



UNITED HOME PRODUCTS, INC.,
Opposer,

-versus-

THE GENERICS PHARMACY, INC.
Respondent-Applicant.

X-----X

}
} **IPC No. 14-2014-00186**
} Opposition to:
} Application No. 4-2014-00000792
} Date filed: 20 January 2014
} **TM: "MULTIGY"**
}
}
}
}

NOTICE OF DECISION

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THE GENERICS PHARMACY, INC.
Respondent-Applicant
459 Quezon Avenue
Quezon City, Metro Manila

GREETINGS:

Please be informed that Decision No. 2015 - 257 dated November 06, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 06, 2015.

For the Director:

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

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IPC No. 14-2014-00186
 Opposition to:
 Application No. 4-2014-00000792
 Date Filed: 20 January 2014
 Trademark: "MULTIGY"
 Decision No. 2015- 257

DECISION

UNITED HOME PRODUCTS, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-00000792. The application, filed by The Generics Pharmacy, Inc.² ("Respondent-Applicant"), covers the mark "MULTIGY" for use on "*pharmaceutical product used as herbal dietary supplement that acts as anti-aging with anti-oxidant properties*" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
"GROUNDS FOR OPPOSITION"

"The grounds for this Verified Notice of Opposition are as follows:

"7. The mark 'MULTIGY' applied for by Respondent-Applicant so resembles the trademark 'MULTI-B' owned by Opposer which was applied for registration with this Honorable Bureau on 24 July 2012, or prior to the filing of the application of the mark 'MULTIGY' by Respondent-Applicant on 20 January 2014.

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

"9. The registration of the mark 'MULTIGY' 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

¹A domestic corporation duly organized and existing under the laws of the Republic of the Philippines with office address at 4/F Bonaenture Plaza, Ortigas Avenue, Greenhills, San Juan City, Metro Manila, Philippines.

²A domestic corporation with business address at 1459 Quezon Avenue, Quezon City, Metro Manila, Philippines.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"10. Under the above-quoted provision, any mark which is similar to a mark with an earlier filing date, shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a mark with an earlier filing date that confusion or deception in the mind of the purchasers will likely result.

"11. Respondent-Applicant's use and registration of the mark 'MULTIGY' will diminish the distinctiveness of Opposer's trademark 'MULTI-B'.

"ALLEGATIONS IN SUPPORT OF THE OPPOSITION

"In support of this Verified Notice of Opposition, Opposer will rely upon and prove the following facts:

"12. Opposer is the owner of the trademark 'MULTI-B'. It is engaged in the marketing and sale of a wide range of pharmaceutical products.

"12.1. The trademark application for the trademark 'MULTI-B' was filed with the IPO on 24 July 2012, which is prior to the filing date of the Trademark Application for the mark 'MULTIGY' by Respondent-Applicant on 20 January 2014. A certified true copy of the Acknowledgment issued by the IPO acknowledging the receipt of the Trademark Application for the trademark 'MULTI-B' on 24 July 2012 is attached hereto as x x x

"12.2. There is no doubt that by virtue of the prior filing of the Trademark Application for the trademark 'MULTI-B', Opposer has acquired an exclusive ownership over the trademark 'MULTI-B' to the exclusion of all others.

"13. The trademark 'MULTI-B' has been extensively used in commerce in the Philippines.

"13.1. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, the product has been registered with the Food and Drug Administration. As evidence of such registration a certified true copy of Certificate of Listing of Identical Drug Product No. DRP-2586-03 for 'MULTI-B' is attached hereto as x x x

"13.2. A sample product label bearing the trademark 'MULTI-B' actually used in commerce is hereto attached as x x x

"13.2. In fact no less than the Intercontinental Marketing Services ('IMS') itself, the world's leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than one hundred (100) countries, acknowledged and listed the brand 'MULTI-B' as one of the leading brands in the Philippines in the category of 'A11D- Vitamin B1 & Combination' in terms of market share and sales performance. The Certification and sales performance issued by the IMS is attached hereto as x x x

"14. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark, 'MULTI-B' to the exclusion of all others.

"15. The registration of Respondent-Applicant's mark 'MULTIGY' will be contrary to Section 123.1 (d) of the IP Code. 'MULTIGY' is confusingly similar to Opposer's trademark 'MULTI-B'.

"15.1. There are no set rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or is a colorable imitation of, another. Nonetheless, jurisprudence provides enough guidelines and tests to determine the same.

"15.1.1. In *Societe Des Produits Nestle, S.A. vs. Court of Appeals* (356 SCRA 207, 216 [2001]), the Supreme Court, citing *Etepha vs. Director of Patents* (16 scra 495, 497-498 [1966]), held '[i]n determining if colorable imitation exists, jurisprudence has developed two kinds of tests - the Dominancy Test and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitute infringement. On the other side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity.'

"15.1.2. It is worthy to note at this point that in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* [Supra, p. 221,] the Supreme Court held "[T]he totality or holistic test only relies on visual comparison between two trademarks whereas the dominancy test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks."

