



UNITED AMERICAN PHARMACEUTICALS, INC., }  
Opposer, }

-versus-

ELMER C. TENDERO, }  
Respondent-Applicant. }

X-----X

IPC No. 14-2010-00134  
Opposition to:  
Appln No. 4-2009-012035  
Date filed: 25 November 2009  
TM: "MACROCEF"

### NOTICE OF DECISION

**OCHAVE & ESCALONA**  
Counsel for the Opposer  
66 United Street, Mandaluyong City  
Metro Manila

**ELMER C. TENDERO**  
Respondent-Applicant  
No. 160 Scout Limbaga Ext.,  
Quezon City

#### GREETINGS:

Please be informed that Decision No. 2014 - 306 dated November 21, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 21, 2014.

For the Director:

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





UNITED AMERICAN PHARMACEUTICALS, } IPC NO. 14- 2010-00134  
INC., } Opposition to:  
Opposer, } Application No. 4-2009-012035  
-versus } Date filed : 25 November 2009  
ELMER C. TENDERO, }  
Respondent-Applicant. } Trademark **MACROCEF**  
x-----x } Decision No. 2014- 306

### DECISION

UNITED AMERICAN PHARMACEUTICALS (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2009-012035. The application, filed by ELMER C. TENDERO (Respondent-Applicant)<sup>2</sup>, covers the mark “MACROCEF”, for use on “pharmaceutical preparations for the treatment of respiratory tract infections and abdominal pain” under Class 05 of the International Classification of Goods and Services<sup>3</sup>.

The Opposer relies on the following grounds in support of its Opposition:

“7. The mark ‘MACROCEF’ owned by Respondent-Applicant so resembles the trademark ‘MACROL’ owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark ‘MACROCEF’.

“8. The mark ‘MACROCEF’, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark ‘MACROCEF’ is applied for the same class of goods as that of Opposer’s trademark ‘MACROL’, i.e. Class (5) of the International Classification of Goods.

“9. The registration of the trademark ‘MACROCEF’ 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:

- (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

<sup>1</sup> A domestic corporation with address at 66 United Street, Mandaluyong City

<sup>2</sup> Filipino citizen with address at 160 Scout Limbaga Extension, Quezon City

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.



- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion.

“10. Under the above-quoted provision, any mark, which is similar to a registered mark, shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

According to the Opposer:

“10. Opposer is the registered owner of the trademark ‘MACROL’.

“10.1. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products. The trademark application for the trademark ‘MACROL’ was filed with the Bureau of Patents, Trademarks and Technology Transfer Bureau on 29 September 1994 by Opposer and was approved for registration on 30 July 1997 to be valid for a period of twenty (20) years, or until 30 July 2017. Thus, the registration of the mark ‘MACROL’ subsists and remains valid to date.

“11. The trademark ‘MACROL’ has been extensively used in commerce in the Philippines.

“11.1. Opposer has dutifully filed its Affidavit of Use pursuant to the requirement of the law to maintain the registration of the trademark ‘MACROL’ in force and effect. Certified true copies of the Affidavits of Use are hereto attached and made integral part hereof as Exhibits ‘C’ and ‘D’.

“11.2. A sample of product label bearing the trademark ‘MACROL’ actually used in commerce is hereto attached and made an integral part hereof as Exhibit ‘E’.

“11.3. No less than the Intercontinental Marketing Services (IMS) itself, the world’s leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand ‘MACROL’ as one of the leading brands in the Philippines in the category of ‘JOIF-Macrolides and Similar Type Market’ in terms of market share and sales performance. A copy of the Certification and sales performance is hereto attached and made an integral part hereof as Exhibit ‘F’.

“11.4. In order to legally market, distribute and sell these pharmaceutical preparations in the Philippines, Opposer registered the product with the Bureau of Food and Drugs Administration (‘BFAD’). A certified true copy of the Certificate of Product Registration issued by the BFAD for



'MACROL' is hereto attached and made an integral part hereof as Exhibit 'G'.

"11.5. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark 'MACROL' to the exclusion of all others. xxx"

To support its opposition, the Opposer submitted as evidence the following:

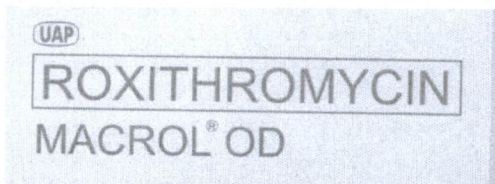
1. Print-out of IPO e-Gazette showing the Respondent-Applicant's trademark application published for opposition;
2. Copy of Certificate of Registration No. 65100 for the trademark "MACROL";
3. Copy of Affidavits of Use dated 7 June 2002 and 31 August 2007;
4. Sample product label of "MACROL";
5. Certification from Intercontinental Marketing Service (IMS) dated 8 June 2010; and
6. Copy of Certificate of Product Registration issued by the Bureau of Food and Drugs dated 23 April 2010<sup>4</sup>

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 11 August 2010. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 2 August 2012 Order No. 2012-1085 declaring the Respondent-Applicant in default.

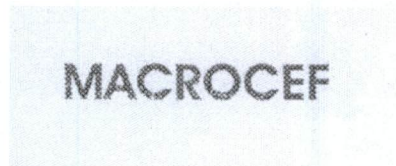
Should the Respondent-Applicant be allowed to register the trademark MACROCEF?

The records show that when the Respondent-Applicant filed its application on 25 November 2009, the Opposer already has an existing registration for the trademark MACROL<sup>5</sup> issued on 30 July 1997 covering goods under classes 5 namely: "Antibacterial medicinal preparation". The Respondent-Applicant's trademark application therefore indicates goods that are similar and/or closely related to those covered by the Opposer's trademark registration.

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?



Opposer's mark



Respondent-Applicant's mark

<sup>4</sup> Exhibits "A" to "G" inclusive of sub-markings

<sup>5</sup> Exhibits "C"




What is common between the two marks is the use of the prefix "MACRO". "MACRO, however, is not unique to the Opposer or to its mark and goods under class 05. The Trademark Registry, the contents of which this Bureau can take cognizance of, is replete with registered trademarks containing the prefix "MACRO" covering goods under class 05 including "MACROLANE" (Reg. No. 4-2011-015354), "MACRONOX" (Reg. No. 4-2009-004891), "MACROZITH" (Reg. No. 4-2012-003698), "MACRODIN" (Reg. No. 4-2006-010042), and "MACROPEN" (Reg. No. 4-2006-005630). These registrations were issued to different proprietors. In fact, the Opposer itself submitted as evidence the "Certification" issued by Intercontinental Marketing Service (IMS) dated 08 June 2010 the sales data covering the period May 2009-April 2010 for "JO1F-Microlides and Similar Type Market"<sup>1</sup>. The mark MACROL is obviously derived from the product description "Macrolides".

Hence, the point of determination as to whether the competing marks are confusingly similar is on the other features, syllables or letters in combination with the prefix "MACRO". In this regard, what follows the prefix "MACRO" in the Respondent-Applicant's mark is the syllable "CEF". This is definitely different in looks with the letter "L" which is appended to the prefix "MACRO" in the Opposer's mark. Corollarily, consumers can easily see and hear the differences in appearance and sound between MACROL and MACROCEF.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-012035 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 2014.

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

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<sup>1</sup> Exhibit "F".