

QUALIFIRST HEALTH, INC.,
Opposer,

-versus-

BIOCARE LIFESCIENCES, INC.,
Respondent-Applicant.

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}	IPC No. 14-2016-00728
}	Opposition to:
}	Appln. Ser. No. 4-2016-011341
}	Date Filed: 19 September 2016
}	
}	TM: MOXILAV

NOTICE OF DECISION

OCHAVE & ESCALONA
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No. 66 United Street
Mandaluyong City

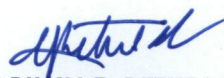
BIOCARE LIFESCIENCES, INC.
Respondent-Applicant
Unit LG-23 Star Centrum Building
Malugay Street corner Gil Puyat Avenue
Brgy. Bel-Air, Makati City

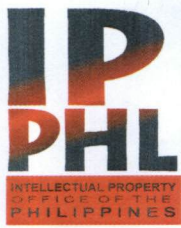
GREETINGS:

Please be informed that Decision No. 2017 - 327 dated 30 August 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, 04 September 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



QUALIFIRST HEALTH, INC.

Opposer,

versus-

BIOCARE LIFESCIENCES, INC.,

Respondent-Applicant.

x-----x

IPC NO. 14-2016-00728

Opposition to:

Appln. Ser. No. 4-2016-011341

Filing Date: 19 September 2016

Trademark: **MOXILAV**

Decision No. 2017 - 327

DECISION

QUALIFIRST HEALTH, INC.¹ ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2016-011341. The application, filed by BIOCARE LIFESCIENCES, INC.² ("Respondent-Applicant") covers the mark **MOXILAV** for use on "*pharmaceutical (drug) - antibiotic, anti-emetic, alpha-1-receptor blocker, proton pump inhibitor*" under Class 5 of the International Classification of goods³.

The Opposer alleges, among others, the following:

"7. The mark 'MOXILAV' applied for by Respondent-Applicant so resembles the trademark "MOXIQAV" owned by Opposer and duly registered with the IPO prior to the publication for opposition of the mark 'MOXILAV'.

"8. The mark 'MOXILAV' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'MOXILAV' is applied for the same class and/or closely related class and goods as that of the Opposer's trademark 'MOXIQAV', *i.e.*, Class 05 of the International Classification of Goods.

"9. The registration of the 'MOXILAV' in the name of the Respondent will violate Sec. 123 (d) 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

¹ A corporation duly organized and existing under the laws of the Philippines with principal office located at Unit 902 Citi State Centre, Pasig City.

² A corporation organized and existing under the laws of the Philippines with address at Unit LG-23 Star Centrum Bldg. Malugay St. cor. Gil Puyat Avenue, Brgy. Bel-Air, Makati City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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(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.

"11. Respondent-Applicant's use and registration of the mark 'MOXILAV' will diminish the distinctiveness of Opposer's trademark 'MOXIQAV'."

The Opposer's evidence consists of the following:

1. Print-out of the relevant portion of the IPOPHL E-Gazette dated 02 November 2016;
2. Certified copy of the Certificate of Registration No. 4-2008-013218 issued on 23 February 2009 for the mark MOXIQAV; and
3. Declaration of Actual Use for the mark MOXIQAV filed in 2011 and 2015.

This Bureau issued on 22 December 2016 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 24 January 2017. The Respondent-Applicant, however, did not file an answer. On 25 July 2017, Order No. 2017-1570 was issued declaring Respondent-Applicant in default for failure to file the answer. Accordingly, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark **MOXILAV**?

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.⁴

Section 123.1 (d) of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines (IP Code), as amended, provides:

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

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G. R. No. 114508, 19 Nov. 1999.

iii. If it nearly resembles such a mark as to be likely to deceive or cause confusion;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, said mark cannot be registered.

The records show that at the time the Respondent-Applicant filed its application for the mark MOXILAV on 19 September 2016, the Opposer already has an existing registration for the trademark MOXIQAV issued on 22 February 2009. As such, the certificate of registration in its name is a *prima facie evidence* of the validity of the registration, ownership of the mark and its exclusive right to use it in connection with the goods and/or services and those that are related thereto, pursuant to Section 138 of the IP Code.

But are the marks of the parties confusingly similar as to likely cause confusion, mistake or deception on the consumers?

The marks of the parties are herein reproduced:

Moxiqav

Opposer's Mark

MOXILAV

Respondent-Applicant's Mark

From the comparison of the above marks, it is clear that Respondent-Applicant's mark MOXILAV so resembles the Opposer's trademark MOXIQAV, that it will likely cause confusion, mistake or deception on the part of the purchasing public. Both marks contain almost identical letters arranged precisely in the same order except for the letter "Q" in Opposer's MOXIQAV mark which was replaced with a letter "L" to form the Respondent-Applicant's mark MOXILAV. Although the contending marks are different in the way it is written, that is, Opposer uses a combination of upper and lower case letters while Respondent-Applicant's mark only uses upper case letters, nevertheless, the differences in the marks, are inconsequential to avoid a finding of confusing similarity. The trademarks MOXIQAV and MOXILAV are practically identical marks in sound and appearance that they leave the same commercial impression upon the public. An unfair competitor need not copy the entire mark to accomplish its fraudulent purposes. It is enough if he takes the one feature which the average buyer is likely to remember. It is apparent that when MOXILAV is pronounced, it produces a similar sound as that of Opposer's MOXIQAV that the former cannot be distinguished from the latter, thus, is confusingly similar. In addition, both trademarks cover pharmaceutical preparations falling under Class 05 of the international classification of goods. As such, if Respondent-Applicant's mark will be allowed registration, both products will flow through the same channels of trade, therefore, confusion between the two trademarks would likely result to prospective buyers.



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 purchaser as to cause him to purchase the one supposing it to be the other⁵.

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two marks is such that there is possibility of the older brand mistaking the newer brand for it.⁶

A boundless choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his product from those of others. When, however, there is no reasonable explanation for the defendant's choice of such a mark though the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive.⁷

In *American Wire & Cable Co. vs. Director of Patents*⁸, the Supreme Court held:

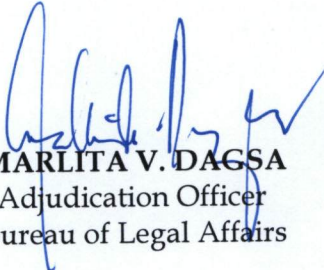
As in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the appellee had to choose a trademark so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark.

Thus, the application for registration of Respondent-Applicant's mark cannot be given due course as it is contrary to Section 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2016-011341, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 30 AUG 2017


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs

⁵ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No. 112012, 4 Apr. 2001, 356 SCRA 207, 217.

⁶ *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

⁷ *Converse Rubber Corporation vs. Universal Rubber Products, Inc.*, G.R. No. L-27906. January 8, 1987.

⁸ 31 SCRA 544