

BIOMEDIS, INC.,
Opposer,

IPC NO. 14-2010-0064
Opposition to:

-versus-

Appln. Ser. No. 4-2009-009162
Date Filed: 11 September 2009
TM: "AMBICLAV"

AMBICA INTERNATIONAL TRADING CORP.,
Respondent-Applicant.

Decision No. 2011-33

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DECISION

BIOMEDIS, INC. ("Opposer"), a domestic corporation duly organized and existing under the laws of the Philippines, with principal business address at 750 Shaw Boulevard, Mandaluyong City, filed on 12 March 2010 an opposition to Trademark Application Serial No. 4-2009-009162. The trademark application, filed by AMBICA INTERNATIONAL TRADING CORPORATION ("Respondent-Applicant"), a domestic corporation with principal address at 9 Amsterdam Extension, Merville Park Subdivision, Parañaque City, covers the mark AMBICLAV for use on "pharmaceutical preparations with antibacterial action" falling under Class 5 of the International Classification of goods.

The Opposer alleges the following:

- "1. The mark AMBICLAV owned by Respondent-Applicant so resembles the trademark AMOCLAV owned by Opposer and duly registered with his Honorable Bureau prior to the publication for opposition of the mark AMBICLAV.
- "2. The mark AMBICLAV will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark AMBICLAV is applied for the same class of goods as that of Opposer's trademark AMOCLAV, i.e. Class 05 of the International Classification of Goods for Anti-Bacterial Pharmaceutical Preparation.
- "3. The registration of the mark AMBICLAV in the name of the Respondent-Applicant will violate Sec 123 of the IP Code, which provides, in part, that a mark cannot be registered if it:
x x x"

The Opposer's evidence consists of the following:

1. Exh. "A" to "A-1" – copies of the pertinent pages of the IPO E-Gazette;
2. Exh. "B" – certified true copy of Cert. Of Reg. No. 4-1999-003627 for the trademark AMOCLAV;
3. Exh. "C" – certified true copy of Declaration of Actual Use;
4. Exh. "D" – sample product label bearing the mark AMOCLAV;
5. Exh. "E" – copy of certification and sales performance; and
6. Exh. F" – certified true copy of Certificate of Product Registration issued by the BFAD.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 30 March 2010. However, the Respondent-Applicant did not file an Answer. Hence, under Rule 2, Sec. 11 of the Regulations on Inter Partes Proceedings, as amended, the case

was deemed submitted for decision on the basis of the opposition and the evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark AMBICLAV?

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 and sale of an inferior and different articles of his products. In this regard, Sec 123.1 d) of R.A. 8293 also known as the Intellectual Property Code of the Philippines ("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.

Records show that at the time the Respondent-Applicant filed its trademark application on 11 September 2009, the Opposer has already an existing trademark registration for the mark AMOCLAV under Reg. No. 4-1999-003627. The Opposer's trademark registration covers "medical preparation for use as antibacterial" under Class 5 of the International Classification of goods. Hence, the competing marks are used on similar or closely related goods.

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?

The logo for the Opposer's mark, "AmoClav", is written in a bold, black, sans-serif font. The letters are closely spaced, and the 'o' is lowercase while the others are uppercase.

Opposer's mark

The logo for the Respondent-Applicant's mark, "AMBICLAV", is written in a bold, black, serif font. The letters are widely spaced, and all are uppercase.

Respondent-Applicant's mark

This Bureau finds the competing marks confusingly similar. The features or parts of the competing marks that draw the eyes and the ears are the syllables "AM" and "CLAV". Their prominence renders the difference in the letters between them, "O" for the Opposer's and "BI" for the Respondent-Applicant's, inconsequential. 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. Aptly, considering that both marks are used on similar or closely related pharmaceutical products, confusion, mistake or even deception, as to the goods or products or with respect to the origins or manufacturers thereof are likely. Consumers may even assume that one mark is just a variation of the other and there is a connection or association between the two marks and/or between the contending parties themselves, when in fact there is none.

It is stressed that the law on trademarks and trade names is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessary precludes the trading by one dealer upon the good name and reputation built by another.⁵

The field from which a person may select a trademark is practically unlimited. As in all cases of colourable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, Respondent-Applicant had to come up with a mark

identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁶

The Respondent-Applicant was given opportunity to explain its side and defend its trademark application. However, it failed or chose not to do so.

WHEREFORE, premises considered, the opposition is hereby SUSTAINED. Let the wrapper of the Trademark Application Serial No. 4-2009-009162 be returned, together with a copy of this decision, to the Bureau of Trademark (BOT) for information and appropriate action.

SO ORDERED.

Makati City, 31 March 2011.

Atty. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs