



BIOFEMME, INC.

Opposer,

-versus-

PFIZER, INC.

Respondent-Applicant.

IPC No. 14-2009-000134

Case Filed: 14 May 2009

Opposition to:

Application No. 4-2008-012617

Date Filed: 15 October 2008

Trademark: "TERRAMYCIN"

Decision No. 2014- 295

DECISION

BIOFEMME, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2008-012617. The application, filed by Pfizer, Inc.² ("Respondent-Applicant"), covers the mark "TERRAMYCIN" for use on *"pharmaceutical preparations, namely, an antibiotic preparation containing oxytetracycline or a derivative thereof; veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides"* under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"GROUNDS FOR OPPOSITION"

"The grounds for this opposition are as follows:

"1. The trademark "TERRAMYCIN" so resembles "TRIMYCIN" trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark "TERRAMYCIN". The trademark "TERRAMYCIN", which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark "TERRAMYCIN" is applied for the same class of goods as that of trademark "TRIMYCIN", i.e. Class (5).

"2. The registration of the trademark "TERRAMYCIN" in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", which provides, in part, that a mark cannot be registered if it:

x x x

¹ A foreign corporation with principal address at 235 East and 42nd Street, New York, New York 10017, USA.

² A foreign corporation with address at 235 East 42nd Street, New York, New York 10017, United States of America.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"Under the above-quoted provision, any mark which is similar to a registered mark shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

"3. Respondent's use and registration of the trademark "TERRAMYCIN" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "TRIMYCIN".

"ALLEGATIONS IN SUPPORT OF THE OPPOSITION"

"In support of this Opposition, Opposer will rely upon and prove the following facts:

"4. Opposer, the registered owner of the trademark "TRIMYCIN", is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark "TRIMYCIN" was originally filed with the Philippine Patent Office by Opposer's sister company, United American Pharmaceuticals, Inc. ("UAP") on 03 October 1979 and was approved for registration on 17 December 1985, valid for a period of twenty (20) years. A copy of the Certificate of Registration Number 34979 for the trademark "TRIMYCIN" is hereto attached as Annex "B". On 1 June 2005 UAP transferred its ownership of the mark "TRIMYCIN" to herein Opposer. A copy of the Deed of Assignment is hereto attached as Annex "C". Prior to its expiration, Opposer filed for renewal of registration with the Intellectual Property Office which was approved and valid for a period of ten (10) years from 17 December 2005. A copy of the Certificate of Renewal of Registration is hereto attached as Annex "D".

"5. The trademark "TRIMYCIN" has been extensively used in commerce in the Philippines.

"5.1 Opposer dutifully filed Affidavits of Use pursuant to the requirement of law, to maintain the registration of "TRIMYCIN" in force and effect. Copies of the Affidavits of Use filed are hereto attached as Annexes "E", "F" and "G".

"5.2 A sample of product label bearing the trademark "TRIMYCIN" actually used in commerce is hereto attached as Annex "H".

"5.3 In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, we registered the products with the Bureau of Food and Drugs (BFAD). A copy of the Certificate of Product Registration issued by the BFAD for the mark "TRIMYCIN" is hereto attached as Annex "I".

"6. There is no doubt that by virtue of the prior filing and registration of the mark "TRIMYCIN", the Opposer has acquired an exclusive ownership over the "TRIMYCIN" mark to the exclusion of all others.

"7. "TERRAMYCIN" is confusingly similar to "TRIMYCIN".

"7.1 There are no set rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or is a colorable imitation of, another. Nonetheless, jurisprudence provides enough guidelines and tests to determine the same.

"7.1.1 In fact, in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* [356 SCRA 207, 216,] the Supreme Court, citing *Ethepa v. Director of Patents*, held "[i]n determining if colorable imitation exists, jurisprudence has developed two kinds of tests - the Dominancy Test and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitute infringement. On the side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity."

"7.1.2 It is worthy to note at this point that in *Societe' Des Produits Nestle', S.A. vs. Court of Appeals* [Supra, p. 221,] the Supreme Court held "[T]he totality or holistic test only relies on visual comparison between two trademarks whereas the dominancy test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks."

"7.1.3 Relative thereto, the Supreme Court in *McDonalds' Corporation vs. L.C. Big Mak Burger, Inc.* [437 SCRA 10] held:

x x x

"7.1.4 Applying the dominancy test, it can be readily concluded that the trademark "TERRAMYCIN", owned by Respondent, so resembles the trademark "TRIMYCIN", that it will likely cause confusion, mistake and deception on the part of the purchasing public.

