



MERIAL LIMITED,
Opposer,

-versus-

BAYER INTELLECTUAL PROPERTY GMBH,
Respondent- Applicant.

} **IPC No. 14-2013-00041**
}
} **Opposition to:**
} **Appln. No. 4-2012-005727**
} **Date Filed: 14 May 2012**
} **TM: "PROCOX"**
}
}
}

x-----x

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 120 dated April 20, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 20, 2016.

For the Director:


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

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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MERIAL LIMITED,

Opposer,

-versus-

IPC No. 14-2013-00041

Opposition to Trademark

Application No. 4-2012-005727

Date Filed: 14 May 2012

Trademark: **"PROCOX"**

BAYER INTELLECTUAL PROPERTY GMBH,

Respondent-Applicant.

X ----- X Decision No. 2016- 120

DECISION

Merial Limited¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-005727. The application, filed by Bayer Intellectual Property GmbH² ("Respondent-Applicant"), covers the mark "PROCOX" for use on "*veterinary preparations*" under Class 05 of the International Classification of Goods³.

The Opposer maintains that it is the owner of the mark "PREVICOX", which it registered in the Philippines as early as 2004 for use on "*anti-inflammatory veterinary products*". It claims that the mark has acquired inherent distinction and that it has built superior quality-image and substantial reputation therefor. It contends that the mark "PROCOX" is confusingly similar to its mark "PREVICOX". It accuses the Respondent-Applicant of bad faith in adopting the applied mark. In support of its Opposition, the Opposer submitted the affidavit of Anne-Sophie Chacornac, with annexes.⁴

The Respondent-Applicant filed its Answer on 05 July 2013 alleging, among others, that "PROCOX" is to be used specifically for endoparasiticides for dogs and cats while the Opposer's mark "PREVICOX" covers anti-inflammatory veterinary products. It claims to be the originator of "PROCOX", which it registered worldwide. It denies that the marks are confusingly similar reasoning that the two differ in spelling number of letters and pronunciations. It contends that it applied for registration of "PROCOX" without reference to the Opposer's mark. The Respondent-Applicant's evidence consists of the following:⁵

¹ A corporation duly organized and existing under and by virtue of the laws of France with office address at 29 Avenue Tony Garnier.

² A German corporation with office address at Alfred-Nobel-Strasse 10 40789 Monheim Am Rhein, Germany.

³ 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.

⁴ Marked as Exhibit "A" to "E", inclusive.

⁵ Marked as Exhibits "1" to "4".

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1. trademark registrations for the mark "PROCOX" issued by the European Union, Germany, World Intellectual Property Office (WIPO), United States of America, South Africa and New Zealand;
2. photos of and launch dates of "PROCOX" products; and
3. advertising materials of "PROCOX" products.

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. This Bureau's Alternative Dispute Resolution Services submitted a report that the parties refused to mediate. Accordingly, the Hearing Officer conducted and terminated the preliminary conference on 03 February 2014 wherein only counsel for the Opposer appeared and was directed to submit to its position paper within ten days from therefrom. The Respondent-Applicant, on the other hand, is deemed considered to have waived its right to submit its position paper. On 13 February 2014, the Opposer submitted its position paper and the case thus submitted for decision.

The primordial issue in this case is whether the trademark application for the mark "PROCOX" should be allowed.

Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("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"

Records reveal that at the time the Respondent-Applicant filed its application for the mark "PROCOX" on 14 May 2012, the Opposer has a valid and existing registration of the mark "PREVICOX" under Certificate of Registration No. 4-2010-001811 issued on 09 September 2009.

But are the competing marks, as depicted below, confusingly similar?

PREVICOX

Opposer's mark

PROCOX

Respondent-Applicant's mark

The marks are apparently similar with respect to its final syllable "COX". From the sample label⁶ submitted by the Opposer, however, it appears that the term *cox* is derived from *fircoxib*. Therefore, it gives away to the consumers the goods or service and/or the kind, nature, use or purpose thereof. As such, the Opposer cannot claim exclusive use or protection therefrom.

This Bureau finds that confusion, much less deception, is unlikely. Aside from the identical last syllable, the competing marks are distinguishable from each other. The /pre-vi/ in the Opposer's mark is visually and aurally different from the /pro/ in the Respondent-Applicant's. Also, because of the disparity between the goods covered by the Opposer's mark on one hand, and the goods indicated in the Respondent-Applicant's application on the other, it is doubtful if the consumers in encountering the mark "PREVICOX" will have in mind or be reminded of the trademark "PROCOCX". While both marks deal with veterinary preparations, the Opposer's products are anti-inflammatory while the Respondent-Applicant's are parasiticides. Although both pharmaceuticals, they serve different purposes, making confusion even more improbable.

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.⁷ Respondent-Applicant's trademark sufficiently met this function.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filerwrapper of Trademark Application Serial No. 4-2012-005727 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 APR 2016


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

⁶ Exhibit "D-95".

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.