



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

MINOPHAGEN PHARMACEUTICALS CO., LTD.,
Opposer,

-versus-

EUROHEALTHCARE EXPONENTS, INC.,
Respondent-Applicant.

IPC No. 14-2016-00255
Opposition to:

Appln. Serial No. 4-2015-013368
Date Filed: 23 November 2015

TM: MINOGLLEN

X-----X

NOTICE OF DECISION

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EUROHEALTHCARE EXPONENTS, INC.

Respondent- Applicant
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GREETINGS:

Please be informed that Decision No. 2017 - 355 dated 06 October 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, 06 October 2017.

MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs



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IPC No. 14-2016-00255

Opposition to:
Application No. 4-2015-013368
Date Filed: 23 November 2015
Trademark: "MINOGLLEN"

Decision No. 2017- 355

DECISION

MINOPHAGEN PHARMACEUTICAL CO., LTD.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2015-013368. The application, filed by Eurohealthcare Exponents, Inc.² ("Respondent-Applicant"), covers the mark "MINOGLLEN" for use on "*pharmaceutical preparations used for the treatment of serious infections caused by susceptible aeruginosa, Proteus species, Escherichia Coil, Klebsiella, Enterobacter, Serratia Species, Citrobacter species, and staphylococcus species*" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"14. In the Philippines, opposer is the registered owner of the trademark MINOPHAGEN, the particulars of which are as follows:

x x x

"15. Opposer's mark MINOPHAGEN and respondent-applicant's mark MINOGLLEN are confusingly similar with each other considering that:

"a) Seven of eight letters in respondent-applicant's mark MINOGLLEN are present in opposer's mark MINOPHAGEN and in the same sequential position, as follows:

"b) Both marks have nearly identical components, namely:

"MI-NO-PHA-GEN	for opposer
"MI-NO-GLEN	for respondent-applicant

"The first two syllables MI and NO are identical.

¹With address at 3-2-11, Nishi-shinjuku, Shinjuku-ku, Tokyo, Japan.

²With address at #67 Scout Fuentabella St. Tomas Morato, Quezon City, Metro Manila, Philippines.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"The last syllables GEN and GLEN respectively, are nearly identical in spelling, appearance and pronunciation.

"c) Respondent-applicant's mark MINOGLLEN and opposer's trademark MINOPHAGEN are both word marks in plain lettering. There are no stylized letterings to distinguish one from the other; nor are there any unique device accompanying the words. Under these circumstances, respondent-applicant's MINOGLLEN is even more confusingly similar to opposer's mark MINOPHAGEN.

"d) Because they are nearly identical in spelling and appearance, the two (2) marks are also phonetically alike. There is little difference in their sound and pronunciation. Applying the test of 'idem sonans', respondent-applicant's mark MINOGLLEN is similar aurally to opposer's mark MINOPHAGEN; hence the likelihood of confusion (Amigo Manufacturing, Inc. vs. Cluett Peabody, Co., Inc., G.R. No. 139300, 14 March 2001).

"e) Under Philippine law and jurisprudence, it is not required that the marks should be exactly or absolutely alike or identical. It is enough that under certain conditions, confusion as to the goods themselves or the source of the goods may give rise to a reasonable chance of confusion.

"16. Section 123.1, subparagraph (d) of the Intellectual Property Code of the Philippines categorically provides that:

x x x

"17. The case of American Wire and Cable Co. vs. Director of Patents (G.R. No. L-26557, February 18, 1970), where the Supreme Court found DURAFLEX and DYNAFLEX to be confusingly similar, finds application in the instant case, to wit:

x x x

"18. In the case of the opposer's mark MINOPHAGEN and the respondent-applicant's mark MINOGLLEN, the marks are nearly identical in the light of the following facts:

"18.1. The nearly identical components and sequencing of the same

"18.2. Both are in plain lettering without styling or design

"18.3. Spelling

"18.4. Visually

"18.5. Aurally

"Hence, the two (2) marks are, for all intents and purposes, practically identical and confusingly similar. It is very easy to mistake respondent-applicant's products bearing the mark MINOGLLEN for opposer's goods bearing the mark MINOPHAGEN. Hence, the use and registration of the mark MINOGLLEN will create confusion, mistake and deception in the minds of the purchasing public.

