

BRISTOL MYERS COMPANY, PETITIONER, VS. THE DIRECTOR OF PATENTS AND UNITED AMERICAN PHARMACEUTICALS, INC., RESPONDENTS.

G.R. No. 21587. May 19, 1966

Ponente: BENGZON, J.P., J.

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BENGZON, J.P., J.:

A petition for registration in the Principal Register of the Patent Office of the trademark "BIOFERIN" was filed on October 21, 1957 by United American Pharmaceuticals, Inc. Said domestic corporation first used the afore-stated trademark in the Philippines on August 13, 1957. It covers "a medicinal preparation of antihistamic, analgesic, antipyretic with vitamin C and Bioflavenoid used in the treatment of common colds, influenza and other febrile diseases with capillary hemorrhagic tendencies." The product falls under Class 6 of the official classification, that is, "Medicines and Pharmaceutical Preparations."

Bristol Myers Co., a corporation of the State of Delaware, U.S.A., filed on January 6, 1959 an opposition to the application. Said oppositor is the owner in the Philippines of the trademark "BUFFERIN" under Certificate of Registration No. 4578 issued by the Philippine Patent Office on March 3, 1954. Its trademark is also registered in the United States under Certificate of Registration No. 566190 issued on November 4, 1952. It was first used in the Philippines on May 13, 1953. The product covered by "BUFFERIN" also belongs to Class 6, Medicines and Pharmaceutical Preparations. Designated as "Antacid.analgesic," it is intended for relief in cases of "simple headaches, neuralgia., colds, menstrual pain and minor muscular aches."

The thrust of oppositor's contention was that the registration of the applicant's trademark "BIOFERIN" would violate its rights and interests in its registered trademark "BUFFERIN" as well as mislead and confuse the public as to the source and origin of the goods covered by the respective marks, in view of the alleged practically the same spelling, pronunciation and lettertype design of the two trademarks covering" goods of the same class.

The parties thereafter filed on January 18, 1961 a joint petition stipulating as to the facts and submitting the case upon the issue of whether or not, considering all the factors involved, in both trademarks—as the parties would discuss in their memoranda—there will be such confusing similarity between the two trademarks as will be likely to deceive the purchasing public.

After submission of memoranda, on June 21, 1963 the Director of Patents rendered a decision granting the petition for registration and dismissing the opposition, on the ground that, all factors considered, the trademarks in question are not confusingly similar, so that the damage feared by the oppositor will not result.

From said decision the oppositor appealed to this Court by petition for review filed on July 24, 1963. The sole issue raised thereby is: Are the trademarks "BIOFERIN" and "BUFFERIN," as presented to the public in their respective labels, confusingly similar?

Appellant contends that confusing similarity will obtain because both products are primarily used for relief of

pains such as headaches and colds; and because the words "BIOFERIN" and "BUFFERIN" are practically the same in spelling and pronunciation.

In determining whether two trademarks are confusingly similar, the test is not simply to take their words and compare the spelling and pronunciation of said words. Rather, it is to consider the two marks in their entirety, as they appear in the respective labels, in relation to the goods to which they are attached. Said rule was enunciated by this Court through Justice Felix Bautista Angelo in *Mead Johnson & Co., vs. N.V.J. Van Dorp, Ltd.*, L-17501, April 27, 1963, thus:

"It is true that between petitioner's trademark 'ALACTA' and respondent's 'ALASKA' there are similarities in spelling, appearance and sound for both are composed of six letters of three syllables each and each syllable has the same vowel, but in determining if they are confusingly similar a comparison of said words is not the only determining factor. The two marks in their entirety as they appear in the respective labels must also be considered in relation to the goods to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other. * * *"

Applying this test to the trademarks involved in this case, it is at once evident that the Director of Patent did not err in finding no confusing similarity. For though the words "BIOFERIN" and "BUFFHRIN" have the same suffix and similar-sounding prefixes, they appear in their respective labels with strikingly different backgrounds and surroundings, as to color, size and design.

For convenience we sum up these differences, as follows :

Relevant Factors

"BIOFERIN"

"BUFFERIN"

1. Shape & Size, of Rectangular, about Rectangular,

Label 3-3/4" X 2-1/4" 3-3/4" x 1-1/4"

2. Color of Label

Predominantly yellow Predominantly white

3. Color background of Olive-green Blue

word-mark

4. Over-all Layout At the top center, At left side of label,

word-mark "BIOFE- work,mark "BUF-

RIN"; below it are FERIN"; with "Bris-

contents of medicine, tol Myers Co., New
arranged horizontal- York, N. Y." below it;
ly; at bottom, center, at right side, con-
"United Pharmaceu- tents, indications,
ticals, Inc." in olive- dosage are grouped
green background. together, printed
At left side—dosage, perpendicularly.
printed perpendicu-
larly; at right side,
indications, also per-
pendicularly printed

5. Form of Product Capsules — 1labels Tablets — label says;
says: "50 capsules" "36 Tablets"
Label states: "To be No such statement.
dispensed only by or
on the prescription
of a physician".

Accordingly, taken as they will appear to a prospective customer, the trademarks in question are not apt to confuse. Furthermore, the product of the applicant is expressly stated as dispensable only upon doctor's prescription, while that of oppositor does not require the same. The chances of being confused into purchasing one for the other are therefore all the more rendered negligible. Although oppositor avers that some drugstores sell "BIO FERIN" without asking for a doctor's prescription, the same if true would be an irregularity not attributable to the applicant, who has already clearly stated the requirement of a doctor's prescription upon the face of the label of its product.

Wherefore, the decision of the Director of Patents appealed from is hereby affirmed without costs. So ordered.

Bengzon, C.J., Bautista Angelo, Concepcion, Reyes, J.B.L., Barrera, Dizon, Regala, Makalintal, Zaldivar and Sanchez, JJ., concur.

Decision affirmed.

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