



MERCK KGaA,
Opposer,

-versus-

SEL-J PHARMA CORPORATION,
Respondent-Applicant.

X-----X

}
} IPC No. 14-2011-00549
} Opposition to:
} Appln No. 4-2011-010574
} Date filed: 06 September 2011
} TM: "PLETHIROX"
}
}
}
}
}

NOTICE OF DECISION

BUCOY POBLADOR & ASSOCIATES

Counsel for the Opposer
21st Floor, Chatham House
116 Valero corner Rufino Streets
Salcedo Village, Makati City

SEL-J PHARMA CORPORATION

Respondent-Applicant
2nd Floor, Villanueva Compound
CCA Road corner J. Aguilar Drive
Pamplona, Las Pinas City

GREETINGS:

Please be informed that Decision No. 2014 - 220 dated September 08, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 08, 2014.

For the Director:


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



MERCK KGaA,
Opposer,

IPC No. 14-2011-00549
Opposition to:

-versus-

SEL-J PHARMA CORPORATION,
Respondent-Applicant.

Application No.: 4-2011-010574
Date filed : 06 September 2011
Trademark : **"PLETHIROX"**

x -----x

Decision No. 2014 - 220 ,

DECISION

MERCK KGaA ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2011-010574. The application, filed by SEL-J PHARMA CORPORATION ("Respondent-Applicant")², covers the mark "PLETHIROX" for use on "pharmaceutical products with roxithromycin as the active ingredient" under class 05 of the International Classification of Goods and Services³.

The Opposer alleges among other things the following:

"1. The mark 'PLETHIROX' which respondent-applicant seeks to register so resembles Opposer's registered trademark 'EUTHYROX' which when applied to or used in connection with the goods covered by the application under opposition will likely cause confusion, mistake and deception on the part of the purchasing public.

"2. The registration of the mark 'PLETHIROX' in the name of respondent-applicant will violate Section 123.1 (d) of Republic Act No. 8293 ('Intellectual Property Code') x x x.

Thus, any mark which is identical with a registered mark belonging to a different person or legal entity should be denied registration in respect of similar or related goods, or if the mark applied for registration nearly resembles such registered mark that confusion or deception in the mind of the buying public will likely result.

"3. Opposer's Philippine Trademark Registration No. 4-1999-001481 has not been abandoned and is currently in full force and effect. By virtue of Certificate of Trademark registration No. 4-1999-001481, Opposer has acquired ownership over the mark 'EUTHYROX' to the exclusion of all others.

"4. Opposer's aforementioned registered trademark 'EUTHYROX' and the mark 'PLETHITOX' which respondent-applicant seeks to register are practically identical in sound and appearance that they leave the same comer upon the purchasing public.

"5. The mark 'PLETHIROX' which respondent-applicant seeks to register is visually and phonetically conf Opposer's registered trademark 'EUTHYROX' as likely to cause confusion, mistake and deception to the public as to the source or origin of respondent-applicant's goods.

¹ A German corporation with business address at Frankfurter Strabe 250, 64293 Darmstadt, Germany.

² A Philippine corporation with principal office address at 2nd Floor, Villanueva Compound, CAA Road corner J. Aguilar Drive, Pamplona, Las Pinas, Philippines.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

"6. The use by, and registration in favour of, respondent-applicant of the confusingly similar mark 'PLETHIROX' on its goods will enable it to unjustly benefit from Opposer's established reputation and goodwill.

"7. In view of the prior adoption and registration of the trademark 'EUTHYROX' by the Opposer, respondent-applicant is clearly not entitled to register the confusingly similar mark 'PLETHIROX'.

"8. The registration of the trademark subject of the instant opposition will undoubtedly violate Opposer's rights and interests in its 'EUTHYROX' trademark, cause confusion between Opposer's and respondent-applicant's businesses and products, and will most assuredly result in the dilution and loss of distinctiveness of Opposer's registered trademark 'EUTHYROX'.

The Opposer's evidence consists of the following

1. Exhibit "A" - Legalized and Authenticated Special Power of Attorney;
2. Exhibit "B" - Joint Affidavit of Jessica Schneider and Diana Schmerler;
3. Exhibit "C" - Certified copy of Philippine Trademark Registration No. 4-1999-001481 for the mark EUTHYROX; and,
4. Exhibit "D" - Publication of Trademark Application No. 4-2011-010574 for the mark PLETHIROX from official website of Intellectual Property Office of the Philippines.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 21 February 2012. Respondent-Applicant however, did not file an answer. Thus, this instant case is submitted for decision.

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

The instant opposition is anchored on Section 123.1 paragraph (d) of the IP Code which 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 mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 06 September 2011, the Opposer has already an existing trademark registration for the mark EUTHYROX bearing Registration No. 4-1999-001481 issued on 20 January 2003.⁴ This registration covers "pharmaceutical, veterinary and sanitary preparation in the treatment of diseases of the thyroid gland" under Class 5. Hence, the competing marks are used on similar or closely goods.

Nevertheless, it is unlikely that the coexistence of the marks will cause confusion, much less deception, among the public. The competing marks are reproduced as follows:

EUTHYROX

Opposer's mark

PLETHIROX

Respondent-Applicant's mark

⁴ Exhibit "C" of Opposer.

The first and middle syllables of the contending marks are: "EU-THY" for the Opposer, and "PLE-THI" for the Respondent-Applicant. They appear distinct from each other. The ending syllable of the marks are the same, both has ROX at the end of their word mark. However, the similarity of ROX is insufficient to conclude the resemblance between the two marks as the marks entirely differ from each other both in spelling and pronunciation. The marks produce a different sound, setting it apart distinctively from each other.

Moreover, a scrutiny of the Respondent-Applicant's trademark application shows that the coverage of the mark PLETHIROX is not the same with that of the Opposer's EUTHYROX. PLETHIROX qualifies its goods as: pharmaceutical products with roxithromycin as the active ingredient.⁵ Roxithromycin is an antibiotic used to treat infections caused by bacteria. It belongs to the macrolide family of antibiotics. It can be used to treat some respiratory tract infections (RTIs) and their complications, as well as some other infections caused by bacteria.⁶ On the other hand, EUTHYROX is for the treatment of diseases of thyroid gland.⁷ The illness to be treated by the use of the contending marks is likewise different from each other. Thus, while both fall under Class 05 of the International Classification of Goods, the purpose and use of both marks are different. It is very remote, because of the mentioned dissimilarities for the buyers to be confused or commit mistake in buying their goods.

It is emphasized that the essence of trademark registration is to give protection to the owners 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 or 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.⁸ This Bureau finds the Respondent-Applicants' mark consistent with this function.

Moreover, taking into account that the only similarity between the competing marks is the suffix "ROX", sustaining the instant opposition would have the unintended effect of giving the Opposer the exclusive right to use "ROX", which evidently and sufficiently describes the pharmaceutical goods involved, i.e. pharmaceutical used in the treatment of hypertension.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-010574 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 08 September 2014.


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

⁵ File wrapper records.

⁶ Roxithromycin, NPS Medicine Wise, available at <http://www.nps.org.au/medicines/infections-and-infestations/antibiotics/for-individuals/antibiotics-for-respiratory-tract-infections/for-individuals/active-ingredients/roxithromycin> (last accessed 08 September 2014).

⁷ Exhibit "C" of Opposer.

⁸ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No., 115508, 19 Nov. 1999.