BIOFEMME, INC., Opposer, **-versus-** **WOCKHARDT LIMITED,** Respondent- Applicant.	}	**IPC No. 14-2014-00295** Opposition to: Appln. No. 4-2011-006315 Date Filed: 31 May 2011 **TM: "NADOXIN"**

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 80 dated March 17, 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, March 17, 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

BIOFEMME, INC.,
Opposer,

-versus-

WOCKHARDT LIMITED,
Respondent-Applicant.
x ---------- x

IPC No. 14-2014-00295
Opposition to Trademark
Application No. 4-2011-006315
Date Filed: 31 May 2011
Trademark: **"NADOXIN"**

Decision No. 2017-80

DECISION

Biofemme, Inc.[1] ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-006315. The contested application, filed by Wockhardt Limited[2] ("Respondent-Applicant"), covers the mark "NADOXIN" for use on *"medicinal and pharmaceutical preparations"* under Class 05 of the International Classification of Goods[3].

The Opposer anchors its opposition on the provision of Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It alleges, among others, that the mark "NADOXIN" will likely cause confusion, mistake and deception with its registered mark "DOXIN" on the part of the purchasing pubic, especially that both marks cover the same class and goods.

According to the Opposer, the mark "DOXIN" was first registered with the then Philippine Patent Office on 15 March 1979 by Therapharma, Inc. and the latter has timely filed a petition for renewal of registration. On 17 December 2008, the said registration was assigned by Therapharma, Inc. to the Opposer. Thereafter, it timely filed another petition for renewal of registration and submitted the pertinent Declaration of Actual Use ("DAU"). In order to legally market the product, it registered the same with the Food and Drug Administration ("FDA"). Also, the International Marketing Services ("IMS") acknowledged and listed the brand "DOXIN" as one of the leading brands in the Philippines in the category *"J01A Tetracyclines and Combinations"*. In support of its Opposition, the Opposer submitted the following as evidence:[4]

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[1] A domestic corporation with office address at Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City.
[2] A foreign corporation with address at Wockhardt Towers, Bandra Kurla Complex, Bandra (East), Mumbai-400 051, India.
[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] Exhibits "A" to "M".

1. copy of Respondent-Applicant's trademark application as published in the IPO E-Gazette;
2. certified true copy of Certificate of Registration No. 27144;
3. certified true copy of Certificate of Renewal Registration No. 36642;
4. certified true copy of the Assignment of Registered Trademark dated 17 December 2008;
5. certified true copies of the Affidavits of Use and DAUs for the mark "DOXIN";
6. Certificate of Product Registration No. DR-X1308;
7. sample product packaging of "DOXIN"; and
8. copy of the Certification and sales performance issued by the IMS.

The Respondent-Applicant filed its Answer on 23 October 2014 alleging, among others, that the word "DOXIN" is similar to the International Nonproprietary Name (INN) *doxycycline*, which is the generic name of the Opposer's products. It thus contends that the said mark cannot be registered pursuant to Section 123.1 (h) of R.A. No. 8293, also known as the Intellectual Property Code ("IP Code).

In alternative, the Respondent-Applicant contends that the marks are not confusingly similar in spelling and pronunciation. It points out that "DOXIN" pertains to *doxycycline* while "NADOXIN" to *nadifloxacin.* It also asserts that the Opposer is barred by laches because the latter did not challenge the registration of the same mark "NADOXIN" under Certificate of Registration No. 4-2011-002760 issued on 17 February 2012. The Respondent-Applicant's evidence consists of the printout of the webpage of the World Health Organization (WHO) and the affidavit of Debolina Partap, with annexes.[5]

Pursuant to Office Order No. 154, s. 2010, the Adjudication Officer referred the case to mediation. This Bureau's Alternative Dispute Resolution Services, however, submitted a report that the parties refused to mediate. Accordingly, a Preliminary Conference was conducted on 17 March 2015. Upon termination thereof on even date, the Adjudication Officer directed the parties to submit their respective position papers. After which, the case is then deemed submitted for resolution.

The issue in this case is whether the Respondent-Applicant's trademark application for the mark "NADOXIN" should be allowed registration.

Records reveal that the Respondent-Applicant filed an application for its mark "NADOXIN" on 20 February 2015. On the other hand, the Opposer's predecessor-in-interest was issued registration for the mark "DOXIN" as early as 15 March 1979 and the same remains valid and existing.

Section 123.1(d) of the IP Code, relied upon by Opposer, provides that:

[5] Marked as Exhibits "1" and "2", inclusive.

"Section 123.1. 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
(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion; x x x"

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown hereafter for comparison:

Doxin	NADOXIN
Opposer's mark	*Respondent-Applicant's mark*

The marks are apparently similar with respect to the similar incorporation of the syllables "DOXIN". The Opposer's sample label[6] shows that the generic name of the mark "DOXIN" is *doxycycline hyclate.* Obviously, the mark "DOXIN" is derived from the generic name of the product. These kinds of mark or brand name give away or tell the consumers the goods or service and/or the kind, nature, use or purpose thereof. Although registrable, the mark "DOXIN" is a weak mark. On the other hand, the Respondent-Applicant's mark is used or intended to be used on products with a generic name *nadifloxacin.* In the same vein, the latter clearly also derived its mark from the generic name of the pharmaceutical covered by "NADOXIN".

Be that as it may, this Adjudication Officer finds that the competing marks confusingly similar. Looking at the marks, it appears that the Respondent-Applicant merely added the syllable "NA" in the Opposer's mark. Even though the marks are both shortened versions of their generic names, there are many other combinations of words and/or syllables that the Respondent-Applicant could have come up from the generic name *nadifloxacin.* Of course, as in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark.[7]

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[6] Marked as Exhibit "L".
[7] American Wire & Cable Company vs. Director of Patents, G.R. No. L-26557, 18 February 1970.

Succinctly, 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.[8] 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 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."[9] This is especially true in this case wherein the competing goods fall under identical and/or related class as in this case.

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.[10] This Bureau finds that the Respondent-Applicant's trademark failed to meet this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-006315 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 MAR 2017

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

[8] Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.
[9] Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.
[10] Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.