



MERCK KGAA.,  
Opposer,

-versus-

DARVYS PHARMA, INC.,  
Respondent- Applicant.

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}  
} IPC No. 14-2010-00179  
} Opposition to :  
} Appln. Serial No. 4-2009-011080  
} Date filed: 29 October 2009  
} TM: "VISTRA"  
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**NOTICE OF DECISION**

**BUCOY POBLADOR & ASSOCIATES**  
Counsel for the Opposer  
21 Floor, Chatham House  
Valero corner Rufino Streets, Salcedo Village  
Makati City

**DARVYS PHARMA INC.**  
Respondent-Applicant  
5/F Semicon Center Bldg., 50 Marcos Highway  
Pasig City

**GREETINGS:**

Please be informed that Decision No. 2013 - 240 dated December 13, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 13, 2013.

For the Director:

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



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 Opposition to:  
 Appln. Serial No. 4-2009-011080  
 Date Filed : 29 October 2009  
 Trademark: "VISTRA"  
 Decision No. 2013 - 240

**DECISION**

MERCK KGAA, (Opposer"<sup>1</sup>), filed on 19 August 2010 an opposition to Trademark Application No. 4-2009-011080. The application, filed by DARVYS PHARMA, INC. (Respondent-Applicant"<sup>2</sup>), covers the mark "VISTRA" for use on goods under class 5<sup>3</sup> for pharmaceutical preparation.<sup>4</sup>

The Opposer interposes the following grounds for opposition:

"1. The mark 'VISTRA' which respondent-applicant seeks to register so resembles Opposer's registered trademark 'VITESTRA' which when applied to or used in connection with the goods covered by the application under opposition will likely cause confusion, mistake and deception on the part of the purchasing public.

"2. The registration of the mark 'VISTRA' in the name of respondent-applicant will violate Section 123.1 (d) of Republic Act No. 8293 ('Intellectual Property Code')  
 x x x

Thus, any mark which is identical with a registered mark belonging to a different person or legal entity should be denied registration in respect of similar or related goods, or if the mark applied for registration nearly resembles such registered mark that confusion or deception in the mind of the buying public will likely result.

"3. Respondent-applicant's use and registration of the mark 'VISTRA' will diminish the distinctiveness and dilute the goodwill of Opposer's registered trademark 'VITESTRA'."

The following are the allegations in support of the opposition:

"1. Opposer is a German corporation with general partners engaged in the business of manufacturing and distributing pharmaceutical products and preparations classified under International Class 05 of the Nice Classification.

<sup>1</sup> A German corporation with business address at Frankfurter Strasse 250, 64293 Darmstadt, Germany.  
<sup>2</sup> A domestic corporation with principal business address at I/FSGS Foundation Building, No. 1335 G. Araneta Avenue, Quezon City.  
<sup>3</sup> The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.  
<sup>4</sup> The application was published in the Intellectual Property Office Official Gazette, officially released for circulation On 26 April 2010.

"2. Opposer is the registered owner in the Philippines of the trademark VITESTRA as evidenced by Certificate of Trademark Registration No. 4-2008-007763 issued on 03 September 2009 covering goods under International Class 05.

"3. Opposer's Philippine Trademark Registration No. 4-2008-007763 has not been abandoned and is currently in full force and effect. By virtue of Certificate of Trademark Registration No. 4-2008-007763, Opposer has acquired ownership over the mark 'VITESTRA' to the exclusion of all others.

"4. Opposer's aforementioned registered trademark 'VITESTRA' and the mark 'VISTRA' which respondent-applicant seeks to register are practically identical in sound and appearance that they leave the same commercial impression upon the purchasing public.

"5. The mark 'VISTRA' which respondent-applicant seeks to register is visually and phonetically confusingly similar to Opposer's registered trademark 'VITESTRA' as likely to cause confusion, mistake and deception to the public as to the source or origin of respondent-applicant's goods.

"6. The use by, and registration in favour of. Respondent-applicant of the confusingly similar mark 'VISTRA' on its goods will enable it to unjustly benefit from Opposer's established reputation and goodwill.

"7. In view of the prior adoption and registration of the trademark 'VITESTRA' by the Opposer, respondent-applicant is clearly not entitled to register the confusingly similar mark 'VISTRA'.

"8. The registration of the trademark subject of the instant opposition will undoubtedly violate Opposer's rights and interests in its 'VITESTRA' trademark, cause confusion between Opposer's and respondent-applicant's businesses and products, and will most assuredly result in the dilution and loss of distinctiveness of Opposer's registered trademark 'VITESTRA'."

The Opposer's evidence consists of the following

1. Exhibit "A" - Special Power of Attorney;
2. Exhibit "B" - Joint Affidavit of Ulrich Fogel and Jonas Kolle;;
3. Exhibit "C" - Certified true copy of Certificate of Trademark Registration No. 4-2008-007763; and,
4. Exhibit "D" - Publication of Trademark Application No. 4-2009-011080 for the mark VISTRA.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 01 October 2010. Respondent-Applicant however, did not file an answer. Thus, the Respondent-Applicant was declared in default and the case deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark VISTRA?

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 or 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>5</sup>

Thus, Section 123.1 paragraph (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 29 October 2009, the Opposer has already an existing trademark registration for the mark VITESTRA bearing Registration No. 4-2008-007763 issued on 03 September 2009 and valid until 03 September 2019.<sup>6</sup>

But, are the contending marks, depicted below, resemble each other such that confusion, even deception, is likely to occur?

VITESTRA

Opposer’s Trademark

**VISTRA**

Respondent-Applicant’s Trademark

The foregoing marks show compound similarities consisting of the prefix VI and the suffix TRA which is visually apparent. While the Opposer’s mark is longer because of the middle syllable TES which is not present in the Respondent-Applicant’s mark, instead has only the letter S in between VI and TRA, the aural similarity is perceptible when the marks are pronounced.

In this regard, a scrutiny of the Respondent-Applicant’s trademark application shows that the coverage of the mark VISTRA is broadly stated as pharmaceutical preparation. Without any qualification, this product could include those intended to address or apply to illnesses or diseases afflicting both humans and animals which is the goods covered by the Opposer’s trademark.<sup>7</sup>

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 other.<sup>8</sup> Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.<sup>9</sup>

<sup>5</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

<sup>6</sup> Exhibit “C” of Opposer.

<sup>7</sup> Id.

<sup>8</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

<sup>9</sup> Emerald Garment Manufacturing Corp. V. Court of Appeals, G.R. No. 100098, 29 December 1995.

Succinctly, because the coverage of the Respondent-Applicant's trademark application would allow using the mark VISTRA on goods or pharmaceutical products that are already dealt in by the Opposer using the mark VITESTRA, the changes in spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. VITESTRA and VISTRA identical sounds which make it not easy for one to distinguish one mark from the other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound, however, is practically replicated when one pronounces the Respondent-Applicant's mark. There is the likelihood therefore that information, assessment, perception or impression about VISTRA-marked products delivered and conveyed through words and sounds and received by the ears may unfairly cast upon or attributed to VITESTRA-denominated products of the Opposer, and vice-versa.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.<sup>10</sup> The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court.<sup>11</sup>

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Accordingly, this Bureau finds 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 **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2009-011080 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 13 December 2013.

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

<sup>10</sup> American Wire and Cable Co. v. Director of Patents, et al., (31 SCRA 544) G.R. No. L-26557, 18 February 1970.

<sup>11</sup> Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.