PARKE DAVIS & COMPANY. Opposer, - versus - SUPERIOR PHARMACRAFT, INC., Respondent-Applicant.	)	INTER PARTES CASE NO. 3438 OPPOSITION TO: Application Serial No. 41300 Filed : May 8, 1980 Applicant : Superior Pharma-craft, Inc. Trademark : AMCILLIN Used on : Respiratory tract infections, geni-tourinary infections, gastro-intestinal infections, skin and soft tissue infections DECISION NO. 92-30 (TM) November 13, 1992

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DECISION

On October 5, 1989, Parke Davis & Company a corporation organized and existing under the laws of the State of Michigan, U.S.A., located and doing business at 201 Tabor Road, Morris Plains, New Jersey, U.S.A., but not licensed to do as it is not doing business in the Philippines, believing that it would be damaged by registration, filed its Verified Notice of Opposition in the matter for the registration of the trademark "AMCILLIN" bearing Serial No. 41300 for respiratory tract infections which application was filed on May 8, 1980 by Superior Pharmacraft, Inc., a domestic corporation with address at 245 P. Tuason Boulevard, Cubao, Quezon City, Metro Manila, which application was published on page 7 of No. 6, Volume II, June 30, 1989 issue of the Official Gazette of the Bureau of Patents, Trademarks and Technology Transfer and officially released for circulation on July 3, 1989.

The grounds for opposition are as follows:

"1. Opposer is the owner of the trademark AMCILL used for a pharmaceutical preparation i.e. antibiotic for the treatment of various infections. Such ownership subsists up to date and has never been abandoned;

2. Opposer's ownership of the trademark AMCILL as used in the goods aforesaid, is evidenced by certificates of registrations which it obtained from various countries, notably the United States of America;

3. The trademark AMCILLIN applied for by Applicant is confusingly similar to Opposer's trademark AMCILL, and its registration would therefore be contrary to Section 4(d) of Republic Act No. 166, as amended;

4. The trademark AMCILL can be considered a world famous mark that deserves protection under and pursuant to the Convention of Paris for the Protection of Industrial Property (Lisbon version) to which the Philippines like the United States of America, is a signatory;

5. In the Philippines, the trademark AMCILL has been continuously used by Opposer for almost three (3) years and has been recognized by the medical profession and the buying public as indicative of the origin of the goods of Opposer so much so that Applicant's use of a confusingly similar mark like AMCILLIN diminishes the distinctiveness of the trademark AMCILL and thereby dilutes Opposer's goodwill thereon, and is, therefore, tantamount to infringement and unfair competition."

The Opposer relies on the following facts:

"a. Opposer adopted and first used the trademark AMCILL in the U.S.A. for a broad spectrum antibiotic used for treatment of various infections. It secured registration of the said trademark in that country on March 31, 1970 under Certificate of Registration No. 888558;

b. Opposer likewise secured registration of its trademark AMCILL in other countries, most of which registrations are current and subsisting;

c. Opposer has, moreover, secured registration on December 30, 1977 of its trademark AMCILL in the Philippines in the Principal Register for Classes 5 goods under Registration No. 25553 and said registration is effective and valid to date. A copy of the said original registration is attached hereto as Annex "A";

d. Goods bearing Opposer's trademark AMCILL have been sold not only in the U.S.A. and other countries but in the Philippines as well for almost three (3) years now, and due to the high quality of such goods, the consuming public have associated the trademark AMCILL, and the goods on which it is used, with the Opposer. As such, the trademark AMCILL enjoys tremendous goodwill;

e. The trademark AMCILL applied for by the Applicant, apart from being almost similar in appearance and presentation, is, when pronounced, is idem sonams with Opposer's trademark AMCILL and the use of the trademark AMCILLIN in the Philippine market on similar goods, which will be made possible if it is registered, is likely to cause or lead to confusion of the buying public and drug store clerks at the point of purchase."

On June 20, 1990, a Notice to Answer was sent to Respondent-Applicant by registered mail with return card no. 3202, requiring it to file its Answer to the Notice of Opposition within fifteen (15) days from receipt thereof, and that Respondent-Applicant received said Notice on June 28, 1990 at 12:05 P.M. but despite receipt of the Notice respondent-applicant did not file its Answer or any responsive pleading thereto.

On August 13, 1990, Opposer filed a Motion to declare Respondent-Applicant in default in view of the latter's failure to file its Answer. Thus this Bureau declared Respondent-Applicant in default (ORDER NO. 90-440) dated August 21, 1990 and allowed Opposer to present its evidence ex-parte.

