



PEDIATRICA, INC.,
Opposer,

-versus-

ATTY. AMBROSIO V. PADILLA III,
Respondent-Applicant.

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} IPC No. 14-2014-00192
} Opposition to:
} Application No.4-2013-00013552
} Date filed: 12 November 2013
} TM: "FERIDIN"
}
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}
}
}
}

NOTICE OF DECISION

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

ATTY. AMBROSIO V. PADILLA III
Respondent-Applicant
Unit 1001 88 Corporate Center
Sedeno corner Valero Streets
Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 15 dated February 16, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 16, 2015.

For the Director:

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



PEDIATRICA, INC.,	}	IPC No. 14-2014-00192
Opposer,	}	Opposition to:
	}	
- versus -	}	Application No. 4-2013-00013552
	}	Date Filed: 12 November 2013
ATTY. AMBROSIO V. PADILLA III,	}	
Respondent-Applicant.	}	Trademark: FERIDIN
x-----x	x	Decision No. 2015 - <u>15</u>

DECISION

PEDIATRICA, INC.¹ ("Opposer") filed a Verified Notice of Opposition to Trademark Application No. 4-2013-00013552. The contested application, filed by ATTY. AMBROSIO V. PADILLA III² ("Respondent-Applicant"), covers the mark FERIDIN for use on "*(pharmaceutical product) – pharmaceutical product for the treatment of iron deficiency anemia during pregnancy, lactation and postpartum, and also for the prevention of iron deficiency anemia*" under Class 05 of the International Classification of goods³.

The Opposer alleges, among other things, that:

"7. The mark FERIDIN applied for by Respondent-Applicant so resembles the trademark FERLIN owned by Opposer and duly registered with this Honorable Bureau prior to the publication of the application for the mark FERIDIN.

"8. The mark FERIDIN will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark FERIDIN is applied for the same class and goods as that of Opposer's trademark FERLIN, *i.e.*, Class 05 of the International Classification of Goods for pharmaceutical preparations related to the treatment of iron deficiency.

"9. The registration of the mark FERIDIN in the name of the Respondent-Applicant will violate Sec. 123.1(d) of the IP Code, which provides, in part, that a mark cannot be registered if it:

x x x

(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:

- 1 A domestic corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines, with office address at Bonaventure Plaza, Greenhills, San Juan, Metro Manila, Philippines.
- 2 Appears to be a Filipino, with office address at Unit 1001, 88 Corporate Center, Sedeno corner Valero Streets, Salcedo Village, Makati City, Philippines.
- 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.

- (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

"10. 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.

"11. Respondent-Applicant's use and registration of the mark FERIDIN will diminish the distinctiveness of Opposer's trademark FERLIN."

The Opposer's evidence consists of the following:

1. Copy of the pertinent page of the IPO e-Gazette bearing publication date of 14 April 2014 (*Exhibit "A"*);
2. Certified true copy of Registration No. 20285 for the trademark FERLIN (*Exhibit "B"*);
3. Certified true copy of the Petition for Renewal of Registration filed with the IPO on 7 October 2013 (*Exhibit "C"*);
4. Certified true copies of the Affidavits of Use for the mark FERLIN (*Exhibits "D", "E", "F", "G", "H" and "I"*);
5. Sample product label bearing the trademark FERLIN (*Exhibit "J"*);
6. Certification and sales performance issued by the IMS Health Philippines, Inc. (*Exhibit "K"*); and
7. Certified true copy of the Certificate of Product Registration No. DR-7153 issued by the Food and Drug Administration (*Exhibit "L"*).

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 29 May 2014. The Respondent-Applicant, however, did not file his Verified Answer. Thus, this Bureau issued Order No. 2014-1033 dated 07 August 2014 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 FERIDIN?

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

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

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 his trademark application on 12 November 2013, the Opposer has long been issued a certificate of registration (No. 20285) on 08 October 1973 for the trademark FERLIN which was timely renewed thereafter. The Opposer's mark is registered under Class 05 as "hematinic pediatric liquid". This good as compared with the Respondent-Applicant's are related being both pharmaceutical products intended for the treatment of iron deficiency anemia under Class 05.

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

Ferlin

Opposer's Mark

Feridin

Respondent-Applicant's Mark

Based on the pharmaceutical products to which the opposing marks are attached, it can be inferred that the first three (3) letters -FER- are derived from the word "FERROUS" which relates to or indicates the presence of iron⁵. This notwithstanding, the marks show resemblance to each other. The letters following the "FER" in the Respondent-Applicant's mark look and sound similar to those in the Opposer's. The middle letter "L" in the Opposer's was changed to "ID" in the Respondent-Applicant'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.⁶ Also, 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 effects of the words and letters contained in the mark.⁷

Succinctly, because the Opposer's and Respondent-Applicant's marks both deal with pharmaceutical products for the treatment of iron deficiency anemia⁸, the changes in the spelling therefore did not diminish the likelihood of the occurrence of mistake, confusion or even deception.

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

5 <http://en.wikipedia.org/wiki/Ferrous>

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

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

8 Opposer's Exhibit "J".


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.⁹

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. 4-2013-00013552 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 February 2015.


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

⁹ *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.