

F. HOFFMANN – LA ROCHE AG,
Opposer,

-versus-

**AMBICA INTERNATIONAL TRADING
CORPORATION,**
Respondent-Applicant.

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} **IPC No. 14-2014-00403**
} Opposition to:
} Appln. Serial No. 4-2014-00005643
} Date Filed: 7 May 2014
} **TM: "ROCEF"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 18 dated January 18, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 18, 2016.

For the Director:


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

<p>F. HOFFMANN- LA ROCHE AG, Opposer,</p> <p>-versus-</p> <p>AMBICA INTERNATIONAL TRADING CORPORATION, Respondent-Applicant.</p>	<p>} IPC NO. 14-2014-00403 } Opposition to: } } Appln. Ser. No. 4-2014-00005643 } Date Filed: 7 May 2014 } } Trademark: ROCEF } } } Decision No. 2016- <i>18</i></p>
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DECISION

F. HOFFMANN-LA ROCHE AG, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-00005643. The application, filed by AMBICA INTERNATIONAL TRADING, (Respondent-Applicant)², covers the mark “ROCEF”, for use on “pharmaceutical preparations namely anti-bacterial” under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

“1. The Opposer is the registered owner in the Philippines of the ROCEPHIN mark for ‘Antibiotic preparations’ in Class 5 under Registration No. 038834 issued by IPO on April 29, 1988, long before the Respondent-Applicant filed its application for registration of the mark ROCEF for ‘Pharmaceutical preparations namely anti-bacterial’ in Class 5 on May 7, 2014 under Serial No. 4-2014-00005643.

“2. The Opposer is the prior user of the ROCEPHIN mark in Philippine commerce and elsewhere, having first used the same since May 27, 1982. In the Philippines, pharmaceutical products bearing the Opposer’s ROCEPHIN mark have been sold as early as November 1, 1983.

¹ A corporation duly organized under the laws of Switzerland with principal address at Grenzacherstrasse 124, 4070 Basel, Switzerland

² A domestic corporation with principal address at #9 Amsterdam Extension, Merville Park Subdivision, Paranaque City

³ 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.

“3. The Respondent-Applicant’s mark ROCEF is identical with, or closely resembles the Opposer’s ROCEPHIN mark as to be likely, when applied to or used in connection with the goods of the Respondent-Applicant, to cause confusion, mistake and deception on the part of the purchasing public by misleading them into thinking that the Respondent-Applicant’s goods either come home from the Opposer or are sponsored or licensed by it.

“4. A side-by-side comparison of the marks clearly shows that the Respondent-Applicant’s mark ROCEF and the Opposer’s mark ROCEPHIN mark have the same dominant feature – that is, both marks dominantly make use of the letters/syllables ‘ROCE’. The Respondent-Applicant’s mark ROCEF differentiates itself from the Opposer’s ROCEPHIN mark by merely replacing the letters ‘PHIN’ with the letter ‘F’. The Respondent-Applicant’s mark ROCEF therefore creates a similar, if not identical, over-all commercial impression to that of the Opposer’s ROCEPHIN mark.

“5. Moreover, the goods in connection with which the mark ROCEF is sought to be registered are identical, similar to, or closely related with, the goods for which the Opposer’s mark ROCEPHIN is used and registered. Indeed, the Respondent-Applicant intends to use the mark ROCEF for ‘Pharmaceutical preparations namely anti-bacterial’; whereas, the Opposer uses ROCEPHIN mark for ‘antibiotic preparations’ which is used in the treatment of infections. Both marks unmistakably cover identical, similar or closely related goods.

“6. Clearly, the Respondent-Applicant’s adoption of the confusingly identical or similar mark ROCEF for its goods in Class 5 is likely to indicate a connection between such goods and those of the Opposer. Such use, adoption and registration of the mark ROCEF will likely confuse, mislead and deceive the purchasing public into believing that the goods bearing the said trademark originate from or are licensed or sponsored by the Opposer. There is also the likelihood that the purchasing public will make the mistake of buying the Respondent-Applicant’s products even if they meant to buy the Opposer’s products because of the similar visual and aural impressions created by the marks.

