MERCK, INC., Opposer, **-versus-** **NUTRAMEDICA, INC.,** Respondent-Applicant.	}	**IPC No. 14-2011-00315** Opposition to: Appln. Serial No. 4-2011-000915 Date filed: 29 Jan. 2011 TM:**"DIATROL"**

x----------x

NOTICE OF DECISION

BUCOY POBLADOR & ASSOCIATES
Counsel for the Opposer
21st Floor, Chatham House
Valero corner Rufino Streets
Salcedo Village, Makati City

HUTRAMEDICA, INC.
c/o HAIDEE MANALO
For the Respondent-Applicant
No. 35 Scout Lozano St.,
Brgy. Laging Handa
Quezon City

GREETINGS:

Please be informed that Decision No. 2012 – 221 dated November 07, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 07, 2012.

For the Director:

Atty. RAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs

MERCK, INC.,
Opposer,

- versus -

NUTRAMEDICA, INC.,
Respondent-Applicant.
x————————————————x

IPC No. 14-2011-00315
Opposition to:

Appln. No. 4-2011-000915
(Filing Date: 27 Jan. 2011)
TM: "DIATROL"

Decision No. 2012- 221

DECISION

MERCK, INC. ("Opposer")[1], filed on 26 August 2011 an opposition to Trademark Application Serial No. 4-2011-000915. The application, filed by NUTRAMEDICA, INC. ("Respondent-Applicant")[2], covers the mark "DIATROL" for use on "*Oral Hypoglycemic Drug*" under Class 5 of the International Classification of goods/services.[3]

The Opposer alleges among other things, that it is the registered owner of the mark "DIANORM" under Reg. No. 4-2000-005313 issued on 23 April 2009 for use "*oral hypoglycemic tablets*" under Class 5. According to the Opposer, because DIATROL is confusingly similar to DIANORM, its registration is proscribed by Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). To support its opposition, the Opposer submitted the following:

1. Special Power of Attorney it executed in favor of its counsel;
2. specimen label of DIANORM "*oral hypoglycemic*" product;
3. Affidavit of its President and Managing Director Ramonito T. Tampos; and
4. certified copy each of the Securities and Exchange Commission Certificate of Filing of Amended Articles of Incorporation of the Opposer, Reg. No. 4-2000-005313 for the mark DIANORM issued on 23 April 2009, and the Declaration of Actual Use ("DAU") filed by Sonix Pharmaceuticals, Inc., ("Assignor" to Opposer of Reg. No. 4-2000-005313);
5. copies of the DAU it filed in connection with Trademark Application Serial No. 4-2000-005827, sales invoice/evidence of sale of pharmaceutical product for various years, and product information, all in relation to DIANORM.

The Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 09 September 2011. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the mark DIATROL?

---

1 A corporation organized and existing under the laws of the Republic of the Philippines, with business address at 24/F GT Tower International, 6813 Ayala corner H.V. dela Costa St., Salcedo Village, 1227 Makati City, Philippines

2 No. 35 Scout Lozano St., Barangay Laging Handa, Quezon City

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.

The essence of trademark registration is to give protection to the owners of 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 product.[4] Thus, Sec. 123.1(d) of the IP Code provides that a mark cannot be registered if its 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 nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 27 January 2011, the Opposer already has an existing trademark registration for DIANORM under Reg. No. 4-2000-005313 issued on 23 April 2009. The Opposer's trademark registration indicates that the mark is for use on "*oral hypoglycemic tablets*" under Class 5. This is the same product covered by the Respondent-Applicant's trademark application.

But, do the marks resemble each other such that confusion, or even deception, is likely to occur?

Both marks start with the letters or prefix "DIA". This Bureau agrees with the Opposer's assertion that DIA is the "easily recalled feature of the competing marks"[5]. Considering therefore, that the marks are used or for use on "*oral hypoglycemic*" products, the difference in the composition of the marks as regards their respective last syllables did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing 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 purchaser as to cause him to purchase the one supposing it to be the other[6]. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, 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 confuse persons in the ordinary course of purchasing the genuine article[7].

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 it.[8] The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:[9]

> 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

---

[4] See *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.
[5] Verified Notice of Opposition, page 3, third paragraph.
[6] *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 04 Apr. 2001, 356 SCRA 207, 217.
[7] *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.
[8] *American Wire and Cable Co. v. Director of Patents et al.*, (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.
[9] *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

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

There is the likelihood that information, assessment, perception or impression about DIATROL products may be unfairly cast upon or attributed to the DIANORM products and the Opposer, and *vice-versa.*

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant Opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2011-000915 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 07 November 2012.

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