



GLAXO GROUP LIMITED,
Opposer,

-versus-

SHEILA MAE M. VELILLA,
Respondent- Applicant.

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}
} IPC No. 14-2012-00120
} Opposition to:
} Appln. Serial No. 4-2011-750096
} Date Filed: 07 December 2011
} TM: "CLAVIMOX"

NOTICE OF DECISION

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SHEILA MAE M. VEVILLA
Respondent-Applicant
35 Scout Lozano St.,
Brgy. Laging Handa
Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 67 dated April 16, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 16, 2013.

For the Director:


ATTY. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



GLAXO GROUP LIMITED,
Opposer,

IPC No. 14-2012-00120
Case Filed: 14 May 2012

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SHEILA MAE M. VELILLA,
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TM: "CLAVIMOX"

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Decision No. 2013- 67

DECISION

GLAXO GROUP LIMITED, ("Opposer")¹ filed on 14 May 2012 a Verified Notice of Opposition to Trademark Application Serial No. 4-2011-750096. The application, filed by SHEILA MAE M. VELILLA ("Respondent-Applicant")², covers the mark "CLAVIMOX" for use on "pharmaceutical preparations" under Class 5 of the International Classification of Goods and Services³.

The Opposer anchors its opposition on the ground that the Respondent-Applicant's trademark CLAVIMOX nearly resembles the Opposer's mark CLAVAMOX registered in the Philippines under Registration No. 4-2003-000226 issued on 20 November 2005 for goods in Class 5 namely "antibiotic preparations". According to the Opposer, the registration of the mark CLAVIMOX is proscribed by Sec. 123.1 (d) of R.A. No. 8293, which provides:

Section 123. Registrability. 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 good 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;

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¹ A corporation duly organized and existing under the laws of England, with business address at 980 Great West Road Brentford Middlesex TW8, 9GS, England.

² With business address at No. 35 Scout Lozano St., Brgy. Laging Handa, Quezon City, Philippines.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

In support of its opposition, the Opposer submitted as evidence the following:

1. Exhibit "A" – Affidavit executed by Ms. Joanne Green;
2. Exhibit "A-1" – A print-out from the Intellectual Property Office (IPO) database of Philippine Trademark Registration No. 4-2003-000226;
3. Exhibit "A-2" – A print-out from the Intellectual Property Office (IPO) database of Philippine Trademark Registration No. 4-2011-750096;
4. Exhibit "A-3" – A print-out from the Intellectual Property Office (IPO) database of Philippine Trademark Registration No. 4-2000-006661;
5. Exhibit "A-4" – A copy of the CPR with Certificate of Product Registration No. VR-3278;
6. Exhibit "A-5" – Photos, packaging and package inserts of the products bearing the trademark CLAVAMOX;
7. Exhibit "A-6" – Samples of product packaging, package inserts and tablets sold in the Philippines;
8. Exhibit "A-7" – A list of the worldwide trademark registrations and applications for CLAVAMOX;
9. Exhibit "A-7-a" – A copy of the certificate trademark registration for CLAVAMOX issued in Germany;
10. Exhibit "A-7-b" – A copy of the certificate trademark registration for CLAVAMOX issued in Italy;
11. Exhibit "A-7-c" – A copy of the certificate trademark registration for CLAVAMOX issued in France;
12. Exhibit "A-7-d" – A copy of the certificate trademark registration for CLAVAMOX issued in Canada;
13. Exhibit "A-7-e" – A copy of the certificate trademark registration for CLAVAMOX issued in Austria;
14. Exhibit "A-7-f" – A copy of the certificate trademark registration for CLAVAMOX issued in Panama;
15. Exhibit "A-7-g" – A copy of the certificate trademark registration for CLAVAMOX issued in United States of America;
16. Exhibit "A-8" – Printouts from the website http://rxbestpriceonline.com/item.php?group_id=148&id=4953;
17. Exhibit "A-8-a" – Printouts from the website <http://www.drugs.com/vet/c;avamox-tablets.html>;
18. Exhibit "A-8-b" – Printouts from the website <http://www.petplace.com/drug-library/amoxicillin-clavulanate-clavamox/page1.aspx>;
19. Exhibit "A-8-c" – Printouts from the website <http://www.1800petmeds.com/Clavamox-prod3319.html>;
20. Exhibit "A-8-d" – Printouts from the website http://www.drsfostersmith.com/product/prod_display.cfm?pcatid=10121;
21. Exhibit "A-8-e" – Printouts from the website http://ratguide.com/meds/antimicrobial_agents/clavamox_amoxicillinclavulanate.php;
22. Exhibit "A-8-f" – Printouts from the website <http://heartlandvetsupply23.com/p-2738-clavamox-drops-for-cats-and-dogs.aspx>;

