

LABORATOIRES EXPANSCIENCE,
Opposer,

INTER PARTES CASE NO. 3868
Opposition to:

-versus

Serial No.: 77448
Date Filed: August 23, 1991
Trademark: "MUSKELAX"

MEDICHEM PHARMACEUTICALS, INC,
Respondent-Applicant.

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DECISION NO. 97-37

DECISION

This pertains to an opposition filed by Laboratoires Expanscience, Inc., in the matter of application for registration of the trademark "MUSKELAX" for use on analgesic/anti-inflammatory medicinal preparation in Class 5 bearing Serial No. 77448 filed on August 23, 1991 by Respondent-Applicant MEDICHEM PHARMACEUTICALS, INC. with address at Makati City, Philippines and which application was published for opposition in the Official Gazette of the BPTTT, Volume V, No. 5, officially released on October 28, 1992.

The herein Opposer is a foreign corporation with business address at 93 Boulevard dela Mission Marchand 92400 COURBEVOIE, FRANCE.

The following, grounds upon which Opposer basis its opposition are as follows:

"1. The Opposer is the owner of the trademark "MUSTELA", having been the first to adopt the same in trade and commerce for goods falling under International Classes 3 and 5 (Include other classes, if any).

"2. The trademark "MUSTELA" was registered by Opposer in France on 13/04/1950 under Registration No. 470541. Registrations in countries all over the world have also been obtained.

"3. Foregoing trademark registration have not been abandoned and are currently in force,

"4. The trademark "MUSTELA" which Opposer originated and adopted is known in the Philippines and elsewhere in the world. Opposer's products carried under said mark had, through the years, earned international acclaim as well as the distinct reputation of high quality products, first use in USA 1987, Greece 1980, Mexico 1962, France 1950, Canada 1989, Philippines 1991, Australia 1987, Spain 1964, Switzerland 1964, Portugal 1964, Italy 1964."

Opposer relied on the following facts to support its contention.

"1. The trademark "MUSKELAX" of the Respondent-Applicant is a flagrant and veritable imitation of herein Opposer's trademark as likely to cause confusion, mistake and deception to the buying public as to the source of Respondent-Applicant's goods.

"2. Opposer had invested tremendous amount of resources in the promotion of its "MUSTELA" trademark, i.e., advertisements in well-known newspapers, magazines, and other publications around the world. It is the resultant goodwill and popularity of Opposer's trademark that Respondent-Applicant wishes to exploit and capitalize.

"3. The application subject of this opposition was filed only on August 23, 1991 whereas herein Opposer has been granted Certificates of Registration for its mark "MUSTELA" in France

and in the Philippines. Registrations and applications for trademark protection have also been obtained/filed in Europe, Asia, Africa and America.

“4. The registration of Respondent-Applicant's mark would violate Opposer's rights and interests in its trademark, cause confusion between the Opposer's and Respondent-Applicant's respective businesses and will most assuredly cause the dilution and loss of distinctiveness of Opposer's “MUSTELA”.”

On March 8, 1993, Medichem Pharmaceuticals, Inc., the herein Respondent filed its Answer through Counsel denying the material allegations in the opposition.

The issues having been joined, this Office called this case for pre-trial. Failing to reach an amicable settlement, the parties went into trial.

On June 8, 1995, the parties submitted a Joint Stipulation of Facts, to wit:

“1. Opposer is the owner of the trademark “MUSTELA” and has in its favor subsisting trademark registrations covering the said trademark in various foreign countries. Opposer is further the registered owner of the “MUSTELA” trademark in the Philippines under Philippine Trademark Registration No. 59568 issued on 21 November 1994. The underlying trademark application from which the said Philippine Registration No. 59568 issued was based upon Opposer's corresponding French Trademark Registration No. 1556802 dated 24 October 1989.

“2. Opposer has been in continuous use of its “MUSTELA” trademark in the Philippines since the year 1991. On the other hand, Respondent-Applicant has been in continuous use of the mark “MUSKELAX” in the Philippines since May 1991.

“3. Opposer uses its trademark "MUSTELA" on perfume and hygienic products, more specifically on skin care lotion and cream. On the other hand, Respondent-Applicant uses the mark “MUSKELAX” on analgesic/anti-inflammatory medicinal preparations. Respondent-Applicant filed on 23 August 1991 an application for the registration of the mark “MUSKELAX” on 23 August 1991 under Application Serial No. 77448 which application is the subject of the present opposition.

“4. The sole issue in this case is whether or not Opposer's trademark “MUSTELA” and Respondent-Applicant's mark “MUSKELAX” are confusingly similar with each other as to bar the registration of the latter mark in accordance with Section 4(d) of Republic Act No. 166, as amended.”