"19. The test of confusing similarity which would preclude the registration of a trademark is not whether the challenged mark would actually cause confusion, mistake

or deception in the minds of the purchasing public but whether the use of such mark would likely cause confusion or mistake. The law does not require that the competing marks must be so identical as to produce actual error or mistakes. It is sufficient that the similarity between the two marks be such that there is a possibility or likelihood of the purchaser of the old brand mistaking the newest brand for it. (*Acoje Mining Co., Inc. vs. Director of Patents*, 38 SCRA 480 [1971]).

"20. It is settled jurisprudence that identity or similarity in the dominant features of two (2) competing marks will cause mistake or confusion in the minds of the purchasing public. The case of *Co Tiong Sa vs. Director of Patents* (95 Phil. 1 [1954]) categorically held, as follows:

x x x

"21. Similarly, the Supreme Court in the case of *Phil. Nut Industry, Inc. vs. Standard Brands, Inc.* (G.R. No. L-23035, 31 July 1975, 65 SCRA 575) held that:

x x x

"22. The dominancy test was applied by the Supreme Court in many other cases including *Lim Hoa vs. Director of Patents* (100 Phil. 214 [1956]), *Converse Rubber Corporation vs. Universal Rubber Products, Inc.* (G.R. No. L-27906, 08 January 1987, 147 SCRA 154) and *Asia Brewery, Inc. vs. Court of Appeals* (G.R. No. 103543, 05 July 1993, 224 SCRA 437).

"23. In the case of *McDonald's Corporation, et al. vs. L.C. Big Mak Burger, et al.* (G.R. No. 143993, August 18, 2004), the Supreme Court likewise applied the test of dominancy in determining that the mark BIG MAC of McDonald's Corporation and the mark BIG MAK of L.C. Big Mak Burger are confusingly similar. The Court ruled as follows:

x x x

"24. This was further affirmed in the 2007 case of *McDonald's Corporation vs. Macjoy Fastfood Corporation* (G.R. No. 166115, February 2, 2007) where the Supreme Court again applied the test of dominancy and ruled that there is confusing similarity between the McDonald's marks and the mark MACJOY & Device.

"25. Visually, the words: MINOPHAGEN and MINOGLLEN when placed side by side, especially when viewed from a distance, look very much alike. Phonetically, MI-NO-PHA-GEN and MI-NO-GLEN are also practically alike except for a mild but hardly perceptible gap in the third component of opposer's mark MINOPHAGEN. However, a listener or purchaser will hardly distinguish one from the other when both marks are spoken or pronounced or verbalized. Hence, there is a real risk that the pharmaceutical preparations of respondent-applicant labeled MINOGLLEN will be mistaken as opposer's pharmaceutical preparations marked MINOPHAGEN.

"26. Respondent-applicant's mark and opposer's mark cover similar goods under International Class 05.

"27. 'Pharmaceutical preparations' are sold in pharmacies, drug stores, hospitals, clinics and similar establishments. They are therefore found in the same channels of business and trade. Hence, the potential confusion on the consuming public is greater, if not, almost certain. The purchasing public will likely be deceived to purchase a pharmaceutical preparation of respondent-applicant labeled MINOGLLEN in

the belief that they are purchasing opposer's products bearing the label MINOPHAGEN. This will thus result to damage to the public and to opposer's business and goodwill over its products bearing the mark MINOPHAGEN.

"28. In the case of Esso Standard Eastern, Inc. vs. Court of Appeals, et al. (G.R. No. L-29971, August 31, 1982), the Supreme Court held that:

x x x

"29. Corollary, the Office of the Director General, IPO of the Philippine held in the case of Korea United Pharm, Inc. vs. Beecham Group P.L.C. (Appeal No. 14-06-25, April 18, 2008) that 'if there is any possibility of such confusion in the case of medicines, public policy requires that the use of the confusingly similar name be enjoined' in order to protect consumers from the constant threat of medicine switching because of confusingly similar marks for medicines.

