

NOVARTIS AG,
Opposer,

-versus-

SCHEELING PHARMA CARE LINK, INC.,
Respondent-Applicant.

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IPC No. 14-2009-00209
Opposition to:

Appln. Serial No. 4-2009-002086
Date of Filed: 26 February 2009

TM: EURIMAX

NOTICE OF DECISION

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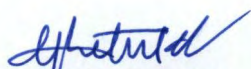
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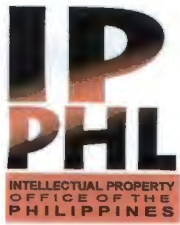
GREETINGS:

Please be informed that Decision No. 2016 - 461 dated 14 December 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOP HL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 15 December 2016.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



NOVARTIS AG,

Opposer,

-versus-

SHEELING PHARMA CARE LINK, INC.,
Respondent-Applicant.

IPC No. 14-2009-00209

Opposition to:
Application No. 4-2009-002086
Date Filed: 26 February 2009
Trademark: "EURIMAX"

Decision No. 2016- 461

DECISION

NOVARTIS AG¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2009-002086. The application, filed by Scheeling Pharma Care Link, Inc.² ("Respondent-Applicant"), covers the mark "EURIMAX" for use as "anti-bacterial medicinal/pharmaceutical preparation" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
"LEGAL GROUNDS FOR THE OPPOSITION

"3. The trademark EURIMAX being applied for by respondent-applicant is confusingly similar to opposer's trademark EURAX, as to be likely, when applied to or used in connection with the goods of respondent-applicant, to cause confusion, mistake and deception on the part of the purchasing public.

"4. The registration of the trademark EURIMAX in the name of respondent-applicant will violate Section 123.1, subparagraph (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, to wit: x x x

"5. The registration of the trademark EURIMAX in the name of respondent-applicant is contrary to Section 123.1, subparagraph (e) of the Intellectual Property Code of the Philippines, as follows: x x x

"6. The registration of the trademark EURIMAX in the name of respondent-applicant will also violate Section 6bis of the Paris Convention for Protection of Industrial Property, to which the Philippines is a party having acceded thereto as early as September 27, 1965, the provision of which is as follows: x x x

¹ A foreign corporation duly organized and existing under and by virtue of the laws of Switzerland with business address at 4002 Basel, Switzerland.

² A corporation organized and existing under and by virtue of the laws of the Philippines with office address at OMM-CITRA Bldg., San Miguel Avenue, Ortigas Center, Pasig City, Metro Manila, Philippines.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"7. The registration and use by respondent-applicant of the trademark EURIMAX will diminish the distinctiveness of opposer's registered trademark EURAX and dilute opposer's goodwill thereto.

"8. The registration of the trademark EURIMAX in the name of respondent-applicant is contrary to other provisions of the Intellectual Property Code of the Philippines.

"FACTS AND CIRCUMSTANCES
IN SUPPORT OF THE OPPOSITION

x x x

"9. The mark EURIMAX of respondent-applicant Scheeling Pharma Care Link, Inc. is confusingly similar with the trademark EURAX of opposer Novartis AG, based on the following circumstances:

- a. "The first three (3) letters, i.e. E-U-R, and the last two letters, i.e. A-X, of both marks are identical.
- b. "Both marks sound alike when pronounced due to the similarity of the letters and their respective positions. Opposer's mark is pronounced as EUR-AX while respondent-applicant's mark is pronounced as EUR-IM-AX.
- c. "Both marks are wordmarks in plain letterings and not stylized. Neither are both marks in color nor are they compounded with a unique device or design. Hence, the similarity between the two (2) marks is even more pronounced and/or enhanced.

x x x

"10. It is settled jurisprudence that identity or similarity in the dominant features of two (2) competing marks will cause mistake or confusion in the minds of the purchasing public. The case of *Co Tiong Sa vs. Director of Patents* (95 Phil. 1 [1954]) categorically held, as follows: x x x

"11. It has also been held in the case of *Phil. Nut Industry, Inc. vs. Standard Brands, Inc.* (G.R. No. L-23035, 31 July 1975, 65 SCRA 575) that: x x x

"12. The dominancy test was applied by the Supreme Court in many other cases including *Lim Hoa vs. Director of Patents* (100 Phil 214 [1956]), *Converse Rubber Corporation vs. Universal Rubber Products, Inc.* (G.R. No. L-27906, 08 January 1987, 147 SCRA 154) and *Asia Brewery, Inc. vs. Court of Appeals* (G.R. No. 103543, 05 July 1993, 224 SCRA 437).

