



THERAPHARMA, INC.,
Opposer,

-versus-

AMVAC AG,
Respondent-Applicant.

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} IPC No. 14-2012-00136
} Opposition to:
} Appln. Serial No. 4-2011-010333
} Date Filed: 31 August 2011
} TM: "AMVAC" (Design Mark
} in Colour)

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 204 dated October 18, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 18, 2013.

For the Director:

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



THERAPHARMA, INC.,
Opposer,

IPC No. 14-2012-00136
Case Filed: 21 March 2012

-versus-

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TM: "AMVAC" (Design Mark in Colour)

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Decision No. 2013- 204

DECISION

THERAPHARMA, INC. ("Opposer")¹ filed on 21 March 2012 an opposition to Trademark Application Serial No. 4-2011-010332. The application, filed by AMVAC AG, ("Respondent-Applicant")², covers the mark "AMVAC" (Design Mark in Colour) for use on "scientific and technological services and research, in particular in the field of chemical, biochemical, molecular biological and biological preparations for medical and hygienic purposes, medicines, vaccines and contraceptives" under Class 42 of the International Classification of Goods and Services³.

The Opposer alleges among other things, the following:

1. The mark "AMVAC" owned by Respondent-Applicant so resembles the trademark "AMVASC" owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark "AMVAC" and thus, will likely to cause confusion, mistake, and deception on the part of the purchasing public.
2. The registration of the mark "AMVAC" in the name of the Respondent-Applicant will violate Sec. 123 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:

¹ A domestic corporation duly organized and existing under the laws of the Philippines, with office address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan City, Metro Manila, Philippines.

² A foreign corporation with address at Metallstrabe 4, 6300 Zug, Switzerland.

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.

- (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;

3. 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.

To support its opposition, the Opposer submitted the following:

- 1. Exhibits "A" to "A-1" – Copies of the pertinent pages of the IPO E-Gazette;
- 2. Exhibit "B" – Certified true copy of the Certificate of Registration No. 4-2006-000470 for the trademark "AMVASC";
- 3. Exhibit "C" – Certified true copy of the Declaration of Actual Use;
- 4. Exhibit "D" – Sample product label bearing the trademark "AMVASC" actually used in commerce; and
- 5. Exhibit "E" – Certified true copy of the Certificate of Listing of Identical Drug Product issued by the BFAD for the product bearing the trademark "AMVASC".

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant. However, the Respondent-Applicant failed to file an answer. Accordingly, the Hearing Officer issued on 14 August 2013 an Order No. 2013-1126 declaring the Respondent-Applicant in default.

Should the Respondent-Applicant trademark application be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owner of the 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 products⁴.

Thus, Sec. 123.1 (d) of R.A. 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 a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 31 August 2011, the Opposer has already an existing Trademark Reg. No. 4-2006-000470 date of registration 19 March 2007 for the mark "AMVASC" used on medicinal preparation for

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

the treatment of hypertension, chronic stable angina and myocardial ischemia due to vasospastic angina under Class 5 of the International Classification of Goods and Services⁵.

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

Amvasc

AMVAC
Innovative Vaccines

Opposer's Mark

Respondent-Applicant's Mark

The issue of whether the competing marks are confusingly similar has already been passed upon by this Bureau in its earlier decision. In its Decision No. 2009-67, promulgated on 15 June 2009, deciding Inter Partes Case No. 14-2008-00124 entitled Therapharma, Inc. v. Amvac, AG, this Bureau held:

"Pursuant to the aforequoted provision, the application for registration of the subject mark cannot be allowed. Opposer's mark "AMVASC" is confusingly similar to Respondent-Applicant's mark "AMVAC". Similarly, "is applied to goods that are closely related to Respondent-Applicant's goods under the following Classes to wit: (i) Class 05 consisting of pharmaceutical and veterinary preparations such as chemical, biochemical, molecular biological and vaccines, disinfectants, contraceptives, plasters, materials for dressings, sanitary preparations for medical purposes namely sanitary napkins and tampons and dietetic substances adapted for medical use, (ii) Class 10 namely surgical and medical apparatus and instruments, contraceptives and accessories therefore included in this class, (iii) Class 42 composed of scientific and technological services research specifically the field of chemical, biochemical, molecular biological and biological preparations for medical and hygienic purposes, medicines, vaccines and contraceptives, and (iv) Class 44 consisting of medical and veterinary services, hygienic and beauty care for human beings or animals."

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"It is observed that the dominant feature of the Oppsoer's marks "AMVASC" is exactly same with Respondent-Applicant's mark "AMVAC" (Emphasis supplied) in appearance despite the insertion of the letter "S" are also relatively phonetically similar and because they cover similar goods if not the same goods that flow through the same channel of trade. Co-existence of the two marks is not impossible and would likely cause confusion as to source or origin."

⁵ Exhibit "B".

“Respondent-Applicant is applying for the registration of the mark “AMVAC” to be used for pharmaceutical and veterinary preparations *inter alia* while Opposer’s mark “AMVASC” was registered for the marketing and sale of a wide range of pharmaceutical products which are essentially the same kind of business as of Respondent-Applicant’s.”

“Moreover, a careful reading of Opposer’s and Respondent-Applicant’s respective goods show that they are the same goods and it is clear that: 1) they serve the same or complementary purpose; and 2) it might be reasonably assumed that they originate from one manufacturer (**ESSO Standard Eastern, Inc. v. Court of Appeals, et.al., G.R. No. L-29971, August 31, 1982**). Noteworthy is the fact that both are pharmaceutical-related companies seeking registration for exactly the same kind of goods, i.e. pharmaceuticals that the Opposer had already registered for.”

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The decision became final and executory on 30 October 2011.

Inter Partes Case No. 14-2008-00124 involves the same parties in the instant case, and practically the same mark. Thus, there is no reason for this Bureau to deviate from the ruling it made in the previous case. While, the marks applied this time by the Respondent-Applicant includes embellishment and stylized font, the fact remain that the mark is visibly and aurally recognized as AMVAC. The likelihood of confusion persists.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-010333 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 18 October 2013.


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

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