"7.1.5 Clearly, the Respondent adopted the dominant features of the Opposer's mark "TRIMYCIN";

"7.1.6 As further ruled by the High Court in McDonald's case [p.33]

x x x

"7.2 The trademark "TRIMYCIN" and Respondent's trademark "TERRAMYCIN" are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

"7.2.1 Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed trademark "TERRAMYCIN" is applied for the same class and goods as that of trademarks "TRIMYCIN", i.e. Class (5);, to the Opposer's extreme damage and prejudice.

"7.3 Yet, Respondent still filed a trademark application for "TERRAMYCIN" despite its knowledge of the existing trademark registration of "TRIMYCIN" which is confusingly similar thereto in both its sound and appearance.

"8. Moreover, Opposer's intellectual property right over its trademark is protected under Section 147 of Republic Act No. 8293, otherwise known as the Philippine Intellectual Property Code ("IP Code"), which states:

x x x

"9. To allow Respondent to continue to market its products bearing the "TERRAMYCIN" mark undermines Opposer's right to its marks. As the lawful owner of the marks "TRIMYCIN", Opposer is entitled to prevent the Respondent from using a confusingly similar mark in the course of trade where such would likely mislead the public.

"9.1 Being the lawful owner of "TRIMYCIN", Opposer has the exclusive right to use and/or appropriate the said marks and prevent all third parties not having its consent from using in the course of trade identical or similar marks, where such would result in a likelihood of confusion.

"9.2 By virtue of Opposer's ownership of the trademark "TRIMYCIN", it also has the right to prevent third parties, such as Respondent, from claiming ownership over Opposer's marks or any depiction similar thereto, without its authority or consent.

"9.3 Moreover, following the illustrative list of confusingly similar sounds in trademarks which the Supreme Court cited in McDonald's Corporation, McGeorge Food Industries, Inc. vs. L.C. Big Mak Burger, Inc., 437 SCRA 268 (2004), it is evident that the mark "TERRAMYCIN" is aurally confusingly similar to Opposer's mark "TRIMYCIN".

"9.4 To allow Respondent to use its "TERRAMYCIN" mark on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the "TERRAMYCIN" products of Respondent originate from or is being manufactured by Opposer, or at the very least, is connected or associated with the "TRIMYCIN" products of Opposer, when such connection does not exist.

"9.5 In any event, as between the Respondent, a newcomer, which by the confusion loses nothing and gains patronage unjustly by the association of its products bearing the "TERRAMYCIN" mark with the well-known "TRIMYCIN" mark, and the first user and actual owner of the well-known mark, Opposer, which by substantial investment of time and resources and by honest dealing has already achieved favor with the public and already possesses goodwill, any doubt should be resolved against the newcomer, Respondent, considering that Respondent, as the latter entrant in the market had a vast range of marks to choose from which would sufficiently distinguish its products from those existing in the market.

"10. The registration and use of Respondent's confusingly similar trademark on its goods will enable the latter to obtain benefit from Opposer's reputation and goodwill and will tend to deceive and/or confuse the public into believing that Respondent is in any way connected with the Opposer.

"11. Likewise, the fact that Respondent seeks to have its mark "TERRAMYCIN" registered in the same class (Nice Classification 5) as the trademark "TRIMYCIN" of Opposer plus the fact that both are for treatment of the skin will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

"12. Thus, Opposer's interests are likely to be damaged by the registration and use of the Respondent of the trademark "TERRAMYCIN". In support of the foregoing, the instant Opposition is herein verified by Ms. Susan Yumul which likewise serves as her affidavit (Nasser v. Court of Appeals, 191 SCRA 783 [1990]).

The Opposer's evidence consists of a copy of the IPO E-Gazette officially released on 13 February 2009; copy of the certificate of registration No. 34979 for the trademark "TRIMYCIN"; copy of the deed of assignment between UAAP and herein Opposer, Biofemme, Inc.; copy of the certificate of renewal of registration for the mark "TRIMYCIN" issued on 17 December 1985; copies of the affidavits of use filed; a sample of product label bearing the trademark "TRIMYCIN"; copy of the certificate of product registration issued by BFAD for the mark "TRIMYCIN".⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant, Pfizer, Inc., on 08 June 2009. The Respondent-Applicant filed their Answer on 02 October 2009 and avers the following:

x x x

"Admissions and Denials

"1. Respondent specifically denies the prefatory paragraph of the Verified Opposition dated 14 May 2009 to the extent that it is alleged that Opposer Biofemme, Inc. will be damaged by the approval of Respondent's application. Opposer will not suffer any damage if the opposed application proceeds to registration. Respondent denies, for lack of knowledge or information sufficient to form a belief as to the truth thereof, the rest of the allegations in the prefatory paragraph to the extent that it states the business details of the Opposer.