"15.1.3. Relative thereto, the Supreme Court in *McDonalds' Corporation vs. L.C. Big Mak Burger, Inc.* (437 SCRA 10, 32-33 [2004]) held:

x x x

"15.1.4. This was affirmed in *McDonald's Corporation vs. Macjoy Fastfood Corporation* (514 SCRA 95, 107-108 [2007]), which held that, '[t]he Court has consistently used and applied the dominancy test in determining confusing similarity or likelihood of confusion between competing trademarks.'

"15.1.5. In fact the dominancy test is 'now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code, which defines infringement as the colorable imitation of a registered mark xxx or a dominant feature thereof.' x x x

"15.1.6. Thus, applying the dominancy test in the instant case, it can be readily concluded that the mark 'MULTIGY', owned by Respondent-Applicant, so resembles Opposer's trademark 'MULTI-B', that it will likely cause confusion, mistake and deception on the part of the purchasing public.

"15.1.6.1. Respondent-Applicant's mark 'MULTIGY' appears and sounds almost the same as Opposer's trademark 'MULTI-B'.

"15.1.6.2. The first five (5) letters of Respondent-Applicant's mark 'M-U-L-T-I-G-Y' are exactly the same as that of Opposer's trademark 'M-U-L-T-I--B'.

"15.1.6.3. Both marks are composed of three (3) syllables, i.e., Respondent-Applicant's mark MUL/TI/GY and Opposer's mark MUL/TI-/B.

"15.6.4. Both marks are pronounced with the same intonation.

"15.1.7. Clearly, the Respondent-Applicant's mark 'MULTIGY' adopted the dominant features of the Opposer's trademark 'MULTI-B'.

"15.1.8. As further ruled by the High Court in the McDonald's Corporation case [supra, p.33-34 [2004]]:
x x x

"15.1.9. In American Wire & Cable Co., vs. Director of Patents (31 SCRA 544, 547-548 [1970]), the Supreme Court explained:
x x x

"15.2. Opposer's trademark 'MULTI-B' and Respondent-Applicant's mark 'MULTIGY' are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

"15.3. Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed mark 'MULTIGY' is applied for the same class and goods as that of Opposer's trademark 'MULTI-B' under Class 05 of the International Classification of Goods for pharmaceutical products.

"15.4. Nevertheless, Respondent-Applicant still filed a trademark application for 'MULTIGY' despite its knowledge of the existing trademark application of 'MULTI-B' which is confusingly similar thereto in both its sound and appearance, to the extreme damage and prejudice of Opposer.

"15.5. 'x x xWhen, as in the present case, one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill. x x x

"16. To allow Respondent-Applicant to market its products bearing the mark 'MULTIGY' undermines Opposer's right to its trademark 'MULTI-B'. As the lawful owner of the trademark 'MULTI-B', Opposer is entitled to prevent the Respondent-

Applicant from using a confusingly similar mark in the course of trade where such would likely mislead the public.

"16.1. Being the lawful owner of 'MULTI-B', Opposer has the exclusive right to use and/or appropriate the said trademark and prevent all third parties not having its consent from using in the course of trade identical or similar marks, where such would result in a likelihood of confusion.

"16.2. By reason of Opposer's ownership of the trademark 'MULTI-B', it also has the right to prevent the third parties, such as Respondent-Applicant, from claiming ownership over Opposer's trademark or any depiction similar thereto, without its authority or consent.

"16.3. Moreover, following the illustrative list of confusingly similar sounds in trademarks cited in McDonald's Corporation case (supra, p. 34 [2004]), it is evident that Respondent-Applicant's mark 'MULTIGY' is aurally confusingly similar to Opposer's trademark 'MULTI-B':

x x x

"16.4. Further, the fact that Respondent-Applicant seeks to have its mark 'MULTIGY' registered in the same class (Nice Classification 05) as Opposer's trademark 'MULTI-B' will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

"17. The registration and use of Respondent-Applicant's confusingly similar mark 'MULTIGY' on its goods will enable the latter to obtain benefit from Opposer's reputation and goodwill, and will tend to deceive and/or confuse the public into believing that Respondent-Applicant is in any way connected with the Opposer.

"17.1. As held in *Sterling Products International, Inc. vs. Farbenfabriken Bayer Aktiengesellschaft, et. al.* (27 SCRA 1214, 1227 [1968]) there are two types of confusion in trademark infringement. '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 assumed to originate with the plaintiff, and the public would be deceived either into that belief or in to belief that there is some connection between the plaintiff and defendant which, in fact, does not exist.'

"17.2. The doctrine of confusion of business or origin is based on cogent reasons of equity and fair dealing. It has to be realized that there can be unfair dealing by having one's business reputation confused with another. 'The owner of a trademark or trade name has a property right in which he is entitled to protection, since there is damage to him from confusion of reputation or goodwill in the mind of the public as well as from confusion of goods.' xxx

"17.3. Applying the foregoing to the instant case, to allow Respondent-Applicant to use its mark 'MULTIGY' on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into

believing that the product of Respondent-Applicant with a mark 'MULTIGY' originated from or is being manufactured by Opposer, or at the very least, is connected or associated with the 'MULTI-B' product of Opposer, when such connection does not exist.