"13. In the recent case of *McDonald's Corporation, et. al. vs. L.C. Big Mak Burger, et. al.* (G.R. No. 143993, August 18, 2004), the Supreme Court likewise applied the test of dominancy in determining that the mark BIG MAC of McDonald's Corporation and the mark BIG MAK of L.C. Big Mak Burger are confusingly similar. The Court ruled, as follows: x x x

"14. The foregoing pronunciation was further affirmed in the 2007 case of *McDonald's Corporation vs. Macjoy Fastfood Corporation* (G.R. No. 166115, February 2, 2007) where the Supreme Court again applied the test of dominancy and ruled that there is confusing similarity between the McDonald's marks and the mark MACJOY & Device.

"15. The reasoning in the McDonald's case (supra) applying the Dominancy Test is relevant in the instant case. Opposer's mark EURAX is identical to respondent-applicant's mark EURIMAX where the dominant features are the first two letters E-U-R and the last letters A-X. Hence, respondent-applicant's mark EURIMAX will create confusion, mistake and deception in the minds of the consuming public.

"16. Opposer's mark and respondent-applicant's mark both cover the same goods under International Class 5.

"Opposers mark EURAX covers:

"Chemical products for the treatment of parasitic and pruritic skin infections"

"while respondent-applicant's mark EURIMAX covers:

"Anti-bacterial/medicina./pharmaceutical preparation.

"The goods being similar, these are sold, marketed and/or found in the same channels of business and trade, thus compounding the likelihood of confusion.

"17. In the case of Esso Standard Eastern, Inc. vs. Court of Appeals, et al. (G.R. No. L-29971, August 31, 1982), the Supreme Court held that: x x x

"18. In the Philippines, opposer is the long-time registrant of the trademark EURAX, the particulars of which are as follows:

x x x

"19. The foregoing shows that opposer's registration of its mark EURAX has long been obtained and the same registration is still subsisting as it was renewed on March 12, 2004, long before respondent-applicant filed its application of its mark EURIMAX on February 26, 2009. Hence, opposer's prior registration of its mark EURAX bars the registration of respondent-applicant's mark EURIMAX.

"20. Section 123.1, subparagraph (d) of the Intellectual Property Code of the Philippines explicitly provides that: x x x

"21. In support and as evidence of use of the EURAX mark, copies of sales invoices for products bearing the mark EURAX are enclosed herewith as Annex 'B' and made integral parts hereof.

"22. Hence, by virtue of opposer's prior registration of the mark EURAX, and its wide use and promotion in the Philippines, respondent-applicant's application for registration of the confusingly similar mark EURIMAX should be denied.

"23. Opposer is the owner of and/or registrant of and/or applicant in many trademark registrations and/or applications of the trademark EURAX around the world under International Class 5, more particularly for 'Chemical products for the treatment of parasitic and pruritic skin infections'. Around the world, opposer maintains registrations and/or applications for registration of its trademark EURAX, in the name of opposer Novartis AG or any of its main business companies, in OHIM, Australia, Japan, Hong Kong, Thailand, The United Kingdom and Vietnam, among others.

"24. Certified copies of certificates of registrations from OHIM, Australia, and Japan are attached herewith, marked as Annexes 'C' to 'E' and made as integral parts hereof.

"25. Opposer extensively sells and distributes its products around the world. The list of countries where its products are exported is enclosed herewith as Annex 'F' and made as an integral part hereof;

"26. By virtue of opposer's prior registration of the trademark EURAX in the Philippines and its prior application and/or registration and ownership of this trademark around the world, said trademark has therefore become distinctive of opposer's goods and business.

"27. It is obvious that by adopting the confusingly similar mark EURIMAX for exactly the same goods that opposer is internationally known for, respondent-applicant's intention is to 'ride-on' the goodwill of oppsoer and 'pass-off' its goods as those of opposer.

"28. A boundless choice of words, phrases and symbols is available to a person who wishes to have a trademark sufficient unto itself to distinguish its products from those of others. There is no reasonable explanation therefore for respondent-applicant to use the word EURIMAX when the field for its selection is so broad.