"2. Respondent specifically denies the first ground of the opposition, the truth being that the marks do not resemble each other. A comparison of the features of Opposer's TRIMYCIN mark and Respondent's TERRAMYCIN mark readily shows the marked differences between these marks.

"3. Respondent specifically denies the second ground of the opposition, the truth being that Section 123 of the IP Code is inapplicable to the case at bar.

⁴ Marked as Annexes "A" to "I".

Respondent's mark cannot be said to be "identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date." This Honorable Office's own records would show that Respondent's TERRAMYCIN trademark had been used in the Philippines as early as 25 April 1950, and registered on 15 September 1953, long before Opposer's predecessor-in-interest registered its mark on 17 December 1985.

"4. Respondent specifically denies the third and last ground of the opposition, the truth being that Respondent has its own well-established reputation and therefore does not need to ride on the supposed goodwill of Opposer's trademark, nor design any act to dilute the supposed goodwill of Opposer's trademark. Respondent cannot be said to diminish the alleged distinctiveness of Opposer's trademark, as in fact it was Respondent who first used and registered its well-known trademark in the Philippines.

"5. Respondent specifically denies the allegations in paragraphs 4, 5, 5.1, 5.2, 5.3, 8 and 9.2 and the attachments referred to in those paragraphs for lack of knowledge or information to form a belief as to the truth thereof.

"6. Respondent admits the allegations in paragraphs 7.1, 7.1.1, 7.1.2, 7.1.3, and 7.1.6 to the extent that these state rulings made by the Supreme Court but specifically denies all conclusions made by the Opposer which purport to be supported by those rulings, the truth being that the grounds for Opposition and the allegations in support thereof cannot sustain the Opposer's claim that the Respondent is not entitled to register the TERRAMYCIN mark.

"7. Respondent specifically denies the allegations in paragraphs 6, 7.1.4, 7.1.4.1, 7.1.4.2, 7.1.4.4, 9, 9.1, 9.3, 9.4, 9.5, 10, 11 and 12, including the attachments referred to in those paragraphs, for being mere conclusions and not statements of ultimate facts, for being baseless and self-serving, for lack of knowledge sufficient to form a belief as to the truth thereof, and for the reasons stated in the Averments and Defenses in this Answer.

"Averments and Defenses

"Respondent repleads the foregoing allegations insofar as they are applicable, and further states:

"7. In 1949, scientists at Respondent's predecessor, Chas. Pfizer & Co., Inc., discovered a new antibiotic preparation containing oxytetracycline, which was given the name TERRAMYCIN. The discovery was published as early as 27 January 1950 in an article entitled "Terramycin, A New Antibiotic," found in volume 111, page 85, of the Science Journal. Science Journal is the academic journal of the American Association for the Advancement of Science and is considered one of the world's most prestigious scientific journals, having been first published into circulation in 1880. TERRAMYCIN was initially developed as a broad spectrum antibiotic and is an effective agent against pneumococcus pneumonia, staphylococcus infections, streptococcus infections, brucellosis, rickettsial diseases such as scrub typhus and Rocky Mountain spotted fever, venereal diseases such as gonorrhea, intestinal amoebiasis, bacillary dysentery and others. It is likewise active against a wide variety of bacteria, from infections caused by chlamydia (e.g., the chest infection psittacosis, the eye infection

trachoma, and the genital infection urethritis), infections caused by mycoplasma organisms (e.g., pneumonia), acne (e.g., propionibacterium acnes), and flare-ups due to chronic bronchitis.

