

PEDIATRICA, INC.,
Opposer,

-versus-

WYETH,
Respondent-Applicant.
x-----x

IPC No. 14-2008-00056
Opposition to:

Serial No. : 4-2007-004988
Date filed : 17 May 2007
Trademark : "VESTEME"

Decision No. 09-36

DECISION

This pertains to a Verified Opposition filed on 25 March 2008 by herein opposer, Pediatrica, Inc., a corporation duly organized and existing under the laws of the Philippines with principal office located at 3rd Floor Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, against the application filed on 17 May 2007 bearing Serial No. 4-2007-004988 for the registration of the trademark "VESTEME" used for goods in Class 05 namely, pharmaceutical preparations for the treatment of diseases and disorder of the central nervous system, which application was published in the Intellectual Property Office Official Gazette, officially released for circulation on 25 January 2008.

The respondent-applicant in this instant opposition is Wyeth, a foreign corporation with registered business address at Five Giralda Farms, Madison, New Jersey 07940-0874, United States of America.

The grounds for the opposition are as follows:

"1. The trademark "VESTEME" so resembles "RESTIME" trademark owned by opposer, registered with this Honorable Office prior to the publication for opposition of the mark "VESTEME". The trademark "VESTEME", which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark "VESTEME" is applied for the same class of goods as that of trademark "RESTIME", i.e. Class (5).

2. The registration of the trademark "VESTEME" in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", x x x

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.

3. Respondent use and registration of the trademark "VESTEME" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark "RESTIME".

The allegation of facts are as follows:

"4. Opposer, the owner of the trademark "RESTIME", is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark "RESTIME" was filed with the Intellectual Property Office on 7 August 2007 and valid for a period of ten (10) years. Hence, Opposer's registration of the "RESTIME" trademark subsists and remains valid to date. x x x

5. There is no doubt that by virtue of the prior filing and registration of the mark “RESTIME” mark to the exclusion of all others.

6. “VESTEME” is confusingly similar to “RESTIME”.

6.1 There are no set rules that can be deduced in particularly ascertaining whether one trademark is confusingly similar to, or is a colorable imitation of, another. Nonetheless, jurisprudence provides enough guidelines and test to determine the same.

x x x

6.1.4 Applying the dominancy test, it can be readily concluded that the trademark “VESTEME”, owned by Respondent, so resembles the trademark “RESTIME”, that it will likely cause confusion, mistake and deception on the part of the purchasing public.

6.1.4.1 First, “VESTEME” sounds the same as “RESTIME”;

6.1.4.2 Second, the appearance of the mark “VESTEME” is almost the same as that of “RESTIME”.

6.1.4.3 Third, both marks are composed of two (2) syllables;

6.1.5 Clearly, the Respondent adopted the dominant features of the Opposer’s mark “RESTIME” as the pronunciation of both marks is the same;

x x x

6.2 The trademark “RESTIME” and Respondent’s trademark “VESTEME” are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

6.2.1 Thus, the two marks can easily be confused for one over the other, most especially considering that the opposed trademark “VESTEME” is applied for the same class and goods as that of trademark “RESTIME”, i.e. Class (5); to the Opposer’s extreme damage and prejudice.

6.3 Yet, Respondent still filed a trademark application for “VESTEME” despite its knowledge of the existing trademark registration of “RESTIME” which is confusingly similar thereto in both its sound and appearance.

7. Moreover, Opposer’s intellectual property right over its trademark is protected under Section 147 of Republic Act No. 8293, otherwise known as the Philippine Intellectual Property Code (“IP Code”), which states: x x x

8. To allow Respondent to continue to market its products bearing “VESTEME” mark undermines Opposer’s right to its marks. As the lawful owner of the marks “RESTIME”, Opposer is entitled to prevent the Respondent from using a confusingly similar in the course of trade where such would likely mislead the public.

8.1 Bring the lawful owner of “RESTIME”, Opposer has the exclusive right to use and/or appropriate the said marks and prevent all third parties not having its consent from using in the course of trade identical or similar marks, where such would result in a likelihood of confusion.

8.2 By virtue of Opposer's ownership of the trademark "RESTIME", it also has the right to prevent third parties, such as Respondent, from claiming ownership over Opposer's marks or any depiction similar thereto, without its authority or consent.

8.3 Moreover, following the illustrative list of confusingly similar sounds in trademarks which the Supreme Court cited in McDonald's Corporation, McGeorge Food Industries, Inc. vs. L.C. Big Mak Burger, Inc., 437 SCRA 268 (2004), it is evident that the mark "VESTEME" is aurally confusingly similar to Opposer's mark "RESTIME".

8.4 To allow Respondent to use its "VESTEME" mark on its product would likely cause confusion or mistake in the mind of the public or deceive purchasers into believing that the "VESTEME" products of Respondent originate from or is being manufactured by Opposer, or at the very least, is connected or associated with the "RESTIME" products of Opposer, when such connection does not exist.