"29. The registration and use of the trademark EURIMAX by respondent-applicant will deceive and/or confuse purchasers into believing that respondent-applicant's goods and/or products bearing the trademark EURIMAX emanate from or are under the sponsorship of opposer Novartis AG, owner and registrant of the trademark EURAX. This will therefore diminish the distinctiveness of Opposer's trademark EURAX and dilute opposer's goodwill thereto.

The Opposer's evidence consists of a copy of Certificate of Renewal of Registration No. R-3324; copies of sales invoices for products bearing the mark EURAX; a copy of OHIM Certificate of Registration No. 007210867 for the mark EURAX; a copy of Certificate of Reg. No. 91,520 for the mark EURAX in Australia; a copy of Certificate of Reg. No. 1819083 for the mark EURAX in Japan; list of countries where products bearing the mark EURAX are exported; the Affidavit-Testimony of Mary F. Leheny and Beth M. Nussbaum, authorized signatories of Novartis AG; copies of sales invoices for products bearing the mark EURAX; a copy of Certificate of Registration No. 91,520 for the mark EURAX in Australia; a copy of Certificate of Reg. No. 1819083 for the mark EURAX in Japan; a copy of Certificate of Product Registration issued by BFAD for the mark EURAX⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 07 October 2009. Respondent-Applicant filed its Answer on 02 December 2009 and avers the following:

x x x

⁴ Marked as Exhibits "A" to "K", inclusive.

"II. SPECIAL AFFIRMATIVE ALLEGATIONS

"2.1. The opposition is groundless, based as it is on erroneous facts and presumptions.

"2.2. Respondent-Applicant's EURIMAX does not, and will not, create confusion among the consuming public in relation to opposer's Eurax. Respondent-applicant's EURIMAX does not, in any way, resemble nor compete with the opposer's Eurax as erroneously claimed, given that EURIMAX is greatly different from Eurax as to: a) purpose and/or use; b) specific and general appearance; c) price; and d) availability and/or accessibility to the consuming public.

"2.3. Opposer's claim that its mark, Eurax is an internationally well-known mark is self-serving at best. It is settled that for a mark to be considered internationally well-known, various criteria should first be taken into account by competent authority of the Philippines. Opposer has not submitted sufficient evidence to satisfy such criteria.

"2.4. As there is no danger of confusion between the two (2) subject marks, and as Opposer has not duly proven that its mark is well-known, there is thus no basis for Opposer's claim that the registration of Respondent-applicant's EURIMAX will diminish the distinctiveness of its mark Eurax, if indeed, the latter mark has achieved such distinctiveness.

"2.5. With due respect, Respondent-applicant, a corporation in the pharmaceutical business, was not even aware of the mark Eurax until it was notified about its existence via the present Opposition. Respondent-Applicant therefore strongly takes exception to the claim that its mark EURIMAX will dilute the alleged distinctiveness attained by the mark Eurax, and especially to the claim that Respondent-applicant adopted its mark to ride on Opposer's purported goodwill over the mark Eurax.

x x x

"3.a.1. The Opposition is an unsigned pleading. A mere perusal of the Opposition will show that despite having three signatories (xxx), the same was filed unsigned. A copy of the unsigned page is hereto attached marked as Exhibit '1' and made an integral part hereof.

"3.a.2. Instantly, there is already ground for the denial of the Opposition in line with Republic of the Philippines v. Kenrick Development Corporation, 498 SCRA 220 (2006) which upheld that-

"3.b.1. Without waiving such basic procedural yet jurisdictional flaw, a cursory look at the two marks will show that there is likelihood of confusion between them and the products they represent.

"3.b.2. To begin with the application of the Dominancy Test is misplaced. The factual milieu of the present case will readily show that the Holistic Test applies.

"3.b.3. Case law with similar factual milieu as that of the present case has resolved that in determining confusing similarity between the two marks

BIOFERIN and BUFFERIN, it is erroneous to limit comparisons to the contending marks' respective spellings and pronunciations; they are to be considered in their entirety. Thus: x x x

"3.b.4. Respondent-Applicant respectfully submits that in light of the similar facts of the instant case to the above-cited case, the subject marks should be considered in their entirety.

"3.b.5. A cursory look at the two marks readily shows their respective appearance are so different and apart from each other so as to preclude any danger of confusion among the consuming public. That the marks have some similar letters to their names is so negligible as to confuse one for the other.