"8. TERRAMYCIN was launched on 20 January 1950, and was in fact the first pharmaceutical product sold in the United States of America under the "Pfizer" label that thereafter gave Respondent the historic opportunity to break into international markets. In a book entitled The Legend of Pfizer, published in 1999, a chapter dedicated to Respondent's achievements in the 1950's confirmed that:

- (a) TERRAMYCIN was first "Pfizer Antibiotic" exclusively developed by its own scientists in late 1949. According to John McKeen, the name "TERRAMYCIN" was appropriate, as he "wanted a name connected with the earth, and one that could easily be recalled by doctors and scientists and people in general, because it came from the earth."
- (b) On New Year's Eve in 1950, TERRAMYCIN's first human clinical trial was conducted in New York's Harlem Hospital. The result of the tests surpassed Respondent's highest expectations, as patient's fevers plunged, infections were cured and side effects were minimized;
- (c) Thereafter, the original TERRAMYCIN team formed the backbone of Respondent's Antibiotic Research Division;
- (d) The original TERRAMYCIN patent was issued in 1950;
- (e) In the first years of TERRAMYCIN's production between 1950 and 1952, booming demand for the new drug triggered record growth, doubling the company's revenue. "TERRAMYCIN was so popular that the salesmen spent their first months on the job simply taking orders." Respondent's Accounting Department swelled in size as it reaped the rewards of TERRAMYCIN. Respondent's worldwide organization expanded rapidly. Soon, Respondent became known as "a pioneer in the 'Age of Antibiotics,' the first company to successfully mass-produce penicillin and the first to bring the world wonder drugs like streptomycin, Terramycin and Tetracycline."
- (f) TERRAMYCIN was originally sold as a capsule, but was later available in a variety of forms. In 1952 alone, Respondent introduced 15 new variations of TERRAMYCIN including a flavored oral formula and a broad array of dosages in every conceivable strength. TERRAMYCIN was even proven effective for livestock and agricultural applications.

"9. To ensure its exclusive use over its brand and protect the goodwill which it had so long tried to build through years of extensive marketing, Respondent sought the trademark registration of the TERRAMYCIN mark in the following jurisdictions all over the world:

x x x

"10. In the Philippines, Respondent's TERRAMYCIN mark was first used on 25 April 1950, and was first registered in the name of Chas. Pfizer & Co., Inc. on 15 September 1953 under Certificate of Registration No. 4320 (filed on 5 August 1950 bearing Application Serial No. 2038) under Republic Act No. 166. This registration was subsequently renewed in the name of Respondent Pfizer Inc. on 15 September 1973 and 15 September 1993 under Certificate of Renewal of Registration No. 1432 for antibiotic preparations containing oxytetracycline or derivatives thereof under then Class 6.

"11. Due to oversight but without any intention on the part of the Respondent to abandon its TERRAMYCIN mark, Respondent's registration was deemed cancelled due to its then resident agent's failure to file the Affidavit of Use for the 10th anniversary of the mark's registration. This fact only came to the knowledge of Respondent in 2008 shortly before it was preparing the Affidavit of Use for the 15th anniversary in 2008-2009. Be that as it may, Respondent never ceased using, marketing and selling its TERRAMYCIN trademark for its products since its launch on 25 April 1950. These products have been continuously covered by Certificates of Product Registration issued by the Bureau of Food and Drugs in favor of Pfizer's Philippine affiliate, Pfizer, Inc.

"12. Through the years, the TERRAMYCIN mark became better known for its various skin antibiotic preparations that did not necessarily incorporate the oxytetracycline compound. Oxytetracycline is used to treat lethal yellowing in palm trees. Oxytetracycline in combination with Polymyxin B Sulfate is indicated for the treatment of superficial ocular infection involving the conjunctiva and/or cornea due to susceptible microorganisms. The TERRAMYCIN mark is now better known as over-the-counter antibacterial skin ointment consisting of Polymyxin B Sulfate () Bacitracin Zinc () Neomycin Sulfate which is indicated as first aid treatment for the prevention of infection in minor cuts, scrapes, burns, abrasions, insect bites, pimples, pustules and other skin breaks. On the other hand, the oxytetracycline compound expanded its usefulness as a veterinary indication to control the outbreak of American and European Foulbrood in honeybees. It could also be used to correct breathing disorders in livestock by administering the drug through a powder preparation or an intramuscular injection. In view of the foregoing, the replacement application of TERRAMYCIN, bearing Trademark Application No. 4-2008-012617 filed by Respondent on 15 October 2008, was broadened to include "pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax, disinfectants; preparations for destroying vermin; fungicides, herbicides" under Class 5. It was this replacement application that is now subject to Opposer's opposition.

