



PEDIATRICA, INC.,  
Opposer,

-versus-

THE GENERICS PHARMACY, INC.,  
Respondent-Applicant.

X-----X

}  
} **IPC No. 14-2011-00205**  
} Opposition to:  
} Appln Serial No. 4-2011-000679  
} Date Filed: 21 January 2011  
} **TM: "NAPLEX"**  
}

### NOTICE OF DECISION

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For the Respondent-Applicant  
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#### GREETINGS:

Please be informed that Decision No. 2015 - 162 dated July 27, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 27, 2015.

For the Director:

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



**PEDIATRICA, INC.,**  
Opposer,

- versus -

**THE GENERICS PHARMACY, INC.,**  
Respondent-Applicant.  
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IPC No. 14-2011-00205  
Opposition to:

Appln. No. 4-2011-000679  
Date Filed: 21 January 2011  
Trademark : "NAPLEX"

Decision No. 2015 - 162

### DECISION

PEDIATRICA, INC. ("Opposer"),<sup>1</sup> filed a verified opposition to Trademark Application Serial No. 4-2011-000679. The application, filed by PEDIATRICA, INC. ("Respondent-Applicant"),<sup>2</sup> covers the mark "NAPLEX" for use on "*pharmaceutical product categorized as non-steroidal anti-inflammatory drug*" under class 05 of the International Classification of Goods.<sup>3</sup>

The Opposer alleges the following:

"7. The mark 'NAPLEX' owned by Respondent-Applicant so resembles the trademark 'NAPREX' owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark 'NAPLEX'.

"8. The mark 'NAPLEX' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'NAPLEX' is applied for the same class and goods as that of Opposer's trademark 'NAPREX', i.e. Class 05 of the International Classification of Goods as pharmaceutical preparation.

"9. The registration of the mark 'NAPLEX' in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code.

"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."

The Opposer's evidence consists of the following:

1. Copies of the pertinent pages of the IPO E-Gazette
2. Certified true copy of Certificate of Registration No. 27231 for "NAPREX";
3. Certified true copy of the Certificates of Renewal of Registration No. 27231;
4. Certified true copy of Affidavits of Use;
5. Sample product label;

<sup>1</sup> A corporation duly organized and existing under and by virtue of the laws of the Philippines, with principal business address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

<sup>2</sup> With business address at 459 Quezon Avenue, Quezon City, Philippines.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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 Certification and sales performance of "NAPREX"; and,
7. Certified true copy of the Certificate of Product Registration issued by the BFAD for "NAPREX".

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 27 June 2011. Respondent-Applicant however, did not file an answer. Thus, this instant case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark NAPLEX?

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 out into the market a superior 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.<sup>4</sup>

Sec. 123.1 (d) R.A. No. 8293, also known as the Intellectual Property Code ("IP Code") provides:

Sec. 123. Registrability. - 123.1. 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:

- (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;**  
(Emphasis Supplied)

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 21 January 2011<sup>5</sup>, the Opposer has already an existing trademark registration for the mark NAPREX bearing Registration No. 27231 issued on 15 March 1979<sup>6</sup> in the Philippines. It remains active under the name of herein Opposer up to the present.<sup>7</sup> Unquestionably, the Opposer's application and registration preceded that of Respondent-Applicant's.

A comparison of the Opposer's mark with the Respondent-Applicant's is depicted below:

**Naprex**

Opposer's Trademark

**NAPLEX**

Respondent-Applicant's Trademark

<sup>4</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

<sup>5</sup> Filewrapper records.

<sup>6</sup> Exhibit "B" of Opposer.

<sup>7</sup> Exhibits "C" to "H" of Opposer.

The only difference between the competing marks is with respect to the fourth letter - "R" in the Opposer's as against "L" in the Respondent-Applicant's. Notwithstanding the difference in the font which appear very unsubstantial, the competing marks obviously closely resemble each other. The visual and aural similarities of the marks are very apparent.

The likelihood of confusion, however, subsists because the marks cover similar goods. A consumer on account of the very close resemblance of one to the other in respect of the visual properties, will find no distinction regardless of how these marks are pronounced. Opposer's NAPREX particularly covers goods namely, acetaminophen preparation. This refers to pain reliever and a fever reducer. It is also used to treat many conditions such as headache, muscle aches, arthritis, backache, toothaches, colds, and fevers.<sup>8</sup> On the other hand Respondent-Applicant's NAPLEX are pharmaceutical products categorized as non-steroidal anti-inflammatory drug. Obviously, they are intended for related purpose, cater to the same group of purchasers or patients, and available in the same channels of trade.

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.<sup>9</sup> Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.<sup>10</sup>

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 mistake on the part of the buying public. To constitute an infringement of an existing trademark, 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.<sup>11</sup> The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court.<sup>12</sup>

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 on 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 of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

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

<sup>8</sup> Drugs.com available at <http://www.drugs.com/acetaminophen.html> (last accessed 27 July 2015).

<sup>9</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

<sup>10</sup> Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.

<sup>11</sup> American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.

<sup>12</sup> Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-000679 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 27 July 2015.

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