"3.b.6. A simple pronunciation of both words will show that despite the similarity in the first three (3) letters and last two (2) letters, the letters 'IM' in EURIMAX makes such a distinctive and significant sound which cannot, in anyway, be confused with Eurax. The resulting aural pronunciation gives Respondent-applicant's mark EURIMAX a distinctive meter and cadence, all its own, the long and playful sound of which is completely removed from the curt and short meter produced in pronouncing Eurax.

"3.b.7. Moreover, a detailed comparison indubitably shows the apparent differences between the two marks and the products to which they are attached or associated: x x x

"3.b.8. First, as mentioned by the Opposer itself, Eurax covers 'chemicals for the treatment of parasitic and puritic skin infections' x x x while EURIMAX covers 'anti-bacterial/medicinal/pharmaceutical preparation' x x x

"3.b.9. It means that Eurax is a topical solution used to treat skin infections, whereas EURIMAX is an antibiotic which is used for the treatment of bone and joint infections, bronchitis and other lower respiratory tract infections, gonorrhea, meningitis, otitis media, peritonitis, pharyngitis, sinusitis, skin infection and urinary tract infections. x x x

"3.b.10. Second, Eurax is a non-prescription drug, it can be procured by any one over the counter, whereas, obtaining EURIMAX requires a prescription from a licensed physician. As proof that a prescription is required to acquire EURIMAX, a sample of the box of EURIMAX with a large Rx sign is hereto attached x x x

"3.b.11. Third, unlike Eurax which is a lotion and applied to the skin and is strictly 'for external use only' x x x, EURIMAX which comes in the form of a film coated tablet or powder for injection, is administered internally. The film coated tablet is swallowed through mouth while the powder for injection is first diluted in water and is thereafter injected intravenously to the patient. x x x

"3.b.12. The above clearly and undeniably demonstrate the differences between the two marks, ,proving that there is no danger of creating confusion between the two marks among the consuming public. That the two marks share some letters is negligible, and is far outweighed by the glaring differences between the two marks, thus negating all unsubstantiated claim that Respondent-applicant's mark may deceive the consuming public into thinking that it is Opposer's mark.

"3.c.1. The foregoing table of comparison easily shows that Opposer's reliance on the McDonald's and Esso Standard Eastern cases, both applying the Dominancy Test, is misplaced. The Holistic Test correctly applies in the present case.

"3.c.2. In McDonald's Corporation et al. v. L.C. Big Mak Burger, et al. x x x

"3.c.3. Then also, it is beyond cavil that McDonald's products such as its BIG MAC, has acquired such distinctiveness around the globe that it was but expected to accord it the protection as an internationally well-known mark.

"3.c.4. In the case at hand however, not only do the two marks create different visual and aural impressions, but Opposer's mark has not even achieved the mark of distinctiveness as an internationally well-known mark in the same way that the mark BIG MAC has.

"3.c.5. As for the inapplicability of the Esso Standard Eastern case, suffice it to say that Opposer itself admitted the standard by which goods are said to be 'related'. To wit: x x x

"3.c.6. While the subject marks are classified under the same class, their similarities end there, if measured by the above table of comparisons. For one, they do not have the same descriptive properties. One is for internal infections, such as bronchitis, meningitis, gonorrhoea, while the other is simply for the treatment of skin infections like scabies.

"3.c.7. For another, the above table of comparison shows that the products on which the marks are used are completely different in form, composition, texture and quality: one is in tablet and powder form, to be respectively ingested orally and applied intravenously; the other is in liquid form to be rubbed on the skin. Lastly, it is evident that the goods the subject marks cover do not serve the same purpose. And while they are both sold in drugstores, Respondent-applicant's mark EURIMAX can only be purchased via a doctor's prescription while Opposer's mark Eurax is sold openly in the counters and may be purchased without a prescription. Eurax is an over-the-counter drug; EURIMAX is not.

"3.c.8. But more importantly, the total look of both marks' packaging would negate all possibilities that one mark would be confused for the other:

"a. The typeface and sizes of the letters of the respective marks are so different from each other.

"b. The rectangular white and yellow carton box containing EURIMAX tablets, as well as the tiny glass laboratory vial containing EURIMAX powder, could hardly be confused with the white and purple plastic bottle of Eurax.

"c. The supplemental designs and devices accompanying both marks give the respective brands a distinct total look that are completely different and diverse from each other. EURIMAX has two distinct overlapping squares on the lower left portion of its label, while Eurax's background is a purple rectangle, atop of which are two hands, one scratching the other, in a darker purple.

