



PEDIATRICA, INC.,
Opposer,

-versus-

PRESTIGE BRANDS INTERNATIONAL, INC.,
Respondent- Applicant.

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IPC No. 14-2013-00022
Opposition to:
Appln.Serial No. 4-2012-000034
Date Filed: 02 January 2012
TM: "PEDIACARE"

X-----X

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 131 dated May 03, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 03, 2016.

For the Director:

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

PEDIATRICA, INC,
Opposer,

-versus-

IPC No. 14-2013-00022
Opposition to Trademark
Application No. 4-2012-000034
Date Filed: 02 January 2012

PRESTIGE BRANDS INTL., INC.
Respondent-Applicant.

Trademark: "**PEDIACARE**"

x ----- x Decision No. 2016- 131

DECISION

Pediatrica, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-000034. The contested application, filed by Prestige Brands International, Inc.² ("Respondent-Applicant"), covers the mark "PEDIACARE" for use on *"pharmaceutical products for children, namely: products for colds, cough, runny nose, flu, sore throat, congestion, fever, pain, allergy and gas relief"* under Class 05 of the International Classification of Goods³.

The Opposer anchors its opposition on Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines (IP Code). It claims to be the owner of the mark "PEDIATECH", registered under Certificate of Registration No. 4-2005-000437 issued on 01 December 2007. It contends that "PEDIATECH" and "PEDIACARE" appears and sounds almost the same and are similar with respect to their first five letters as well as with the number of letters and syllables composing the marks. It asserts that since the Respondent-Applicant seeks to register "PEDIACARE" also in Class 05, coupled by the fact that the competing marks pertain to pharmaceutical product for cough, colds, decongestants, nasal preparations and analgesics, among others, there will be confusion among the purchasers. In support its Opposition, the Opposer submitted the following as evidence:

1. the Respondent-Applicant's mark published for opposition;
2. certified true copy of Trademark Registration No. 4-2005-000437;
3. certified true copy of the Declaration of Use and Affidavit of Use; and

¹ A domestic corporation duly office address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

² A foreign corporation organized under the laws of the State of Virginia, United States of America (USA) with principal place of business at 660 White Plain Road, Tarrytown, New York, 10591, USA (formerly with address at 90 North Broadway, Irvington, New York 10533, USA).

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

4. sample product labels bearing the trademark "PEDIATECH"⁴

The Respondent-Applicant filed its Answer on 24 April 2013 alleging, among others, that confusion of products or origin is unlikely because the marks "PEDIACARE" and "PEDIATECH" are neither identical nor confusingly similar. It contends that the term "PEDIA", which is common to both marks, is derived from the words "PEDIATRICS" or "PEDIATRICIAN". It asserts that since "PEDIA" is descriptive, the dominant element of its mark is "CARE" while that of the Opposer's is "TECH". It also avers that the Opposer is barred from claiming that the marks are confusingly similar as the latter previously stated during the application of the mark "PEDIATECH" that the said mark is not confusing with "PEDIA CARE" of Johnson and Johnson. The Respondent-Applicant's evidence consists of the following:

1. sworn statement of Samuel C. Cowley;
2. certification in duplicate;
3. certified true copy of the Registrability Report (Paper No. 2) issued in Application No. 4-2005-000437 for "PEDIATECH"; and
4. certified true copy of the response dated 22 August 2006.⁵

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. The parties, however, refused to mediate. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on 10 February 2015. The parties were directed to submit their respective position papers. After which, the case is deemed submitted for decision.

The primordial issue in this case is whether the trademark "PEDIACARE" should be allowed.

Records reveal that at the time the Respondent-Applicant filed an application for "PEDIACARE" on 02 January 2012, the Opposer has a valid and existing registration of "PEDIATECH" under Certificate of Registration No. 4-2005-000437 issued on 01 December 2007 for use on *"baby care products namely: baby soap, shampoo, bath liquid, oil cologne, lotion, powder; soaps, cologne oils, cosmetics, hair shampoo, hair conditioner for all ages"* and *"pharmaceutical and nutritional preparations namely: analgesics and antipyretics, antirheumatic, anti-inflammatory analgesics, antacids, antiulcerants, git regulators, antiflatulents and anti-inflammatories, antipasmotics, antidiarrheals, laxatives, purgatives, digestives, cholagogues, cholelitholytics and hepatic protectors, respiratory stimulants, antiasthmatic preparations, cough and cold remedies, decongestants and other nasal preparations, other drugs acting on respiratory system, aminoglycosides,*

