



UNITED HOME PRODUCTS, INC.,
Opposer,

-versus-

TGP PHARMA, INC.,
Respondent-Applicant.

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IPC No. 14-2014-00532
Opposition to:
Application No.4-2014-00007233
Date filed: 09 June 2014
TM: "DERMKLIN"

x-----x

NOTICE OF DECISION

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

TGP PHARMA, INC.
Respondent-Applicant
Edison Street corner Cul de Sac Street
Km.14 West Service Road
Parañaque City

GREETINGS:

Please be informed that Decision No. 2015 - 89 dated May 14, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 14, 2015.

For the Director:


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



UNITED HOME PRODUCTS, INC.,	}	IPC No. 14-2014-00532
Opposer,	}	Opposition to:
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-versus-	}	Application No. 4-2014-00007233
	}	Date Filed: 09 June 2014
TGP PHARMA, INC.,	}	
Respondent-Applicant.	}	Trademark: DERMKLIN
x-----x	x	Decision No. 2015 - <u>89</u>

DECISION

UNITED HOME PRODUCTS, INC.¹. (“Opposer”) filed on 05 December 2014 an opposition to Trademark Application Serial No. 4-2014-00007233. The application, filed by TGP PHARMA, INC.² (“Respondent-Applicant”), covers the mark “DERMKLIN” for the use on “*medicine; antibacterial; clindamycin preparations*” under Class 05 of the International Classification of goods³.

The Opposer alleges that “DERMKLIN” is confusingly similar to its registered mark “DERMALIN”, which is also used for antibacterial, antifungal, antiscabies preparations for the treatment of skin orders. According to the Opposer, the registration of “DERMKLIN” will violate Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”).

To support its opposition, the Opposer submitted copies of the pertinent pages of the IPO E-Gazette, certified copy of Certificate of Registration No. 35737 for the trademark “DERMALIN”, certified true copy of Certificate of Renewal of Registration No. 35737 for trademark “DERMALIN”, certified true copy of Assignment of Registered Trademark, certified true copies of the Affidavits of Use, certified true copy of the Certificate of Product Registration No. DR-8833, a sample product label bearing the trademark “DERMALIN”, and original copy of the Certification and sales performance issued by Intercontinental Marketing Services (“IMS”)⁴.

A Notice to Answer was served to Respondent-Applicant requiring it to file a Verified Answer within thirty (30) days from receipt of the said notice. The Respondent-Applicant, however, failed to file the Answer. Accordingly, the Respondent-Applicant was declared in default pursuant to Rule 2, Sections 9 and 10 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 4/F Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Metro Manila, Philippines.
² A domestic corporation with principal address at Edison St. corner Cul de Sac St., KM. 14, West Service Road, Parañaque City, Metro Manila.
³ The 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.
⁴ Exhibits “A” to “K”.

the amended Rules and Regulations on Inter Partes Proceedings (promulgated through Office Order No. 99, s. 2011, which took effect on 17 July 2011).

Should the Respondent-Applicant be allowed to register the trademark "DERMKLIN"?

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. Thus, Section 123.1(d) of the IP Code provides that 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;

xxx"

In this regard, the records and evidence show that at the time the Respondent-Applicant filed its trademark application on 09 June 2014, the Opposer has an existing registration for the mark "DERMALIN", which was filed with the Philippine Patent Office on 14 December 1981 by Myra Pharmaceuticals, Inc. This was later renewed and assigned to the Opposer on 17 November 2011 via Assignment of Registered Trademark. The registration covers "*topical antibacterial, antifungal, antiscabies preparations for the treatment of skin orders*" under Class 5, similar and/or closely related to the goods indicated in the Respondent-Applicant's trademark application.

But do the competing marks resemble each other that confusion and deception is likely to occur?

