



J. URIACH COMPANIA, S.A.,
Opposer,

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IPC No. 14-2012-00017

Opposition to:
Appln. Serial No. 4-2011-009126
Date Filed: 04 August 2011
TM: "RUVASTIN"

-versus-

ZUNECA INCORPORATED,
Respondent- Applicant.

x-----x

NOTICE OF DECISION

SIGUION REYNA, MONTECILLO & ONGSIAKO LAW OFFICES

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ZUNECA INCORPORATED
c/o **ATTY. EDEN D. SARNE**
Counsel for Respondent-Applicant
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#108 Valero St., Salcedo Village
Makati City

GREETINGS:

Please be informed that Decision No. 2014 - 250 dated October 13, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 13, 2014.

For the Director:


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



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 Date Filed : 04 August 2011
 Trademark: "RUVASTIN"
 Decision No. 2014 - 250

DECISION

J. URIACH COMPANIA, S.A., ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2011-009126. The application, filed by ZUNECA INCORPORATED, ("Respondent-Applicant")², covers the mark "RUVASTIN" for use on "pharmaceutical products to restore/normalize cholesterol, and lipids level" under class 05 of the International Classification of Goods and Services³.

The Opposer alleged the grounds for this Opposition as follows:

"5. Opposer is the registered owner of the trademarks 'RUPAFIN' as used on goods falling under Class 5 worldwide. Opposer also has trademark applications and/or registrations for the mark in various classes in different countries worldwide long before the appropriation and filing of respondent-applicant of an application for the registration of the trademark 'RUVASTIN'. x x x

x x x

"7. Through years of international marketing and promoting the name, the mark created and adopted by the Opposer has become internationally well known and has acquired worldwide goodwill. Further, as proof of the international popularity and goodwill established by the Opposer for the mark in various classes, Opposer attaches hereto and marks the following documentary evidence consisting of copies of actual product labels that show the use of the registered trademark in countries all over the world; and copies of promotional materials used in promoting bearing the trademark.

"8. Under Section 147 of Republic Act No. 8293, the Opposer has the right to exclude others from registering or using confusingly similar marks such as respondent-applicant's mark 'RUPAFIN' for goods falling under International Class 5.

"9. Opposer submits that Respondent-Applicant's 'RUVASTIN' mark should not be allowed for registration because it is confusingly similar to Opposer's 'RUPAFIN' trademark, being applied for use in the same class 5 of goods as those covered by Opposer's trademark registration. Registration of the mark 'RUVASTIN' in the name of respondent-applicant would violate the pertinent provision of Republic Act No. 8293.

x x x

¹ A corporation duly organized and existing under the laws of Spain, with business address at Av. Cami Reial, 51-57, Pol. Ind. Riera de Caldes, 08184 Palau Solia I Plegamans, Barcelona, Spain.

² With registered address at K-6th Street, East Kamias, Quezon City.

³ 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.

"10. Worse, both respondent-applicant's and Opposer's marks are intended for products belonging to the same class of goods (Class 5), thus, further increasing the probability of causing confusion to the consuming public. In *Coffee Partners, Inc. vs. San Francisco Coffee & Roastery, Inc.*, G.R. No. 169504, the Supreme Court held that the likelihood of confusion is higher when the parties are engaged in the same or substantially the same business. x x x

"11. Thus, Opposer's rights under the provision of IP Code and the Paris Convention on the Protection of Industrial Property must be protected. Allowing the registration of respondent-applicant's mark will inevitably cause the dilution and loss of distinctiveness of Opposer's trademark.

"12. Accordingly, respondent-applicant should be precluded from appropriating and registering the mark 'RUVASTIN' in its name since it is confusingly similar to Opposer's mark 'RUPAFIN'. Opposer is the rightful owner of the mark and is responsible for establishing it as an internationally well-known mark.

The Opposer submitted the following evidence marked as Exhibits "A" to "HHH", inclusive of submarkings:

1. Verification and Certification with Special Power of Attorney;
2. Opposer's trademark registrations and pending trademark applications for the trademark RUPAFIN;
3. Trademark Registrations for RUPAFIN for various foreign countries including the Philippines (some registrations are without official language translation);
4. Community Trademark Registration;
5. Affidavit of Jorge Isern Jara; and,
6. Actual product packaging of RUPAFIN from Barcelona-Espana; and,
7. Promotional materials for RUPAFIN.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 03 April 2012. Respondent-Applicant however, did not file an answer. Thus, it was declared in default⁴, submitting this instant case for decision.

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

The instant opposition is anchored on Section 123.1 paragraph (d) of the IP Code which 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 04 August 2011, the Opposer has already an existing international and local trademark registration for RUPAFIN. In the Philippines, it was issued Registration No. 4-2009-005286 on 02 October 2009⁵. Unquestionably, the Opposer's application and registration preceded the Respondent-Applicant's.

⁴ Order No. 2012-1423 dated 06 November 2012.

⁵ Exhibit "MM" of Opposer.

Nevertheless, a comparison of the Opposer's mark with the Respondent-Applicant's as depicted below:

RUPAFIN

Opposer's mark

RUVASTIN

Respondent-Applicant's mark

shows that both contain the prefix "RU", middle letter "A", and the suffix "IN". It is not sufficient to reach a conclusion that there is the likelihood of confusion, much less deception. The middle consonant letters consisting of "P" and "F" in the Opposer's mark, and "V", "S" and "T" in the Respondent-Applicant's mark create a visual and aural distinction of the said marks.

That confusion or mistake, much less deception, unlikely in this instant, is bolstered by the fact that the goods covered by the RUPAFIN trademark registration are different from those indicated in the RUVASTIN trademark application. Apparently, the illness to be treated by the use of the product is entirely distinct from each other. While the products involved are both falling under classification no. 5, the Opposer's RUPAFIN particularly covers antihistaminic pharmaceutical preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, material for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides⁶; whereas the Respondent-Applicant's RUVASTIN is a medicine to normalize cholesterol and lipids level.⁷ In fact, the Respondent-Applicant has indicated in its trademark application for that RUVASTIN is translated as: RU – restore or normalize cholesterol and lipids level; VAS – vascular stability is maintained; and TIN – triglyceride is normalize. Thus, the mark RUVASTIN shows that it is a creative concept from the combination of its use and purpose as a pharmaceutical product.

Furthermore, it is doubtful if the consumers in encountering the mark RUVASTIN will have in mind or be reminded of the mark RUPAFIN. The Opposer has not established that RUPAFIN is a well-known mark, nor its fame that could support a claim that the Respondent-Applicant's trademark application and use of the its mark manifest the latter's intent of riding in on the goodwill supposedly earned and enjoyed by the Opposer's mark.

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.⁸ This Bureau finds that the mark RUVASTIN meets this function.

⁶ Exhibit "MM" of Opposer.

⁷ Filewrapper records.

⁸ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-009126 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 13 October 2014.


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