23. Exhibit "A-8-g" – Printouts from the website <http://en.wikipedia.org/wiki/Clavamox>.
24. Exhibit "A-9" – A copy of a CLAVAMOX product brochure;
25. Exhibit "A-9-a" – A copy of a CLAVAMOX product sell sheet;
26. Exhibit "A-9-b" – A copy of a CLAVAMOX Owner Information Sheet;
27. Exhibit "A-9-c" – A copy of a CLAVAMOX product detailer; and
28. Exhibit "A-9-d" – Printouts from the website http://www.pfizerah.com/Product_Overview.aspx?drug=CT&species=FL.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 08 June 2012. However, the Respondent-Applicant did not file the Verified Answer.

Should the Respondent-Applicant's trademark application be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his products⁴.

In this regard, Section 123.1 (d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services or closely related goods or services, or if it is nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed her trademark application on 07 December 2011, the Opposer has an existing registration issued by the Intellectual Property Office of the Philippines on 20 November 2005 bearing Reg. No. 4-2003-000226 for the mark CLAVAMOX for Antibiotic preparations under Class 5 of the International Classification of Goods.

A scrutiny of the mark applied for registration by the Respondent-Applicant shows that the same is nearly identical to the Opposer's, as shown below:

CLAVAMOX

Opposer's mark

CLAVIMOX

Respondent-Applicant's mark

Both marks consists of three (3) syllables and nine (9) letters and out of the nine letters, the only difference is one letter more specifically in their 3rd syllables which is "A" in the

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

Opposer's and "I" in the Respondent-Applicant's mark. The changes did little in conferring upon the Respondent-Applicant's mark a character that would make it clearly distinct from the Opposer's. The marks look and sound alike. In this regard, it is stressed that confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusingly similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchasers as to cause him to purchase the one supposing it to be the other⁵.

Colorable imitation does not mean such similarities as amounts to identity, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in the form, content, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confusion persons in the ordinary course of purchasing genuine article⁶.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it⁷. The Respondent-Applicant's trademark application covers "pharmaceutical preparation". This means therefore, that it also includes "antibiotics" and similar or related pharmaceutical products. Succinctly, the Opposer's trademark Reg. No. 4-2003-000226 covers "antibiotic preparations". In this regard trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound produced by CLAVAMOX is practically replicated when one pronounces the Respondent-Applicant's mark. The likelihood of confusion would subsist not only on the purchaser's perception of goods but also on the origins thereof as held by the Supreme Court⁸:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into

⁵ Societe Des Produits Nestle S.A. v. Court of Appeals G.R. No. 1,000098 29 December 1995.

⁶ Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 Dec. 1995.

⁷ See American Wire and Cable Co. v. Director of Patents et.al. (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

⁸ Converse Rubber Corporation v. Universal Rubber Products, Inc., et.al. G.R. No. L-27906, 08 Jan. 1987.

belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

It is stressed that the Respondent-Applicant was given the opportunity to explain her side and defend her trademark application. However, she failed and/or chose not to do so.

WHEREFORE, premises considered the opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-750096 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 April 2013.



ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs



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