent-Applicant filed its Answer on 6 July 2011, alleging among other things, the following affirmative and special defenses:

"1. The Applicant's 'Trymerin' is not confusingly similar to the Opposer's mark 'Trimycin'.

"2. A simple perusal of the Applicant's mark and the Opposer's mark would readily show that they are very different from each other and will definitely not cause confusion in the minds of the purchasing public.

"3. A plain examination of 'Trymerin' and 'Trimycin' is sufficient to reveal that they are easily distinguishable from each other visually and phonetically. Hence, confusion is not even remotely likely to occur.

xxx

"7. A perusal of the label and packaging of the two (2) products would show that there is no similarity in the way the marks 'Trymerin' and 'Trimycin' were used or even in the general appearance thereof. For one, the colors used in the packaging are entirely distinct. It may be well to underscore that in all 'Trimycin' products, the dominant color of the packages is orange with a spatter of red, green and brown colors. In all 'Trymerin' products, however, the colors white and green or yellow are dominantly used.

"8. Other distinguishing marks, the background, the arrangement and the pictorial contents are likewise totally different. The fonts used and the size of the marks are likewise completely different. Even a simple glance of the marks and their packaging would show that there is nothing in the said marks that could in any way be considered as confusingly similar.

"9. It is also important to note also, that at the front portion of the labels or packages of both marks, the origin or the manufacturer appears thereon. Thus, Opposer's fear that there may be confusion in origin is clearly unfounded.

xxx

"11. It is an established principle in Philippine trademark jurisprudence, that in pharmaceutical products, consumers are more wary of the nature of product they are buying. Accordingly, the Opposer's claim that the mark is being registered for goods under Nice Classification 05, same as

⁴ Annexes "A" to "I"

Opposer's 'Trimycin', and thus, would cause confusion, must necessarily fail.

"12. Prescinding therefrom, it is of utmost importance to emphasize that confusion is almost impossible in the instant case considering that the nature of the products as well as their application are completely different. The Opposer's product 'Trimycin' is an ointment, its application is external and cannot be taken orally. The label of 'Trimycin' is explicit in declaring that it is used as an ointment and is used for 'cuts, burns, wounds and abrasions'.

"13. On the other hand, 'Trymerin' is a Cotrimazole antibacterial, that comes either in suspension bottles or in capsules. All 'Trymerin' products should be taken orally and cannot be used externally. Its label indicates that it is for treatment of infection of respiratory, gastro-intestinal and genitourinary tracts, skin and soft tissues and other infections susceptible to its components. xxx"

The Respondent-Applicant submitted as evidence, the following:

1. Sample product labels/packaging of "TRYMERIN"; and
2. Sample product labels/packaging of "TRIMYCIN".⁵

The Preliminary Conference was held on 27 September 2011. The Opposer and the Respondent-Applicant submitted their position papers on 3 November 2011 and 21 October 2011, respectively.

Records show that at the time Respondent-Applicant applied for registration of the mark "TRYMERIN" the Opposer already registered the mark "TRIMYCIN" under of Registration No. 34976. The goods covered by the Opposer's trademark registration are also under Class 05, namely: "topical treatment of infectious skin diseases", while the Respondent-Applicant's trademark application indicates use as "quinolones, sulfonamide, cotrimazole preparations".

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

The competing marks are reproduced below:

TRIMYCIN

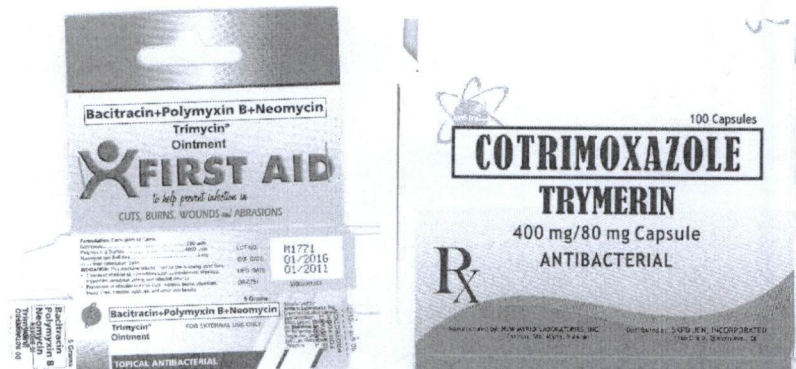
Opposer's mark

TRYMERIN

Respondent-Applicant's mark

⁵ Annexes "A" and "B" inclusive of submarkings

The marks are phonetically similar with respect to the first two syllables (“TRI-MY”) and (“TRY-ME”). Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. It is noteworthy that the generic or non-proprietary name of the Opposer’s drug the is BACITRACIN+POLYMYXIN B+NEOMYCIN, while that of the Respondent-Applicant is COTRIMOXAZOLE, as seen from a reproduction of the packagings⁶ below:



Clearly, as seen from the labels, the nature and administration of the pharmaceutical products are different. The Opposer’s product, TRIMYCIN⁷ is an ointment and the method of administration is by external application on “cuts, burns, wounds and abrasions”. On the other hand, the Respondent-Applicant’s product, TRYMERIN⁸ is a Cotrimazole antibacterial indicated for “infections of the respiratory, gastro-intestinal and genitourinary tracts, skin and soft tissues” in tablet and capsule form which are taken orally. The labels/packaging are designed in different color schemes, the Opposer uses orange, red, green while the Respondent-Applicant uses yellow and green. The resultant marks portray different commercial impressions thus, confusion and deception is unlikely.

Under the foregoing factual backdrop, this Bureau finds the Supreme Court’s ruling in Etepha A. G v. Director of Patents⁹ relevant to this case, to wit:

In the solution of a trademark infringement problem, regard too should be given

to the *class* of persons who buy the particular product and the circumstances ordinarily attendant to its acquisition.¹⁶ The medicinal preparation clothed with the trademarks in question, are unlike articles of everyday use such as candies, ice cream, milk, soft drinks and the like which may be freely obtained by anyone, anytime, anywhere. Petitioner's and respondent's products are to be dispensed upon medical prescription. The respective labels say so. An intending buyer must have to go first to a licensed doctor of medicine; he receives instructions as to

⁶ Annex “1-B” and “2”

⁷ Annex “2”

⁸ Annex “1-B”, “1-C”

⁹ G.R. L. No. 20635, 31 March 1996


what to purchase; he reads the doctor's prescription; he knows what he is to buy. He is not of the incautious, unwary, unobservant or unsuspecting type; he examines the product sold to him; he checks to find out whether it conforms to the medical prescription. The common trade channel is the pharmacy or the drugstore. Similarly, the pharmacist or druggist verifies the medicine sold. The margin of error in the acquisition of one for the other is quite remote.

We concede the possibility that buyers might be able to obtain Pertussin or Attusin without prescription. When this happens, then the buyer must be one thoroughly familiar with what he intends to get, else he would not have the temerity to ask for a medicine — specifically needed to cure a given ailment. In which case, the more improbable it will be to palm off one for the other. For a person who purchases with open eyes is hardly the man to be deceived.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-0100111 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 11 November 2014.


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