

HYPHENS PHARMA PTE. LTD.,
Opposer,

-versus-

SYSMEX CORPORATION,
Respondent-Applicant.

X-----X

IPC No. 14-2016-00162

Opposition to:

Appln. Serial No. 4-2013-012243

Date Filed: 09 October 2013

TM: HYPHEN BIOMED

NOTICE OF DECISION

FEDERIS & ASSOCIATES LAW OFFICES

Counsel for Opposer
2004 and 2005 88 Corporate Center
141 Valero corner Sedeño Sts.,
Salcedo Village, Makati City


E.B. ASTUDILLO & ASSOCIATES

Counsel for Respondent- Applicant
Citibank Center, 10th Floor
8741 Paseo de Roxas, Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 282 dated August 10, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 11 August 2016.


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
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

HYPHENS PHARMA PTE. LTD.,

Opposer,

-versus-

SYSMEX CORPORATION,

Respondent-Applicant.

X ----- X

IPC No. 14-2014-00158

Opposition to Trademark

Application No. 4-2013-012243

Date Filed: 09 October 2013

Trademark: **"HYPHEN BIOMED"**

Decision No. 2016- 282

DECISION

Hyphens Pharma Pte. Ltd.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-012243. The application, filed by Sysmex Corporation² ("Respondent-Applicant"), covers the mark "HYPHEN BIOMED" for use on *"in vitro diagnostic and diagnostic preparations, in vitro chemical reagents and chemical preparations, in vitro testing reagents and preparations, in vitro diagnostic preparations for use in clinical and medical namely, diagnostic and controls for immunochemistry, coagulation, immunohematology, chemistry, microbiology, hematology, immunology, serology, in vitro reagents for blood coagulation analysis, test kits consisting primarily of diagnostic preparations for medical or veterinary use, buffer solutions, diluents for use in medical or veterinary apparatus, control materials for use in medical or veterinary apparatus, chemical references materials for use in medical or veterinary apparatus, quality control standard solutions and quality control materials to be used for controls of medical or veterinary apparatus, calibration solutions, preparations of known concentration used for setting up standard curves in medical or veterinary apparatus"* under Class 05 of the International Classification of Goods³.

According to the Opposer, its company came into existence under the name Hyphens Marketing & Technical Services Pte Ltd. as early as 1986. It changed its name to Hyphens Pharma Pte. Ltd. in 2010 to better reflect its business focus and aspiration in pharmaceuticals and biochemical products for human health care. With headquarters in Singapore, its business is focused on specialty pharmaceuticals and has now extensive reach in Southeast Asian market in that field. To date, it has achieved a total of sixty-five (65) approvals across six countries, which includes twenty-nine (29) medicinal products, seventeen (17) cosmetics and three food supplements. It has earned million of dollars for its worldwide sales under the

¹ A corporation duly organized and existing under and by virtue of the laws of Singapore with office address at 138 Joo Seng Road, 3rd Floor, Singapore 368361.

² With office address at 1-5-1 Wakinhoma-Kaigandori, Chuo-ku, Kobe, Hyogo, Japan.

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.

MS

trademark "HYPHENS" and has received many awards and accolades for its products.

The Opposer alleges, among others, that its "HYPHENS" trademark and name has become a valuable asset. To protect its distinctiveness and exclusive use over the same, it applied for and/or registered "HYPHENS" for goods under Class 05 in different parts of the world. In the Philippines, it was issued Certificate of Registration No. 4-2010-010469 issued on 20 January 2011. It also has another pending application for "HYPHENS ASEAN'S SPECIALTY PHARMA COMPANY" filed on 21 June 2013. Its products are sold and distributed by Hyphens Pharma Philippines, Inc. and in various pharmacies in the country. It claims damage and injury in the Respondent-Applicant's adoption of "HYPHEN BIOMED" contending that the latter is confusingly similar to its trademark and/or tradename. In support of its Opposition, the Opposer submitted the affidavits of its Managing Director, Lim See Wah, and Jan Abigail Ponce, with their respective annexes.⁴

The Respondent-Applicant filed its Answer on 11 September 2014 denying that "HYPHEN BIOMED" is confusingly similar with the Opposer's "HYPHENS" marks. It points out that its mark is composed of two words – "HYPHEN" consisting of two syllables and "BIOMED" consisting of three – while that of the Opposer's contains a single word "HYPHENS" which consists of two syllables. It contends that the Opposer's mark is monochromatic while its applied mark is colorful. Also, it asserts that the respective devices of the marks are distinct from each other. It believes that confusion is highly unlikely since the goods covered by the marks are unrelated and non-competing as the Opposer's goods are medicines while its products are clinical testing devices. It also claims that the mark "HYPHEN BIOMED" is well-known.