"13. Given the foregoing, Opposer's bold contention that Respondent is a mere "newcomer" is downright false. Opposer cannot claim that Respondent merely "adopted" Opposer's mark or that Respondent "still filed a trademark application for 'TERRAMYCIN' despite its knowledge of the existing trademark registration of 'TRIMYCIN'." As stated, Respondent's TERRAMYCIN trademark had been used in the Philippines as early as 25 April 1950, and registered on 15 September 1953, long before Opposer's predecessor-in-interest registered its mark on 17 December 1985. In view thereof, Respondent has preferential rights over TERRAMYCIN, as it was the first user of the mark and has openly and

continuously used the mark through the years. Since a mark of ownership is acquired by adoption and use thereof in commerce in the Philippines, it belongs to the person who first used and gave it value.

"14. Furthermore:

- (a) The marks are substantially different in sound and spelling. Visually and aurally, the marks can be readily set apart from each other. TRIMYCIN has three syllables while TERRAMYCIN has four. The "mycin" suffix is a common element found in most antibiotic compounds derived from fungi, and hence cannot be used as basis for comparison. On the other hand, "TERRA" is the Latin term for "earth," which is different from "TRI," which is numerical prefix meaning "three."
- (b) Opposer, as successor-in-interest of United American Pharmaceuticals, Inc., is estopped from opposing Respondent's application or has otherwise lost its right of action on account of laches. Respondent has filed and consistently renewed its trademark registration for TERRAMYCIN from 1950 to 2004 without any opposition, petition for cancellation, or claim of confusing similarity, from UAPI whatsoever. If at all, it was TRIMYCIN that diluted the distinctiveness of the TERRAMYCIN mark, and not the other way around.
- (c) The IP Code recognizes a limitation to actions for infringement in that a registered mark shall have no effect against any person who in good faith was using the mark for the purpose of his business or enterprise.
- (d) Respondent has already earned significant goodwill through constant and notorious use of its TERRAMYCIN mark, which is a separate property right entitled to protection.
- (e) Since oxytetracycline first became available in the 1950's, Respondent, its subsidiaries, joint ventures, sister concerns, predecessors-in-title, licensees and assignees in several other countries have continuously and exclusively marketed the product under the TERRAMYCIN mark. In the course of Respondent's extensive and notorious use and appropriation of TERRAMYCIN to identify its drug throughout the world, TERRAMYCIN was firmly established as a well-known mark and has obtained goodwill and general international consumer recognition as belonging to only one source, i.e., Pfizer. Soon, TERRAMYCIN became a trusted name among medical professionals and patients. Well-known marks are entitled to a broader amount of protection under the IP Code.

"15. Based on the foregoing, Opposer cannot rightfully claim any relief. It is clear that the assailed acts of Respondent were all done in good faith and in accordance with the provisions of existing laws. Hence, the Opposition is completely baseless and should be dismissed for lack of merit.

"16. In support of the foregoing, this Answer is herein verified by Respondent's Attorney-in-Fact and Senior for Trademarks, Mr. Richard Friedman, which likewise serves as his affidavit.