"30. In the Philippines, opposer is the registered owner of the trademark MINOPHAGEN, the particulars of which are as follows:

x x x

"31. Opposer's registration of its mark MINOPHAGEN on October 9, 2014 is more than one (1) year prior to respondent-applicant's application for registration of the confusingly similar mark MINOGLLEN on November 23, 2015. Its application on June 19, 2014 is one year and a half prior to respondent-applicant's application for MINOGLLEN. Section 123.1, subparagraph (d) of the Intellectual Property Code of the Philippines categorically provides that:

x x x

"32. By virtue of opposer's prior application and registration of the trademark MINOPHAGEN in the Philippines which predates the filing of the trademark application by respondent-applicant for MINOGLLEN by at least one (1) year, the trademark MINOPHAGEN has therefore become distinctive of opposer's goods and business.

x x x

"33. Section 147.1 of the IP Code of the Philippines vests upon owner of a registered mark the exclusive right to prevent all third parties, without its consent, from the use of identical or similar signs which would result in likelihood of confusion.

x x x

"34. Clearly and explicitly, under the foregoing IP Code provision, opposer Minophagen Pharmaceutical Co., Ltd. possesses the right to prevent respondent-applicant Eurohealthcare Exponents, Inc. from using the trademark MINOGLLEN through its registration with the IPO of the Philippines. The trademark MINOGLLEN is 'similar' to opposer's trademark MINOPHAGEN and is intended 'for goods which are identical to those in respect of which the trademark (MINOPHAGEN of opposer) is registered, where such would result in a likelihood of confusion'.

"35. The only means by which respondent-applicant Eurohealthcare Exponents, Inc. may validly use its mark MINOGLLEN through its registration with the IPO of the Philippines is by 'having the owner's (opposer Minophagen Pharmaceutical Co., Ltd.) consent' which it did not have nor does it have. Needless to state, respondent-

applicant Eurohealthcare Exponents, Inc. never secured opposer's consent to its application.

"36. The foregoing IP Code provision even more emphatically states that 'in case of use of a confusingly similar mark, for identical goods, a likelihood of confusion shall be presumed.' Respondent-applicant's application for the trademark MINOGLLEN squarely fits the law's conditions or qualifications.

x x x

"37. Moreover, as prior registrant, opposer has the exclusive right to use the mark MINOPHAGEN in connection with the same or related goods and/or services. Under Section 138 of the IP Code, a certificate of registration shall be prima facie evidence of the validity of (a) registration, (b) registrant's ownership of the mark, and (c) registrant's exclusive right to use the same in connection with the same or related goods or services.

x x x

"38. In the Philippines, Opposer's registration of its mark MINOPHAGEN for 'Pharmaceutical preparations' was on October 9, 2014, more than one (1) year prior to respondent's application for registration of MINOGLLEN on November 23, 2015. Its application on June 19, 2014 is one year and a half prior to respondent-applicant's application for MINOGLLEN. By virtue of opposer's prior application and registration of the trademark MINOPHAGEN in the Philippines, said trademark has become distinctive of opposer's goods and business.

"39. The choice by respondent-applicant Eurohealthcare Exponents, Inc., likewise a pharmaceutical company, is so limitless that if it really wanted to distinguish its mark from others, it could very easily and conveniently have chosen or adopted an entirely unique word or mark that will leave no iota of confusion with another pharmaceutical product. That is did otherwise casts doubt on its real intention which may likely be to 'ride-on' the goodwill of the nearly identical mark owned by opposer Minophagen Pharmaceutical Co., Ltd., one of the Japan's leading pharmaceutical companies.

"40. In the case of American Wire & Cable Co. vs. Director of Patents (G.R. No. L-26557, February 18, 1970), the Supreme Court held that:

x x x

"41. Moreover, it has been held in many other cases, like the foregoing, that:

x x x

"42. The registration and/or use of the trademark MINOGLLEN by respondent-applicant will deceive and/or confuse purchasers into believing that respondent-applicant's goods bearing the trademark MINOGLLEN emanate from or are under the sponsorship of opposer Minophagen Pharmaceutical Co., Ltd., owner/registrant of the trademark MINOPHAGEN. This will diminish the distinctiveness and dilute the goodwill of opposer's trademark.

