

**BIOMEDIS, INC.,**  
Opposer,

**-versus-**

**JUVENTIS PHARMACEUTICALS  
PHILS., INC.,**  
Respondent-Applicant.

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**IPC No. 14-2010-00173**  
Opposition to:  
Appln. No. 4-2010-000192  
Date Filed: 07 January 2010  
TM: "MEROP'NEM"

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**NOTICE OF DECISION**

**OCHAVE & ESCALONA**  
Counsel for the Opposer  
66 United Street  
Mandaluyong City


**JUVENTIS PHARMACEUTICALS PHILS., INC.**  
Respondent-Applicant  
Unit 6 2/F 8467, West Service Road  
SS-Highway, Sun Valley  
Paranaque City

**GREETINGS:**

Please be informed that Decision No. 2016 - 16 dated January 15, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 15, 2016.

For the Director:

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

BIOMEDIS, INC.,

*Opposer,*

-versus-

JUVENTIS PHARMACEUTICALS  
PHILS., INC.

*Respondent-Applicant.*

IPC No. 14-2010-00173

Case Filed: 16 August 2013

Opposition to:

Application No. 4-2010-000192

Date Filed: 07 January 2010

Trademark: "MEROP'NEM"

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Decision No. 2016- 16

## DECISION

BIOMEDIS, INC.<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-000192. The application, filed by Juventis Pharmaceuticals Phils., Inc.<sup>2</sup> ("Respondent-Applicant"), covers the mark "MEROP'NEM" for use on "*pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; materials for stopping teeth; dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides*" under Class 05 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x   x   x  
"GROUNDS FOR OPPOSITION"

"The grounds for this opposition are as follows:

"1. The trademark 'MEROP'NEM' so resembles 'MEROP' trademark owned by Opposer, which was applied for registration with this Honorable Office prior to the application of the mark 'MEROP'NEM'. The trademark 'MEROP'NEM', which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'MEROP'NEM' is applied for the same class of goods as that of the trademark 'MEROP', i.e. Class (5);

"2. Moreover, the trademark 'MEROP'NEM' is very similar to, if not almost identical, and so resembles the generic name of a pharmaceutical preparation i.e. MEROPENEM.

<sup>1</sup> A domestic corporation organized and existing under the laws of the Republic of the Philippines with principal office located at 108 Rada St., Legaspi Village, Makati City.

<sup>2</sup> A domestic corporation with principal office address at Unit 6 2/F 8467 West Service Road, SS-Highway, Sun Valley, Paranaque City.

<sup>3</sup> The 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.

"3. The registration of the trademark 'MEROP'NEM' in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the 'Intellectual Property Code of the Philippines', which provides, in part, that a mark cannot be registered if it:

x x x

'Under the above-quoted provision, any mark which is similar to a mark with an earlier filing 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, or the mark applied for consists of a generic name, or when the mark is used to designate the characteristics of the goods.

"4. Respondent's use and registration of the trademark 'MEROP'NEM' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'MEROP'.

#### "ALLEGATIONS IN SUPPORT OF THE OPPOSITION

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

"4. Opposer, the registered owner of the trademark 'MEROP', is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'MEROP' was filed with the Intellectual Property Office on 09 January 2008 by Opposer and was approved for registration on 19 January 2009. x x x

"4.1. In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, Opposer registered the products with the Bureau of Food and Drugs (BFAD). x x x

"4.2. A sample of product label bearing the trademark 'MEROP' actually used in commerce is hereto attached x x x

"5. There is no doubt that by virtue of the prior registration of 'MEROP', the Opposer has acquired an exclusive ownership over 'MEROP' mark to the exclusion of all others.

"6. 'MEROP'NEM' is confusingly similar to 'MEROP'.

"6.1 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.

"6.1.1 In fact, in Societe' Des Produits Nestle', S.A. vs. Court of Appeals [356 SCRA 207, 216] the Supreme Court, citing Ethepa v. Director of Patents, 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.

"6.1.2 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 dominance test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks."

"6.1.3 Relative thereto, the Supreme Court in *McDonalds' Corporation vs. L.C. Big Mak Burger, Inc.* [437 SCRA 10] held:

x x x

"6.1.4 Applying the dominance test, it can be readily concluded that the trademark 'MEROP'NEM', owned by Respondent, so resembles the trademark 'MEROP', that it will likely cause confusion, mistake and deception on the part of the purchasing public.

"6.1.4.1 First, 'MEROP'NEM' appears almost the same as 'MEROP';

"6.1.4.1 Second, the entire mark 'MEROP' of the Opposer is in the Respondent's mark 'MEROP'NEM';

"7.1.4.3 Third, both marks are composed of six (6) letters;

"6.1.5 Clearly, the Respondent adopted the dominant features of the Opposer's mark 'MEROP';

"6.1.6 As further ruled by the High Court in *McDonald's* case [p33]

x x x

"6.2 The trademark 'MEROP' and Respondent's trademark 'MEROP'NEM' are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

"6.2.1 Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed trademark 'MEROP'NEM' is applied for the same class and goods as that of the trademark 'MEROP', i.e. Class (5), to the Opposer's extreme damage and prejudice.

