

PEDIATRICA, INC.,

Opposer,

-versus-

MEDETHIX, INC.,

Respondent-Applicant.

X-----X

IPC No. 14-2014-00308

Opposition to:

Appln. Serial No. 4-2013-00005568

Date filed: 15 May 2013

TM: "NUTRIMIN SN 5"

NOTICE OF DECISION

OCHAVE & ESCALONA

Counsel for the Opposer

No. 66 United Street

Mandaluyong City

MEDETHIX INC.

Respondent-Applicant

6th Floor, RFM Corporate Center

Pioneer St., Mandaluyong City

GREETINGS:

Please be informed that Decision No. 2015 - 276 dated December 01, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 01, 2015.

For the Director:

Edwin O. Dating
Atty. EDWIN DANILO A. DATING

Director III

Bureau of Legal Affairs

PEDIATRICA, INC., } **IPC NO. 14-2014-00308**
Opposer, } Opposition to:
 }
-versus- } Appln. Ser. No. 4-2013-00005568
 } Date Filed: 15 May 2013
MEDETHIX, INC., } **Trademark: NUTRIMIN SN 5**
Respondent-Applicant. }
x-----x } Decision No. 2015- 276

DECISION

PEDIATRICA, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2013-00005568. The application, filed by MEDETHIX, INC. (Respondent-Applicant)², covers the mark “NUTRIMIN SN 5”, for use on “Finished Pharmaceutical product (Amino Acids & Multivitamins)” under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

“7. The mark ‘NUTRIMIN SN 5’ applied for by Respondent-Applicant so resembles the trademark ‘NUTRILIN’ owned by Opposer, and duly registered with this Honorable Bureau prior to the publication for opposition of the application for the mark ‘NUTRIMIN SN 5’.

“8. The mark ‘NUTRIMIN SN 5’, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark ‘NUTRIMIN SN 5’ is applied for the same class and good as that of trademarks ‘NUTRILIN’, i.e. Class (5) of the International Classification of Goods as Pharmaceutical Preparations.

“9. The registration of the mark ‘NUTRIMIN SN 5’ 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

¹ A domestic corporation organized and existing under Philippine laws with address at Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan, Metro Manila

² A domestic corporation with address at 506 5th Floor RFM Corporate Center, Pioneer Street, Mandaluyong City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion;

“10. 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.

“11. Respondent-Applicant’s use and registration of the mark ‘NUTRIMIN SN 5’ will diminish the distinctiveness of Opposer’s trademark ‘NUTRILIN’.

According to the Opposer:

“12. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products and is the registered owner of the trademark ‘NUTRILIN’.

“12.1. The trademark application for the trademark ‘NUTRILIN’ was filed with the Philippine Patent Office on 10 May 1971 by Opposer and was approved for registration on 29 March 1973 to be valid for a period of twenty (20) years, or until 29 March 1993.

“12.2. Prior to the lapse of the twenty (20) year term, Opposer timely filed a petition for renewal of registration thereof, which was accordingly granted to be valid for another twenty (20) years, or until 29 March 2013.

“12.3. Again, prior to the lapse of the twenty (20) year term, Opposer timely filed a petition for renewal of registration thereof, which was accordingly granted to be valid for another ten (10) years, or until 29 March 2023.

“12.4. Thus, the registration of the trademark ‘NUTRILIN’ subsists and remains valid to date.

“13. The trademark ‘NUTRILIN’ has been extensively used in commerce in the Philippines.

“13.1. Opposer has dutifully filed Affidavits of Use to maintain the registration of the trademark ‘NUTRILIN’ in force and effect pursuant to the requirement of the law.

“13.2. In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, the product has been registered with the Food and Drugs Administration.

“13.3. A sample of product labels bearing the trademark ‘NUTRILIN’ actually used in commerce is hereto attached as Exhibit ‘L’ and ‘M’.

“13.4. No less than the Intercontinental Marketing Services (IMS) itself, the world’s leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand ‘NUTRILIN’ as one of the leading brands in the Philippines in the category of ‘AllA Multivitamins + Minerals’ and AiiB Multivitamins without minerals’ in terms of market share and sales performance.

