

ARES TRADING, S.A.,
Opposer,

-versus-

SRS PHARMACEUTICALS PHILS. INC.,
Respondent- Applicant.

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IPC No. 14-2013-00200
Opposition to:
Appln. No. 4-2012-014296
Date Filed: 23 November 2012
TM: "ZEXIF"

NOTICE OF DECISION

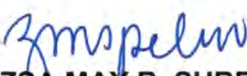
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GREETINGS:

Please be informed that Decision No. 2016 - 326 dated 23 September 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 23 September 2016.


Atty. ZSA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

ARES TRADING, S.A.,

Opposer,

-versus

SRS PHARMACEUTICALS PHILS. INC.,

Respondent-Applicant.

X ----- X

IPC No. 14-2013-00200

Opposition to Trademark

Application No. 4-2012-014296

Date Filed: 23 November 2012

Trademark: **"ZEXIF"**

Decision No. 2016- 326

DECISION

Ares Trading, S.A.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-014296. The contested application, filed by SRS Pharmaceuticals Phils. Inc.² ("Respondent-Applicant"), covers the mark "ZEXIF" for use on *"pharmaceutical and medical preparations for the treatment of infections and diseases, illness and ailments, health, food and dietary supplements, home remedy and herbal preparations, food products, medical devices, sanitary preparations; dietetic substances adapted for medical use, food for babies"* under Class 05 of the International Classification of Goods³.

The Opposer claims to be the prior adopter, user and owner of the trademark "REBIF". In the Philippines, it registered the marks "REBIF" and "REBIF MAN LOGO" under Certificate of Registration Nos. 4-2001-6157, 4-1993-429902, 4-2002-7773, 4-2002-7771 and 4-2002-7772 issued, respectively, on 09 October 2006, 29 March 1995, 26 February 2006, 20 November 2005 and 26 February 2006. According to the Opposer, "REBIF" (interferon beta-1a) is a self-injected relapsing multiple sclerosis ("MS") therapy to decrease the frequency of relapse and delay the occurrence of some of the physical disability that is common in people with MS. The drug was approved in Europe in 1998 and in the United States in 2002. The mark is registered in more than eighty (80) countries worldwide.

The Opposer contends that "REBIF" and "ZEXIF" are confusingly similar as the Respondent-Applicant merely changed the letters "R" and "B", respectively, to "Z" and "X". It points out that both marks are composed of five letters and two syllables. It also asserts that confusion is highly likely as both marks cover similar or

¹ A corporation duly organized and existing under the laws of Switzerland with principal office address Zone Industrielle De L'Ouriettaz, 1170, Aubonne, Switzerland.

² With office address at Unit 1903 Jollibee Plaza Condominium, F. Ortigas Center, Pasig City, Manila, Philippines.

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.

related goods. In support of its Opposition, the Opposer submitted the following as evidence:⁴

1. certified copy of the its trademark registrations;
2. notarized affidavit of Jessica Schmidt and Steffen Schaffner, with annexes; and,
3. affidavit-direct testimony of Atty. John Ryan E. Seguit.

The Respondent-Applicant filed its Answer on 22 August 2013 denying that its mark "ZEXIF" is confusingly similar with the Opposer's mark "REBIF". It argues that the competing marks are composed of two syllables, which are entirely distinct from each other. It also believes that the goods of the Opposer are not always available and sold together with its own. It further posits that since the products involved are sold in pharmacies where prescriptions are required and pharmacies are present, there is no possibility of confusion or deception.

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. The parties, however, failed to mediate. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on 05 February 2014. The parties were then directed to submit their respective position papers. After which, the case is deemed submitted for decision.

The issue is whether the Respondent-Applicant's mark "ZEXIF" should be allowed registration.

Records reveal that at the time the Respondent-Applicant filed the contested application on 23 November 2012, the Opposer has valid and existing registrations for the marks "REBIF" and "REBIF MAN LOGO" issued as early as 20 November 2005.

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

Opposer's marks:



⁴ Marked as Exhibits "B" to "E", inclusive.

REBIF  *Rebif*

Respondent-Applicant's mark:

ZEXIF

There is no question that the Opposer's man logo is different from the Respondent-Applicant's mark "ZEXIF". As to the Opposer's word mark, the manifest similarities between the competing marks are the second letter "E" and ending letters "IF". These similarities, however, are insufficient to arrive at a conclusion that the marks are confusingly similar. When appreciated in their entirety, the marks "REBIF" and "ZEXIF" are different visually, aurally and/or in connotation. The confusion or mistake, much less deception, is improbable in this case bolstered by the fact that the competing marks pertain to pharmaceutical products, which sale and dispensing require the assistance of pharmacists. Since the "REB" before the similar ending letters "IF" in the Opposer's mark is easily differentiated from "ZEX" in the Respondent-Applicant's, it is very unlikely for a pharmacist to commit a mistake in reading the prescription.

Moreover, it is doubtful if the consumers in encountering the mark "ZEXIF" will have in mind or be reminded of the trademark "REBIF". The Opposer has not established by substantial evidence that "REBIF" is a well-known mark or that its mark's fame could support the claim that Respondent-Applicant's trademark application and use of the mark "ZEXIF" manifest the latter's intent of riding in on the goodwill supposedly earned and enjoyed by the former. Furthermore, the Trademark Registry of this Office reveals several other trademarks under Class 05 that employ the final letters "IF" in their trademarks including "BOSULIF", "NASALIF", "LERIF" and "LEDERRIF", all belonging to different proprietors. Hence, similarity in this aspect alone is not enough to prevent a junior user registration of its mark provided that the later mark is endowed with other distinguishing features and characteristics such as that of the Respondent-Applicant's.


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 protect the manufacturer against substitution and sale of an inferior and different article as his product.⁵ The Respondent-Applicant's trademark sufficiently met this requirement.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-014296 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 SEP 2016


ATTY. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.