"d. The generic names for each mark are enclosed in a rectangular box and situated atop the marks. Even the said generic names set the marks apart from

each other. Eurax's generic name is just one word: Crotamiton, whereas EURIMAX's generic name is Cefuroxime Axetil, composed of two scientific words. The overall visual impact of these generic names alone sets apart each mark from the other. A purchaser will instantly notice that one has a longer generic name atop its brand name, even without actually reading the generic names.

"3.c.9. It is thus beyond question that the Holistic Test applies in the present case.

"3.c.10. As held by the Supreme Court in Emerald Garment Manufacturing Corporation v. Court of Appeals, 251 SCRA 600 (1995) x x x

"3.c.11. By simply looking at the boxes of Eurax x x x and EURIMAX x xx, the common man in the streets will at once see the difference between the two. There is simply no way that an everyday purchaser will confuse the respective marks and their products for each other.

"3.c.12. It begs stressing that the box of EURIMAX is predominantly white with two (2) yellow overlapping boxes on the lower left portion, in contrast thereto, the box of Eurax is pre-dominantly purple with an outline of two overlapping hands, one scratching the other. Worth stressing also is that EURIMAX's packaging also has a bold Rx sign on the lower right corner, while the Eurax bottle clearly states in red font that it is 'For External Use Only'.

"3.c.13. Simply put, the total look of the mark and the products to which they are attached are so different from each other that it is impossible to confuse one for the other.

"3.c.14. The Supreme Court held in Del Monte x x x

"3.c.15. Applying Del Monte in the instant case, not only is the container of Eurax, a plastic bottle container for lotions, highly different from EURIMAX's blister packs and vial containers, the price of the two goods are also extremely varied.

"3.c.16. The Eurax lotion is sold in the market for around One Hundred Pesos (P115.00) for its 60ml container, while EURIMAX sells for Seventy Pesos (P70.00) per tablet and Two Hundred Fifty Pesos x x x per powder vial.

"3.c.17. A single tablet EURIMAX is not sufficient for the treatment of the internal infections indicated in its medical literature. Respondent-applicant's EURIMAX is an antibacterial medicine, i.e., it is an antibiotic that should be taken twice or thrice daily for a period of seven (7) to even twenty-one (21) days per treatment. x x x

"3.c.18. In contrast, a bottle of Eurax at P115.00 is sufficient for a one time purchase to cure a case of simple scabies. Truly, a purchaser can never miss out on the vast difference in prices of the two products. The difference is at once apparent, not only in these difficult times, but even under any ordinary circumstance. The differing price ranges will at once create a significant impact on the purchaser's pockets. x x x

"3.c.19. More importantly, the Holistic Test applies because the Dominancy Test is usually applied to composite marks- marks which are composed of two or more features, one of which is dominant. Such is unavailing in the instant case since the only mark being applied for registration is simply EURIMAX.

"3.c.20. Nevertheless, while the Holistic Test is the applicable test in the instant case, applying the dominancy test in the instant case will still show that there can be no likelihood of confusion between Eurax and EURIMAX.

"3.c.21. Opposer's mark is Eurax x x x and not EURAX as consistently used in their Opposition. x x x

"3.c.22. Neither do the two marks sound the same as Opposer erroneously represents. A simple pronunciation of both words show that despite their similarity in the first three (3) letters and last two (2) letters, the letters 'IM' in EURIMAX makes a distinctive sound which cannot in anyway be confused with Eurax. To reiterate, EURIMAX when pronounced creates a longer metered word x x x

"3.c.23. Regardless, it is still arguable if the Dominance Test can be used in the instant case x x x

"3.c.24. Again, the McDonald's case, the registration of L.C. Big Mak Burger was disallowed because it sounded exactly like the Big Mac of McDonald's Corporation, thus - x x x

"3.c.25. For the aforesaid cases to apply, there should be a dominant word or sound of a dominant word which is being copied. x x x

"3.c.26. In the case at hand, there is no dominant word in the Opposer's Eurax being used or copied in EURIMAX. The subject marks distinctively stand alone respectively. There is no confusing similarity between Eurax and EURIMAX when articulated or enunciated. x x x

"3.c.27. Clearly then, while the Holistic Test applied in the factual background of the present case, an application of the Dominancy Test likewise negates any confusing similarity between the subject marks.

