

BIOMEDIS, INC.,
Opposer,

-versus-

SUN PHARMA PHILIPPINES, INC.,
Respondent- Applicant.

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IPC No. 14-2013-00393
Opposition to:
Appln. Serial No. 4-2013-00007320
Date Filed: 24 June 2013
TM: "DECITEX"

NOTICE OF DECISION

OCHAVE & ESCALONA
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SUN PHARMA PHILIPPINES, INC.
Respondent-Applicant
Unit 604, 6th Floor, Liberty Center Building
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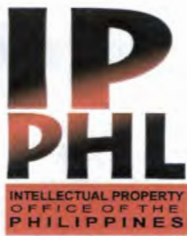
GREETINGS:

Please be informed that Decision No. 2016 - 191 dated June 27, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 27, 2016.

For the Director:

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



BIOMEDIS, INC.,

Opposer,

- versus -

SUN PHARMA PHILIPPINES, INC.,

Respondent-Applicant.

X-----X

IPC NO. 14 - 2013 - 00393

Opposition to:
Trademark Application Serial No.
4201300007320

TM: "DECITEX"

DECISION NO. 2016 - 191

DECISION

BIOMEDIS, INC. (Opposer)¹ filed an Opposition to Trademark Application Serial No. 4-2013-00007320. The trademark application filed by SUN PHARMA PHILIPPINES, INC. (Respondent-Applicant)², covers the mark DECITEX for services under Class 5 of the International Classification of Goods³ particularly, "*pharmaceutical preparation.*"

The Opposer's based its Opposition on the following grounds:

- 1.) The mark "DECITEX" applied for by Respondent-Applicant so resembles the trademark "DOCETAX" owned by Opposer and by duly registered with this Honorable Bureau prior to the publication of the application for the mark "DECITEX."
- 2.) The mark "DECITEX" will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark "DECITEX" is applied for the same class and goods as that of Opposer's trademark "DOCETAX."
- 3.) The registration of the mark "DECITEX" in the name of the Respondent-Applicant will violate Sec. 123.1 (d) of the IP Code.

¹ A domestic corporation duly organized and existing under the laws of Philippines with office address located at 108 Rada St, Dynavision Building, Legaspi Village, Makati City, Metro Manila.

² A domestic corporation with office address located at Unit 604, 6th Floor, Liberty Center Building, 104 H.V. Dela Costa St. Salcedo Village, Makati City, Metro Manila.

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.*

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- 4.) Respondent-Applicant's use and registration of the mark "DECITEX" will deminish the distinctiveness of Opposer's trademark "DOCETAX."

To support its Opposition, the Opposer submitted the following exhibits:

Exhibit "A" – Print-out copy of the page of IPOPHL e-gazette dated 22 August 2013; and

Exhibit "B" –Copy of the Certificate of Registration of the Opposer for the Trademark DOCETAX;

This Bureau served a Notice to Answer to the Respondent-Applicant on 30 October 2013. However, the Respondent-Applicant did not file an answer to the Opposition. In view of the failure to file an Answer, an Order dated 7 February 2014 was issued declaring the Respondent-Applicant in default. Consequently, this case was deemed submitted for decision.

The issue in the present case is whether to allow the registration of herein Respondent-Applicant "DECITEX" trademark.

The instant opposition is anchored on Section 123.1, paragraph (d), of the IP Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

The Opposer argues that "DECITEX" is confusingly similar to Opposer's trademark "DOCETAX" and being applied for the same class and goods. Opposer further argues that Respondent-Applicant's use of the mark "DECITEX" 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 "DOCETAX", will undermine the distinctive character or reputation of the latter's trademark.

The trademarks subject of the instant case are reproduced below for examination.

DOCETAX

Opposer's Trademark

DECITEX

Respondent's – Applicant's Trademark

Upon perusal of the two competing trademarks and the evidence submitted by the Opposer, this Bureau finds the Opposition meritorious.

Five (5) of the seven (7) letters of the competing wordmarks, specifically, "D", "E", "C", "T" and "X", are the same. They both have three (3) syllables. The close similarities in the syllables and phonetic effects of the identical arrangements of the consonants in the two trademarks create the same impression on the buying the public. The negligible differences in the vowels of the marks are not enough to distinguish the two word marks from each other.

Our Supreme Court has consistently held that trademarks with *idem sonans* or similarities of sounds are sufficient ground to constitute confusing similarity in trademarks.⁴ The Court has ruled that the following words: Duraflex and Dynaflex;⁵ Lusolin and Sapolin;⁶ Salonpas and Lionpas;⁷ and Celdura and Cordura⁸ are confusingly similar. In addition, the Supreme Court, citing Unfair Competition and Trade Marks, 1947, vol. 1 by Harry Nims, recognized the confusing similarities in sounds of the following trademarks: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jazz-Sea"; "Silver Flash" and "Supper-Flash"; "Cascarete" and Celborite"; "Celluloid and Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and Fermetex"; and "Zuso" and "HooHoo."⁹ Evidently, the subject trademarks "DECITEX" and "DOCETAX" fall squarely within the purview of this *idem sonans* rule.

Moreover, this Bureau also finds that the goods subject of the competing trademarks, are similar and/or closely related. There is the likelihood that the product of the Respondent-Applicant may be confused with the Opposer's. The public may even be deceived that Respondent-Applicant's products originated from the Opposer, or that there is a connection between the parties and/or their respective goods.

The field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of design available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.¹⁰

Time and again, it has been held in our jurisdiction that the law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for purposes of the law that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.¹¹ Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.¹² Because the respondent-applicant will use his mark on goods that are similar and/or closely related to the opposer's, the consumer is likely to assume that the

⁴ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

⁵ American Wire & Cable Company vs. Director of Patents and Central Banahaw Industries, G.R. L-26557 18 February 1970

⁶ Sapolin Co. vs. Balmaceda, 67 Phil 795

⁷ Marvex Commercial Co., Inc. vs. Petra Hawpa and Co, G.R. No. L-19297, 22 December 1966

⁸ Co Tiong vs. Director of Patents, 95 Phil 1

⁹ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

¹⁰ American Wire & Cable Company vs. Dir. Of Patent, G.R. No. L-26557, February 18, 1970.

¹¹ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

¹² Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992


respondent-applicant's goods originate from or sponsored by the opposer or believe that there is a connection between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:¹³

Callman notes two types of confusion. 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 be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

WHEREFORE, premises considered, the instant opposition to Trademark Application Serial No. 4201300007320 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4201300007320 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 27 JUN 2016


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

¹³ Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987