



ALLERGAN INC.,
Opposer,

-versus-

RENOVO LIMITED,
Respondent-Applicant.

} **IPC No. 14-2011-00357**
} Opposition to:
} Appln. Serial No. 4-2010-012072
} Filing Date: 08 Nov. 2010
} **TM: "JUVISTA"**
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NOTICE OF DECISION

TAW & ASSOCIATES

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GREETINGS:

Please be informed that Decision No. 2013 - 17 dated January 28, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 28, 2013.

For the Director:


Atty. PAUL U. SAPAK
Hearing Officer
Bureau of Legal Affairs



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- versus -

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Opposition to:

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TM: "JUVISTA"

Decision No. 2013- 17

DECISION

ALLERGAN INC. ("Opposer")¹ filed on 04 October 2011 an opposition to Trademark Application Serial No. 4-2010-012072. The application, filed by RENOVO LIMITED ("Respondent-Applicant")², covers the mark "JUVISTA" for use on goods under Class 5 of the International Classification of Goods or Services³, namely:

"Pharmaceutical preparations, namely, wound healing preparations, preparations for the prevention, reduction, inhibition or treatment of scarring, preparations for the treatment, reduction, inhibition or prevention of fibrosis, preparations for the treatment, inhibition or prevention of the development of fibrotic conditions, preparations for the purpose of prevention, reduction, inhibition or treatment of scarring in connection with surgery and trauma, treatment of nerves, surgery of nerves or trauma, preparations for the treatment, reduction, inhibition or prevention of dermal wounds, preparations for the treatment, reduction, inhibition or prevention of dermal, scarring, preparations for the treatment, reduction, inhibition or prevention of dermal fibrotic conditions, preparations for the treatment of damaged ligaments, tendons or cartilage, preparations for the promotion of re-epithelialization, preparations for the treatment of chronic wounds, preparations for the treatment of burns, preparations for the treatment, reduction, inhibition or prevention of ulcers or pressure sores, preparations for the treatment, reduction, inhibition or prevention of adhesions and strictures, preparations for the treatment of cardiovascular and vascular restenosis, preparations for the purpose of prevention, reduction, inhibition or treatment of scarring in the treatment of the eye, preparations for the purpose of prevention, reduction, inhibition or treatment of scarring in the treatment of nerves, surgery of nerves or trauma. Topical and injectable pharmaceutical preparations for the reduction of scarring, fibrosis and fibrotic conditions in human tissue resulting from surgery or trauma. Topical and injectable pharmaceutical preparations, namely formulations of proteins that can stimulate the growth of cells for the prevention, reduction, inhibition or treatment of dermal scarring or fibrosis; treatment, inhibition or prevention of the development of dermal fibrotic conditions. Topical and injectable pharmaceutical preparations, namely formulations of proteins than can stimulate the growth of cells to aid in the optimal healing of incisions to epithelial and connective tissue after surgical incisions."

The Opposer alleges among other things, that it will be damaged by the registration of the mark in favor of the Respondent-Applicant and contends that the subject trademark application should be denied because it violates Section 123.1, paragraphs (d), (e) and (f) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). To support its

- 1 A corporation duly existing and register under the laws of the United States of America(U.S.A.), with address at 2525 Dupont Drive, Irvine, California 92612, U.S.A.
- 2 A company incorporated under the laws of the United Kingdom (U.K.) with address at Manchester Incubator Building, 48 Grafton Street Manchester, M13 9XX U.K..
- 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.

opposition, the Opposer submitted as evidence the following:

