



PEDIATRICA, INC.,
Opposer,

-versus-

RS SAN JUAN AND ASSOCIATES,
Respondent-Applicant.

}
} IPC No. 14-2013-00409
} Opposition to:
} Appln No. 4-2013-500202
} Date filed: 21 January 2013
} TM: "L-FERRIN"
}
}
}
}

X-----X

NOTICE OF DECISION

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

RS SAN JUAN AND ASSOCIATES
Respondent-Applicant
21 Sandringham Street
Barrington Place, Town and Country Estates
Antipolo City, Rizal

GREETINGS:

Please be informed that Decision No. 2014 - 219 dated September 10, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 10, 2014.

For the Director:

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



PEDIATRICA, INC.,
Opposer,

IPC No. 14-2013-00409
Opposition to Trademark
Application No. 4-2013-500202
Date Filed: 21 February 2013

-versus-

RS SAN JUAN AND ASSOCIATES,
Respondent-Applicant.

Trademark: "**L-FERRIN**"

X ----- X

Decision No. 2014- 219

DECISION

Pediatrica, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-00500202. The contested application, filed by RS San Juan and Associates² ("Respondent-Applicant"), covers the mark "L-FERRIN" for use on "*pharmaceuticals and health supplements*" under Class 05 of the International Classification of Goods³.

The Opposer anchors its opposition on the provisions of Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It alleges that Respondent-Applicant's mark "L-FERRIN" will likely cause confusion, mistake and deception *vis-a-vis* its own mark registered "FERLIN". It contends that it has registered its mark way back 08 October 1973 and that the same has been acknowledged as one of the leading brands in the Philippines by the International Marketing Services ("IMF"). In addition, it avers that its product has been registered with the Food and Drug Administration (FDA).

In support of its Opposition, the Opposer submitted the following as evidence:

1. copy of Respondent-Applicant's application as published in the IPO E-Gazette;
2. certified true copy of Principal Register No. 20285 for the mark "FERLIN";
3. certified true copies of the Declaration of Actual Use (DAU) for "FERLIN";
4. sample product label bearing the mark "FERLIN";
5. certification and sales performance issued by the IMS; and

¹ A domestic corporation duly organized and existing under and by virtue of the laws of the Philippines, with business address at Bonaventure Plaza, Greenhills, San Juan.

² Appears to be a domestic corporation with office address at 21 Sandringham St., Barrington Place, Town and Country Estates, Antipolo City, Rizal.

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

6. copy of the Certificate of Product Registration No. DA-000187 issued by the FDA.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 07 November 2013. The Respondent-Applicant, however, failed to file its Answer. Thus, the Hearing Officer issued Order No. 2014-425 on 02 April 2014 declaring the Respondent-Applicant in default and the case submitted for decision.

The primordial issue in this case is whether the trademark application by Respondent-Applicant's mark "L-FERRIN" should be allowed.

Section 123.1(d) of the IP Code, relied upon by Opposer, provides that:

"Section 123.1. A mark cannot be registered if it:


xxx

(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"***

Records reveal that the Opposer filed an application for its mark "FERLIN" as early as 31 July 1972 with the then Philippine Patents Office ("PPO"). The application was eventually allowed and the mark was registered on 08 October 1973. On the other hand, the Respondent-Applicant only sought registration for its mark "L-FERRIN" on 21 January 2013.

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown below for comparison:



Ferlin

Opposer's mark



L FERRIN

Respondent-Applicant's mark

⁴ Marked as Exhibits "A" to "F".

Visually comparing the two marks, it can be readily observed that both similarly appropriate the syllable "FER". The prefix is succeeded by the suffix "LIN" in the Opposer's mark and "RIN" in the Respondent-Applicant's. Obviously, the syllables "LIN" and "RIN" are confusingly similar aurally and visually as they are only one letter different. That Respondent-Applicant adopts an additional prefix, "L", only highlights the resemblance of the competing marks. It appears that the Respondent-Applicant only rearranged the order of the letters in the Opposer's registered mark. 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 purchased as to cause him to purchase the one supposing it to be the other.⁵

Noteworthy, the trademarks "FERLIN" and "L-FERRIN" both refer to goods under Class 05. The Opposer's trademark registration covers "*hematinic pediatric liquid*". This means that the Respondent-Applicant uses or can use the mark "L-FERRIN" for pharmaceutical products that are indicated in the Opposer's registration or for goods that are similar or related thereto. It has been time and again reiterated by the Supreme Court that the registered trademark owner may use his mark on the same or similar products, in different segments of the market, and at different price levels depending on variations of the products for specific segments of the market. The Court has recognized that the registered trademark owner enjoys protection in product and market areas that are the normal potential expansion of his business.⁶ Thus, the consumers may have the notion that Opposer expanded business and manufactured a new product by the name "L-FERRIN", which could be mistakenly assumed a derivative or variation of "FERLIN".

Finally, it is emphasized that 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.⁷ Respondent-Applicant's trademark fell short in meeting this function.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

⁵ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, April 4, 2001.

⁶ Societes des Produits Nestle, S.A. vs. Martin T. Dy, Jr., G.R. No. 172276, 08 August 2010.

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-500202 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 September 2014.


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