

PEDIATRICA, INC.,
Opposer,

-versus-

J.F. DRAF PHARMACEUTICALS CORPORATION,
Respondent-Applicant.

} **IPC No. 14-2016-00422**
}
} Opposition to:
} Appln. Serial No. 4-2016-003660
} Date Filed: 07 April 2016
}
}
} **TM: MUPEZIN**
}

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NOTICE OF DECISION

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No. 66 United Street,
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JF DRAF PHARMACEUTICALS CORP.
Respondent- Applicant
Suite 407 Greenhills Mansion
37 Annapolis Street, North East Greenhills
San Juan City, Metro Manila

GREETINGS:

Please be informed that Decision No. 2017 - 184 dated 01 June 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHEL 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, 01 June 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

PEDIATRICA, INC.,
Opposer,

-versus-

**J.F. DRAF PHARMACEUTICALS
CORPORATION,**
Respondent-Applicant.

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 }Date Filed: 7 April 2016
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 }Trademark: "MUPEZIN"
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 }Decision No. 2017- 184

DECISION

PEDIATRICA, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2016-00003660. The application, filed by JF DRAF PHARMACEUTICALS CORPORATION Respondent-Applicant)², covers the mark "MUPEZIN", for use on "pharmaceutical preparation as anti-bacterial" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

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

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

"9. The registration of the mark 'MUPEZIN' in the name of the Respondent-Applicant will violate Sec. 123.1 (d) of the IP Code, which provides, in part, that a mark cannot be registered if it:

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

² A corporation with address at Suite 407, Greenhills Mansion, 37 Annapolis St., North East Greenhills, San Juan 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 confusion or deception in the mind of the purchasers will likely result.

The Opposer also alleges, among others, the following facts:

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

“11.1. The trademark application for the trademark ‘MUPICIN’ was filed with the IPO on 16 October 2008 by Opposer was approved for registration on 16 March 2009 to be valid for a period of ten (10) years, or until 16 March 2019.

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

“12. The trademark ‘MUPICIN’ has been extensively used in commerce in the Philippines.

“12.1. Opposer has dutifully filed Declarations of Actual Use pursuant to the requirement of the law to maintain the registration of ‘MUPICIN’ in force and effect. Xxx

“12.3. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, the product has been registered with the Bureau of Food and Drugs (now Food and Drug Administration). xxx

“12.4. 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 ‘MUPICIN’ as one of the leading brands in the Philippines in the category of ‘D06A- Topical Anti-bacterials’ in terms of market share and sales performance.

“13. By virtue of the foregoing, there is no doubt that the Opposer has acquired an exclusive ownership over the trademark ‘MUPICIN’ to the exclusion of all others. xxx

“15. The registration of Respondent-Applicant’s mark ‘MUPEZIN’ will be contrary to Section 123.1 (d) of the IP Code. ‘MUPEZIN’ is confusingly similar to Opposer’s trademark ‘MUPICIN’. xxx”

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

1. Print-out of page of Intellectual Property Office (“IPO”) E-Gazette showing published mark “MUPEZIN”;
2. Copy of Registration No.4-2008-012666, issued on 16 March 2009 for the mark “MUPICIN” covering goods under class 5, namely: “antibacterial pharmaceutical preparation”;
3. Copies of Declaration of Actual Use dated 20 September 2011 and 2 October 2013;
4. Sample packaging for the pharmaceutical product “MUPICIN”;
5. Certificate of Listing of Identical Drug Product from the Bureau of Food and Drugs; and
6. Certification from Intercontinental Marketing Services dated 29 July 2015.⁴

This Bureau served upon the Respondent-Applicant a “Notice to Answer” which was received on 1 September 2016. The Respondent-Applicant however did not file an Answer, thus an order was issued on 27 March 2017 declaring the Respondent-Applicant in default.

Records show that at the time Respondent-Applicant applied for registration of the mark “MUPEZIN” the Opposer already registered the mark “MUPICIN” under of Registration No. 4-2008-012666.⁵ The goods covered by the Opposer’s trademark registration are also under Class 05, namely: “antibacterial pharmaceutical preparation”, same as Respondent-Applicant’s trademark application which indicates use as “pharmaceutical preparation as antibacterial”.

Do the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

MUPICIN

Mupezin

Opposer’s mark

Respondent-Applicant’s mark

⁴ Exhibits “A” to “G”

⁵ Exhibit “B”

The marks are similar with respect to the prefix, ("MUP") and suffix ("IN") . Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. As seen from the Opposer's packaging⁶, there is a reason to infer that the mark "MUPICIN" was derived from a combination of the first four letters, "MUPI" and last three letters "CIN" of the generic name "MUPIROCIN". By deleting the middle syllable "RO", the Opposer's mark is plainly a combination of the first and last syllable of the generic name MUPIROCIN. On the other hand, Respondent-Applicant's mark uses the middle syllable "PEZ", which when combined with the other syllables result to a mark with a different phonetic sound, MUPEZIN from Opposers. MUPEZIN is distinct from MUPICIN, which is actually similar to the generic name of Opposer's pharmaceutical product, MUPIROCIN. To sustain the opposition on the ground of the commonality between the marks as to the prefix "MUPI" and "MUPE" and prefix "IN" would have the effect of giving the Opposer exclusive use of a mark and/or as part thereof for use, which closely sounds like the generic name MUPIROCIN or topical antibacterial products.

Thus, in determining whether the competing marks are confusingly similar is to look for the letters or syllables appended to the syllables "MU" and "IN". In this regard, the syllable of the marks, "PEZ" and "PIC" are very phonetically and visually dissimilar. When pronounced, the resultant words have a different sound. Visually and aurally the marks are not the same.

It is noteworthy that the products involved in this case are pharmaceutical products, where the purchaser will be more wary and exercise precaution in buying these. The Supreme Court in *Etepha A. G v. Director of Patents*⁷ is relevant to this case, to wit:

In the solution of a trademark infringement problem, regard too should be given to the *class* of persons who buy the particular product and the circumstances ordinarily attendant to its acquisition.¹⁶ The medicinal preparation clothed with the trademarks in question, are unlike articles of everyday use such as candies, ice cream, milk, soft drinks and the like which may be freely obtained by anyone, anytime, anywhere. Petitioner's and respondent's products are to be dispensed upon medical prescription. The respective labels say so. An intending buyer must have to go first to a licensed doctor of medicine; he receives instructions as to what to purchase; he reads the doctor's prescription; he knows what he is to buy. He is not of the incautious, unwary, unobservant or unsuspecting type; he examines the product sold to him; he checks to find out whether it conforms to the medical prescription. The common trade channel is the pharmacy or the drugstore. Similarly, the pharmacist or druggist verifies the medicine sold. The margin of error in the acquisition of one for the other is quite remote.

We concede the possibility that buyers might be able to obtain Pertussin or Attusin without prescription. When this happens, then the buyer must be one thoroughly familiar with what he intends to get, else he would not have the temerity to ask for a medicine — specifically needed to cure a given ailment. In which case, the more improbable it will be to palm off one for the other. For a person who purchases with open eyes is hardly the man to be deceived.

⁶ Exhibit "E"

⁷ G.R. L. No. 20635, 31 March 1996

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2016-003660 is hereby **DISMISSED**. 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, 07 JUN 2017



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