

PHARMA NUTRIA N.A. INC.,  
Opposer,

-versus-

PHIL. SHINPOONG PHARMA, INC.,  
Respondent- Applicant.

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}  
} IPC No. 14-2015-00553  
} Opposition to:  
} Application No. 4-2015-003311  
} Date Filed: 26 March 2015  
} Trademark: "CLAMOXIN"  
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}

**NOTICE OF DECISION**


**LORELIE ENYA J. MENESES**  
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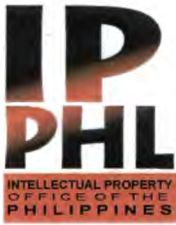
**PHIL. SHINPOONG PHARMA, INC.,**  
Respondent-Applicant  
Unit 2314 Medical Ortigas Building  
San Miguel Avenue, Ortigas Center  
Pasig City

**GREETINGS:**

Please be informed that Decision No. 2016 - 377 dated October 13, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 13, 2016.

  
**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs



PHARMA NUTRIA N.A. INC.,  
*Opposer,*

IPC NO. 14-2015-00553

versus-

Appln. Ser. No. 4-2015-003311

Filing Date: 26 March 2015

PHIL. SHINPOONG PHARMA, INC.,  
*Respondent-Applicant.*

Trademark: CLAMOXIN

x-----x

Decision No. 2016 - 377

### DECISION

PHARMA NUTRIA N.A. INC.,<sup>1</sup> ("Opposer") filed an Opposition to Trademark Application No. 4-2015-003311. The application, filed by PHIL. SHINPOONG PHARMA, INC.<sup>2</sup> ("Respondent-Applicant"), covers the mark CLAMOXIN for use on "*pharmaceutical preparations, agents for infectious disease*" under Class 05 of the International Classification of goods<sup>3</sup>.

Opposer alleges that it is the registrant of the trademark "CLAVOXIN" under Certificate of Registration No. 1625 issued on 09 June 2008 and Certificate of Registration No. 11971 issued on 26 December 2013. Opposer also claims that it is the prior or earlier user of the trademark "CLAVOXIN" having utilized the same since 14 June 2007. According to Opposer, Respondent-Applicant's mark "CLAMOXIN" bears a very strong resemblance aurally to Opposer's registered trademark "CLAVOXIN" that to allow its registration will result in confusion, mistake and deception on the part of the purchasing public and considering that it is being applied under exactly the same class of goods, will contravene of Sec. 123.1.(d) of the Intellectual Property Code.

The Opposer's evidence consists of the following:

1. Exhibit "A" - Printout of two (2) pages of IPO E-Gazette which was officially released on 12 October 2015;
2. Exhibit "B" - Copy of Certificate of Reg. No. 4-2008-001625 for the trademark CLAVOXIN issued on 09 June 2008;
3. Exhibit "C" - Copy of Certificate of Reg. No. 4-2013-011971 for the trademark CLAVOXIN issued on 26 December 2013;
4. Exhibit "D" - Copy of the Actual Declaration of Actual Use of trademark CLAVOXIN;
5. Exhibits "E" - List of Customers for the product CLAVOXIN;

<sup>1</sup> A corporation duly organized and existing under the laws of the Philippines with principal S.V. More Group Corporate Center, #16 Scout Tuason Street cor. Roces Avenue, Brgy. Laging Handa, Quezon City

<sup>2</sup> A domestic corporation with office address at Unit 2314 Medical Ortigas Building, San Miguel Avenue, Ortigas Center, Pasig City.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE

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6. Exhibit "F" - sample product packaging bearing the mark CLAVOXIN, sales order, invoices;
7. Exhibits "G" - printout of CLAVOXIN product information from the website <http://www.thefilipinodoctor.com>;
8. Exhibit "H" - printout of the application details of Respondent-Applicant for the mark CLAMOXIN;
9. Exhibit "I" - printout of the details of FDA registration of CLAMOXIN from the website of FDA and C; and
10. Exhibit "I-2" - copy of the Certificate of Product Registration of the drug CLAVOXIN.

This Bureau issued on 09 December 2015 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant on 07 January 2016. The Respondent-Applicant, however, did not file the Answer. On 18 July 2016, this Bureau declared Respondent-Applicant in default. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark CLAMOXIN?

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.<sup>4</sup> Thus, Sec. 123.1 (d) of the 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 or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its application for the mark CLAMOXIN on 26 March 2015, the Opposer already has an existing registration for the trademark CLAVOXIN issued as early as 09 June 2008. Opposer's mark is used on goods falling under Class 05, namely, "*medicines, pharmaceutical preparation as antibacterial containing amoxicillin (as trihydrate) and potassium clavulanate*". On the other hand, the Respondent-Applicant's mark is being applied for use on "*pharmaceutical preparations, agents for infectious disease*" also under Class 05. Medical preparations used to treat infections caused by bacteria and other microorganisms are called "antibiotics" or "anti-bacterials."<sup>5</sup> Since the marks of the parties are used on medicinal preparation to treat infections, their goods are similar or closely related.

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

<sup>4</sup>See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

<sup>5</sup> See Definition of Antibiotic, MedicineNet, available at <http://www.medterms.com/script/main/art.asp?articlekey=8121> (last accessed 12 October 2016)

# CLAVOXIN

# CLAMOXIN

*Opposer's Mark*

*Respondent-Applicant's Mark*

A perusal of the composition of the competing trademarks involved in this case show that both marks contain three syllables consisting of eight (8) letters. Opposer's mark is composed of the letters "C-L-A-V-O-X-I-N" while that of Respondent-Applicant consists of the letters "C-L-A-M-O-X-I-N". Respondent-Applicant copied almost all the letters of Opposer's mark except the letter "V" which was replaced with letter "M" to form its mark CLAMOXIN. Both marks have similar first and third syllables "CLA" and "XIN". Also, both marks are written in plain upper case letters and contain no other features that there is nothing that could help the consumers distinguish one from the other. Thus, the marks of the parties are confusingly similar as to likely cause confusion, mistake or deception on the part of the consumers as to the source of the goods and will falsely suggest a connection between Opposer and Respondent-Applicant.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other<sup>6</sup>. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article<sup>7</sup>.

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, patent and warrant a denial of an application for registration, 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.<sup>8</sup> 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:<sup>9</sup>

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

<sup>6</sup> *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

<sup>7</sup> *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

<sup>8</sup> *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

<sup>9</sup> *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

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.


It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.<sup>10</sup>

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2015-003311, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 13 OCT 2016

  
**MARLITA V. DAGSA**  
Adjudication Officer  
Bureau of Legal Affairs

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<sup>10</sup> *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990.