"6.3 Yet, Respondent still filed a trademark application for 'MEROP'NEM' despite its knowledge of the existing trademark registration of 'MEROP' which is confusingly similar thereto in both its sound and appearance.

"7. Moreover, Opposer's intellectual property right over its trademark is protected under Section 147 of Republic Act No. 8293, otherwise known as the Philippine Intellectual Property Code ('IP Code'), which states:

x x x

"8. To allow Respondent to continue to market its products bearing the 'MEROP'NEM' mark undermines Opposer's right to its marks. As the lawful owner of the mark 'MEROP', Opposer is entitled to prevent the Respondent from using a confusingly similar mark in the course of trade where such would likely mislead the public.

"8.1 Being the lawful owner of 'MEROP', Opposer has the exclusive right to use and/or appropriate the said marks 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.

"8.2 By virtue of Opposer's ownership of the trademark 'MEROP', it also has the right to prevent the third parties, such as Respondent, from claiming ownership over Opposer's marks or any depiction similar thereto, without its authority or consent.

"8.3 Moreover, following the illustrative list of confusingly similar sounds in trademarks which the Supreme Court cited in McDonald's Corporation, McGeorge Food Industries, Inc. vs. L.C. Big Mak Burger, Inc., 437 SCRA 268 (2004), it is evident that the mark 'MEROP'NEM' is aurally confusingly similar to Opposer's mark 'MEROP'.

"8.4 To allow Respondent to use its 'MEROP'NEM' mark on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the 'MEROP' product of Respondent originate from or is being manufactured by Opposer, or at the very least, is connected or associated with the 'MEROP'NEM' product of Opposer, when such connection does not exist.

"9. Likewise, the fact that Respondent seeks to have its mark 'MEROP'NEM' registered in the same class (Nice Classification 5) as the trademark 'MEROP' of Opposer plus the fact that both are antibacterial will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

"10. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent of the trademark 'MEROP'NEM'. In support of the foregoing, the instant Opposition is herein verified by Mr. Dante Sibug which likewise serves as his affidavit (Nasser v. Court of Appeals, 191 SCRA 783 [1990]).

The Opposer's evidence consists of a copy of the pertinent pages of the IPO E-Gazette officially released on 15 June 2010; a copy of the Certificate of Registration no. 4-2008-000272 for the trademark "MEROP" issued on 19 January 2009; a copy of the Certificate of Product Registration issued by the (BFAD) for the brand name "MEROP"; and, a sample product label bearing the trademark "MEROP".<sup>4</sup>

<sup>4</sup> Marked as Annexes "A" to "D".

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 01 October 2010. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark MEROP'NEM?

The Opposer anchors its opposition on Sections 123.1 paragraphs (d), (h) and (j) and 147 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

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;"

x x x

(h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;

x x x

(j) Consists exclusively of signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services.

Sec. 147. Rights Conferred. - 147.1. The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

Records show that at the time the Respondent-Applicant filed its trademark application on 07 January 2010, the Opposer has an existing trademark registration for the mark MEROP under Certificate of Registration No. 4-2008-000272 issued on 19 January 2009. The registration covers "antibacterial pharmaceutical preparation" in Class 05. On the other hand, Respondent-Applicant's trademark application for the mark MEROP'NEM covers "pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; materials for stopping teeth; dental wax;



disinfectants; preparations for destroying vermin; fungicides, herbicides" under Class 05.

The MEROP'NEM mark, subject of this opposition is reproduced below:

## **MEROP'NEM**

### Respondent-Applicant's mark

Respondent-Applicant adopted the name of or the term used to refer to an ultra-broad-spectrum injectable antibiotic used to treat a wide variety of infections, MEROPENEM<sup>5</sup>, except that it deleted the second letter E and replaced it with an apostrophe (') to come up with the mark MEROP'NEM. Here the word "MEROPENEM" is generic and descriptive for injectable carbapenem antibiotic<sup>6</sup> and therefore cannot be appropriated by Respondent-Applicant for its exclusive use. Sec. 123.1 paragraphs (h) and (j) of the IP Code states:

Sec. 123. Registrability. – 123.1. A mark cannot be registered if it:

x x x

(h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;

x x x

(j) Consists exclusively of signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services.

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

It is emphasized that 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

<sup>5</sup> en.wikipedia.org/wiki/Meropenem.

<sup>6</sup> http://www.medicinenet.com/meropenem-injection/article.htm.

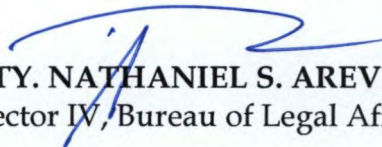
sale of an inferior and different article as his product.<sup>7</sup> This Bureau finds that the mark applied for registration by the Respondent-Applicant does not meet this function.

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1 paragraphs (h) and (j) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-000192 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 January 2016.

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

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<sup>7</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepe v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).