

BIOMEDIS INC.,
Opposer,

-versus-

CARELS PHARMACEUTICAL, INC.,
Respondent- Applicant.

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} **IPC No. 14-2012-00055**
} Opposition to:
} Appln. No. 4-2011-011658
} Date Filed: 29 September 2011
} **TM: "NALPENT"**

NOTICE OF DECISION

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

CARELS PHARMACEUTICAL, INC.
Respondent-Applicant
Unit 1402 Centerpoint Building
Garnet Street, Pasig City

GREETINGS:

Please be informed that Decision No. 2016 - 138 dated May 05, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 05, 2016.

For the Director:

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

BIOMEDIS INC.,
Opposer,

-versus-

CARELS PHARMACEUTICAL, INC.,
Respondent-Applicant.

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} Opposition to:

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} Appln. Ser. No. 4-2011-011658

} Date Filed: 29 September 2011

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} Trademark: "NALPENT"

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DECISION

BIOMEDIS INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-011658. The application, filed by CARELS PHARMACEUTICAL, INC., (Respondent-Applicant)², covers the mark "NALPENT", for use on "analgesic pharmaceutical preparation" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"1. The trademark 'NALPENT' so resembles 'NALPHINE' owned by Opposer, which was applied for registration with this Honorable Office prior to application of the mark 'NALPENT', 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 'NALPENT' is applied for the same class and good as that of trademarks 'NALPHINE', i.e. Class (5) used as analgesic.

"2. The registration of the trademark 'NALPENT' in the name of the Respondent will violate Sec. 123 of Republic Act 8293, otherwise known as the 'Intellectual property Code of the Philippines', 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:

- (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;

¹ A corporation duly organized and existing under Philippine laws with address at 108 Rada St., Legaspi Village, Makati City

² A domestic corporation with address at Unit 1402 Centerpoint Bldg., Garnet St., 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.

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.

“3. Respondent’s use and registration of the trademark 'NALPENT' will diminish the distinctiveness and dilute the goodwill of Opposer’s trademark 'NALPHINE’.

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 4-2006-005234 dated 26 March 2006 for the mark “NALPHINE”;
3. Copy of Declaration of Actual Use dated 15 February 2009;
4. Sample product label of “NALPHINE”; and
5. Copy of Certificate of Product Registration issued by the Bureau of Food and Drugs dated 11 March 2011⁴

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 3 May 2011. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 26 September 2012 Order No. 2012-1309 declaring the Respondent-Applicant to have waived its right to file an Answer.

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 9 February 2012. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 15 February 2013, Order No.2013-280 declaring the Respondent-Applicant to have waived its right to file an Answer.

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

Records show that at the time Respondent-Applicant applied for registration of the mark “NALPENT” the Opposer already registered the mark “NALPHINE” under of Registration No. 4-2006-005234 dated 26 March 2006. The goods covered by the Opposer’s trademark registration are also under Class 05, namely: “medicinal preparation for use as analgesic, while the Respondent-Applicant’s trademark application indicates use as “analgesic pharmaceutical preparation”.

The competing marks are reproduced below:

⁴ Exhibits "A" to "E"

Nalphine

NALPENT

Opposer's mark

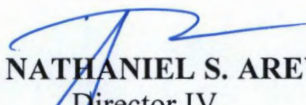
Respondent-Applicant's mark

The marks are similar with respect to five letters "N"- "A"- "L"- "P" and "E" in the suffix. Such similarities however, are not sufficient to conclude that confusion among the consumers is likely to occur. The Opposer argues that the mark NALPENT cannot be registered because it is confusingly similar to its mark NALPHINE. Evidence reveal that the generic and/or descriptive term for the pharmaceutical product the mark identifies is NALBUPHINE hydrochloride. NALBUPHINE is a generic name and is listed in the WHO Chronicle as International Nonproprietary Names (INN) for Pharmaceutical Products⁵. The Opposer concocted the first and last syllables to form the prefix and suffix of its product, NALPHINE. It is not uncommon, that registered owners of pharmaceutical products add, substitute letters, play on the syllables of the INN or generic names of drugs to create their unique brand name. The Respondent-Applicant merely appropriated the first three letters of the generic name and created its own suffix PENT. Respondent-Applicant's mark NALPENT is creative and unique and is not considered confusingly similar to Opposer's mark NALPHINE, which is a close replication of the generic name NALBUPHINE, without the second syllable "BU". Therefore, the use of Respondent-Applicant of the mark NALPENT will not result to a likelihood of confusion.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-011658 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, 05 MAY 2016.


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

⁵ Exhibit "H"