

BIOMEDIS, INC.,
Opposer,

-versus-

EON PHARMATEK, INC.,
Respondent - Applicant.

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IPC No. 14-2014-00432
Opposition to:
Appln. Serial No. 4-2013-005102
Date Filed: 3 May 2013
TM: "ONFLOX"

NOTICE OF DECISION

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


EON PHARMATEK, INC.
Respondent-Applicant
No. 17, 3rd Street, Brgy. Kapitolyo
Pasig City

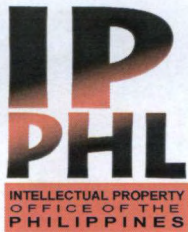
GREETINGS:

Please be informed that Decision No. 2016 - 150 dated May 18, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 18, 2016.

For the Director:


MARILYN F. RETUTAL
IFRS IV
Bureau of Legal Affairs



BIOMEDIS, INC.,
Opposer,

-versus-

EON PHARMATEK, INC.,
Respondent-Applicant.

} IPC NO. 14-2014-00432

} Opposition to:

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} Appln. Ser. No. 4-2013-005102

} Date Filed: 3 May 2013

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} Trademark: "ONFLOX"

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x-----x} Decision No. 2016- 150

DECISION

BIOMEDIS, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2013-005102. The application, filed by EON PHARMATEK, INC. (Respondent-Applicant)², covers the mark "ONFLOX", for use on "Antibacterial Pharmaceutical Preparations" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The trademark 'ONFLOX' filed by Respondent-Applicant so resembles the trademark 'INOFLOX' owned by Opposer and duly registered with the IPO prior to the publication for opposition of the mark 'ONFLOX'.

"8. The mark 'ONFLOX' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'ONFLOX', is applied on the same class and goods as that of Opposer's trademark 'INOFLOX', i.e. Class (5) of the International Classification of Goods as Antibacterial Pharmaceutical Preparations.

"9. The registration of the mark 'ONFLOX' in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides, in part, that a mark cannot be registered if it:

(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:

¹ A domestic corporation duly organized and existing under Philippine laws with address at 6/F Dynavision Bldg., 108 Rada Street, Legaspi Village, Makati City

² A domestic corporation with address at 17, 3rd Street, Bo. Kapitolyo, Pasig City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

- (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;

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 also alleges, among others, the following facts:

"10. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. The trademark application for the trademark 'INOFLOX' was filed with the Bureau of Patents, Trademarks and Technology Transfer on 25 January 1989 by Opposer and was approved for registration by this Office on 18 July 1990 to be valid for a period of twenty (20) years or until 18 July 2010.

"10.2. Before the expiration of the registration, Opposer filed an application for renewal of the registration of the trademark 'INOFLOX' with the IPO, which was approved to be valid for another period of ten (10) years from 18 July 2010, or until 18 July 2020.

"10.3. Thus, the registration of the trademark 'INOFLOX' subsists and remains valid to date.

"11. The trademark 'INOFLOX' has been extensively used in commerce in the Philippines.

"11.1. Opposer has dutifully filed Affidavits of Use pursuant to the requirement of the law.

"11.2. A sample of product packaging label bearing the trademark 'INOFLOX' actually used in commerce is hereto attached and made an integral part hereof.

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

"11.4. By virtue of the foregoing, there is no doubt that the Opposer has acquired exclusive ownership over the trademark 'INOFLOX' to the exclusion of all others.xxx

"12. The registration of the mark 'ONFLOX' will be contrary to Section 123.1 (d) of the IP Code. 'ONFLOX' is confusingly similar to the Opposer's trademark 'INOFLOX'."

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of IPO e-Gazette showing the Respondent-Applicant's trademark application;
2. Copy of Certificate of Registration No. 48600 dated 18 July 1990 for the mark "INOFLOX" for goods under class 5 namely "Broad spectrum bactericidal preparations" ;
3. Copy of Certificate of Renewal of Registration for the mark "INOFLOX";
4. Copies of Affidavits of Use dated 27 June 1995; 16 August 2000 and 21 September 2005;
5. Sample packaging label of the product "INOFLOX"; and
6. Copy of Certificate of Product Registration from the Food and Drugs Administration dated 15 May 2013⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 10 October 2014. On 14 October 2014, the Respondent-Applicant filed a letter addressed to the Director of the Bureau of Trademarks, as purportedly an Answer to the Notice of Opposition, but failed to attach a Verification, Special Power of Attorney or proof of authority. Thus, the Bureau on 7 November 2014, issued Order No. 2014-1422 declaring the Respondent-Applicant in default.

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

Records show that at the time Respondent-Applicant applied for registration of the mark "ONFLOX" the Opposer already registered the mark "INOFLOX" under Certificate of Registration No. 48600⁵ dated 18 July 1990. The goods covered by the Opposer's trademark registration are also under Class 05, namely: "Broad spectrum bactericidal preparations", while the Respondent-Applicant's trademark application indicates use as "antibacterial pharmaceutical preparations".

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:

Inoflox

Opposer's mark

ONFLOX

Respondent-Applicant's mark

⁴ Exhibits "A" to "H"

⁵ Exhibit "B"

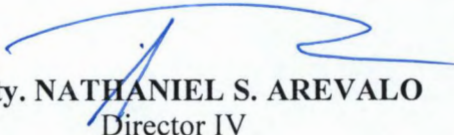
The marks are phonetically similar with respect to the last syllable ("FLOX") and two letters in their prefixes "O" and "N". Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. It is noteworthy that the generic or non-proprietary name of the Opposer's drug is OFLOXACIN, as seen from a reproduction of the packaging⁶.

Thus, the syllable "OFLOX" is the prefix of the generic name. Predictably, the letters "IN", used by the Opposer as its prefix is the last two letters of the generic name. On the other hand, the Respondent-Applicant in creating its mark inserted the letter "N" in between the prefix "OFLOX" of the drug's generic name. When the prefixes "INO and "ON" are appended, the resultant marks are not confusingly similar. The consumer can easily discern the visual and aural differences between the two (2) marks.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-005102 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **18 MAY 2016**


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

⁶ Opposer's Annex "G"; Respondent-Applicant's Annex "2"