“7. Given the prior use and registration of the Opposer’s ROCEPHIN mark in the Philippines, there is no clear reason for the Respondent-Applicant to have adopted the mark ROCEF for its goods, other than to trade the goodwill and strong recognition of the ROCEPHIN mark, thereby misleading the public into believing that its identical or similar goods bearing the mark ROCEF originate from, or are licensed or



sponsored by, the Opposer, which has been identified in the trade by consumers as the exclusive source of Class 5 goods bearing the ROCEPHIN mark. It is clear that the Respondent-Applicant's adoption of the mark ROCEF for its own preparations will result in the capitalization of the popularity and brand recall of the Opposer's ROCEPHIN mark. In this sense, the registration and use of the mark ROCEF will give undue trade advantage to the Respondent-Applicant at the expense and to the prejudice of the Opposer.

“8. The registration and use by the Respondent-Applicant of the mark ROCEF in relation to the goods in Class 5 will diminish the distinctiveness and dilute the goodwill of the Opposer's ROCEPHIN mark.

“9. By filing the application for the registration of the mark ROCEF, the Respondent-Applicant represents that it is the originator, true owner and first user of the mark when, in fact, the mark ROCEF is merely a copy or close derivative of the Opposer's prior registered ROCEPHIN mark and the Opposer and its predecessors-in-interest are the first users of the ROCEPHIN mark in Philippine commerce and elsewhere, having utilized the same in the Philippines and around the world for over three decades now. Without a doubt, the Respondent-Applicant's use of the confusingly similar mark ROCEF as the brand name for its goods is likely to cause consumer confusion as to the origin of said goods.

“10. In sum, the registration of the confusingly similar or identical mark ROCEF in the name of Respondent-Applicant will violate Section 123.1(d) of the IP Code, which states 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: (1) 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'.

The Opposer also alleges, among others, the following facts:

“1. Opposer is a manufacturer and seller of pharmaceutical products bearing the ROCEPHIN mark. It has marketed and sold these goods in the Philippines for more than thirty years now. The Opposer has been commercially using the ROCEPHIN mark in the Philippines and around the world long before the Respondent-Applicant's use of the confusingly similar mark ROCEF.

“2. The Opposer is the prior registered owner of the ROCEPHIN mark in the Philippines, having applied for its registration on April 11,

1988. Throughout the years, the Opposer has maintained the registration of the ROCEPHIN mark. xxx”

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

1. Notarized and authenticated Verified Notice of Opposition dated 14 October 2014;
2. Notarized and authenticated Affidavit of Tapio Blanc dated 14 October 2014;
3. Copy of Registration No. 038834 for the mark "ROCEPHIN";
4. Listing of "ROCEPHIN" in the Monthly Index of Medical Specialties (MIMS) Philippine website;
5. Samples of sales invoices and promotional materials showing the mark "ROCEPHIN"⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 3 February 2015. The Bureau received via registered mail the Respondent-Applicant's Answer on 20 March 2015. The Bureau issued Order No. 2015-480 directing the Respondent-Applicant to submit the original Secretary's Certificate within ten (10) days from receipt of order. The Respondent-Applicant, however, filed its Compliance beyond the ten (10) day period, thus, on 10 September 2015, the Bureau issued Order No. 2015-1395, declaring the Respondent-Applicant in default for failure to complete the requirements on time.

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

Records show that at the time Respondent-Applicant applied for registration of the mark "ROCEF" the Opposer already registered the mark ROCEPHIN under Registration No. 038834 issued on 29 April 1988. The goods covered by the Opposer's trademark registration are also under Class 05, same as indicated in the Respondent-Applicant's trademark application.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

The competing marks are reproduced below:



Opposer's mark



Respondent-Applicant's mark

⁴ Exhibits "A" to "D"

In coining its mark, the Respondent-Applicant appropriated most of the literal elements of the Opposer's mark ROCEPHIN. The Respondent-Applicant copied four (4), R-O-C-E, of the eight (8) letters from Opposer's mark and added the letter "F" which when pronounced produces the same sound as the letters "PH", without any other additional letters or syllables.


The marks are *idem sonans* with respect to the syllables ("ROCEPH") and ("ROCEF"). Deletion of the suffix "IN" in the Respondent-Applicant's mark ROCEF, does little to distinguish it from the Opposer's mark, ROCEPHIN. Visually and aurally, the marks are confusingly similar, specially that they are applied on similar or closely related goods under the same class 5, particularly, antibiotics or anti-bacterials. The mark applied for registration by the Respondent-Applicant could also be seen or passed as a variation of the Opposer's mark.

The public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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 substitution and sale of an inferior and different article as his product.⁵

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-00005643 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 18 January 2016.


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

⁵*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).