As Jointly Stipulated by the parties after admission of facts stated in their Joint Stipulation of Facts, they have agreed and therefore submitted to this Honorable Office that the only issue to be resolved is:

WHETHER OR NOT the marks “MUSKELAX” and “MUSTELA” are confusingly similar to each other.

The applicable provision is Section 4(d) of R.A. No. 166, as amended which provides:

“SEC. 4. Registration of trademarks, trade names and service mark on the principal register. - There is hereby established a register of trademarks, trade names and service marks which shall be known as the principal register. The owner of a trade mark, trade name or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register unless it:

x x x

- (d) Consists of or comprise 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 service of the applicant, to cause confusion or mistake or to deceive consumers”.

A close and careful consideration of the records sets forth the findings to wit:

1. No confusion would exist even if “MUSKELAX” and “MUSTELA” appear simultaneously and side by side with each other in the market.
2. Both marks may co-exist independently from each other without giving rise to confusion among consumers as both differ in MEANING, SPELLING, SOUND, APPEARANCE, PICTORIAL REPRESENTATION, SIZE, as well as SHAPE:
3. The only similarity between them is the common use of the word “MUS”.

In resolving whether or not “MUSKELAX” is confusingly similar with “MUSTELA”, the test is not simply to take their words and compare the SPELLING and PRONUNCIATION of said words. Rather it is consider the two marks in their entirety as they appear in their respective labels, in relation to the goods to which they are attached (Mead Johnson & Co. vs. N.V.J Van Dorp., Ltd., L-17501, April 27, 1963).

Trademark having the same suffix and similar sounding prefix but with strikingly different background are not apt to confuse prospective customers. As stated by the Supreme Court in the case of Bristol Myers Company, Petitioner vs. The Director of Patents and United American Pharmaceuticals Inc., Respondent (17 SCRA 126), “For though the words “BIOFERRIN” and “BUFFERIN” have the same suffix and similar sounding prefixes, they appear in their respective labels with strikingly different backgrounds and surroundings as to color, size and design”.

One important factor to be considered is the class of purchasers of the products in question. x x x regard too should be given to the class of persons who buy the particular product and the circumstances ordinarily attendant to its acquisition. The medicinal preparations clothed with the trademarks in question, is unlike articles of everyday use such as candies, ice cream, milk, soft drinks and the like which may be freely obtained by anyone, (Supra, at p. 501).

It must be noted that the goods covered by the mark “MUSKELAX” are to be dispensed upon medical prescription. 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.

On the other hand, the products covered by the mark “MUSTELA” is not dependent upon prescription of a physician as the products are specifically perfumery and hygienic products namely skin care lotion and cream. The chances of the consumer being confused into purchasing one for the other therefore are the more rendered negligible. He know 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. Similarly, the pharmacist or druggist verifies the medicine sold. Therefore, the margin of error in the acquisition of one for the other is quite remote.

The Supreme Court has consistently held that in cases requiring prescription of a doctor before a product could be purchased, the possibility of confusion, or mistake or to deceive purchasers is quite remote. (Etepha vs. Director of Patents, et. al. Supra; Bristol Myers Co. vs. Director of Patents, 17 SCRA 129, Mead Johnson & Co. vs. N.V.J. Van Dorp Ltd., 7 SCRA 168, American Cyanamid Co. vs. Director of patents, 76 SCRA 568)

Also, in another case, the Supreme Court ruled: It is true that between Petitioner's trademark "ALACTA" and Respondent's trademark "ALASKA" there are similarities in spelling, appearance and sound for both are composed of six letters of three syllables each and each syllable has the same vowel, but in determining if they are confusingly similar, a comparison of said words is not the only determining factor. The two marks in their entirety, as they appear in their respective labels must also be considered in relation to the goods, to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is similar to the other. (Mead Johnson Co. vs. N.V.J. Van Dorp. Ltd, at al., 7 SCRA-768)

Applying these tests to the trademarks involved in the instant case, it is clear that no likelihood of confusion among the consumers of the products carrying the competing marks could take place.

WHEREFORE, in view of all the foregoing, this Opposition case is, it is hereby DENIED. Accordingly, Application Serial No. 77448 for the registration of the trademark "MUSKELAX" filed on August 23, 1991 by Respondent-Applicant Medichem Pharmaceuticals, Inc., is hereby, GIVEN DUE COURSE.

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

SO ORDERED.

Makati City, December 16, 1997.

EMMA C. FRANCISCO
Director