The Opposer's evidence consists of a copy of Certificate of Registration No. 4-2014-007736 for the mark MINOPHAGEN; printouts of the pages from Minophagen Pharmaceutical's website at <http://www.miniophagen.co.jp/English>; list of countries

with the corresponding years when the pharmaceutical products sold under the mark STRONGER NEO-MINOPHAGEN C acquired drug approval from the drug authorities; a copy of the product label bearing the mark MINOPHAGEN C filed with the Food and Drug Administration of the Philippines; list of trademark registrations for the mark MINOPHAGEN in various countries around the world; copies of Certificates of Registrations for the mark MINOPHAGEN issued by countries around the world; promotional materials showing use of the mark STRONGER NEO-MINOPHAGEN C and the company name Minophagen Pharmaceutical Co., Ltd. and copies of academic journals.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 2 August 2016. Said Respondent-Applicant, however, did not file an Answer.

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

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

Sec. 123.Registrability. - 123.1. A mark cannot be registered if it:

x x x

- (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;"

Sec. 138. *Certificates of Registration.* - A certificate of registration of a mark shall be *prima facie* evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.

Sec. 147.*Rights Conferred.* - 147.1. The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

Records show at the time the Respondent-Applicant filed its trademark application on 23 November 2015, the Opposer has an existing trademark registration for the mark MINOPHAGEN under Trademark Reg. No. 4-2014-007736 issued on 09

⁴Marked as Exhibits "A" to "H".

October 2014. The registration covers "pharmaceutical preparations" under Class 05. On the other hand, Respondent-Applicant's trademark application covers "pharmaceutical preparations used for the treatment of serious infections caused by susceptible aeruginosa, Proteus species, Escherichia Coil, Klebsiella, Enterobacter, Serratia Species, Citrobacter species, and staphylococcus species" under Class 05.

Hence, the question, does MINOGLLEN resemble MINOPHAGEN such that confusion or deception is likely to occur? The marks are shown below:

MINOPHAGEN

MINOGLLEN

Opposer's trademark

Respondent-Applicant's mark

This Bureau noticed that the products covered by the marks have different preparations. Designated as MINOGLLEN, Respondent-Applicant's pharmaceutical products are detailed as to its indications which are "pharmaceutical preparations used for the treatment of serious infections caused by susceptible aeruginosa, Proteus species, Escherichia Coil, Klebsiella, Enterobacter, Serratia Species, Citrobacter species, and staphylococcus species". On the other hand, Opposer's products covered under MINOPHAGEN are generally pharmaceutical preparations. However, confusion is likely in this instance because of the close resemblance between the marks and that the goods belong to Class 05, Medicines and Pharmaceutical preparations. Both marks have the same prefixes "MI" and "NO" and suffixes that are phonetically alike, "GEN" and "GLEN". Respondent-Applicant merely deleted the third syllable and inserted the letter "L" after the letter "G" in Opposer's MINOPHAGEN to come up with the mark MINOGLLEN. It could result to mistake with respect to perception because the marks sound so similar. Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"⁵, "SAPOLIN" and "LUSOLIN"⁶, "CELDURA" and "CORDURA"⁷, "GOLD DUST" and "GOLD DROP".

⁵ *MacDonalds Corp, et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

⁶ *Sapolin Co. v. Balmaceda and Germann & Co*, 67 Phil, 705.

⁷ *Co Tiong SA v. Director of Patents*, G.R. No. L- 5378, 24 May 1954; *Celanes Corporation of America vs. E. I. Du Pont de Nemours & Co* (1946), 154 F. 2d 146 148.)

The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, to wit:

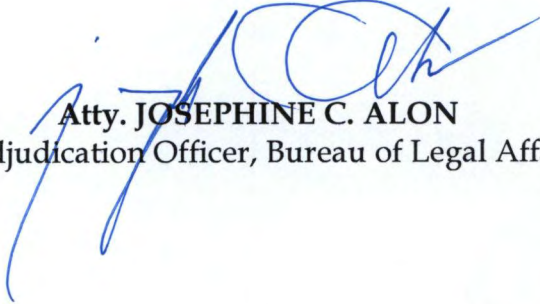
Two letters of "SALONPAS" are missing in "LIONPAS": the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance...."SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.⁸

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2015-013368 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 OCT 2017.


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs

⁸ *Marvex Commercial Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297,22 Dec. 1966.