UNITED AMERICAN PHARMACEUTICALS, INC., Opposer, **-versus-** **MEDIRICH PHARMA DISTRIBUTION CORP.,** Respondent –Applicant.	}	**IPC No. 14-2013-00367** Opposition to: Appln. Serial No. 4-2012-0014963 Date Filed: 12 December 2012 **TM: "FLOXOFEL OD"**

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for the Opposer
No. 66 United Street
Mandaluyong City

MEDIRICH PHARMA DISTRIBUTION CORP.
Respondent-Applicant
Room 208 J. Borromeo Building
F. Ramos corner Arlington Pond St.
Cebu City

GREETINGS:

Please be informed that Decision No. 2014 - 108 dated April 14, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 14, 2014.

For the Director:

Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs

UNITED AMERICAN PHARMACEUTICALS, INC., Opposer,	}	**IPC No. 14-2013-00367** Opposition to:
- versus -	}	Application No. 4-2012-00014963 Date Filed: 12 December 2012
MEDIRICH PHARMA DISTRIBUTION CORPORATION, Respondent-Applicant.	}	Trademark: **FLOXOFEL OD**
x----------x		Decision No. 2014 - 108

DECISION

UNITED AMERICAN PHARMACEUTICALS, INC.[1] ("Opposer") filed on 28 August 2013 a Verified Notice of Opposition to Trademark Application No. 4-2012-00014963. The application, filed on 12 December 2012 by MEDIRICH PHARMA DISTRIBUTION CORPORATION[2] ("Respondent-Applicant"), covers the mark FLOXOFEL OD for use on *"pharmaceutical product categorized as an anti-infective, used in the treatment of a wide range of infections including lower respiratory tract infections, typhoid fever, paratyphoid fever and urinary infections"* under Class 5 of the International Classification of Goods.[3]

The Opposer anchors its opposition on Section 123.1, paragraph (d)[4] of Republic Act No. 8293 or the Intellectual Property Code of the Philippines ("IP Code"). The Opposer alleges that the mark FLOXOFEL OD applied for by Respondent-Applicant so resembles the trademark FLOXEL owned by Opposer and duly registered prior to the publication of the subject trademark application. According to the Opposer, the registration of the mark FLOXOFEL OD will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark FLOXOFEL OD is applied for the same class and goods as that of the Opposer.

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

1. Copy of the pertinent page of the IPO e-Gazette bearing publication date of 29 July 2013;

---

[1]A domestic corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines, with office address at 132 Pioneer Street, Mandaluyong City, Philippines.

[2]A Philippine corporation, with office address at Rm. 208 J. Borromeo Building, F. Ramos corner Arlington Pond Street, Cebu City, Philippines.

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

[4]Section 123.1 (d) of the IP Code states, "A mark cannot be registered if it x x x 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 goods 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 x x x"

2. Certified true copy of Certificate of Registration No. 4-1999-006295 issued on 17 January 2005 for the trademark FLOXEL;
3. Certified true copy of the Assignment of Registered Trademark dated 22 August 2013 duly filed with the IPO on 27 August 2013;
4. Certified true copies of the Declaration of Actual Use and Affidavit of Use;
5. Sample product label bearing the trademark FLOXEL;
6. Certified true copy of the Certification and sales performance issued by IMS Health Philippines, Inc.; and
7. Copy of the Certificate of Product Registration issued by the Food and Drug Administration.[5]

This Bureau issued a Notice to Answer dated 10 September 2013 and was received by the Respondent-Applicant on 19 September 2013. The Respondent-Applicant, however, did not file its Answer. Accordingly, this Bureau issued Order No. 2014-136 dated 28 January 2014, declaring the Respondent-Applicant in default and submitting the case for decision on the basis of the opposition, affidavit of witness and documentary or object evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the trademark FLOXOFEL OD?

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.[6] Thus, Section 123.1 (d) of R. A. 8293, also known as the Intellectual Property Code of the Philippines ("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 nearly resembles such a mark as to be likely to deceive or cause confusion.

In this regard, the records and evidence show that at the time the Respondent-Applicant filed its application for the mark FLOXOFEL OD on 12 December 2012 the Opposer's affiliate Medichem Pharmaceuticals, Inc. already has an existing registration (No. 4-1999-006295) for the trademark FLOXEL issued on 17 January 2005. The said mark was assigned to herein Opposer by virtue of the Assignment of Registered Trademark filed on 27 August 2013. The Opposer's mark is registered under Class 5 as *"antibacterial pharmaceutical preparation"* while the Respondent-Applicant's mark is applied for Class 5 also, specifically for *"pharmaceutical product categorized as an anti-infective, used in the treatment of a wide range of infections including lower respiratory tract infections, typhoid fever, paratyphoid fever and urinary infections"*.

---

[5] Exhibits "A" to "G", inclusive.

[6] See *Pribhdas]. Mirpuri v. Court of Appeals,* G. R. No. 114508, 19 November 1999.

Undoubtedly, both marks cover goods used for treating infections and bacteria; hence, they are used on similar or closely related goods.

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

Opposer's mark

Respondent-Applicant's mark

The six (6) letters comprising the Opposer's FLOXEL are practically present in the Respondent-Applicant's mark. They both have the same first four letters "F", "L", "O" and "X" and ends with letters "E" and "L". The difference lies in the addition of the middle letters "O" and "F" in the Respondent-Applicant's FLOXOFEL and the letters "OD". The additional letters, however, are inconsequential to negate the possibility of confusion since what appears to be dominant are the letters comprising the Opposer's mark. Also, even though there are variations in the spelling, the marks produce almost the same sound effect when pronounced. The marks FLOXEL and FLOXOFEL when pronounced may cause confusion to purchasers since the first and the last syllables are the same.

As ruled by the Supreme Court, confusion cannot be avoided by merely dropping, adding or changing some of the 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.[7] 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 trade name with that of the other mark or trade name 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.[8]

Succinctly, because the Opposer's and Respondent-Applicant's marks both deal with similar or related goods, the changes in the spelling therefore did not diminish the likelihood of the occurrence of mistake, confusion or even deception.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or

---

[7] *Societe Des Produits Nestle S. A. v. Court of Appeals*, G. R. No. 112012, April 4, 2001.

[8] See *Emerald Garment Manufacturing Corp. v. Court of Appeals*, G.R. No. 100098, 28 Dec. 1995.

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.[9] 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[10]:

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

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 filewrapper of Trademark Application No. 4-2012-00014963 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 April 2014.

Atty. NATHANIEL S. AREVALO
Director IV / Bureau of Legal Affairs

/maane.ipc14-2013-00367

---

[9] *American Wire and Cable Co. v. Director of Patents, et. al.*, G. R. No. L-26557, 18 February 1970.

[10] *Converse Rubber Corporation v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.