4 Marked as Exhibits "A" to "D-1".

5 Marked as Exhibits "1" to "4".

cephalosporins, chloramphenicols, macrolides, penicillins, quinolones, tetracyclines, antifungals, antibacterial combinations, other antibiotics, antituberculosis agents, gulphonamides, antiamebics, anthelmintics, antileprotics, antivirals, antineoplastic, antimalarials, filaricides, vitamin a, vitamin d, vitamin e, vitamin b`s with c, vitamin c, calcium with vitamins, multivitamins with minerals, vitamins with hormones, electrolytes and minerals, antianemics, infant/follow-on formulae, enteral/nutrition products, parenteral nutrition, tonics, appetite stimulants, antiobesity agents, mouth/throat preparations, anti-infectives, anti-infectives with corticosteroids, topical corticosteroids, acne treatment preparations, antiseptics and disinfectants, medicated surgical dressings, fungicides, and antiparasites, topical antivirals, keratolytics, skin protectives, antihistamines/antipruritics antihistamines and antiallergics, vaccines, immunosuppressants, cardiac drugs, anti-anginal drugs, ace-inhibitors/other hypertensives, beta blockers, calcium antagonists, diuretics, antidiuretics, peripheral vasodilators and cerebral activators, vasoconstrictors, migraine drugs, haemostatics, anticoagulants, antithrombotics and fibrinolytics, haemorrhoidal, phlebitis and varicose preparations, haemorrhologicals, haematopoietic agents, other cardiovascular drugs, tranquilizers, hypnotics and sedatives, anticonvulsants, antidepressants, cns stimulants, nootropics and neurotonics, antiemetic and antivertigo drugs, neuromuscular disorder drugs, muscle relaxants, corticosteroids hormones, anabolic agents, other hormone related drugs, insulin, oral antidiabetic agents, thyroid preparations, antithyroids, antihyperlipidaemic agents, eye anti-infectives and antiseptics, eye corticosteroids, eye antiseptics with corticosteroids, miotics drugs, mydriatics, drugs, glaucoma preparations, ear anti-infectives and antiseptics, ear corticosteroids, ear antiseptics with corticosteroids, oral rehydration salts”.

Section 123.1(d) of the IP Code, relied upon by Opposer, provides that:

"Section 123.1. 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 x x x”***

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown hereafter for comparison:

PediaTech **PEDIACARE**

Opposer's mark

Respondent-Applicant's mark

Upon scrutiny of the subject trademarks, it can be readily gleaned that both begin with "PEDIA". In this regard, the Respondent-Applicant contends that the said term is derived from "PEDIATRICS" or "PEDIATRICIAN". It is noteworthy that both Opposer's and Respondent-Applicant's trademarks pertain to pharmaceutical products for children as explicitly stated in their respective registration and/or application. The sample labels⁶ submitted by the Opposer for "Nutralin" and "Biogesic for Kids" also indicates that the same are intended for children. A trademark which appropriates the "PEDIA" and is used on this line of products is a suggestive mark; therefore, a weak mark. A mark or brand name itself gives away or tells the consumers the goods or service and/or the kind, nature, use or purpose thereof.

What easily comes to the mind one when one sees or hears a mark or brand name of oral antiseptics of which the prefix "PEDIA" is a part of is the very concept or idea of the goods. What will set apart or distinguish such mark from another which also includes the same letters or syllables on products for kids are the letters, words or devices that accompany "PEDIA". In this case, it will be highly unlikely that the consumers will be misled, confused or deceived that the Respondent-Applicant's goods came from or are connected to or associated with that of the Opposer's. The Opposer's mark uses "TECH" after the "PEDIA" while the Respondent-Applicant appropriates "CARE". The words "TECH" and "CARE" are easily distinguishable in view of their clear and obvious differences in spelling, pronunciation and meaning.

While the combination of the words "PEDIA" and "TECH" may have resulted in a mark that possesses distinctive quality which rendered it registrable, such mark is only considered a suggestive mark. It is a weak mark if ranged against another mark which, while bearing some resemblance, is endowed with other characteristics and features capable of distinguishing the same.

Finally, 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 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

⁶ Marked as Exhibits "D" and "D-1".

protect the manufacturer against substitution and sale of an inferior and different article as his product.⁷ This Bureau finds that Respondent-Applicant's trademark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-000034 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 03 MAY 2016


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

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.