On October 17, 1990, Respondent-Applicant filed an urgent manifestation and motion praying that the order of default No. 90-440 dated August 21, 1990 be reconsidered and SET ASIDE. Finding that the Respondent-Applicant has no intention whatsoever to abandon the said case and considering further that it is ready, willing and able to present a valid defense, this Bureau issued ORDER NO. 90-260 dated December 26, 1990 setting aside the order of default, and respondent-applicant was ordered to file its Answer to the verified Notice of Opposition within fifteen (15) days from receipt thereof.

On May 31, 1991, this Bureau issued another Order ORDER NO. 91-483 declaring Respondent-Applicant MOTU PROPRIO as in DEFAULT for failure to file its Answer or any manifestation therein and allowed opposer to present its evidence ex-parte.

On August 19, 1991, Opposer presented its evidence consisting of Exhibits "A" to "G" and their corresponding submarkings.

On October 14, 1991, Opposer submitted its memorandum, arguing that trademark application no. 41300 for the mark "AMCILLIN", in the name of respondent-applicant be denied registration on ground that it is CONFUSINGLY SIMILAR to opposer's registered mark "AMCILL".

> THE ONLY ISSUE IN THIS PROCEEDING IS WHETHER OR NOT RESPONDENT-APPLICANT'S TRADEMARK "AMCILLIN" IS CONFUSINGLY SIMILAR TO OPPOSER'S TRADEMAK "AMCILL".

Sec. 4(d) of R.A. 166, as amended, reads:

> SECTION 4. Registration of trademarks, tradenames and service marks on the principal register. There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. The owner of a trademark, tradename or service mark used to distinguish his goods, business or services of others shall have the right to register the same on the principal register, unless it:
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> xxx
>
> d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers."

A cursory review of the documentary exhibits, actual labels of both trademarks the first six letters and the first two syllables of "AMCILL" and "AMCILLIN" are identical, pronounced in the same manner and are the dominant parts of the marks.

In Philippines Nut Industry, Inc. vs. Standard Brands, Inc., 65 SCRA 575, the Court held:

> "In the cases involving infringement of trademark brought before the Court, it has been consistently held that there is infringement of trademark when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity; that whether or not a trademark causes confusion and is likely to deceive the public is a question. Fact which is to be resolved by applying the "test of dominancy", meaning if the competing trademark contains the main or essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes places; that duplication or imitation is not necessary, a similarity in the dominant features of the trademarks would be sufficient."

The two marks are also used on identical products for respiratory tract infections, genitourinary infections, gastro-intestinal infections, skin and soft tissue infections, and for a broad spectrum antibiotic used for treatment of various infections which fall under Class 6 of the international classification of goods, which would cause the likelihood of confusion, mistake or deception as to the source or origin of the goods in the mind of the purchasing public.

In American Wires and Cables Co. vs. Director of Patents, February 18, 1970, 31 SCRA 544, the Supreme Court held that the determinative factor in a contest involving the registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. In short, to justify a denial of an application for registration, the law does not require that the competing trademarks be so identical as to produce actual error or mistake; it would be sufficient that the similarity be such that there is a possibility or likelihood that the purchasers mistake the older for the newer brand. Thus, the Court found trademark "DYNAFLEX" for electric wires to be confusingly similar to "DURAFLEX", also for electric wires.

Likewise in "Operators, Inc. vs. Director of Patents, L-17901, October 29, 1965, it was held that considering the similarity in APPEARANCE and SOUND between the marks, "AMBISCO" for candy products was found to be confusingly similar with "NABISCO" for bakery product. Based on the foregoing, it is clear that Respondent-Applicant's mark "AMCILLIN" would cause confusion or mistake, or to deceive purchasers that its products are those of the Opposer.

It may also be stated that Respondent-Applicant exerted no effort to defend its rights in this case. In fact, it failed to file its Answer to this Opposition, hence, it was declared in default.

WHEREFORE, premises considered herein Notice of Opposition is, as it is hereby GRNATED. Accordingly, Application Serial No. 41300 filed on May 8, 1980 by Superior Pharmacraft, Inc., for the trademark "AMCILLIN" is hereby REJECTED.

Let a filewrapper of this case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision. Likewise, let a copy of this Decision be furnished the Trademark Examining Division for information and to update its records.

SO ORDERED.

IGNACIO S. SAPALO
Director