



MERIAL,

Opposer,

-versus-

VIRBAC S.A.,

Respondent-Applicant.

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IPC NO. 14-2010-00305

Opposition:

Appln. Ser. No. 4-2010-500453

(Filing Date: 31 March 2010)

Trademark: **FIPROLINE**

Decision No. 2012- 63

DECISION

MERIAL (“Opposer”)¹ filed on 6 December 2010 an opposition to Trademark Application Serial No. 4-2010-500453. The application, filed by VIRBAC S.A., (“Respondent-Applicant”)², covers the mark “FIPROLINE” for use on “veterinary preparations, particularly an antiparasitic preparation for external use” under class 5 of the International Classification of Goods/Services.³ The Opposer alleges among other things, that it is the owner of the marks “FRONTLINE”, “FRONTLINE SPRAY LABEL MARK AND FRONTLINE SPRAY BOTTLE DESIGN”, having used, registered and popularized the same in various countries including the Philippines. According to the Opposer, the registration of Respondent-Applicant’s mark is in violation of Sec. 123.1, pars. (d), (e) and (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”).

The Opposer’s evidence consists of the following:

1. Exh. “A”- authenticated and Verified Notice of Opposition;
2. Exh. “B” - authenticated affidavit –testimony of Anne-Sophie Chacornac;
3. Exh. “C” - duplicate of invoices showing the date of first use in France and in the Philippines;
4. Exh. “D” - certified copy of Reg. No. 4-1995-097756 in the Philippines for the mark Frontline issued on 1 July 2005;
5. Exh. “D-1”- certified copy of Reg. No. 4-2009-004144 in the Philippines for the mark Frontline ;
6. Exh. “D-2”-certified copy of Reg. No. 4-2009-004156 for the mark Frontline;
7. Exh. “D-3”-certified copy of Reg. No. 4-2009-00157 in the Philippines for the mark Frontline;
8. Exhs. “D-4” to “D-5”- certified copy of Reg. Nos. 9346759 and 93496789 in France for the mark Frontline (and their renewal certificates);
9. Exh. “D-6” - certified copy of Reg. No. 2, 763, 796 for the mark Frontline in the U.S.A.;
10. Exh. “D-7”- certified copy of Reg. No. 001966787 in the European Country for the mark Frontline;
11. Exh. “D-8”- certified copy Reg. No. 1557026 in the United Kingdom for the mark Frontline (and renewal certificate);

¹ A corporation organized and existing under the laws of France, with principal office at 29 Avenue Tony Garnier 69007 Lyon France.

² With address at 1 ERE Avenue 2065 M-L.I.D. 06516 Caros Cedex, France.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks 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 Purpose of the Registration of Marks concluded in 1957.

12. Exh. "D-9"-certified copy of Reg. No. 622226 in Australia for the mark Frontline (and renewal certificate);
13. Exh. "D-10"-certified copy of Reg. No. 237804 in New Zealand for the mark Frontline (and renewal certificate);
14. Exh. "D-11"-certified copy of Reg. No. 95012677 in Malaysia for the mark Frontline;
15. Exh. "D-12"-certified copy of Reg. No. 495697 in South Korea for the mark Frontline;
16. Exh. "D-13"-certified copy of Reg. no. 4811669 in Japan for the mark Frontline;
17. Exh. "D-14"-certified copy of Reg. No. 1410461 in the People's Republic of China for the mark Frontline (and renewal certificate);
18. Exh. "D-15"- certified copy of Reg. No. 695986 for the mark Frontline (and renewal certificate);
19. Exh. "D-16"- certified copy of Reg. No. 1.711.108 in Argentina for the mark Frontline;
20. Exh. "D-17"-certified copy of International Reg. No. 621912 designating *interalia*, Austria, Bulgaria, Benelux, China, Czech Republic, Germany, Hungary, Italy, Montenegro, Poland, Portugal, Romania, Serbia, Slovakia, Spain, and an extract of the Official database of the International Trademarks showing the current status, for the mark Frontline; and
21. Exhs. "E"- to "E-10"- duplicate invoices concerning the sales of Frontline Product in France, United kingdom, United States of America, Philippines, Ukrainian, Lithuania, Russia.

The Respondent-Applicant filed on 31 May 2011 its Verified Answer denying all the material allegations of the opposition and disputing the Opposer's claim that its mark FIPROLINE is confusingly similar to FRONTLINE. The Respondent-Applicant's evidence consists of the affidavit of Mr. Eric Maree; print-out of the screen pages of its institutional website www.verbac.com; list of its registrations and applications for the trademark FIPROLINE; certified copy of the French Trademark FIPROLINE (nº 08/3588921) along with its translation in English; certified copy of German Trademark FIPROLINE (No. 30 2008 003 366) along with its translation in English; certified copy of the English Trademark FIPROLINE (No. 2518678); certified copy of the International Trademark FIPROLINE (No. 1032318); certified copy of the Phil. Reg. No. 42010500453 for FIPROLINE; invoices evidencing the sale of many products bearing the mark in the U.K. and Germany; and product photos, information, printouts bearing the mark.⁴

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; to protect the manufacturer against and sale of inferior and different articles as his products.⁵

Records and evidence show that at the time the Respondent-Applicant filed its trademark application in the Philippines, the Opposer has existing trademark registrations for the mark FRONTLINE covering goods that are similar and closely related to those indicated in the Respondent-Applicant's application, particularly "*insecticides, anti parasitic and pesticides for veterinary use*". Be that as it may, this Bureau finds that the Respondent-Applicant should be allowed to register the mark FIPROLINE.

