

THE UP JOHN COMPANY,)	INTER PARTES CASE NO. 3573
Opposer,)	
)	OPPOSITION TO:
)	Application Serial No. 67274
)	Filed : March 8, 1989
- versus -)	Applicant : Shell Chemical Co.,
)	(Phils.), Inc.
)	Trademark : DIMOTRIN
)	Used on : Insecticides
)	
)	<u>DECISION NO. 93-17 (TM)</u>
SHELL CHEMICAL CO.,)	
(PHILS.), INC.,)	December 28, 1993
Respondent-Applicant.))	
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DECISION

This is an Opposition to the registration of the trademark DIMOTRIN used for insecticides under Serial No. 67274 in the name of the Respondent-Applicant, SHELL CHEMICALS (PHILIPPINES) INC., (SHELL for brevity), a corporation organized and existing under the laws of the Philippines, with principal address at Shell House, 156 Valero St., Salcedo Village, Makati, Metro Manila. Said application was published for Opposition in the official gazette of the Bureau on Vol. III, No. 3 which was officially released on 29 June 1990.

Opposer UPJOHN COMPANY (UPJOHN for brevity) a corporation duly organized and existing under the laws of Delaware, U.S.A believing that it will be damaged by the said registration filed this opposition based on the following grounds:

“1. The Opposer is the owner of the trademark “MOTRIN” having been the first to adopt the same in trade and commerce for “anti-inflammatory agent” under International Class.

2. The aforesaid trademark was registered by Opposer in the United States of America, its home country, as early as 15 December 1970, and in this jurisdiction as early as 5 March 1987. Particulars of the United States and Philippine registrations are reproduced hereunder, to wit:

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|----|------------------|---|---------------------------|
| a) | Trademark | : | “MOTRIN” |
| | Registration No. | : | 90411 |
| | Date Issued | : | 15 December 1970 |
| | Goods | : | “anti-inflammatory agent” |
| | Issued by | : | U.S. Patent Office |
| b) | Trademark | : | “MOTRIN” |
| | Registration No. | : | 36816 |
| | Date Issued | : | 5 March 1987 |
| | Goods | : | “anti-inflammatory agent” |
| | Issued by | : | Philippine Patent Office |

3. The foregoing trademark registrations have not been abandoned and are currently in force.

4. The “MOTRIN” trademark which Opposer created have gained international acclaim around the world and is considered distinctive of superior

quality pharmaceutical preparations, specifically as used as an “anti-inflammatory agent”. Such reputation is true even in the Philippines.

In its answer, Shell denied all the material allegations of the opposition and further alleged that the marks in question are not confusingly similar and that the goods to which they are used also different.

Pre-Trial Conferences were conducted but the parties were not able to reach an amicable settlement for which trial on the merits ensued.

As correctly pointed out by both parties in their respective memoranda, the only issue in this case is whether the marks in controversy are confusingly similar.

An examination of the pleadings submitted by both parties together with their evidence would reveal that the mark DIMOTRIN is used by Shell for agricultural insecticide while Upjohn is using MOTRIN for anti-inflammatory pharmaceutical preparations. Upjohn alleged that its trademark MOTRIN is wholly contained in Shell’s DIMOTRIN trademark and such circumstance occurs the great possibility of confusion to the consumers who have long identified the MOTRIN trademark as a product of Upjohn.

In order to warrant the denial of a trademark application on the ground of confusing similarity, it would be sufficient for purposes of the law that the similarity between the two labels is such that there is a possibility of likelihood of the purchaser of the older brand mistaking the newer brand for it (American Wire Cable vs. Director of Patents, 31 SCRA 544). Our jurisprudence in relation to the issue of confusing similarity of marks used in connection with medicinal preparations are well settled. The class of customers involved and the circumstances attendant to its acquisition are relevant in resolving this question. Medicinal preparations, clothed with trademarks, are unlike articles of everyday use such as candies, ice cream, milk, softdrinks and the like which may be freely obtained by anyone, anytime, anywhere. These products as a rule cannot be purchased without medical prescription. For this, the buyer must have to go to a duly licensed doctor of medicine; he received instructions on what to purchase; he examines the product sold to him; he checks to find out whether it conforms to the medical prescription. Similarly, the pharmacists or druggist verifies the medicine sold. Thus, between the trademarks “ATUSSIN” and “PERTUSSIN” both used for the treatment of cough, it was held that the margin of error in the acquisition of one for the other is remote (Etepha vs. Director of Patents, 16 SCRA 496). The same conclusion was arrived at in the case of Bristol Mayer vs. Director Patents, 17 SCRA 129 when the trademarks “BIOFERIN and BUFFERIN” were held not confusingly similar although both products are for the treatment of cold.

In the case at bar, it would be very unlikely for a person who intends to buy MOTRIN, an anti-inflammatory agent, to be misled to buying instead Respondent’s pesticide product because it is branded DIMOTRIN.

Another factor that is relevant to the determination of confusingly similarity of marks are the channels through which the goods flow. In Esso Standard Eastern vs. Court of Appeals, 116 SCRA 336, it was held that the trademark ESSO used by a corporation for various petroleum products can be used by another as a trademark for cigarettes as the two classes of products flow through different channels of trade. Petroleum products are principally distributed through gasoline service and lubricating stations, auto shops and hardware stores. Cigarettes are sold in sari-sari and grocery stores and the like.

In the present case, Upjohn products bearing the trademark MOTRIN are sold principally by drug stores while Shell’s DIMOTRIN products are sold principally by agricultural or general merchandise stores.

Likewise, in the case of Sterling Products International Inc. vs. Farbenfabrieken Bayer, etc. 27 SCRA 1214, the Supreme Court ruled that a party may use the trademark BAYER for its

insecticide despite the fact that the same mark is already registered in favor of another party for medicinal products.

WHEREFORE, premises considered, the Opposition is hereby DISMISSED and the Application Serial No. 67274 is hereby GIVEN DUE COURSE.

Let the filewrapper of this case be forwarded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director