"3.d.1. Opposer's contention that its mark Eurax is an internationally well-known mark has not been proven x x x

"3.d.2. Under this jurisdiction, the determination whether a mark is well-known is made by competent authority of the Philippines, taking into account various criteria, which are not restricted to the duration, extent and geographical area of use of the mark x x x

"3.d.3. The fact that a mark has been registered for a period of time in the Philippines and in other countries does not ipso facto make said mark well-known. x x x

"3.d.4. At the outset, Respondent-applicant, itself in the pharmaceutical business in the Philippines, was surprised to learn of a product bearing the mark Eurax, and that the same is being sold in the market. x x x

"3.d.5. If Respondent-applicant, itself in the pharmaceutical business, is not familiar with the mark Eurax, it is but logical to determine whether the common Juan in the streets is familiar with the said mark. x x x

"3.d.6. Further, Opposer failed to adduce evidence as to the extent of its advertisement and promotion of the mark Eurax. As of date, Respondent-applicant is unaware of any print, radio, or TV commercials on Eurax.

"3.d.7. There is likewise no concrete evidence showing the extent of the market share of the mark Eurax both in the Philippines and worldwide. x x x

"3.d.8. In sum, Opposer's mark Eurax is not a well-known mark that has acquired distinction in the market. Even assuming arguendo, that Respondent-applicant's mark is confusingly similar to Opposer's mark, there is in fact no dilution of the latter's distinctiveness as, in the first place, other marks with basically the same letters have either been registered or are pending registration with the Intellectual Property Office ('IPO').

"3.e.1. Opposer's claimed distinctiveness of its mark Eurax is not only self-serving, but clearly unsubstantiated.

"3.e.2. A cursory trademark search readily shows that similar marks bearing similar letters and aural sounds have either been registered or are still pending registration. x x x

"a. The mark EUROFER, Registration No. 4200-3011-584, Registration Date 7/23/2005, under Class 5, as an anti-anemic agent for human use, a product that is contained in carton boxes x x x

"b. The mark EUROL, Registration No. 4200-4003-635, Registration Date 3/18/2006, under Class 3 for Cosmetics Use, x x x

"c. The mark EURA, Registration No. 4200-7005-797, Registration Date 03/03/2008, for Classes 6, 7 and 8 x x x

"d. The mark EURA, Application No. 4200-5011-899, Filing Date 12/5/2005, for Class 9 x x x

"e. The mark EUROHE, Application No. 4200-9004-885, Filing Date 5/19/2009, for Class 11, x x x

"3.e.3. The existence of the above marks in the IPO registry, namely EUROFER, EUROL, EURA and EUROHE, be they as registered marks or marks with pending application, all basically share similar letters found in Eurax. x x x

"3.e.4. The mark EUROFER shares the first three letters found in Eurax, is registered under the same Class 5 as a medicinal agent for anti-anemic use, but has nevertheless been registered with the IPO. x x x

3.e.5. As for EUROL, EURA and EUROHE, it is also very obvious that the marks share similar letters found in Eurax. x x x

"3.e.6. In sum, there is no dilution of distinctiveness of the mark Eurax. If indeed the mark has attained such distinctiveness as a well-known mark, the same has been diluted by the presence of the various cited marks above.

"3.f.1. The foregoing demonstrates that the subject marks are not confusingly similar so as to create confusion in the minds of the buying public. The marks are different both in aural and visual impressions. x x x

"3.f.2. Respondent-applicant, in conducting its business, does not, and has no intention to, ride on the goodwill of third parties. x x x

"3.f.3. To re-emphasize, Respondent-applicant was completely unaware of the existence of the brand Eurax until the filing of the present Opposition. x x x

"3.f.4. Further, EURIMAX was not coined for use to 'ride-on' Opposer's purported goodwill. x x x

"3.f.5. In sum, Opposer's contention that Respondent-Applicant rides on its purported goodwill is false and unsubstantiated.

"3.f.6. Finally, a copy of the Affidavit of Ms. Jovith B. Ramos, the Business Development Manager of Respondent-applicant is hereto attached x x x.

