



INTELLECTUAL PROPERTY
OFFICE OF THE
PHILIPPINES

PEDIATRICA, INC.,
Opposer,

-versus-

BENEDICTO O. TAN,
Respondent-Applicant.

X-----X

}	IPC No. 14-2014-00454
}	Opposition to:
}	
}	Appln. Serial No. 4-2014-001200
}	Date Filed: 29 January 2014
}	
}	TM: NAPAREX

NOTICE OF DECISION

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BENEDICTO O. TAN
Respondent- Applicant
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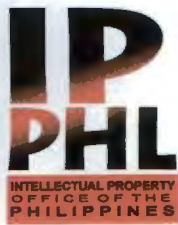
GREETINGS:

Please be informed that Decision No. 2017 - 24 dated 20 June 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL 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, 20 June 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



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BENEDICTO O. TAN,
Respondent-Applicant.

} **IPC NO. 14-2014-00454**
} Opposition to:
}
} **Appln. Ser. No. 4-2014-001200**
} **Date Filed: 29 January 2014**
} **Trademark: "NAPAREX"**
}
} **Decision No. 2017- 241**

x-----x

DECISION

PEDIATRICA, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-001200. The application, filed by BENEDICTO O. TAN, (Respondent-Applicant)², covers the mark "NAPAREX", for use on "it is indicated for unstable coronary artery disease, prevention of clotting during hemodialysis and deep vein thrombosis" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The mark 'NAPAREX' applied for by Respondent-Applicant so resembles the trademark 'NAPREX' owned by Opposer, and duly registered with this Honorable Bureau prior to the publication of the application for the mark 'NAPAREX'.

"8. The mark 'NAPAREX', will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'NAPAREX', is applied for the same class and goods as that of Opposer's trademark 'NAPREX', i.e. Class (5) of the International Classification of Goods for pharmaceutical preparations.

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

¹ A domestic corporation duly organized and existing under the laws of the Philippines with address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

² Filipino with address at 3009 Jollibee Plaza Building, Emerald Avenue, Ortigas Center, Pasig City

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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(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;

“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 cause confusion or deception in the mind of the purchasers will likely result.

“11. Respondent-Applicant’s use and registration of the trademark ‘NAPREX’ will diminish the distinctiveness of Opposer’s trademark ‘NAPREX’.

The Opposer alleges, among other things, that:

“12. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products and is the registered owner of the trademark ‘NAPREX’.

“12.1. The trademark application for the trademark ‘NAPREX’ was originally filed with the Philippine Patent Office on 6 October 1976 by Opposer and was approved for registration on 15 March 1979 to be valid for a period of twenty (20) years, or until 15 March 1999. xxx

“12.3. Again, prior to the expiration of the registration, Opposer filed another application for renewal of registration of the trademark ‘NAPREX’ with the IPO, which was accordingly granted to be valid for another ten (10) years from 15 March 2009 or until 15 March 2019. xxx

“12.4. Thus, the registration of the trademark ‘NAPREX’ subsists and remains valid to date.

“13. The trademark ‘NAPREX’ has been extensively used in commerce in the Philippines.

“13.1. Opposer has dutifully filed Affidavit of Use pursuant to the requirement of the law.

“13.2. A sample product label bearing the trademark ‘NAPREX’ actually used in commerce is hereto attached hereof as Exhibit ‘J’ and made an integral part hereof.xxx”

“13.3. No less than the Intercontinental Marketing Services (‘IMS’) itself, the world’s leading provider of business intelligence and strategic

consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand 'NAPREX' as one of the leading brands in the Philippines in the category of 'N02B Non-Narcotics Analgesics' in terms of market share and performance.xxx

"13.4. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, the product has been registered with the he Food and Drugs Administration. xxx

"14. By virtue of the foregoing, there is no doubt that Opposer's has acquired an exclusive ownership over the trademark, 'NAPREX' to the exclusion of all others. xxx

"15. The registration of Respondent-Applicant's mark 'NAPAREX' will be contrary to Section 123.1 (d) of the IP Code. 'NAPAREX' is confusingly similar to Opposer's trademark 'NAPREX'. xxx

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of IPO e-Gazette showing the Respondent-Applicant's trademark application published for opposition;
2. Copy of Certificate of Registration No. 27231 for the trademark "NAPREX" issued on 15 March 1976;
3. Copies of Certificate of Renewal of Registration No. 27231 for the trademark "NAPREX";
4. Copies of Affidavits of Use and Declaration of Actual Use;
5. Sample product label of "NAPREX"; and
6. Certification from IMS Health dated 4 October 2014.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 5 November 2014. The Respondent-Applicant, however, did not file an answer. Thus, the Hearing Officer issued on 6 February 2015 Order No. 2015-244 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant be allowed to register the trademark NAPAREX? The contending marks are reproduced below:

Opposer's mark

Respondent-Applicant's mark

Naprex

NAPAREX

⁴ Exhibits "A" to "K"

Records show that at the time Respondent-Applicant applied for registration of the mark "NAPAREX" the Opposer already registered the mark NAPREX under Certificate of Registration No. 27231 issued on 15 March 1976⁵. The goods covered by the Opposer's trademark registration are also under Class 5, same as indicated in the Respondent-Applicant's trademark application.

In the instant case, the Respondent-Applicant appropriates all the six letters, N-A-P-R-E-X, of the Opposer's mark NAPREX, adding the letter "A" in the middle, hence NAPAREX. By merely adding one letter between the prefix NAP and suffix REX results to a mark which is confusingly similar to the Opposer's. Both visually and aurally, the two marks are the same. Although the Opposer applies its mark on a pharmaceutical product "paracetamol" as seen from its packaging label⁶, while the Respondent-Applicant applies its mark on a product that "is indicated for unstable coronary artery disease, prevention of clotting during hemodialysis and deep vein thrombosis", the contemporaneous use of very similar marks on pharmaceutical products could lead to a likelihood of confusion.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-001200 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 JUN 2017



ATTY. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs

⁵ Exhibit "B"

⁶ Exhibit "J"