

**WESTMONT PHARMACEUTICALS INC.,**  
*Opposer,*

**-versus-**

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

X-----X

**IPC No. 14-2014-00077**  
Opposition to:  
Appln. Serial No. 4-2013-014140  
Date Filed: 27 November 2013

**TM: COCILONE**

**NOTICE OF DECISION**

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


**GENER C. SANSAET**  
*Counsel for Respondent- Applicant*  
West Tower 2005-A, PSE Center  
Exchange Road, Ortigas Center  
Pasig City

**GREETINGS:**

Please be informed that Decision No. 2017 - 40 dated 16 February 2017 (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, 20 February 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs

**WESTMONT PHARMACEUTICALS, INC.,**

Opposer,

-versus

**AMBICA INTL. TRADING CORPORATION,**

Respondent-Applicant.

IPC No. 14-2014-00092

Opposition to Trademark

Application No. 4-2013-014140

Date Filed: 27 November 2013

Trademark: "**COCILONE**"

X ----- X Decision No. 2017- 40

**DECISION**

Westmont Pharmaceuticals, Inc.<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-014140. The contested application, filed by Ambica International Trading Corporation<sup>2</sup> ("Respondent-Applicant"), covers the mark "COCILONE" for use on "*pharmaceutical preparations used for the relief of acute gout and for the prophylaxis of acute attacks*" under Class 05 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the provision of Section 123.1 (d) of the Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). It contends that the Respondent-Applicant's mark "COCILONE" is confusingly similar to its registered mark "DECILONE" especially that they are applied for the same class and goods. According to the Opposer, it filed an application for the mark "DECILONE-C" with the Philippine Patent Office on 23 October 1967 and was approved registration on 02 September 1969. It thereafter filed appropriate application/petition for renewal and Affidavits of Use. The mark is acknowledged by the International Marketing Services ("IMS") as one of the leading brands in the Philippines in the category of "*H02A – Plain Corticosteroids Market*" in terms of market share and performance. It also registered its products with the Food and Drug Administration ("FDA"). In support of its Opposition, the Opposer submitted the following:

1. pertinent page of the IPO E-Gazette publishing the applied mark for opposition;
2. certified true copy of Certificate of Registration No. 015060;
3. certified true copy of the Certificate of Renewal Registration No. 015060;
4. certified true copy of its Affidavits of Use;

<sup>1</sup> A domestic corporation with office address at 4F Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan, Metro Manila, Philippines.

<sup>2</sup> With office address at #9 Amsterdam Extension, Merville Park Subdivision, Parañaque City.

<sup>3</sup> 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.

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5. sample product label of "DECILONE";
6. certification issued by the IMS; and,
7. copy of the Certificate of Product Registration issued by the FDA.<sup>4</sup>

The Respondent-Applicant filed its Answer on 27 June 2014 denying that the mark "COCILONE" is confusingly similar to "DECILONE". It contends that the two have distinctive pronunciations, fonts, colors and designs. It also asserts that the Opposer could not have acquired any right over the last three letters in the "DECILONE" mark considering that the same is merely derived from the last three letters of *dexamethasone*, the generic name of the product. The Respondent-Applicant's evidence consists of the copies of the trademark application form and Certificate of Product Registrations for "COCILONE".<sup>5</sup>

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. This Bureau's Alternative Dispute Resolution Services, however, submitted a report that the parties refused to mediate. Accordingly, a Preliminary Conference was conducted on 21 June 2016 where only counsel for the Opposer was present. Consequently, the Respondent-Applicant was not able to present the original and/or certified true copies of its Exhibits 2 and 3. As such, these documents are inadmissible for being mere photocopies. On 23 June 2016, Order No. 2016-995 was issued directing the Opposer to submit position paper within ten days from termination of the Preliminary Conference. For its failure to attend the Preliminary Conference, the Respondent-Applicant is considered to have waived to submit position paper. Upon the Opposer's compliance, the case is deemed submitted for decision.

The issue to be resolved is whether the Respondent-Applicant's mark "COCILONE" should be allowed registration.

Section 123.1 (d) the IP Code provides that:

***"Section 123. Registrability. - 123.1. A mark cannot be registered if it:***

***x x x***

***(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; x x x"***

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<sup>4</sup> Marked as Exhibits "A" and "G".

<sup>5</sup> Marked as Exhibits "1" to "3".

Records reveal that the Opposer was issued registration for its mark "DECILONE" on 02 September 1969 under Certificate of Registration No. 015060. The Respondent-Applicant, on the other hand, filed the contested application only on 27 November 2013.

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are reproduced below for comparison:

**DECILONE**                      **COCILONE**

*Opposer's mark*

*Respondent-Applicant's mark*

The competing marks are similar with respect to letters "CILONE". The Opposer's sample product, however, show that the generic name for the "DECILONE" mark is *dexamethasone*. It can thus be inferred that the beginning letters "DE" and ending letters "ONE" in the said mark was adopted from the generic name of the product. This gives away to the consumers an idea as to the active ingredients of the pharmaceutical preparation. As such, this opposition cannot be sustained on this ground alone. Moreover, the manifest difference between the first syllables of the contending marks, "DE" and "CO", are sufficient to distinct one from the other. Visually and aurally, the marks are distinguishable.

More importantly, although both marks cover goods under Class 05, the Respondent-Applicant's trademark application indicates gout medication. These are not similar to those covered by the Opposer's trademark registration, which specifically indicates that the mark "DECILONE" is for "*a pharmaceutical preparation for effective management of various inflammatory and allergic conditions generally responsive to corticosteroid therapy, which include skin diseases, allergic reactions, acute inflammatory eye diseases, musculo-skeletal disorders, blood dyscrasias, certain neoplastic diseases (for temporary remission), collagen diseases and adrenocortical insufficiency*". It is also noteworthy that the products are pharmaceuticals that are dispensed with the aid of pharmacists who are unlikely to confuse the brands given the different uses thereof.

Furthermore, it is doubtful if the consumers in encountering the mark "COCILONE" will have in mind or be reminded of the trademark "DECILONE", and vice-versa. The Opposer has not established that "DECILONE" is a well-known mark nor that its mark's fame could support the claim that Respondent-Applicant's


trademark application and use of the mark "COCILONE" manifest the latter's intent of riding in on the goodwill supposedly earned and enjoyed by the former.

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 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.<sup>6</sup> The Respondent-Applicant's trademark sufficiently met this requirement.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-014140 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, **16 FEB 2017**

  
**Atty. Z'SA MAY B. SUBEJANO-PE LIM**  
Adjudication Officer  
Bureau of Legal Affairs

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<sup>6</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.