



PHARMACIA & UPJOHN COMPANY LLC,
Opposer,

-versus-

MEDHAUS PHARMA, INC.,
Respondent -Applicant.

X-----X

IPC No. 14-2009-00262
Opposition to:
Appln. Serial No. 4-2007-010245
Date Filed: 17 September 2007
TM: "MEDRYL"

NOTICE OF DECISION

QUISUMBING TORRES

Counsel for the Opposer
12th Floor, Net One Centre
26th Street corner 3rd Avenue
Crescent Park West, Bonifacio Global City
Taguig, Metro Manila

ADONISA M. DELOS REYES

Respondent-Applicant's Agent
No. 139K First Street
Kamuning, Quezon City

GREETINGS:

Please be informed that Decision No. 2016 - 141 dated May 10, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 10, 2016.

For the Director:

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634 Philippines • www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph

PHARMACIA & UPJOHN COMPANY LLC,

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IPC No. 14-2009-00262

Opposition to Trademark

Application No. 4-2007-010245

Date Filed: 17 September 2007

Trademark: "**MEDRYL**"

Decision No. 2016- 141

DECISION

Pharmacia & Upjohn Company LLC¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2007-010245. The contested application, filed by Medhaus Pharma Inc.² ("Respondent-Applicant"), covers the mark "MEDRYL" for use on *"antihistamine which is used for treatment of skin irritation in serum sickness, urticarial, hay fever, vasomotor rhinitis, nausea and vomiting, contact dermatitis, insect bites and parkinsonism"* under Class 05 of the International Classification of Goods³.

The Opposer anchors its opposition on the provision of Section 123.1 subparagraphs (d), (e) and (f) of the Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code")⁴. It maintains ownership and exclusive rights over the mark "MEDROL", registered on 03 March 2009 under

¹ A limited liability company organized and existing the laws of Delaware, USA, with principal address at 7000 Portage Road, Kalamazoo, Michigan 49001, USA.

² With known address at 139 K First Street, Kamuning, Quezon City.

³ 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.

⁴ Section 123.1. A mark cannot be registered if it:

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(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;

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use; x x x"

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Registration No. 4-2009-002242, *"for the treatment of endocrine, rheumatic and hematologic disorders, collagen, dermatologic, opthalmic, respiratory, neoplastic and gastrointestinal disease, and certain allergic and edematous states."*

The Opposer argues that Respondent-Applicant's mark "MEDRYL" is confusingly similar to its own mark "MEDROL" by reason of spelling, pronunciation and appearance. It contends that "MEDROL" is fanciful and arbitrary that cannot be broken down in segments to support any contention that substantial differences between the competing marks. It further alleges that the "MEDRYL" mark was adopted specifically to imitate the overall appearance of its own mark.

In support of its Opposition, the Opposer submitted the following as evidence:

1. original legalized affidavit dated 27 October 2009 of Richard A. Friedman;
2. list of countries where the "MEDROL" mark is in use;
3. list of worldwide trademark registrations of "MEDROL" and representative copies of the said trademark registrations all over the world;
4. actual product labels, drug information, electronic copies of screenshots of the official website for MEDROL, <http://www.pfizer.com/>, promotional materials and publications evidencing notorious use of its mark worldwide;
5. affidavit dated 04 November 2009 of Michelle P. Coronel;
6. actual product labels bearing its mark;
7. certified tru copy of Registration No. 4-2009-002242 issued on 15 June 2009;
8. actual promotional materials bearing its mark; and,
9. copies of Certificates of Product Registration Nos. DR-XY7142 abd DR-XY33296 for various "MEDROL" formulations issued by the Bureau of Food and Drugs.⁵

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 12 January 2010. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 15 January 2014 Order No. 2014-062 declaring the Respondent-Applicant in default and the case submitted for decision.

Records and evidence reveal that Respondent-Applicant filed as early as 17 September 2007. However, its application was considered abandoned as of 09 February 2009. It paid for the revival of its application only on 05 March 2009. On the other hand, the Opposer filed an application for the registration of the mark

⁵ Marked as Exhibits "B" to "D", inclusive.

"MEDROL" on 03 March 2009, and was subsequently issued a certificate of registration. the registration covers pharmaceutical products that treat, among other illnesses, "dermatologic", "gastrointestinal disease" and "certain edematous states". The Respondent-Applicant's application indicates use of the mark applied for registration on pharmaceutical products that treat ailments similar to those covered by the Opposer's registration, namely, "antihistamine which is used for skin irritation", "nausea and vomiting", "contact dermatitis" and "insect bites.

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

MEDROL

Opposer's mark

MEDRYL

Respondent-Applicant's mark

The only difference between the two marks is their respective fifth letters where in the letter "o" in Opposer's mark was replaced by the letter with "y" in the Respondent-Applicant's. This difference notwithstanding, the competing marks still look and sound alike. Confusion cannot be avoided by 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 purchased as to cause him to purchase the one supposing it to be the other.⁶ Aptly, the Supreme Court held in the case of **Del Monte Corporation vs. Court of Appeals**⁷, 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, 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

⁶ Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, April 4, 2001.

⁷ G.R. No. L-78325, January 25, 1990.

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."⁸

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.⁹ 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. 4-2007-010245 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **10 MAY 2016**


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

⁸ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

⁹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.