⁴ Marked as Exhibits "1" to "1-d".

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

The Opposer's mark consists of two syllables, each one a common English word – “FRONT” and “LINE”. On the other hand, the Respondent-Applicant's mark is composed of three syllables - “FI”, “PRO” and “LINE”. The only feature in the Respondent-Applicant's mark that is similar to the Opposer's is the last syllable which also forms the word “LINE”. There being a stark difference between the other components of the parties' respective marks (“FRONT” for the Opposer and “FIPRO” for the Respondent-Applicant), this Bureau finds it unlikely for the consumers of goods for veterinary use or purpose to commit mistake or be confused.

In resolving disputes involving trademarks, this Bureau can and should take judicial notice of the contents and information in the Trademark Registry. The registry reveals a number of registered marks with the suffix or ending with the word “LINE” and which cover goods or products for veterinary use, to cite a few:

1. “TERRALINE” (Reg. No. 064170) for “antibiotics for veterinary use”, owned by Ceva Sante Animale;
2. TOPLINE (Reg. No. 055224) for “products for the destruction of pest; pesticides; insecticides; herbicides; fungicides; veterinary preparations”, owned by Cambridge Animal and Public Health Limited;
3. TENALINE (Reg. No. No. 060200) for “antibiotic preparations for veterinary use” owned by Sanofi Sante Nutrition Animale;
4. TENALINE (Reg. No. 4-200200047) for veterinary product for the prevention and treatment of infectious diseases for cattle”, owned by Ceva Sante Animale; and
5. CHOICELINE (Reg. No. 42033001632) for “test strips for medical and veterinary use”, owned by Roche Diagnostic GMBH.

The word or suffix “LINE” therefore is not unusual as part of trademarks for goods or products for veterinary use. Instant recall or reminder of FRONTLINE or of the Opposer's products under the said mark is unlikely when one is confronted with the mark FIPROLINE. Veterinarians in prescribing remedies or relief from afflictions suffered by pets and animals, and the concerned consumers will unlikely based their choice solely on the presence of the suffix or word LINE in the product brand names or marks. They would know the distinction between the different products and manufacturers due to the variance of the other words or letters preceding the word LINE in each brand or trademark. Aptly, and because of the difference between FRONT and FIPRO, it is a very remote possibility for the consumers to even think that the competing marks or the parties have some association or connection with each other. In fact, as borne by the records, the marks have co-existed and have been registered abroad such as in France, Germany and the United Kingdom.

The above notwithstanding, this Bureau noticed that “FIPRO” is obviously derived from “*fipronil*”, a generic name of a chemical composition or product that is used as insecticide.⁶ The

⁶ “**Fipronil** is a broad spectrum insecticide that disrupts the insect central nervous system by blocking the passage of chloride ions through the GABA receptor and glutamate-gated chloride (GluCl) channels, components of the central nervous system. This causes hyperexcitation of contaminated insects' nerves and muscles. Specificity of fipronil on insects may come from a better efficacy on GABA receptor, but also because GluCl channels do not exist in mammals.¹¹ Fipronil was discovered and developed by Rhône-Poulenc between 1985 and 1987, and placed on the market in 1993 under the US Patent No. US 5,232,940 B2. Between 1987 and 1996, fipronil was evaluated on more than 250 insect pests on 60 crops worldwide, and crop protection accounted for about 39% of total fipronil production in 1997. Since 2003, BASF holds the patent rights for producing and selling fipronil-based products in many countries.” (<http://en.wikipedia.org/wiki/Fipronil>)

appearance of “FIPRO” in the brand name, mark or label easily conveys the information that the product is “*fipronil*” or “*fipronil*”-based. Thus, while the Respondent-Applicant may register its mark and have exclusive use of the mark FIPROLINE in its entirety, as it could stand scrutiny against the backdrop of Sec. 123.1(h) of the IP Code⁷, it should not be allowed to have exclusive use of “FIPRO”.

WHEREFORE, premises considered, the instant opposition is hereby DISMISSED. The dismissal of the opposition notwithstanding, it is hereby ruled that the Respondent-Applicant has no exclusive use of the word “FIPRO”.

Let the filewrapper of Trademark Application No. 4-2010-500453 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 12 April 2012.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs



⁷ Under the provision, a mark shall not be registered if it “(h) Consists exclusively of signs that are generic for the goods or services that they seek to identify.” Note the qualification “exclusively”.