“14. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark ‘NUTRILIN’ to the exclusion of all others. xxx”

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of IPO e-Gazette showing the Respondent-Applicant’s trademark application published for opposition;
2. Copy of Certificate of Registration No. 18566 for the trademark “NUTRILIN” issued on 29 March 1973;
3. Copy of Certificate of Renewal of Registration dated 29 March 2013;
4. Copies of Affidavits of Use dated May 1978, 2 March 1983, 7 March 1988, 29 July 1998, 26 April 2003 and 7 August 2008;
5. Copy of Certificate of Product Registration issued by the Food and Drug Administration dated 23 April 2014 and 16 April 2014;
6. Sample Packaging/label of “NUTRILIN”; and
7. Certification from Intercontinental Marketing Service (IMS) dated 10 July 2014⁴

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 28 July 2014. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 6 March 2015 Order No. 2015-401 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant be allowed to register the trademark NUTRIMIN SN 5?

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.⁵ Thus, Sec. 123.1 (d) of R. A. No. 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

⁴ Exhibits “A” to “N”

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

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 Respondent-Applicant applied for registration of the mark "NUTRIMIN" the Opposer already registered the mark "NUTRILIN" under Registration No. 18566 issued on 29 March 1973⁶ The goods covered by the Opposer's trademark registration are also under Class 5 for pharmaceutical products, same as indicated in the Respondent-Applicant's trademark application.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:

Nutrilin

Opposer's mark

NUTRIMIN SN 5

Respondent-Applicant's mark

The marks are similar with respect to the first syllables ("NUTRI"). In this regard, the word "NUTRI" is obviously derived from the word "nutrients" or "nutrition". Taking into account the goods involved, the word "NUTRI" or the marks are suggestive marks. Hence, this Bureau will not sustain the opposition solely on the ground that Respondent-Applicant's mark also contains the word "NUTRI".

Nevertheless, the opposition should be sustained. In their entirety, the marks are confusingly similar. The last syllable "MIN" and "LIN" have two identical literal elements, "IN", differing only in that Respondent-Applicant used "L" instead of "M". The addition of the word/number "SN 5" to the mark "NUTRIMIN" is of no moment. The word "NUTRIMIN" is an *idem sonans* of the dominant feature of Opposer's mark "NUTRILIN". "SN 5" is an insignificant addition because when pronounced, NUTRILIN and NUTRIMIN are confusingly similar. Visually and aurally, the contending marks are the same. The Supreme Court held:

As to the syllabication and sound of the two trade-names "Sapolin" and "Lusolin" being used for paints, it seems plain that whoever hears or sees them cannot but think of paints of the same kind and make. In a case to determine whether the use of the trade-name "Stephens' Blue Black Ink" violated the trade-name "Steelpens Blue Black Ink", it was said and held that there was in fact a violation; and in other cases it was held that trade-names *idem sonans* constitute a violation in matters of patents and trade-marks and trade-names. (Nims on Unfair

⁶ Exhibit "B"

Competition and Trade-Mark, sec. 54, pp. 141-147; N. K. Fairbanks Co. vs. Ogden Packing and Provision Co., 220 Fed., 1002.)⁷

Likewise, the Supreme Court in the case of *Marvex Commercial Co., Inv. V. Petra Hawpia & Co. and the Director of Patents*⁸ is instructive on the matter, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS"; the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance (*Co Tiong Sa vs. Director of Patents*, 95 Phil. 1 citing *Nims, The Law of Unfair Competition and Trademarks*, 4th ed., vol. 2, pp. 678-679). xxx

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).

Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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

⁷ *Sapolin Co., Inc. v. Balmaceda*, G.R. No. L-45502, 2 May 1939

⁸ G.R. No. L-19297, 22 December 1966

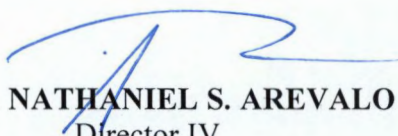
there is some connection between the plaintiff and defendant which, in fact does not exist.⁹

The public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.¹⁰

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-00005568 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 1 December 2015.



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

⁹*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

¹⁰*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).