

UNITED HOME PRODUCTS, INC.,
Opposer,

-versus-

THE GENERICS PHARMACY, INC.,
Respondent- Applicant.

x-----x

}
} IPC No. 14-2012-00571
} Opposition to:
} Appln. Serial No. 4-2012-006827
} Date Filed: June 06, 2012
} TM: "DERMAGEN"
}

NOTICE OF DECISION

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THE GENERICS PHARMACY, INC.,
Respondent- Applicant
459 Quezon Avenue
Quezon City

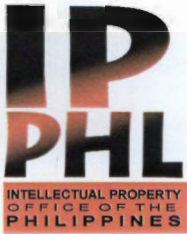
GREETINGS:

Please be informed that Decision No. 2016 - 106 dated April 04, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 04, 2016.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



UNITED HOME PRODUCTS, INC.,
Opposer,

- versus -

THE GENERICS PHARMACY, INC.,
Respondent-Applicant.
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IPC No. 14-2012-00571
Opposition to:

Appln. No. 4-2012-006827
Date Filed: 06 June 2012
Trademark: "DERMAGEN"

Decision No. 2016 - 106

DECISION

UNITED HOME PRODUCTS, INC. ("Opposer"),¹ filed an opposition to Trademark Application Serial No. 4-2012-006827. The application, filed by THE GENERICS PHARMACY, INC. ("Respondent-Applicant"),² covers the mark "DERMAGEN" for use on goods under class³ 05 namely: *pharmaceutical preparation used as topical anti-infectives.*

The Opposer alleges the following grounds for opposition:

"7. The mark 'DERMAGEN' owned by Respondent-Applicant so resembles the trademark 'DERMALIN' owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark 'DERMAGEN'.

"8. The mark 'DERMAGEN' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'DERMAGEN' is applied for the same class and goods as that of Opposer's trademark 'DERMALIN', i.e. Class 05 of the International Classification of Goods as Pharmaceutical Preparation used as Topical Anti-Infectives/Topical Antibacterial.

"9. The registration of the mark 'DERMAGEN' in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code.

"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."

The Opposer's evidence consists of the following:

1. Pertinent pages of the IPO E-Gazette;

¹ A domestic corporation duly organized and existing under the laws of the Philippines, with office at 2nd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.

² A domestic corporation, with address at 459 Quezon Avenue, Quezon City.

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.

2. Certificate of Registration No. 35737 for DERMALIN;
3. Certificate of Renewal of Registration No. 35737 for DERMALIN; and,
4. Assignment of Registered Trademark dated 17 November 2011.

This Bureau issued and served upon the Respondent-Applicant on 23 January 2013. However, this Bureau did not receive an answer and thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision.

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

Section 123.1 paragraph (d) of R.A. No. 8293, also known as the Intellectual Property Code ("IP Code") provides that a mark cannot be registered if it is identical with a registered mark belonging to a different 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 if it nearly resembles such mark as to be likely to deceive or cause confusion.

Records show that Myra Pharmaceuticals, Inc. has registration falling under Class 05 for the trademark DERMALIN for skin disorders since July 1986.⁴ It was later renewed on 08 July 1986 to include: topical antibacterial, antifungal, antiscabies preparations for the treatment of skin disorders.⁵ The trademark DERMALIN was thereafter assigned to herein Opposer on 17 November 2011.⁶ On the otherhand, Respondent-Applicant's DERMAGEN covers goods under Class 05 specifically for pharmaceutical goods used as topical anti-infectives. The competing marks cover products which are similar and/or closely related to each other.

But, are the contending marks, depicted below, resemble each other such that confusion, even deception, is likely to occur?

Dermalin

Opposer's Trademark

DERMAGEN

Respondent-Applicant's Trademark

What is common between the marks is the prefix "DERMA". "DERMA" is obviously derived from the medical term "DERMATOLOGY", which refers to the branch of medicine dealing with skin and its infections.⁷ It is a fair inference that the parties appropriated the prefix "DERMA" as part or component of their respective trademarks because the pharmaceutical products covered by the marks are for the treatment of skin diseases or infections. Thus, this Bureau cannot sustain the opposition on the basis of the prefix "DERMA" alone. To do so would have the effect of giving the Opposer the exclusive right to use the prefix "DERMA", which is already of common usage as far as the pharmaceutical products involved are concerned. In fact, in the Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, there are registered marks covering pharmaceutical preparations or goods related to skin treatment and care, that have the word "DERMA", and registered

⁴ Exhibit "B" of Opposer.

⁵ Exhibit "C" of Opposer.

⁶ Exhibit "D" of Opposer.

⁷ Dictionary.com, available at <http://dictionary.reference.com/browse/dermatology> (last accessed 11 January 2016).

under various owners, among which are: **DERMA** (Reg. No. 5072, class 3); **DERMA VIEWS** (Reg. No. 5957, classes 3 and 5); **DERMA CELESTY** (Reg. No. 13083, class 3); **DERMA VEEN** (Reg. No. 426, classes 3 and 5); **DERMA SOFT** (Reg. No. 33541, class 3); and, **BEAUCHARM DERMA** (Reg. No. 10200, class 44).

Thus, in determining the issue of whether **DERMAGEN** should not be registered on the ground that it is confusingly similar to **DERMALIN**, it is imperative to look into the components, features or elements of the marks aside from the prefix "DERMA". The syllable "LIN" is paired with the prefix "DERMA" producing the Opposer's mark **DERMALIN**. On the other hand, the syllable "GEN" is appended to the prefix "DERMA" resulting in the Respondent-Applicant's mark "DERMAGEN". "LIN" is so visually and aurally different to "GEN". Thus, the consumers can easily distinguish **DERMALIN** from **DERMAGEN**. Confusion, much less deception is unlikely to occur.

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 out into the market a superior 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.⁸ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-006827 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 04 April 2016.


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

⁸ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).