The Respondent-Applicant's evidence consists of the original legalized Answer; original legalized certificate on the authority of Richard A. Friedman to verify the Answer and execute the certificate of non-forum shopping and the authority of undersigned counsel to represent Respondent in these proceedings; electronic copy of Finley, A.C., G.L. Hobby, S.Y. P'an, P.P. Regna, J.B. Routien, D.B. Seeley, G.M. Schull, B.A. Sobin, I.A. Solomons, J.W. Vinson, and J.H. Kane, Terramycin, A New Antibiotic, Science 111:85 (27 January 1950); electronic copy of Fermentation, IND, ENG. CHEM. 1948, 1958-1959 (September 1951); relevant chapters of Jeffrey L. Rodengen, The Legend of Pfizer 80 91999); copies of a representative sample of the Certificate of Registration issued in favor of Respondent and its affiliates in various jurisdictions; certified true copy of Respondent's Philippine trademark registration for TERRAMYCIN under Certificate of Renewal of Registration No. 1432 issued on 15 September 1973, which includes Certificate of Registration No. 4320 issued on 15 September 1953; affidavit dated 13 July 2009 of Gloria G. Nobles; affidavit dated 2 October 2009 of Maria Rita Daniela Maramba Nisperos; original TERRAMYCIN Plus and TERRAMYCIN Wound Wash product flyer; original TERRAMYCIN Plus and TERRAMYCIN Wound Wash print advertisement, published in A12 of the 8 June 2009 issue of The Philippine Daily Inquirer; copies of pages 282 and 417 of MIMS Philippines (116th Ed., 2008), where TERRAMYCIN products were listed and published; copies of pages 307, 447 and 465 of MIMS Philippines (121st Ed., 2009), where TERRAMYCIN products were listed and published; copy of TERRAMYCIN Plus and TERRAMYCIN Wound Wash print advertisement, published in March 2009 issue of Good Housekeeping Magazine; copy of TERRAMYCIN Plus and TERRAMYCIN Wound Wash print advertisement, published in April 2009 issue of YES! Magazine; copy of TERRAMYCIN Plus and TERRAMYCIN Wound Wash print advertisement, published in May 2009 issue of Health Today Magazine; actual sample of a TERRAMYCIN pharmaceutical product, as currently sold in the Philippines; certificate of product registration Nos. DR 4714 (for the Terramycin Ophthalmic Ointment), DRHR 999 (for the Terramycin Wound Wash), and DRXY 29044 (for the Terramycin Plus) currently issued in the name of Pfizer, Inc., and electronic copies of relevant journal articles, such as Finley, A.C., G.L. Hobby, S.Y. P'an, P.P. Regna, J.B. Routien, D.B. Seeley, G.M. Schull, B.A. Sobin, I.A. Solomons, J.W. Vinson, and J.H. Kane, Terramycin, A New Antibiotic, Science 111:85 (27 January 1950).⁵

On 20 May 2010, the Preliminary Conference was held and terminated. Then after, the Opposer filed its position paper on 17 February 2011, while Respondent-Applicant filed their Memorandum on 17 February 2011.

Should the Respondent-Applicant be allowed to register the trademark TERRAMYCIN?

⁵ Marked as Exhibits "A" to "V", inclusive.

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

Sec. 123. Registrability. – 123.1. A mark cannot be registered if it:

x x x

(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 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;"

Sec. 147. *Rights Conferred.* – 147.1. The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

Records show that the trademark TERRAMYCIN was originally registered in the Philippine Patent Office on 15 September 1953. This trademark registration was deemed cancelled due to the non-filing of the Affidavit of Use for the 10th anniversary of the trademark's registration. In October 2008, Respondent-Applicant re-applied to register the mark TERRAMYCIN showing that its non-use is not due to any intention to abandon the trademark but solely due to oversight.⁶ Since the launching of the TERRAMYCIN trademark in the early 50s, Respondent never ceased using, marketing and selling products bearing the trademark TERRAMYCIN. In the Philippines alone, these products have been continuously covered by Certificates of Product Registration issued by the Bureau of Food and Drugs in favor of Pfizer's Philippine Affiliate, Pfizer, Inc.⁷ And, through more than six (6) decades' use and continuous promotions and advertising of the TERRAMYCIN trademark in newspapers, magazines, journals and listing in MIMS Philippines, it has gained and established an invaluable goodwill in its name.

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

⁶ Paragraph 11 of Respondent-Applicant's Answer.

⁷ *Ibid.*

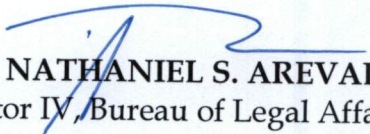
prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁸ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function. In fact, its existence and use in the market preceded the Opposer's mark TRIMYCIN. The Respondent-Applicant's mark has acquired such distinctive name because of its long use such that it is unlikely for the public to confuse it with TRIMYCIN. Corollarily, although both have the same suffix, the suffix "MYCIN" is common to antibiotics or antibiotic medicines. The suffix "MYCIN" is used as a combining form indicating an antibiotic compound derived from a fungus (e.g. streptomycin, neomycin), or derived from a bacterium (e.g. erythromycin, clarithromycin, garamycin). The syllables or letters preceding "MYCIN" in the Respondent-Applicant's mark, TERRA, does not look and sound like TRI.

Succinctly, the fact that the marks have co-existed before only shows that confusion is not likely. TERRAMYCIN's earlier registration (1953) preceded that of TRIMYCIN (1979). When TRIMYCIN was registered, the registration for TERRAMYCIN was still valid. If the marks are confusingly similar, TRIMYCIN should not have been registered at all.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2008-012617 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 05 November 2014.


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

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.