In determining the issue of trademark infringement, the test applied is whether defendant's use of a mark similar to Opposer's creates a likelihood of confusion among the consumers.⁵ The competing marks both start with the letters or syllable "DERM". It is reasonable to infer that in relation to the goods or pharmaceutical products covered by the Opposer's trademark registration and the Respondent-Applicant's trademark application, "DERM" or "DERMA" in case of Opposer's, is derived from "derma" or

⁵ Bass Buster, Inc. v. Gapen Mfg. Co., 420 F. Supp. 144, 156, 191 USPQ 315, 325 (W.D. Mo. 1976).

"dermata" which refers to skin or skin ailment of a (specified) type⁶. It can be concluded therefore that the mark "DERMALIN" is a suggestive mark. Thus, the examination of the Respondent-Applicant's mark in order to determine whether or not it is confusingly similar to the Opposer's is not to be confined on the finding that both marks start with "DERM". The determination as to whether the competing marks are confusingly similar depends on the effect of the letters following or appended to the syllable "DERM". To the eyes, "DERMKLIN" is difficult to distinguish from "DERMALIN". Also, the sounds produced when pronouncing the marks are similar.

In *Marvex Commercial Co., Inc. v. Petra Hawpia & Co., et. al.*,⁷ the Supreme Court held:

"The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that 'SALONPAS' and 'LIONPAS' are confusingly similar in sound: 'Gold Dust' and 'Gold Drop'; 'Jantzen' and 'Jazz-Sea'; 'Silver Flash' and 'Supper-Flash'; 'Cascarete' and 'Celborite'; 'Celluloid' and 'Cellonite'; 'Chartreuse' and 'Charseurs'; 'Cutex' and 'Cuticlean'; 'Hebe' and 'Meje'; 'Kotex' and 'Femetex'; 'Zuso' and 'Hoo Hoo'. Leon Amdur, in his book TradeMark Law and Practice, pp. 419-421, cites, as coming within the purview of the *idem* sonans rule, 'Yusea' and 'U-C-A', 'Steinway Pianos' and 'Steinberg Pianos', and 'Seven-UP' and 'Lemon-Up'. In *Co Tiong vs. Director of Patents*, this Court unequivocally said that 'Celdura' and 'Cordura' are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name 'Lusolin' is an infringement of the trademark 'Sapolin', as the sound of the two names is almost the same."

This Bureau finds merit in the Opposer's argument that the Respondent-Applicant's use and registration of the mark "DERMKLIN" will reduce and affect the distinctiveness of Opposer's trademark "DERMALIN". Considering that both marks are used on similar pharmaceutical products ("antibacterial") and available in similar form of administration ("ointment"), there is likelihood that information, assessment, perception or impression about DERMKLIN products may unfairly cast upon or attributed to the Opposer, and vice-versa.

Furthermore, the Supreme Court in *Del Monte Corporation v. Court of Appeals*⁸, held that:

"The question is not whether the two articles are distinguishable by their labels when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the

⁶ <http://www.merriam-webster.com/dictionary/-derma>

⁷ *Marvex Commercial Co., Inc. v. Petra Hawpia & Co., et.al.*, G.R. No. L-19297, December 22, 1966.

⁸ *Del Monte Corporation v. CA*, G.R. No. L-78325 January 25, 1990

ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods, is the touchstone.”

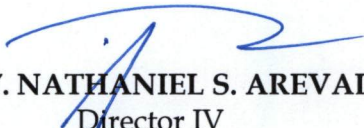
Confusion cannot be avoided by merely adding, removing, or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.⁹ At this juncture, since the goods of the parties are of similar use that the Respondent-Applicant’s product is such as might reasonably be assumed to originate with the Opposer and the public would then be deceived either into that belief or that there is some connection between them when in fact it does not exist.

In light of these circumstances, this Bureau finds that the Respondent-Applicant’s trademark application is proscribed by Sec. 123.1 (d) of the Intellectual Property Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-00007233 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 May 2015.


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

⁹ Societe Des Produits Nestle, S.A. and Nestle Philippines, Inc. v. Court of Appeals, G.R. No. 112012, April 04, 2001.