

PEDIATRICA, INC., Opposer,	} } }	IPC No. 14-2011-00513 Opposition to: Appln. Serial No. 4-2011-005188 Date filed; 5 May 2011
-versus-	}	TM: "MUCOHEX"
	}	
THE OFFICE BUILDING OF THE	}	
THE GENERICS PHARMACY, INC.,	}	
Respondent-Applicant.	}	
X	Х	

NOTICE OF DECISION

OCHAVE & ESCALONA

Counsel for the Opposer No. 66 United Street Mandaluyong City

THE GENERICS PHARMACY

Respondent-Applicant 459 Quezon Avenue Quezon City

GREETINGS:

Please be informed that Decision No. 2015 - $\underline{}$ _ dated July 24, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 24, 2015.

For the Director:

uty. J' ¡EPHINE C. ALON Bure; u of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE



PEDIATRICA, INC.,	}	IPC NO. 14-2011-00513
Opposer,	}	Opposition to
	}	
	}	Application Serial No. 4-2011-005188
-versus-	}	Date Filed: 5 May 2011
	}	Trademark: "MUCOHEX"
THE GENERICS PHARMACY, INC.	}	
Respondent-Applicant.	}	Decision No. 2015
X	x	

DECISION

PEDIATRICA, INC ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2011-005188. The application, filed by THE GENERICS PHARMACY, INC. ("Respondent-Applicant")², covers the mark "MUCOHEX" for medicine, mucolytics, and bromhexine preparations under Class 05 of the International Classification of Goods.³

The Opposer alleged the grounds for this Opposition as follows:

- "1. The mark 'MUCOHEX' owned by Respondent-Applicant so resembles the trademark 'MUCOLEXIN' owned by Opposer and duly registered with this Bureau prior to the publication for opposition of the mark 'MUCOHEX'.
- "2. The mark 'MUCOHEX' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'MUCOHEX' is applied for the same class and goods as that of Opposer's trademark 'MUCOLEXIN', *i.e.* Class 05 of the International Classification of Goods as Pharmaceutical Preparation (Mucolytic).
- "3. The registration of the mark 'MUCOHEX' in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides, in part, that 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 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;"

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¹ A domestic corporation duly organized and existing under the laws of the Philippines, with office address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

A domestic corporation with office address at 459 Quezon Avenue, Quezon City, Philippines.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a Multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

The Opposer submitted the following pieces of evidence, marked as Exhibits "A" to "H":

- 1. Copy of the Intellectual Property Office "E-Gazette" released on 17 October 2011 showing trademarks published for opposition;
- 2. Certificate of Registration No. 20177 for the trademark MUCOLEXIN; and
- 3. Affidavits of Use of the trademark MUCOLEXIN.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 28 November 2011. Respondent-Applicant, however, did not file an answer. Thus, this instant case is submitted for decision.

Records show that the Opposer filed an application for the registration of the trademark MUCOLEXIN with the then Philippine Patent Office on 31 July 1972. The application was approved for registration on 3 October 1973, with validity period of twenty (20) years, or until 3 October 1993. The registration was renewed for another period of 20 years or until 3 October 2013. On the other hand, the Respondent-Applicant filed the trademark application subject of the opposition on 5 May 2011.

The issue to be resolved is whether or not the trademark MUCOHEX is confusingly similar to the Opposer's registered trademark MUCOLEXIN. The competing marks are reproduced below:

Mucolexin

MUCOHEX

Opposer's mark

Respondent-Applicant's Mark

The two word marks are similar in the first four letters forming the prefix "MUCO". Opposer, however, was not able to provide any evidence that it has obtained exclusive use to the said prefix, so as to prevent or exclude others from using the same. It is fairly reasonable to infer that the Opposer has coined its mark from a portion of the term "mucolytic". Its trademark registration covers "Pharmaceutical preparation (Mucolytic)". The Respondent-Applicant's trademark application also indicates use on "medicine, mucolytics, bromhexine preparations". In the medical field, "MUCO" is a prefix which refers to "mucus", and related to the word "mucolytic", which means capable of reducing the viscosity of mucus. Thus, when the term "muco" is used as a trademark or as a component thereof for pharmaceutical products that are applied to reducing the viscosity of the mucus, it is considered as a suggestive mark because it

⁴ Ref; http://medical-dictionary.thefreedictionary.com/muco- citing Mosby's Medical Dictionary, 8th edition. (2009). Retrieved July 21 2015

⁵ Ref: http://medical-dictionary.thefreedictionary.com/mucolytic citing Miller-Keane Encyclopedia and Dictionary of Medicine, Nursing, and Allied Health, Seventh Edition. (2003). Retrieved July 21 2015

gives a clue as to the nature and purpose thereof. Suggestive marks are weak marks as far as their distinctiveness is concerned. This Bureau cannot therefore sustain the opposition on the basis of the similarity of the prefixes of the contending trademarks alone containing "MUCO".

Hence, to determine whether the Respondent-Applicant's mark is confusingly similar to the Opposer's, it is imperative for this Bureau to scrutinize the letters and/or syllables that follow or accompany the said prefix. In this regard, Respondent-Applicant's mark ends with the single syllable "HEX", which is visually and aurally different from the syllable "LEXIN" in the Opposer's trademark, composed of two (2) syllables and five (5) letters. Clearly, these unique dissimilarities in the suffixes of the contending word marks are sufficient as safeguards in order not to mislead or confuse the consumers into believing that the Respondent-Applicant's goods came or originated from or is connected or associated with the Opposer's. There would then be no possibility or likelihood for the purchasing public to mistake "Mucolexin" for "Mucohex".

WHEREFORE, premises considered, the instant Opposition to the Trademark Application No. 4-2011-005188 is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2011-005188 be returned together with the copy of this **DECISION** to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 24 July 2015

ATTY. NA1 (ANIEL S. AREVALO

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Bureau of Legal Affairs

Copy furnished:

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

Mandaluyong City

THE GENERICS PHARMACY

Counsel for the Respondent-Applicant 459 Quezon Avenue, Quezon City, Philippines