







**BIOMEDIS, INC.,**

Opposer,

-versus-

**MYLAN PHARMCEUTICALS PRIVATE LIMITED,**  
Respondent-Applicant.

IPC No. 14-2013-00053

Opposition to Trademark

Appln. No. 4-2012-010518

Date Filed: 29 August 2012

Trademark: **"SISTIN"**

X ----- X Decision No. 2014- 216

### DECISION

Biomedis, Inc.<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-010518. The contested application, filed by Mylan Pharmaceuticals Private Limited<sup>2</sup> ("Respondent-Applicant"), covers the mark "SISTIN" for use on *"pharmaceutical preparations for respiratory system, gastrointestinal system, endocrine system, cardiovascular system, nervous system, musculoskeletal system, urinary system, integumentary system, reproductive system; for treatment of blood disease and disorder; for treatment of cancer; for treatment of colds, cough and influenza; dermatologic pharmaceutical preparations; pharmaceutical preparations for ophthalmic use; for treatment for hypertension; for treatment of obesity; for treatment of gout; anti-inflammatory pharmaceuticals; antibiotics, anti allergic pharmaceutical preparations; pharmaceutical preparations for fungal infections, viral infections, anti-retroviral medicines, pharmaceutical preparations for anesthesia, for asthma, for arthritis; pharmaceutical preparations for diabetes; for benign prostatic hyperplasia; for tuberculosis; for malaria; hormonal preparations, vitamin preparations, immunosuppressants* under Class 05 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the provision of Section 123.1(d) of the Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code")<sup>4</sup>. It claims ownership over the mark "DOCISTIN", which is registered under Certificate Registration No. 4-2002-000905. It asserts that Respondent-Applicant's mark "SISTIN" is confusingly similar to its own mark "DOCISTIN" in appearance and sound,

<sup>1</sup> A domestic corporation organized and existing the laws of the Philippines, with office address at Dynavision Building, 108 Rada Street, Legaspi Village, Makati City

<sup>2</sup> Appears to be a foreign corporation with office address at One India Bulls Centre, Tower 2-B, 7<sup>th</sup> Floor, 841, Senapati Bapat Marg, Elphinstone (West), Mumbai-400 013, India..

<sup>3</sup> 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.

<sup>4</sup> Section 123.1. A mark cannot be registered if it:

xxx

(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; x x x"

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noting that the last five letters of both marks are exactly the same. It contends that the Respondent-Applicant's use of the questioned mark in relation to any of the goods covered by the application, if these goods are considered not similar or closely related to the goods covered by its own trademark, will take unfair advantage of, dilute and diminish the distinctive character or reputation of the latter mark

In support of its Opposition, the Opposer submitted the copy of the pertinent pages of the IPO E-Gazette publishing the mark "SISTIN" and a certified true copy of Certificate Registration No. 4-2002-000905.<sup>5</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 05 April 2013. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 05 July 2013 Order No. 2013-963 declaring the Respondent-Applicant in default and the case submitted for decision.

Records and evidence reveal that the Opposer filed its application for registration of the mark "DOCISTIN" as early as 01 February 2002. This was eventually granted registration on 18 September 2004 under Certificate Registration No. 4-2002-000905. On the other hand, the Respondent-Applicant only sought registration of its mark "SISTIN" on 29 August 2012.

The question to be resolved is whether the competing marks shown below are confusingly similar:

**Docistin**

*Opposer's mark*

**SISTIN**

*Respondent-Applicant's mark*

The only glaring difference between the two marks is the additional first two letters in the Opposer's mark "do". As to the letter "c" in the Opposer's mark which is replaced by the letter "s" in Respondent-Applicant's, they still produce the same sound when read with the other five common letters "istin". These minor differences altogether pale in significance in view of the similarities of the contending mark. Actually, the Respondent-Applicant's mark "SISTIN" may even appear as though it is just the root word of Opposer's mark "DOCISTIN". After all, confusion cannot be avoided by

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<sup>5</sup> Marked as Exhibits "A", "A-1" and "B".



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 purchasers as to cause him to purchase the one supposing it to be the other.<sup>6</sup> Aptly, the Supreme Court held in the case of **Del Monte Corporation vs. Court of Appeals**<sup>7</sup>, thus:

*"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."*

Moreover, notwithstanding the additional prefix "do" in the Opposer's mark, the competing marks reverberate practically the same sound when pronounced. In this connection, the ruling in **Marvex Commercial Co. vs. Peter Hawpia**<sup>8</sup> applies, to wit:

*"The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that 'SALONPAS' and 'LIONPAS' are confusingly similar in sound: 'Gold Dust' and 'Gold Drop'; 'Jantzen' and 'Jazz-Sea'; 'Silver Flash' and 'Supper-Flash'; 'Cascarete' and 'Celborite'; 'Celluloid' and 'Cellonite'; 'Chartreuse' and 'Charseurs'; 'Cutex' and 'Cuticlean'; 'Hebe' and 'Meje'; 'Kotex' and 'Femetex'; 'Zuso' and 'Hoo Hoo'. Leon Amdur, in his book 'TradeMark Law and Practice', pp. 419-421, cites, as coming within the purview of the idem sonans rule, 'Yusea' and 'U-C-A', 'Steinway Pianos' and 'Steinberg Pianos', and 'Seven-Up' and 'Lemon-Up. In Co Tiong vs. Director of Patents, this Court unequivocally said that 'Celdura' and 'Cordura' are confusingly similar in sound; this Court held in Sapolin Co. vs. Balmaceda, 67 Phil. 795 that the name 'Lusolin' is an infringement of the trademark 'Sapolin', as the sound of the two names is almost the same."*

*In the case at bar, 'SALONPAS' and 'LIONPAS', when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see Celanese Corporation of America vs. E. I. Du Pont, 154 F. 2d. 146, 148)."*

Noteworthy, the trademarks "DOCISTIN" and "SISTIN" both refer to goods under Class 05. The Opposer's trademark application/registration pertains to "*anti-cancer medicinal preparation*", which is also covered by Respondent-Applicant's

<sup>6</sup> Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

<sup>7</sup> G.R. No. L-78325, 25 January 1990.

<sup>8</sup> G.R. No. L-19297, 22 December 1966.



application. Thus, even assuming that consumers takes extra caution in buying pharmaceutical products as not to confuse one for the other, there is still possibility of deception such that they may be led to believe that both goods originate from the same source.

Succinctly, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."<sup>9</sup>

Finally, it is emphasized that 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.<sup>10</sup> Respondent-Applicant's trademark fell short in meeting this function.

Accordingly, this Bureau finds and concludes 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 Serial No. 4-2012-010518 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 19 August 2014.

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

<sup>9</sup> Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

<sup>10</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.