



ROXTEC INTERNATIONAL AB,
Opposer,

-versus-

ROCKWOOL INTERNATIONAL A/S,
Respondent- Applicant.

X-----X

} IPC No. 14-2012-00513
}
} Opposition to:
} Appln. Serial No. 4-2011-015058
} Date filed: 16 December 2011
} TM: "ROCKTECH"
}
}
}
}

NOTICE OF DECISION

CRUZ MARCELO & TENEFRANCIA
Counsel for the Opposer
6th, 7th, 8th and 10th Floors
CVCLAW Center
11th Avenue corner 39th Street
Bonifacio Triangle, Bonifacio Global City
Taguig City

**SYCIP SALAZAR HERNANDEZ &
GATMAITAN LAW OFFICE**
Counsel for Respondent-Applicant
SSHG Law Centre, 105 Paseo de Roxas
Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 225 dated November 21, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 21, 2013.

For the Director:

Edwin A. Dating
Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



ROXTEC INTERNATIONAL AB,
Opposer,

-versus-

IPC No. 14-2012-00513
Opposition to Trademark
Application No. 4-2011-015058
Date Filed: 16 December 2011
Trademark: "**ROCKTECH**"

ROCKWOOL INTERNATIONAL A/S,
Respondent-Applicant.

X ----- X

Decision No. 2013- 225

DECISION

Roxtec International AB¹ ("Opposer") filed on 14 January 2013 an opposition to Trademark Application Serial No. 4-2011-015058. The contested application, filed by Rockwool International A/S² (Respondent-Applicant), covers the mark "ROCKTECH" for use on *"insulating materials, namely batts, blankets, mats, moulded pipe sections and sheets, all made of mineral wool and for insulation against sound, noise, heat, cold and fire and for acoustically regulating sound"* and *"building materials made of mineral wool or of mineral wool in combination with other non-metallic materials, namely claddings, fillings, linings, boards, panels, partitions, curtain walls, shingles, slabs and tiles. (nonmetallic)"* under Classes 17 and 19, respectively, of the International Classification of Goods³.

Opposer is the registered owner of the mark "ROXTEC & DEVICE" covered by Certificate of Registration No. 4-2002-001576 issued on 17 January 2005 for goods under Classes 06, 17 and 19. It alleges that "ROCKTECH" is visually and aurally similar to its trademark "ROXTEC & DEVICE" as well as its tradename and thus, proscribed by Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It further asserts that Respondent-Applicant's application came more than nine years from the time it sought registration of its mark.

According to Opposer, its company is the world-leading provider of flexible modular-based cable and pipe seals. It maintains that its company's invention for

¹ A foreign corporation organized and existing under the laws of Sweden, with business address at Rombvagen 2, SE-37123 Karlskrona, Sweden.

² With address at Hovedgaden 584 DK-2640 Hedehusene Denmark, Denmark.

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.

adaptability of cables and pipes of different sizes, called the Multidiameter, is based on sealing modules with removable rubber layers, allowing perfect sealing regardless of the outside dimension of the cable or pipe. Allegedly, this flexible standard concept revolutionized the process of cable routing and pipe installation, simplifying design, speeding up installation work and reducing the need for stock, material and logistics.

Opposer avows that in the present, Roxtec supplies modular-based sealing solutions to marine, oil & gas, power, construction, telecom and nuclear projects around the world. It claims to have promoted its products and services by joining numerous trade fairs and exhibitions around the world. It avers that its at least sixty (60) registrations for the marks "ROXTEC" and "ROXTEC & DEVICE" are evidence of its ownership and widespread use of the marks.

In support of its allegations, the Opposer submitted the following:

1. printout of Certificate of Registration No. 4-2002-001576;
2. copy of Respondent-Applicant's trademark application as published in the IPO e-Gazette;
3. pages of Roxtec's publication "GLOBAL NEWS", downloaded from its website at www.roxtec.com; and,
4. copies of its trademark registrations for marks "ROXTEC" and "ROXTEC & DEVICE".

This Bureau issued a Notice to Answer dated 21 January 2013 and served a copy thereof upon the Respondent-Applicant. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 08 October 2013 Order No. 2013-13855 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved in this case is whether the trademark application by Respondent-Applicant should be allowed.

Section 123.1 (d)) of the IP Code provides that:

"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; xxx."

Perusal of the records reveal that at the time Respondent-Applicant filed for an application of registration of its mark "ROCKTECH" on 16 December 2011, Opposer has an existing and valid registration of its trademark "ROXTEC AND DEVICE" under Registration No. 4-2002-001576 issued on 17 January 2005. Clearly, Opposer is the prior registrant.

Now, to determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown below for comparison:



Opposer's Mark



Respondent-Applicant's Mark

From the illustration, it can be gleaned that the Opposer's mark is composed of a device which consists of three white semi-circles within a black square on the left and the syllables "rox" and "tec" on the right side. On the other hand, Respondent-Registrant's mark is merely a word mark composed of the syllables "rock" and "tech". Despite the device on Opposer's mark and the minor differences in spelling, the competing marks remain visually and aurally similar. Both marks begin with the letters "r" and "o". Although "x" succeeds the letters "ro" in Opposer's mark as opposed to the "ck" in Respondent-Applicant's, they are closely similar when pronounced. Likewise, the second syllables of the competing marks - "tec" and "tech"- albeit different in spelling, reverberates the same sound.

This minute dissimilarities are not sufficient to eradicate the possibility of confusion to the purchasing public. 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.⁴

This Bureau also quotes with favor the ruling of the Supreme Court in the case of **Del Monte Corporation vs. Court of Appeals**⁵, thus:

"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."

Succinctly, since the Respondent-Applicant will also use or uses the mark "ROCKTECH" to goods covered by Classes 17 and 19, the slight differences in the competing marks will not diminish the likelihood of the occurrence of confusion, mistake and/or deception. After all, the determinative factor in a contest involving registration of trade mark is not whether the challenged mark would *actually* cause confusion or deception of the purchasers but whether the use of such mark would *likely* cause confusion or mistake on the part of the buying public.⁶

Moreover, 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."⁷

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

⁴Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁵ G.R. No. L-78325, 25 January 1990.

⁶ American Wire & Cable Company vs. Director of Patents, G.R. No. L-26557, 18 February 1970.

⁷ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

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.⁸ Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample opportunity to defend its trademark application but Respondent-Applicant did not bother to do so.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-015058 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 21 November 2013.


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

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.