"17.4. In Canon Kabushiki Kaisha vs. Court of Appeals (336 SCRA 266, 275 [2000]), the Supreme Court explained that:

x x x

"17.5. Clearly, the scope of protection accorded to trademark owners includes not only confusion of goods but also confusion of origin. As in this case, there is undoubtedly also a confusion of the origin of the goods covered by the mark of Respondent-Applicant and trademark of Opposer, which should not be allowed.

"18. Respondent-Applicant's use of the mark 'MULTIGY' in relation to any of the goods covered by the opposed application, if these goods are considered not similar or closely related to the goods covered by Opposer's trademark 'MULTI-B', will undermine the distinctive character or reputation of the latter trademark. Potential damage to Opposer will be caused as a result of its inability to control the quality of the products put on the market by Respondent-Applicant under the mark 'MULTIGY'.

"19. In case of grave doubt, the rule is that, '[a]s between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favor with the public, any doubt should be resolved against the newcomer inasmuch as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.' (Del Monte Corporation, et. al. vs. Court of Appeals, 181 SCRA 410, 420 [1990])

"19.1. In American Wire & Cable Co., vs. Director of Patents (supra, p/ 551), it was observed that:

"19.2. When a newcomer used, without a reasonable explanation, a confusingly similar, if not at all identical, trademark as that of another 'though the field of its selection was so broad, the inevitable conclusion is that it was done deliberately to deceive.' (Del Monte Corporation, et. al. vs. Court of Appeals, supra, p. 419-420)

"20. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent-Applicant of the mark 'MULTIGY'. The denial of the application subject of this opposition is authorized under the IP Code.

"21. In support of the foregoing, the instant Notice of Opposition is herein verified by Mr. Joselito C. Garcia, which will likewise serve as his affidavit. (Nasser vs. Court of Appeals, 191 SCRA 783, 792-793 [1990]).

The Opposer's evidence consists of a copy of the IPO E-Gazette officially released on 07 April 2014; a copy of the Acknowledgement issued by the IPO acknowledging the receipt of the Trademark Application for the trademark MULTI-B on 24 July 2012; a copy of the Certificate of Listing of Identical Drug Product No. DRP-2586-03 for

MULTI-B; a sample product label bearing the trademark MULTI-B actually used in commerce; and a copy of the Certification and sales performance issued by the IMS.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 04 June 2014. Said Respondent-Applicant, however, did not file an Answer.

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

The Opposer anchors its opposition on Sec. 123 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

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;"

Records show that at the time the Respondent-Applicant filed its trademark application on 20 January 2014, the Opposer already filed on 24 July 2012 an application for the mark MULTI-B under Application No 04-2012-009033. The Opposer's trademark application covers pharmaceutical preparations, vitamins in Class 05. However, based on the records of the Intellectual Property Office, of which this Bureau takes cognizance via judicial notice, Respondent-Applicant's mark MULTIGY for use on dietary herbal supplement in Class 05 was registered on 07 July 2011 under Trademark Reg. No. 13654.

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

MULTI-B

Opposer's trademark

MULTIGY

Respondent-Applicant's mark

This Bureau noticed that the pharmaceutical products covered by the marks are closely-related. Designated as MULTIGY, Respondent-Applicant's pharmaceutical

⁴ Marked as Exhibits "A" to "E, inclusive.

products are herbal dietary supplement in Class 05. Opposer's products covered under MULTI-B are pharmaceutical preparations, vitamins. However, confusion or deception is unlikely to occur in this instance. It is obvious that the prefix MULTI in both marks is a normal prefix to mean "more than one" or "multiple", such as such as multifaceted, multi-millionaire, multinational etc. This Bureau cannot sustain the opposition solely on the ground that both marks contain or start with "MULTI". To do so would have the unintended effect of giving the Opposer exclusive right over the prefix "MULTI". To determine whether two marks that contain the prefix "MULTI" are confusingly similar, there is a need to examine the other letters or components of the trademarks. In this regard, when the syllable "GY" is appended to "MULTI", the resulting mark is distinctive enough to be registered. The combination of words and syllables can be registered as trademarks for as long as it can distinguish the goods of a trader from its competitors, although as suggestive mark.


Moreover, in the Trademark Registry, the contents of which the Bureau can take cognizance of via judicial notice, there are registered marks covering pharmaceutical preparations or drugs that have the prefix "MULTI", such as Multi-More with Reg. No. 42011008262, Multi-KNE with Reg. No. 061685, Multi-ION MB with Reg. No. 42001004705, Multi Defense System with Reg. No. 42008002734 and Multi Circle Device with Reg. No. 42008009329, which are owned by entities other than the Opposer.

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.⁵ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2014-00000792 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 06 November 2015.


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

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.