



BIOMEDIS, INC.,
Opposer,

-versus-

PHIL SHINPOONG PHARMA INC.,
Respondent-Applicant.

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}
} IPC No. 14-2013-00154
} Opposition to:
} Application No.4-2012-009603
} Date filed: 13 February 2009
} TM: "SHINCEF"
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NOTICE OF DECISION

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

PHIL SHINPOONG PHARMA, INC.
Respondent-Applicant
Unit 2314 Medical Plaza Ortigas Building
San Miguel Avenue, Ortigas Center
Pasig City

GREETINGS:

Please be informed that Decision No. 2015 - 16 dated February 13, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 13, 2015.

For the Director:


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



BIOMEDIS, INC.,

Opposer,

-versus

PHIL SHINPOONG PHARMA INC.,

Respondent-Applicant.

X ----- X

IPC No. 14-2013-00154

Opposition to Trademark

Application No. 4-2012-009603

Date Filed: 13 February 2009

Trademark: "**SHINCEF**"

Decision No. 2015- 16

DECISION

Biomedis, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-009603. The contested application, filed by Phil Shinpoong Pharma Inc.² ("Respondent-Applicant"), covers the mark "SHINCEF" for use on "*pharmaceutical preparations- antibacterial (cephalosporin)*" under Class 05 of the International Classification of Goods³.

The Opposer anchors its opposition on the provision of Section 123.1 (d) of the Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). It contends that the Respondent-Applicant's mark "SHINCEF" is confusingly similar to its registered mark "STANCEF" for the following reasons:⁴

12.1.6.1. Respondent-Applicant's mark 'SHINCEF' appears and sounds almost the same as Opposer's mark 'STANCEF'.

12.1.6.2. The first and the last four letter of Respondent-Applicant's mark 'SHINCEF' are exactly the same with Opposer's mark 'STANCEF'.

12.1.6.3. Both marks are composed of two (2) syllables '/SHIN/-/CEF/' and '/STAN/-/CEF/'.

12.1.6.4. Both marks are composed of seven (7) letters 'S-H-I-N-C-E-F' and 'S-T-A-N-C-E-F'.

The Opposer states that its "STANCEF" mark was originally registered under the name of its sister company, Therapharma, on 30 October 2000 and was assigned to it on 26 January 2009. It claims that the assignment and the pertinent

¹ A domestic corporation, duly organized and existing under the laws of the Philippines with office address at Dynavision Building, 108 Rada Street, Legaspi Village, Makati City Philippines.

² With office address at Unit 2314 Medical Plaza Ortigas Building, San Miguel Ave., Ortigas Center, Pasig City, Manila, Philippines.

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.

⁴ See Verified Opposition, pp. 9-10.

Affidavits of Use for the mark are duly filed and recorded. It also avers that the International Marketing Services ("IMS") acknowledged and listed the brand "STANCEF" as one of the leading brands in the Philippines in the category of "J01D-Cephalosporins" in terms of market share and sales performance. It further maintains that it registered its product with the Food and Drug Administration ("FDA") in order to legally market, distribute and sell the same.

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

1. copy of the IPO E-Gazette showing the publication of the Respondent-Applicant's trademark application;
2. certified true copy of Certificate of Registration No. 4-1994-98186;
3. certified true copy of the Deed of Assignment;
4. certified true copy of the Affidavits of Use of "STANCEF";
5. picture of its actual product;
6. copy of the certification by IMS and sales performance; and,
7. certified copy of the Certificate of Product Registration issued by the FDA.

On 29 April 2013, a Notice to Answer was served to the Respondent-Applicant. The latter, however, failed to comply. Thus, the Hearing Officer issued Order No. 2013-1384 on 08 October 2013 declaring the Respondent-Applicant in default and submitting the case for resolution.

The issue is whether the Respondent-Applicant's mark "SHINCEF" should be allowed registration.

As culled from available records, the Opposer's predecessor-in-interest, Therapharma, was issued registration of the mark "STANCEF" as early as 30 October 2008. The Respondent-Applicant, on the other hand, filed the contested application only on 03 August 2012.

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

Stancef

Opposer's mark

SHINCEF

Respondent-Applicant's mark

The manifest similarity between the marks is their common second syllable "CEF". This resemblance, however, can be easily explained by looking at the products they pertain. For the Opposer's mark "STANCEF", the picture of its actual product⁵ and the copy of the Certificate of Registration issued by the FDA⁶ reveal that the said mark is used on medicines with a generic name *cefazonlin*. As it can be fairly presumed that the "CEF" in "STANCEF" was taken from the first syllable of its generic name, it cannot claim exclusive use of the syllable "CEF". Also noteworthy, the Respondent-Applicant's trademark application shows that it intends to use the mark "SHINCEF" to "*pharmaceutical preparations -antibacterial (cephalosporin)*", which likewise explains its appropriation of "CEF".

What will, therefore, determine whether the marks are indeed confusingly similar are the syllables, words or devices that accompany the common syllable "CEF". In this case, the "STAN" in the Opposer's mark and the "SHIN" in the Respondent-Applicant's are easily distinguishable from each other both in spelling and in sound. The confusion or mistake, much less deception, is improbable in this case bolstered by the fact that the competing marks pertain to prescription drugs. The pharmaceutical products bearing the marks are not over-the-counter goods or medicines. Since "STAN" after the prefix "CEF" in the Opposer's mark is easily differentiated from "SHIN" in the Respondent-Applicant's, it is very unlikely for a pharmacist to commit a mistake in reading the prescription.

Moreover, it is doubtful if the consumers in encountering the mark "STANCEF" will have in mind or be reminded of the trademark "SHINCEF". The Opposer has not established that "STANCEF" is a well-known mark nor that its mark's fame could support the claim that Respondent-Applicant's trademark application and use of the mark "SHINCEF" manifest the latter's intent of riding in on the goodwill supposedly earned and enjoyed by the former. Furthermore, the Trademark Registry of this Office reveals several other trademarks under Class 05 that employ "CEF" in their trademarks including "CEF-4", "EDUCEF", "REVACEF" and "ZINACEF". Hence, similarity in this aspect alone is not enough to prevent a junior user registration of its mark provided that the later mark is endowed with other distinguishing features and characteristics such as that of the Respondent-Applicant's.

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

⁵ Exhibit "E".

⁶ Exhibit "G".

manufacturer against substitution and sale of an inferior and different article as his product.⁷ The Respondent-Applicant's trademark sufficiently met this requirement.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-009603 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 13 February 2015.


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

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