



**THERAPHARMA, INC.,**  
Opposer,

**-versus-**

**MANKIND PHARMA, LTD.,**  
Respondent-Applicant.

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}  
} **IPC No. 14-2011-00478**  
} **Opposition to:**  
} **Appl. Serial No. 4-2011-008867**  
} **Date filed: 28 July 2011**  
} **TM: "VERTISTAR"**

**NOTICE OF DECISION**

**OCHAVE & ESCALONA**  
Counsel for Opposer  
66 United Street  
Mandaluyong City

**NICOLAS & DE VEGA LAW OFFICES**  
Counsel for the Respondent-Applicant  
16<sup>th</sup> Floor, Suite 1607 AIC Burgundy Empire  
Tower ADB Avenue. cor. Sapphire & Garnet Rds.  
Ortigas Center, 1605 Pasig City

**GREETINGS:**

Please be informed that Decision No. 2013 - \_\_\_\_ dated January 21, 2013 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, January 21, 2013.

For the Director:

**Atty. PAUSLU. SAPAK**  
Hearing Officer  
Bureau of Legal Affairs



**THERAPHARMA, INC.,**  
*Opposer,*

**IPC No. 14-2011-00478**  
Case Filed: 26 October 2011

Opposition to:

**-versus-**

Appln. No. : 4-2011-008867  
(Filing Date: 28 July 2011)

**MANKIND PHARMA, LTD.,**  
*Respondent.*

**TM: "VERTISTAR"**

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**Decision No. 2013- 09**

## DECISION

**THERAPHARMA, INC.** ("Opposer")<sup>1</sup> filed on 26 October 2011 an opposition to Trademark Application Serial No. 4-2011-008867. The application, filed by **MANKIND PHARMA, LTD.** ("Respondent-Applicant")<sup>2</sup>, covers the mark "**VERTISTAR**" for use on "*pharmaceutical and medicinal preparations*", under Class 5 of the International Classification of Goods<sup>3</sup>.

The Opposer alleges among other things, the following:

1. The mark "**VERTISTAR**" owned by Respondent-Applicant so resembles the trademark "**VESTAR**" owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark "**VERTISTAR**".
2. The mark "**VERTISTAR**" will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark "**VERTISTAR**" is applied for the same class and goods as that of Opposer's trademark "**VESTAR**", *i.e.* Class 05 of the International Classification of Goods as pharmaceutical and medicinal preparation.
3. The registration of the mark "**VERTISTAR**" 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:

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

<sup>2</sup> With office address at 236, Okhla Industrial Area, Phase - III, New Delhi - 110020, India.

<sup>3</sup> 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;

The Opposer's evidence consists of 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 Reg. No. 4-2006-003582 for the mark VESTAR;
3. Exhibit "C": certified true copy of the Declaration of Actual Use;
4. Exhibit "D": sample product label bearing the mark VESTAR; and
5. Exhibit "E": certified true copy of the Certificate of Product Registration issued by the Bureau of Food and Drugs for VESTAR.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 17 August 2012. However, the Respondent-Applicant did not file the required Answer.

Should the Respondent-Applicant's 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 of 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 manufacture against and sale of an inferior and different article of his products.<sup>4</sup>

Thus, Sec. 123.1 (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 is 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 28 July 2011, the Opposer already has an existing registration for the mark VESTAR for use on "*anti-angina medicinal preparation*"<sup>5</sup>. The Respondent-Applicant's trademark application covers "*pharmaceutical and medicinal preparation*", a broad and general statement that obviously would include "*anti-angina medicinal preparation*".

Thus, this Bureau finds that the Opposer's registered mark and the mark applied for registration by the Respondent-Applicant, as shown below:

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<sup>4</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114509, 19 Nov. 1999.

<sup>5</sup> Registered on 15 Jan. 2007.

# Vestar

Opposer's Mark

# VERTISTAR

Respondent-Applicant's Mark

are confusingly similar.

The only difference between the marks is the presence in the Respondent-Applicant's mark of the letters "R", "T", and "I", placed after the syllable or the letters "VE". Apparently, the Respondent-Applicant added the letters "RTI" to make it appear different from the Opposer's. But the eyes and the ears are still drawn or fixated on the syllable "VE" on one end and the word "STAR" at the other. The additional letters, therefore, failed to confer on the Respondent-Applicant's mark visual and aural properties sufficient to prevent the likelihood of said mark being confused with the Opposer's. The changes in the spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. As mentioned above, the coverage of the Respondent-Application is broadly stated as "*pharmaceutical and medicinal preparation*". If the mark VERTISTAR is registered, this would allow the Respondent-Applicant to use the mark even on "*anti-angina medicinal preparation*". There is the likelihood therefore that information, assessment, perception or impression about the goods bearing the mark VERTISTAR may unfairly be cast upon or attributed or confused with VESTAR products and the Opposer, and *vice-versa*.

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>6</sup>. Colorable imitation does not mean such similitude as amounts 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>7</sup>.

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>8</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>9</sup>

<sup>6</sup> *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No. 112012, 4 Apr. 2001, 356 SCRA 207, 217.

<sup>7</sup> *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

<sup>8</sup> *American Wire and Cable Co. v. Director of Patents et al.*, (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

<sup>9</sup> *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

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. Here, 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.

In the instant case, the Respondent-Applicant did not explain why and how it came up with a mark that is essentially composed of the entire mark of the Opposer's for use on goods that include those dealt in by the latter. It is very difficult to understand and highly improbable if the circumstance was purely coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters are available, the Respondent-Applicant had come up with a mark identical or so nearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.<sup>10</sup>

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

**WHEREFORE**, premises considered, the opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-008867 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig Cit, 21 January 2013.

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

<sup>10</sup> See *American Wire ad Cable Co., v. Director of Patents et. al.*, SCRA 544 G.R. No. L-26557, 18 Feb. 1970.