The Respondent-Applicant's evidence consists of a copy of the unsigned page in the Opposition; a sample of the box of EURIMAX with its INDICATION; a photograph of the sample box; a bottle of Eurax showing its INDICATIONS; a photograph of the Eurax bottle; a sample of the box of EURIMAX with a large Rx sign; a photograph of the sample EURIMAX bottle with a large Rx sign; a copy of the sample box of EURIMAX in powder for injection form; a photograph of the said EURIMAX box; a copy of the mark EUROFER with Registration No. 42003011584 issued on 23 July 2005; a copy of the mark EUROL with Reg. No. 42004003635; a copy of the mark EURA with Reg. No. 42007005797; a copy of the mark EURA with Serial Application No. 42005011899; a copy of the mark EUROHE with Serial Application No. 42009004885; and the Affidavit of Ms. Jovith B. Ramos, the Business Development Manager of Respondent-Applicant.⁵

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

The Opposer anchors its opposition on Sections 123.1, paragraphs (d) and (e) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

Sec. 123.Registrability. - 123.1. A mark cannot be registered if it:

x x x

(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 :

⁵ Marked as Exhibits "1" to "15", inclusive.

- (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;"
- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

Records show that at the time the Respondent-Applicant filed its trademark application on 26 February 2009, the Opposer has an existing trademark registration for the mark EURAX under Reg. No. 4-1984-3324 issued on 12 March 1984. The registration covers "chemical products for the treatment of parasitic and pruritic skin infection" in Class 05. On the other hand, Respondent-Applicant's trademark application covers "anti-bacterial medicinal/pharmaceutical preparation" under Class 05.

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

Eurax

EURIMAX

Opposer's trademark

Respondent-Applicant's mark

This Bureau finds that confusion or deception is unlikely to occur in this instance. Although the contending marks have the same first three (3) letters E-U-R and the last two (2) letters A-X, the visual and aural properties in respect of the Respondent-Applicant's mark has rendered said mark a character that is distinct from the Opposer's. While the marks are common as to the letters "E", "U", "R", "A", "X", those in between these letters make it easier for the consumers to distinguish one from the other. Moreover, the pharmaceutical products, although belonging to the same classification, Class 05, they pertain to pharmaceutical or drug products of distinct nature. Designated as EURIMAX (generic name CEFUROXIME), Respondent-Applicant's products are film-coated tablets/powder for injection with indications (anti-bacterial) for bone and joint infections, bronchitis and other lower respiratory tract infections, gonorrhea, meningitis, otitis media, peritonitis, pharyngitis, sinusitis, skin infections and urinary tract infection. Opposer's products covered under EURAX (generic name CROTAMITON) are topical liquid (lotion) for the effective relief of

various forms of itching, also indications for scabies (infestation of the skin by mites) or medication for the treatment of parasitic, and pruritic skin infections. Opposer contends that both products cater to "skin infections", that they are both being sold in the same channels of business and trade. It is worth noting that in Opposer's product under Indications, it did not mention of skin infection, it placed:⁶

"Indication: For the effective relief of various forms of itching. Eurax is also indicated for scabies (infestation of the skin by mites)."

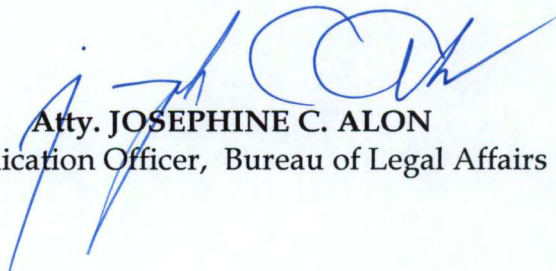
Eurax is primarily an scabicide and anti-pruritic lotion which is meant to relieve and remove the itchiness caused by skin irritation or infection which is external in nature, requiring it to be only for external use only and not for ingestion. EURAX (Crotamiton) is administered topically for percutaneous absorption while CEFUROXIME AXETIL, on the other hand, is an oral cephalosporin which is rapidly hydrolysed to the active parent compound, cefuroxime. Cefuroxime has a broad spectrum of in vitro antibacterial activity which encompasses methicillin-sensitive staphylococci.⁷ Skin infection is only one of the many diseases due to bacteria that CEFUROXIME AXETIL is used for, as compared to CROTAMITON which is generally an antipruritic (anti-itch) cream and for cure for skin infection resulting from scabies or mites that burrow into the skin causing itchiness and infection.

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.⁸ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2009-002086 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 14 DEC 2016


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs

⁶ Exhibit "5" for Respondent-Applicant.

⁷ <http://www.ncbi.nlm.nih.gov/pubmed/8799689>

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.