

UNILAB, INC. (formerly UNITED AMERICAN PHARMACEUTICALS, INC.),
Opposer,

-versus-

AMBICA INTERNATIONAL CORPORATION,
Respondent- Applicant.

}
} IPC No. 14-2016-00220
} Opposition to:
} Appln. Serial No. 4-2015-00010418
} Date Filed: 09 September 2015
} TM: "AMIKA"

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NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for Opposer
No. 66 United Street
Mandaluyong City


AMBICA INTERNATIONAL CORPORATION
Respondent-Applicant
#9 Amsterdam Extension
Merville Park Subdivision
Paranaque City

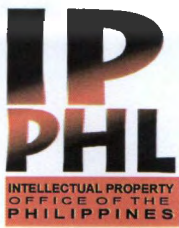
GREETINGS:

Please be informed that Decision No. 2017 - 216 dated June 09, 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, June 13, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



UNILAB, INC. (formerly UNITED AMERICAN PHARMACEUTICALS, INC.);
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-versus-

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} Appln. Ser. No. 4-2015-00010418

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} Trademark: "AMIKA"

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} Decision No. 2017- 216

DECISION

UNILAB, INC. (formerly UNITED AMERICAN PHARMACEUTICALS, INC.), (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2015-00010418. The application, filed by AMBICA INTERNATIONAL CORPORATION Respondent-Applicant)², covers the mark "AMIKA", for use on "pharmaceutical preparations" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The mark 'AMIKA' applied for by Respondent-Applicant so resembles the trademark 'AMIKACIDE' owned by Opposer, and duly registered with the IPO prior to the publication for opposition of the mark 'AMIKA'.

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

¹ A corporation organized and existing under the laws of the Philippines with address at No. 66 United Street, Mandaluyong City

² A Philippine corporation with address at #9 Amsterdam Extension, Merville Park Subdivision, Paranaque 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.

“9. The registration of the mark ‘AMIKA’ 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:

(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 or a mark with an earlier priority date, 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.

“11. Respondent-Applicant's use and registration of the mark ‘AMIKA’ will diminish the distinctiveness of Opposer's trademark ‘AMIKACIDE’.

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

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

“12.1. The original trademark application for the trademark ‘AMIKACIDE’ was filed with the IPO on 4 August 1995 by Opposer and was approved for registration on 9 November 1999 to be valid for a period of twenty years (20) years, or until 9 November 2019.

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

“13. The trademark ‘AMIKACIDE’ has been extensively used by Opposer in commerce in the Philippines.

“13.1. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, Opposer registered the product with the Food and Drug Administration (‘FDA’). xxx

“13.2. Opposer has dutifully filed Affidavits of Use and Declaration of Actual Use to maintain the registration of the trademark ‘AMIKACIDE’ in force and effect pursuant to the requirement of the law. xxx

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

The marks are similar with respect to the prefix, ("AMIKA") which is the Respondent-Applicant's mark. 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 "AMIKACIDE" was derived from a the generic name "AMIKACIN". The Opposer appropriated the four syllables of the generic name, "A-MI-KA-CI" and merely substituted the last letter "N" with "DE". As a result, the word AMIKACIDE and the generic term AMIKACIN are similar visually and phonetically. On the other hand, Respondent-Applicant's appropriated the first three syllables of the generic name as its mark. Obviously, both marks are derived from and are coined from the generic term of the pharmaceutical product. To sustain the opposition on the ground of the commonality between the marks as to the prefix "AMIKA" would in effect of give the Opposer exclusive use of a mark and/or as part thereof, which is identical and closely resembles the generic name AMIKACIN.

As to whether the competing marks are confusingly similar, the Respondent-Applicant does not appropriate the suffix of Opposer's mark, which differentiates it from the Opposer's mark. When pronounced, the marks are not the same, hence, confusion is unlikely. The Bureau will rely on the Court's finding that deception or confusion would depend on the circumstances attendant to the manner of purchasing the goods involved. 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 "P"

⁷ G.R. L. No. 20635, 31 March 1996

consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand 'AMIKACIDE' as one of the leading brands in the Philippines in the category of 'J01k- Aminoglycosides' in terms of market share and sales performance.

"14. By virtue of the foregoing, there is no doubt that the Opposer has acquired an exclusive ownership over the trademark 'AMIKACIDE' to the exclusion of all others. 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 "AMIKA";
2. Copy of Registration No.4-1995-104059, issued on 9 November 1999 for the mark "AMIKACIDE" covering goods under class 5, namely: "medicinal preparation for use as antibacterial";
3. Certificates of Product Registration (2012);
4. Affidavit of Use and Declaration of Actual Use;
5. Sample packaging for the pharmaceutical product "AMIKACIDE"; 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 "AMIKA" the Opposer already registered the mark "AMIKACIDE" under of Registration No. 4-1995-104059.⁵ The goods covered by the Opposer's trademark registration are also under Class 05, namely: "medicinal preparation for use as antibacterial", same as Respondent-Applicant's trademark application which indicates use as "pharmaceutical preparations".

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

AMIKACIDE

AMIKA

Opposer's mark

Respondent-Applicant's mark

⁴ Exhibits "A" to "J"

⁵ Exhibit "B"

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2015-00010418 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, 09 JUN 2017



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