UNITED LABORATORIES, INC., Opposer, **-versus-** **MEGA LIFESCIENCES PUBLIC COMPANY LIMITED,** Respondent- Applicant.	}	**IPC No. 14-2014-00333** Opposition to: Application No. 4-2014-003645 Date Filed: 24 March 2015 TM: **"MEDICOFF C"**

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 385 dated October 17, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 17, 2016.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

UNITED LABORATORIES, INC.,
Opposer,

versus-

MEGA LIFESCIENCES PUBLIC COMPANY LIMITED,
Respondent-Applicant.
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IPC NO. 14-2014-00333

Appln. Ser. No. 4-2014-003645
Filing Date: 24 March 2015
Trademark: **MEDICOFF C**

Decision No. 2016 - 385

DECISION

UNITED LABORATORIES, INC.,[1] ("Opposer") filed an Opposition to Trademark Application No. 4-2014-003645. The application, filed by MEGA LIFESCIENCES PUBLIC COMPANY LIMITED[2] ("Respondent-Applicant"), covers the mark **MEDICOFF C** for use on *"pharmaceutical preparations, drug for medical purposes, dietetic substances adapted for medical use, nutritional supplement, food for babies"* under Class 05 of the International Classification of goods[3].

Opposer alleges that the mark MEDICOFF C applied by Respondent-Applicant so resembles the mark MEDICOL owned by Opposer and registered with the Intellectual Property Office (IPO) prior to the publication of the application for the mark MEDICOFF C. According to Opposer, the mark MEDICOFF C will likely cause confusion, mistake and deception on the part of the purchasing public especially that it is being applied for the same goods, in violation of Section 123.1(d) of the IP Code.

The Opposer's evidence consists of the following:

1. Exhibit "A" - Printout of two (2) pages of IPO E-Gazette which was officially released on 30 June 2014;
2. Exhibit "B" – Copy of Certificate of Reg. No. 33517 for the trademark MEDICOL issued on 01 August 1984;
3. Exhibit "C" – Copy of Certificate of Renewal No. 33517 for the trademark MEDICOL issued on 01 August 2004;
4. Exhibit "D" - copy of Assignment of Trademark between Myra Pharmaceuticals, Inc. and Unam Brands;
5. Exhibit "E" - copy of Assignment of Trademark between Unam Brands and United Laboratories, Inc.
6. Exhibit "F" to "I" - copy of the Affidavit of Use for the mark MEDICOL filed in 1989, 1994, 1999, 2009 ;
7. Exhibit "J"to "L" – Certificate of Product Registration issued by FDA for the drug MEDICOL;
8. Exhibit "M" - sample product packaging bearing the mark MEDICOL; and
9. Exhibit "N" - copy of Certification issued by IMS Health.

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[1] A corporation duly organized and existing under the laws of the Philippines with principal address at No. 66 United Street, Mandaluyong City.
[2] A corporation duly organized and existing under the laws of Thailand with office address at 384, Village No. 4, 6 Alley, Pattana 3 Road, Bangpoo Industrial Estate, Praeksa SubDistrict, Muang Samutprakarn Province, 10280 Thailand
[3] The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

On 07 August 2014, this Bureau issued a Notice to Answer and personally served a copy thereof to the Respondent-Applicant's representative on 11 August 2014. The Respondent-Applicant, however, did not file the Answer. On 02 March 2015, this Bureau declared Respondent-Applicant in default. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark **MEDICOFF C**?

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.[4] Thus, Sec. 123.1 (d) of the 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 or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its application for the mark MEDICOFF C on 24 March 2014, the Opposer already has an existing registration for the trademark MEDICOL issued way back in 01 August 1984. Opposer's mark is used on goods falling under Class 05, namely, *"analgesic/antipyretic preparations"*. On the other hand, the Respondent-Applicant's mark is being applied for use on *"pharmaceutical preparations, drug for medical purposes, dietetic substances adapted for medical use, nutritional supplement, food for babies"* also under Class 05. Thus, the goods are similar or closely related.

But are the competing marks, as shown below, identical or similar or resemble each other such that confusion, mistake or deception is likely to occur?

Medicol	**MEDICOFF C**
Opposer's Mark	*Respondent-Applicant's Mark*

Both marks are "word marks" that appeal both to the visual and the aural senses. What draw one's attention and easily registers in the mind when looking at the Opposer's mark are first two syllables "MEDI". These syllables are identical with the first and second syllables of the Respondent-Applicant's word mark. These parts of the Respondent-Applicant's mark are what immediately strike the eye. Also, when **MEDICOL** is pronounced the same sound is practically replicated when one pronounces the Respondent-Applicant's **MEDICOFF** mark.

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 purchaser as to cause him to purchase the one supposing it to be the other[5]. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or

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[4] *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.
5 *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article[6].

Succinctly, because the Respondent-Applicant, like the Opposer, will use or uses the mark MEDICOFF on similar pharmaceutical products , the difference in the mark did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. There is the likelihood that information, assessment, perception or impression about MEDICOFF products delivered and conveyed through words and sounds and received by the ears may unfairly cast upon or attributed to the MEDICOL products of the Opposer, and *vice-versa*.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.[7] The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof. As held by the Supreme Court:

> 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.[8]

Accordingly, this Bureau finds 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. 4-2014-003645, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 OCT 2016

MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs

6 *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.
7 *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.
8 *Sterling Products International, Incorporated vs. Farbenfabriken Bayer Aktiengesellschaft et. al., G.R. No. L-19906. April 30, 1969*