

BIOMEDIS, INC.,
Opposer,

-versus-

SUHITAS PHARMACEUTICALS INC.,
Respondent- Applicant.

X-----X

} **IPC No. 14-2015-00321**
} Opposition to:
} Appln. Serial No. 4-2015-00002118
} Date Filed: 27 February 2015
} **TM: "OSTEONATE"**

NOTICE OF DECISION

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

SUHITAS PHARMACEUTICALS, INC.
Respondent-Applicant
3rd Floor Centrepoint Building
Pasong Tamo corner Export Bank Drive
Makati City

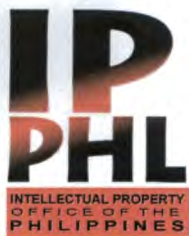
GREETINGS:

Please be informed that Decision No. 2016 - 212 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 30, 2016.

For the Director:

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



BIOMEDIS, INC.,
Opposer,

- versus -

SUHITAS PHARMACEUTICALS INC.,
Respondent-Applicant.

x ----- x

IPC No. 14-2015-00321

Opposition to:

Appln. No. 4-2015-00002118
Date Filed: 27 February 2015
Trademark : "OSTEONATE"

Decision No. 2016 - 212

DECISION

BIOMEDIS, INC. ("Opposer"),¹ filed on 08 July 2015 a verified opposition to Trademark Application Serial No. 4-2015-00002118. The application, filed by SUHITAS PHARMACEUTICALS INC. ("Respondent-Applicant")², covers the mark "OSTEONATE" for use on goods under class 05³ namely: *pharmaceutical (anti-osteoporosis)*.

The Opposer alleges the following grounds for opposition:

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

"8. The mark 'OSTEONATE' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'OSTEONATE' is applied for the same class and goods as that of Opposer's trademark 'OSTEOMET', i.e. Class 05 of the International Classification of Goods as Pharmaceutical Preparation for Bone Disease/Anti-Osteoporosis.

"9. The registration of the mark 'OSTEONATE' 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:

- (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;**
- (Emphasis supplied)

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

² A domestic corporation with address at 3rd Floor Centrepoint Bldg., Pasong Tamo cor. Export Drive, Makati City, Philippines.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

"10. 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's evidence consists of the following:

1. Copy of pertinent page of IPO E-Gazette containing Respondent-Applicant's trademark application; and,
2. Certified true copy (Ctc) of Certificate of Registration No. 4-2012-000847 for OSTEOMET.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer dated 23 July 2015 which was received by the Respondent-Applicant on 03 August 2015. However, this Bureau did not receive an answer and thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision.

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

Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property Code ("IP Code") 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 if it nearly resembles such mark as to be likely to deceive or cause confusion.

Records show that Opposer's registration for the trademark OSTEOMET on 24 May 2012⁴, preceded that of Respondent-Applicant's application for the registration of its trademark OSTEONATE on 27 February 2015.⁵

But are the competing marks, shown below, resemble each other such that confusion, or even deception, is likely to occur?

OSTEOMET

Osteonate

Opposer's Trademark

Respondent-Applicant's Trademark

The competing marks both consists of three syllables - Opposer's "OS/TEO/MET" and Respondent-Applicant's "OS/TEO/NATE". The similarity lies with the syllables "OS/TEO"; and the ending letter "T" both found in OSTEOMET and OSTEONATE, which leaves a prominent similar ending sound.

There is sufficient reason to infer or conclude that "OS/TEO" is derived from the illness intended to be treated by the competing pharmaceutical products, for bone disease or osteoporosis. This observation is supported by the Certificate of Registration of the trademark OSTEOMET submitted by

⁴ Exhibit "B" of Opposer.

⁵ Filewrapper records.

the Opposer as evidence⁶, and the filewrapper record of the instant application, which indicates the goods/services covered by the respective marks.

OSTEOMET thus, is not a highly distinctive as a trademark. At most, it is considered a suggestive mark, which is a weak mark. What will set apart or distinguish such mark from another mark which also includes the same syllables "OS/TEO" are the ending syllable "MET" for the Opposer's; and "NATE" for the Respondent-Applicant's. In this instant, it is very likely that a consumer will be misled or confused is the aural effect of the ending letter "T" which creates perplexity in the over-all sound produced by the competing marks.

Succinctly, because the coverage of the Respondent-Applicant's trademark application would allow using the mark OSTEONATE on goods or pharmaceutical products that are similarly dealt in by the Opposer using the mark OSTEOMET, the minute changes in spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. The competing marks have similarity in sounds, which make it not easy for one to distinguish one mark from the other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound, however, is practically replicated when one pronounces the other mark.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, 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.⁷ 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:⁸

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 on 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 of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, 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.

Finally, it must be emphasized that the Respondent-Applicant was given opportunity to defend its trademark application. It, however, failed to do so. Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

⁶ Id. at 4.

⁷ American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.

⁸ Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2015-00002118 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City **30 JUN 2016**


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