8.5 In any event, as between the Respondent, a newcomer, which by the confusion loses nothing and gains patronage unjustly by the association of its products bearing the "VESTEME" mark with "RESTIME" mark, and the first user and actual owner of the mark, Opposer, which by substantial investment of time and resources and by honest dealing has already achieved favor with the public and already possesses goodwill, any doubt should be resolved against the newcomer, Respondent, considering that Respondent, as the latter entrant in the market had a vast range of marks to choose from which would sufficiently distinguish its products from those existing in the market.

9. The registration and use of Respondent's confusingly similar trademark 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 is in any way connected with the Opposer.

10. Likewise, the fact that Respondent seeks to have its mark "VESTEME" registered in the same class (Nice Classification 5) as the trademark "RESTIME" of Opposer will undoubtedly add to the likelihood of confusion among the purchasers of these two goods.

Subsequently, this Bureau issued a Notice to Answer dated 04 April 2008 to herein respondent-applicant's counsel, directing the filing of Answer within thirty (30) days from receipt. Said Notice was duly received by the latter on 23 April 2008. In fact, a Motion for Extension of Time to File Verified Answer dated 22 May 2008 by respondent-applicant was granted for additional period of thirty (30) days in this Bureau's Order No. 2008-807 dated 29 May 2008. To this date, however, no motion, answer nor any pleading related thereto was filed by respondent-applicant or its agent. Thus, pursuant to Section 11 of Office Order No. 79, series of 2005, this instant opposition case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses and documentary evidence submitted by herein opposer, consisting of Annexes "A" and "B".

The issue -

Whether or not there is confusing similarity between opposer's registered trademark "RESTIME" and respondent-applicant's applied mark "VESTEME", both covering class 5 goods.

Opposer legally anchored this instant opposition on Section 123.1 (d) of Republic Act (R.A.) No. 8293, or the Intellectual Property (IP) Code, which provides, to wit:

“Sec. 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”

The foregoing provision deduced that the determining factor in the registration of marks is whether the use of the competing marks in connection with the goods or business will *likely cause confusion*.

In the instant case, the contending marks are opposer’s trademark “RESTIME” with Philippine registration No. 42006008607, and respondent-applicant’s applied mark “VESTEME”, depicted hereunder:

RESTIME

VESTEME

Opposer’s Mark

Respondent’s Mark

The examination of the marks “RESTIME” and “VESTEME” reveals an over-all conspicuous similarity except for the first letters “R” and “V” in opposer and respondent-applicant’s word marks, respectively; and the difference of “I” in opposer’s “RESTIME”; and “E” in respondent-applicant’s “VESTEME”. Apart from this pint-sized dissimilarity, the remaining letters of the contending marks are identical, both aurally and visually. The font appearance of the marks are almost similar. The sounds affected in the pronunciation of the word marks, despite the stated difference create a comparable confusion to the buying public because obviously, the word marks impressed the same cadence when spoken. (*idem sonans rule*, as illustrated in the case of *Sapolin Co. vs. Balmaceda*, 67 Phil 795).

In so far as the goods covered by the contending marks, both trademarks cover pharmaceutical preparations falling under Class 5 of the Nice Classification of Goods. As such, both products flow through the same channels of trade, therefore, confusion between the two trademarks would likely result to prospective buyers. In the case of *Continental Connector Corp. vs. Continental Specialties Corp.*, 207 USPQ 60, the rule applied was that, the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term. By analogy, confusion cannot also be avoided by merely dropping or changing one of the 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 other. (*Societe Des Produits Nestle, S.A. vs. Court of Appeals*, G.R. No. 112012, April 4, 2001, April 4, 2001) 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. (Nims, The Law of Unfair Competition and Trademarks, 4th ed., Vol. 2, pp. 678-679) Indeed, measured against the dominant-feature standard, Respondent-Applicant's mark must be disallowed. For, undeniably, the dominant and essential feature of the article is the trademark itself.

It is also worthy to note that 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.

Finally, it must be emphasized that opposer's mark "RESTIME" (to which respondent-applicant's mark "VESTEME" is confusingly similar) holds a Certificate of Registration No. 42006008607 (Annex "B"), with a filing date on 07 August 2006 and registration date of 30 April 2007. Thus, opposer is entitled to protection pursuant to Section 147.1, Republic Act No. 8293 which states that in part, "The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are registered where such use would result in a likelihood of confusion."

IN VIEW of all the foregoing, the instant Verified Opposition is, as it is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 4-2007-004988 for the mark "VESTEME" filed on 17 May 2007 covering Class 05 goods for pharmaceutical preparations for the treatment of diseases and disorder of the central nervous system, is hereby REJECTED.

Let the filewrapper of "VESTEME", subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademark (BOT) for appropriate action.

SO ORDERED.

Makati City, 16 February 2009.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office