

UNITED HOME PRODUCT, INC.,
Opposer,

-versus-

JF DRAF PHARMACEUTICALS CORPORATION,
Respondent-Applicant.

X-----X

} **IPC No. 14-2013-00026**
} *Opposition to:*
} *Appln. Serial No. 4-2012-010427*
} *Date Filed: 28 August 2012*
}
} **TM: BACTRICIN**

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for Opposer
No. 66 United Street,
Mandaluyong City

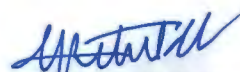
ALEXANDER L. BASIL
Counsel for Respondent- Applicant
116-C J.P. Rizal Street,
Project 4, Quezon City

GREETINGS:

Please be informed that Decision No. 2016 - 515 dated 23 December 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 06 January 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

UNITED HOME PRODUCT, INC.,
Opposer,

IPC NO. 14-2013-00026

- versus -

Opposition to:

Applicatn No. 4-2012-010427
Date Filed: 28 August 2012

**JF DRAF PHARMACEUTICALS
CORPORATION,**
Respondent-Applicant.

Trademark. "BACTRICIN"

x-----x

DECISION NO. 2016 - 515

D E C I S I O N

UNITED HOME PRODUCT, INC. (Opposer)¹, filed an Opposition to Trademark Application Serial No. 4-2012-010427. The application filed, by JF DRAF PHARMACEUTICALS CORPORATION (Respondent-Applicant)², covers the mark "BACTRICIN" for "*pharmaceutical drugs-anti-bacterial*" under Class 5 of the International Classification of Goods.³

The Opposer's based its Opposition on the following grounds:

- 1.) The mark "BACTRICIN" applied for by Respondent-Applicant so resembles the trademark "BACTICIN" owned by Opposer and duly registered with this Honorable Bureau prior to the publication of the application for the mark "BACTRICIN"
- 2.) The mark Bactricin will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark "BACTRICIN" is applied for the same class and goods as that of Opposer's trademark "BACTICIN."

¹ A corporation organized under the laws of Philippines with business address at 4th Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Philippines.

² A corporation organized under Philippine law with address at Suite 407, Greenhills Mansion, 37 Annapolis Street, North East Greenhills, San Juan City, Metro Manila.

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.

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio

Taguig City 1634 Philippines • www.ipophil.gov.ph

T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph

- 3.) The registration of the mark "BACTRICIN" in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code, which provides that, 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.

The pertinent portions of the Opposition are quoted, to wit:

11. Opposer is the owner of the trademark "BACTICIN." It is engaged in the marketing and sale of a wide range of pharmaceutical products. x x x

12. As provided in Section 138 of the IP Code, " A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate."

13. The registration of Respondent-Applicant's mark "BACTRICIN" will be contrary to Section 123.1 (d) of the IP Code. "BACTRICIN" is confusingly similar to Opposer's trademark "BACTICIN." x x x

14. To allow Respondent-Applicant to continue to market its products bearing the mark "BACTRICIN" undermines Opposer's right to its trademark "BACTICIN." As the lawful owner of the trademark from using a confusingly similar mark in the course of trade where such would likely mislead the public. x x x

15. The registration and use of Respondent-Applicant's confusingly similar mark "BACTRICIN" on its goods will enable the latter to obtain benefit from Opposer's reputation and goodwill, and will tend to deceive and/or confuse the public into believing that Respondent-Applicant is in any way connected with the Opposer. x x x

16. In case of grave doubt, the rule is that, " [a]s between a newcomer who by confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favor with the public, any doubt should be resolved against the newcomer inasmuch as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one." (Del Monte Corporation, et Al. vs. Court of Appeals, 181 SCRA 410, 420 [1990])

17. Respondent-Applicant's use of the mark "BACTRICIN" in relation to any of the goods covered by the opposed application, if these goods are considered not similar or closely related to the goods covered by Opposer's trademark "BACTICIN", will undermine the distinctive character or reputation of the latter trademark. Potential damage to Opposer will be caused as a result of its inability to control the quality of the products put on the market by Respondent-Applicant under the mark "BACTRICIN."

18. Thus, Opposer's interest are likely to be damaged by the registration and use of the Respondent-Applicant of the mark "BACTRICIN." The denial of the application subject of this opposition is authorized under the IP Code.

To support its Opposition, the Opposer submitted the following:

1. Exhibit "A" – Copies of the pertinent pages of the IPO E-Gazette; and
2. Exhibit "B" – Certified True Copy of the Certificate of Registration No. 4-2012-001635 for the trademark "BACTICIN."

This Bureau served a Notice to Answer to the Respondent-Applicant on 26 February 2013, requiring the Respondent-Applicant to file a Verified Answer within thirty (30) days from receipt. However, the Respondent-Applicant belatedly filed its Answer to the Opposition. In view of which, an Order dated 18 April 2013 was issued declaring the Respondent-Applicant in default.

Respondent-Applicant filed a Motion for Reconsideration dated 14 May 2013, praying to set aside the order of default. The said motion was denied by the Office in its Order dated 19 July 2013. Consequently, this case was submitted for decision

The issue to resolve in the instant case is whether the Respondent - Applicant should be allowed to register the trademark "BACTRICIN."

This opposition is anchored on Section 123.1, paragraph (d), of the IP Code which 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 mark as to be likely to deceive or cause confusion.

The competing marks are reproduced below for comparison:

BACTICIN

Bactricin

Opposer's Trademark

Respondent -Applicant's
Trademark

Upon close examination of the two contending trademarks and the evidence submitted, this Bureau finds the Opposition meritorious.

Eight (8) of the nine (9) letters composing the wordmark being applied by the Respondent-Applicant, particularly, "B" "A" "C" "T" "I" "C" "I" and "N", are similar with the Opposer's mark. In fact, all the letters in the Opposer's trademark can be found in the Respondent-Applicant's mark.

Moreover, the two wordmarks are both composed of three (3) syllables with similar aural composition – *BAC-TI-CIN* vis a vis *BAC-TRI-CIN*. The close similarities visually and phonetically of the two trademarks create similar impression and confusion on the buying public. The additional letter “R” found on the second syllable of the Respondent-Applicant’s mark is negligible and insufficient to distinguish the two trademarks from each other.

Our Supreme Court has held that *idem sonans* or similarity in the sounds among trademarks is sufficient ground to constitute confusing similarity.⁴ This is especially relevant in the present case, where the records show that goods of both parties subject of the contending marks are similar and/or closely related. The Opposers “BACTICIN” products are for skin antiseptic and disinfectant, which is similar and very much related to Respondent-Applicant’s anti-bacterial “BACTRICIN” products.


Based on the above, there is very likelihood that the products of the Respondent-Applicant may be confused with the Opposer’s. The public may also be deceived that the Respondent-Applicant’s products originated from the Opposer, or that there is a connection between the parties and/or their respective goods.

It has been held consistently in our jurisdiction that the law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for purposes of the law that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁵ Our law does not require actual confusion, it being sufficient that confusion is likely to occur.⁶

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 42012010427 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42012010427 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 23 DEC 2016


Atty. Leonardo Oliver Limbo
Adjudication Officer
Bureau of Legal Affairs

⁴ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

⁵ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

⁶ Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992