1. Exh. "A" – Verified Notice of Opposition;
2. Exh. "B" – Special Power of Attorney confirming appointment of Taw & Associates as counsel of Opposer;
3. Exh. "C" – Affidavit of Opposer's authorized representative, Claire B. Corral ("Corral Affidavit");
4. Exh. "D" – Special Power of Attorney confirming appointment of Taw & Associates as counsel of Opposer;
5. Exh. "E" – website printout of the history of the Opposer from <http://www.allergan.com/about/history.htm>;
6. Exh. "F" – press article printed from <http://www.agn.client.shareholder.com> covering the FDA approval of JUVEDERM;
7. Exh. "G" – Press article printed from <http://www.agn.client.shareholder.com> covering the launching of JUVEDERM;
8. Exh. "H" – announcement of the availability of JUDEVERM printed from <http://www.agn.client.shareholder.com>;
9. Exh. "I" – information about JUDEVERM products printed from http://www.allergan.com/product/medical_aesthetics/juvederm.htm;
10. Exh. "J" – safety information about JUVEDERM products printed from http://www.allergan.com/assent.pdf/juvederm_patient_safety.pdf;
11. Exh. "K" – information about JUVEDERM products printed from http://www.allergan.com/products/medical_aesthetics/juvederm.htm;
12. Exh. "L" – information about JUVEDERM product printed from http://www.allergan.com/product/medical_aesthetics/juvederm.htm;
13. Exh. "M" – printouts of the press release on the "JUVEDERM 'Switch Up' Campaign" published by the Opposer;
14. Exh. "N" – Website printout from <http://multivu.prnewswire.com/mnr/allergan/41442/> showing a story of the Opposer's "JUVEDERM 'Switch Up' Campaign";
15. Exh. "O" – website printout of press release of the different variants of JUVEDERM from <http://agn.client.shareholder.com/>;
16. Exh. "P" – website printout of press release of the different variants of JUVEDERM from <http://agn.client.shareholder.com/t>;
17. Exh. "Q" – website printout Reg. No. 3061345 from the France Intellectual Property Office;
18. Exh. "R" – website printout Reg. No. 3061345 for JUVEDERM from the France Intellectual Property Office;
19. Exh. "S" – Phil. Reg. No.4-2007-003612 issued on 03 Mar. 2008; and
20. Exh. "T" – Phil. Reg. No.4-2010-001021 issued on 31 Dec. 2010.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 28 November 2011. The Respondent-Applicant, however, did not file an Answer.

The Opposer anchors its case on paragraphs (d) to (f) of Sec. 123.1, IP Code, which provides that a mark shall not be registered if it is:

1. identical to a registered mark belonging to a different proprietor or 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. [par. (d)]; or

2. identical with or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippine, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services; provided, that in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark. [par. (e)]; or

3. identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, with is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: provided, that use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: provided, further, that the interests of the owner of the registered mark are likely to be damaged by such use. [par. (f)].

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some factors such as sound; appearance; form; style; shape and size or format; color; use; and the setting in which the words appear may be considered, for indeed, trademark infringement is a form of unfair competition⁴. Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance or meaning, would make it possible for the consumers to believe that the goods or products, to which the mark are attached, emanated from the same source or are connected or associated with one another.

Significantly, this Bureau takes note of press article printed from <http://www.agn.client.shareholder.com>, to wit:

"With the FDA approval, JUVEDERM dermal filler joins BOTOX Cosmetic and an array of other dermal filler and skin care treatments in Allergan's facial aesthetics portfolio, which provides patients and physicians with the most comprehensive total facial rejuvenation product offering available."⁵

There is reason therefore to believe that the mark JUVEDERM is derived from the words "*rejuvenation*" (JUVE) and "*dermal*" (DERM). JUVEDERM thus, connotes "*rejuvenated skin*" which means that the mark may be considered a suggestive mark.

In this regard, the only similarities between JUVISTA and JUVEDERM are the first three (3) letters "JUV". With that, confusion or mistake is unlikely if the marks are allowed to co-exist. The letters succeeding "JUV" in the mark JUVISTA confer thereupon visual and aural properties that make it easily distinguishable from the mark JUVEDERM. Also, while the goods indicated in the Respondent-Applicant's application fall under Class 5 as in the case of some of the goods covered by the Opposer's registrations, these two sets of goods are not actually similar.

⁴ *Clarke v. Manila Candy Co.*, 36 Phil. 100, 106.

⁵ Exh. "F".

The pharmaceutical products under the mark JUVISTA serve therapeutic or curative purpose while the JUVEDERM products are purely for aesthetics. Also, the manner by which these products are used or applied renders nil the possibility of confusion or mistake. The Opposer itself stated:

“...JUVEDERM dermal filler is a non-surgical, physician administered treatment for facial wrinkles. It is injected into the dermis and restores hyaluronic acid-....” (Emphasis supplied)

The procedure in administering the pharmaceutical products, through injections and implants, are done by the physicians themselves. It is very remote that such highly trained professionals would succumb to confusion or mistake in what they put on the bodies of their patients.

Succinctly, the function of the 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 genuine article; to prevent fraud substitution and sale of an inferior and different article as his product.⁶ This Bureau finds that the Respondent-Applicant's mark sufficiently fulfills this function or purpose.

With the conclusion that the mark JUVISTA is not confusingly similar to JUVEDERM, there is no need to dwell on the issue of whether the mark JUVEDERM is a well-known mark. The protection under paragraphs (e) and (f) of Sec. 123.1 of the IP Code applies only if the contending marks are confusingly similar.

WHEREFORE, premises considered, the instant opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2010-012072 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 January 2013.


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


⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R No. L-114508, 19 Nov. 1999.