



L.R. IMPERIAL, INC.,
Opposer,

-versus-

MULTICARE PHARMACEUTICALS
PHILIPPINES, INC.,
Respondent-Applicant.

IPC No. 14-2013-00352
Opposition to:
Application No.4-2012-00011743
Date filed: 24 September 2013
TM: "GLIMET AND DEVICE "

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 29 dated March 12, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 12, 2015.

For the Director:


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



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-versus-

**MULTICARE PHARMACEUTICALS
PHILIPPINES, INC.,**

Respondent-Applicant.

IPC No. 14-2013-00352

Opposition to Trademark

Application No. 4-2012-00011743

Date Filed: 24 September 2013

Trademark: **"GLIMET AND DEVICE"**

x ----- x Decision No. 2015- 29

DECISION

L.R. Imperial, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-00011743. The contested application, filed by Multicare Pharmaceuticals Philippines, Inc.² ("Respondent-Applicant"), covers the mark "GLIMET AND DEVICE" for use on "*pharmaceutical products for treating diabetes specifically type 2 diabetes*" under Class 05 of the International Classification of Goods³.

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 "GLIMET AND DEVICE" is confusingly similar to its registered mark "GLUMET" most especially considering that the marks are applied for the same class of goods. It claims to have registered its mark on 08 July 2004 and has dutifully filed the Declarations of Actual Use (DAU). It maintains that the Intercontinental Marketing Services (IMS) acknowledged and listed its brand as one of the leading brands in the Philippines in the category of "*A10J – Biguanide AntiDiabetics Market*". It further avers 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 the allegations in the Opposition, the Opposer submitted the following as evidence:⁴

1. copy of pertinent page of the IPO E-Gazette publishing the Respondent-Applicant's application;

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

² With address at 26th Floor, Rufino Tower, 6784 Ayala Avenue, Makati City, Metro Manila.

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 Marked as Exhibits "A" to "F".

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2. certified true copy of Certificate of Registration No. 4-2001-003304;
3. copies of the DAU and Affidavits of Use;
4. sample product label;
5. certified true copy of the Certification from IMS and sales performance;
and
6. copy of the certificate of product registration.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 05 September 2013. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 03 February 2014 Order No. 2014-145 declaring the Respondent-Applicant in default and the case submitted for decision.

Records reveal that at the time the Respondent-Applicant's filed its application for "GLIMET AND DEVICE" on 24 September 2013, the Opposer has an existing registration for the mark "GLUMET" under Certificate of Registration No. 4-2001-003304 issued on 08 July 2004.

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

Glumet  **GLIMET**

Opposer's mark

Respondent-Applicant's mark

Upon observation of the subject trademarks, it can be readily gleaned that the two marks differ only with respect with their third letter; i.e. "U" and "I", and the additional device in the Respondent-Applicant's mark. These differences notwithstanding, the competing marks still look and sound alike. Although the Opposer's mark is presumably derived from glucose and *metformin*, when compounded together, a suggestive mark "GLUMET" is formed. The Respondent-Applicant, on the other hand, offered no plausible explanation how it arrived with the mark "GLIMET AND DEVICE", which is only one letter different from that of the Opposer's. 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

⁵ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

Noteworthy, the trademarks "GLUMET" and "GLIMET AND DEVICE" both refer to medicines for treating diabetes. Even assuming that the consumers will not be deceived or confused as to the labels, it is highly likely that they may have the mistaken notion that the Opposer merely expanded business and manufactured a new product by the name of "GLIMET AND DEVICE". In the case of **Societes des Produits Nestle, S.A. vs. Martin T. Dy, Jr.**, the Supreme Court made the following pronouncement:⁶

"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."

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁷

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.⁸ The 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.

⁶ G.R. No. 172276, 08 August 2010.

⁷ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

⁸ 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. 4-2012-00011743 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 12 March 2015.



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