According to the Respondent-Applicant, it has no intention to benefit from the Opposer's reputation, goodwill and advertising. Its company is headquartered in Kobe, Japan and is engaged in the health care business. Originally called TOA Medical Electronics, the "SYSMEX" brand was established in 1978 and was mainly involved in haematology analysers. In 1998, it was renamed as Sysmex Corporation, taking advantage of the brand recognition of their machines. Along with its subsidiaries, it is involved in the development, manufacture and sale of laboratory testing reagents and laboratory equipment and in the development and sale of computer systems for medical institutions and software used for clinical information systems. Through its associated company, it is also engaged in the sale of extracorporeal diagnostic agents and in the import and sale of medical devices. It distributes its products in Japan and overseas, has offices and factories throughout Asia and has branches in Europe, Canada, United States, Germany and New Zealand. The Respondent-Applicant's evidence consists of the following:⁵

⁴ Marked as Exhibits "A" to "M".

⁵ Marked as Exhibits "A" to "F".

1. its 11-Year Growth and Highlights;
2. its consolidated financial statements;
3. catalogs of its products;
4. list of countries where "HYPHEN BIOMED" products are sold;
5. copy of the French registration for "HYPHEN BIOMED";
6. certification dated 29 August 2014; and
7. affidavit-testimont of Fumio Inoue.

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. This Bureau's Alternative Dispute Resolution Services submitted a report that the parties failed to mediate. Accordingly, a Preliminary Conference was conducted on 24 March 2015 wherein counsels for both parties appeared. On the same date, the Preliminary Conference was terminated and the parties were directed to submit their respective position papers within ten days therefrom. After which, the case is deemed submitted for resolution.

The issue in this case is whether the trademark application for the mark "HYPHEN BIOMED" should be allowed.

Section 123.1(d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

"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"

As culled from available records, the Respondent-Applicant filed the contested application on 09 October 2013. On the other hand, the Respondent-Applicant was issued Certificate of Registration No. 4-2010-010469 as early as 20 January 2011 for the mark "HYPHENS". It also filed an application for the "HYPHENS ASEAN'S SPECIALTY PHARMA COMPANY" filed on 21 June 2013. The Trademark Registry of this Office shows that the said application was eventually approved on 19 June 2014.

But are the competing marks, are reproduced hereafter, confusingly similar?



Opposer's marks



Respondent-Applicant's mark

The prevalent feature in the Opposer's marks is the word "HYPHEN". The said word is what impresses the eyes and mind if one encounters the marks "HYPHENS" and "HYPHENS ASEAN'S SPECIALTY PHARMA COMPANY". In this regard, the word "HYPHENS" has no connection to the products covered by the Opposer's mark, i.e medicines and pharmaceutical preparations. Thus, "HYPHENS" is highly distinctive for the goods the mark covers. Perusing the applied mark, it appears that the Respondent-Applicant merely removed the letter "S" in "HYPHENS" and added the word "BIOMED". Nevertheless, the competing marks are still confusingly similar. Also, even with the different devices used, the same conclusion can be withdrawn. After all, 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 As held by the Supreme Court in the case of **Del Monte Corporation vs. Court of Appeals**⁷:

"It has been correctly held that side-by-side comparison is not the final test of similarity. Such comparison requires a careful scrutiny to determine in what points the labels of the products differ, as was done by the trial judge. The ordinary buyer does not usually make such scrutiny nor does he usually have the time to do so. The average shopper is usually in a

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

⁷ G.R. No. L-78325, 25 January 1990.

hurry and does not inspect every product on the shelf as if he were browsing in a library. Where the housewife has to return home as soon as possible to her baby or the working woman has to make quick purchases during her off hours, she is apt to be confused by similar labels even if they do have minute differences. The male shopper is worse as he usually does not bother about such distinctions.

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."

While the Opposer's mark pertain to medicines and pharmaceutical preparations while that of the Respondent-Applicant's covers "*in vitro diagnostic and diagnostic preparations, in vitro chemical reagents and chemical preparations, in vitro testing reagents and preparations, in vitro diagnostic preparations for use in clinical and medical namely, diagnostic and controls for immunochemistry, coagulation, immunohematology, chemistry, microbiology, hematology, immunology, serology, in vitro reagents for blood coagulation analysis, test kits consisting primarily of diagnostic preparations for medical or veterinary use, buffer solutions, diluents for use in medical or veterinary apparatus, control materials for use in medical or veterinary apparatus, chemical references materials for use in medical or veterinary apparatus, quality control standard solutions and quality control materials to be used for controls of medical or veterinary apparatus*", the likelihood of confusion still subsists because they are closely related. Noteworthy, the goods covered are similarly classified under Class 05.

Succinctly, it is settled that the likelihood of confusion extends 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."⁸ As mentioned

⁸ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

above, the syllable "HYPHEN" or "HYPHENS" has no connection or relation to the products involved. Thus, the consumers may have the notion that Opposer expanded business and manufactured a new product by the name "HYPHEN BIOMED".


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 The 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. 4-2013-0012243 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 August 2016.


ATTY. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

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