BIOMEDIS, INC., Opposer, **-versus-** **THE GENERICS PHARMACY, INC.,** Respondent- Applicant.	}	**IPC No. 14-2011-00424** Opposition to: Appln. Serial No. 4-2011-000694 Date Filed: 21 January 2011 **TM: "SUXILAN"**

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NOTICE OF DECISION

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THE GENERICS PHARMACY
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For the Respondent-Applicant
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GREETINGS:

Please be informed that Decision No. 2014 - 196 dated July 31, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 31, 2014.

For the Director:

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

BIOMEDIS, INC.,	}	**IPC No. 14-2011-00424**
Opposer,	}	Opposition to:
	}	
- versus -	}	Application No. 4-2011-000694
	}	Date Filed: 21 January 2011
THE GENERICS PHARMACY, INC.,	}	
Respondent-Applicant.	}	Trademark: **SUXILAN**
x----------x		Decision No. 2014 - 196

DECISION

BIOMEDIS, INC.[1] ("Opposer") filed on 14 September 2011 a Verified Notice of Opposition to Trademark Application No. 4-2011-000694. The contested application, filed by THE GENERICS PHARMACY, INC.[2] ("Respondent-Applicant"), covers the mark SUXILAN for use on *"pharmaceutical product for uterine hypermotility disorders"* under Class 05 of the International Classification of goods[3].

The Opposer alleges, among other things, that:

> "1. The trademark SUXILAN so resembles ISOXILAN trademark owned by Opposer and registered with this Honorable Office prior to the publication for opposition of the mark SUXILAN. The trademark SUXILAN, 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 SUXILAN is applied for the same class as that of trademark ISOXILAN, i.e. class (5);
>
> "2. The registration of the trademark SUXILAN 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
> > (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion; x x x
>
> Under the above-quoted provision, any mark, which is similar to a registered mark, shall be denied registration 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 address at 108 Rada Street, Legaspi Village, Makati City.

2 A domestic corporation with address at 459 Quezon Avenue, Quezon City.

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.

"3. Respondent's use and registration of the trademark SUXILAN will diminish the distinctiveness and dilute the goodwill of Opposer's ISOXILAN."

In support of the Opposition, the Opposer submitted the following pieces of evidence:

1. Copy of the pertinent page of the IPO e-Gazette officially released on 15 August 2011;
2. Certified true copy of the Certificate of Registration for the trademark ISOXILAN;
3. Certified true copy of the Certificate of Renewal of Registration of ISOXILAN;
4. Certified true copy of the Deed of Assignment;
5. Certified true copy of the Notice of Allowance dated 18 March 2011;
6. Certified true copies of the Affidavits of Use for the mark ISOXILAN;
7. Sample product label bearing the trademark ISOXILAN;
8. Copy of the Certificate of Product Registration issued by BFAD for the product ISOXILAN.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 10 October 2011. The Respondent-Applicant, however, did not file its Verified Answer. Thus, this Bureau issued Order No. 2012-1318 dated 12 October 2012 declaring the Respondent-Applicant in default and submitting the case for decision on the basis of the opposition, affidavit of witness and documentary or object evidence submitted by the Opposer.

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

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.[4] 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 and evidence show that at the time the Respondent-Applicant filed its trademark application, the Opposer's sister company, L. R. Imperial, Inc., has already been issued a Certificate of Registration (No. 28530) on 03 October 1980 for the trademark ISOXILAN. By virtue of the Assignment of Trademark Registration, the mark ISOXILAN was assigned and transferred by L. R. Imperial, Inc. to herein Opposer sometime in September 2000. The Opposer's trademark registration which is used for *"cerebral and peripheral vasodilator preparations"* under Class 05 was renewed accordingly.

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

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

ISOXILAN **SUXILAN**

Both marks are word marks without any device or design. Apart from the letter "U", all the remaining letters comprising the Respondent-Applicant's mark are exactly the same and arranged the same way as that of the Opposer's. This slight difference in the spelling, however, is inconsequential to the effect on the eyes and ears. As ruled by the Supreme Court, 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.[5]

Since the Respondent-Applicant adopted almost all the letters in the Opposer's mark and the fact that they are arranged in the same position, give the marks the same sounding effect when pronounced. In determining the issue of confusingly similarity, the court has also taken into account the aural effect of the words and letters contained in the mark.[6]

Succinctly, because the Opposer's and Respondent-Applicant's marks both deal with pharmaceutical products for uterine hypermotility disorders[7], the changes in the spelling therefore did not diminish the likelihood of the occurrence of mistake, confusion or even deception. As trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

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.[8] 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:[9]

> 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

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

6 *Prosource International Inc. v. Horphag Research Management S. A.*, G. R. No. 180073, 25 November 2009.

7 Opposer's Annex "J".

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

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

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. 4-2011-000694 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 July 2014.

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

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