



OFFICE OF THE DIRECTOR GENERAL

THERAPHARMA, INC.,
Appellant,

APPEAL NO. 14-2014-0001
IPC No. 14-2011-00509
Opposition to:

-versus-

Application No. 4-2011-007721
Date Filed: 1 July 2011
Trademark: VASCUGARD

THE GENERICS PHARMACY,
INC.,
Appellee.

X-----X

NOTICE

OCHAVE & ESCALONA
Counsel for Appellant
No. 66 United Street
Mandaluyong City

LENY B. RAZ
Director, Bureau of Trademarks
Intellectual Property Office
Taguig City

THE GENERICS PHARMACY, INC.
Appellee
459 Quezon Avenue,
Quezon City

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Intellectual Property Office
Taguig City

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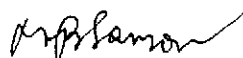
NATHANIEL S. AREVALO
Director, Bureau of Legal Affairs
Intellectual Property Office
Taguig City

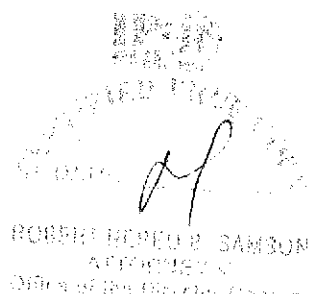
GREETINGS:

Please be informed that on 22 September 2014, the Office of the Director General issued a Decision in this case (copy attached).

Taguig City, 22 September 2014.

Very truly yours,


ROBERT NEREO B. SAMSON
Attorney V


ROBERT NEREO B. SAMSON
ATTORNEY V



OFFICE OF THE DIRECTOR GENERAL

THERAPHARMA, INC.,
Opposer-Appellant,

-versus-

THE GENERICS PHARMACY,
INC.,
Respondent-Appellee.

Appeal No. 14-2014-0001

IPC No. 14-2011-00509

Opposition to:

Application No. 4-2011-007721

Date Filed: 01 July 2011

Trademark: VASCUGARD

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DECISION

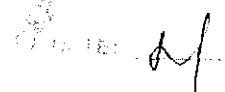
THERAPHARMA, INC. ("Appellant") appeals the decision¹ of the Director of Bureau of Legal Affairs ("Director") dismissing the Appellant's opposition to the registration of the mark "VASCUGARD".

On 01 July 2011, THE GENERICS PHARMACY, INC. ("Appellee") filed Trademark Application No. 4-2011-007721 for the mark VASCUGARD for use on pharmaceutical product, namely, calcium channel blocker. On 10 October 2011, the trademark application was published in the Intellectual Property Office Electronics Gazette for Trademarks. On 09 November 2011, the Appellant filed a "VERIFIED OPPOSITION" alleging that it will be extremely damaged and prejudiced by the registration of VASCUGARD.

The Appellant maintained that it is engaged in the marketing and sale of a wide range of pharmaceutical products. The Appellant claimed that it is the owner of the trademark "VASCORIDE" which is registered² for use on medicinal preparation for the treatment of hypertension. The Appellant asserted that VASCUGARD so resembles VASCORIDE and that the Appellee's use of this mark will likely cause confusion, mistake, and deception on the part of the purchasing public, especially considering that these marks are applied for the same class of goods like anti-hypertension. According to the Appellant, 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

¹ Decision No. 2013-218 dated 12 November 2013.

² Certificate of Registration No. 4-2004-01163 which is valid for a period of ten (10) years from 31 December 2005.


ROBERT NEREO B. SAMSON
ATTORNEY AT LAW
Office of the Director General

result. The Appellant averred that the Appellee's use and registration of VASCUGARD will diminish and dilute the goodwill of VASCORIDE.

The Bureau of Legal Affairs issued on 25 November 2011 a notice to the Appellee requiring it to file an answer to the opposition. The Appellee did not file an answer and consequently, the Appellee was declared in default.³

In dismissing the opposition, the Director held that if the marks are placed side by side, the eyes can easily distinguish one mark from the other. The Director ruled that VASCUGARD sounds distinct from VASCORIDE and that aside from the obvious difference between "GARD" and "RIDE", the "CU" in VASCUGARD is pronounced as "kyu" in contrast with the "CO" in VASCORIDE. The Director ruled that the Bureau of Legal Affairs cannot sustain the opposition merely on the basis or ground that the first four letters of the contending marks are the same. According to the Director, to do so will have the unintended effect of giving the Opposer (Appellant) the exclusive right to use the descriptive prefix or suffix "VASC" for use on pharmaceutical products that treats ailments relating to the heart and the circulatory system.

On 02 January 2014, the Appellant filed an "APPEAL MEMORANDUM [Re: Decision No. 2013-218 dated 12 November 2013]" reiterating the argument that VASCUGARD is confusingly similar to VASCORIDE. The Appellant maintains that the Appellee's use of VASCUGARD will take unfair advantage of, dilute, and diminish the distinctive character or reputation of VASCORIDE. The Appellant argues that potential damage to it will be caused as a result of its inability to control the quality of products put on the market by the Appellee under the confusingly similar mark VASCUGARD.

This Office issued on 09 January 2014 an Order giving the Appellee thirty (30) days from receipt of the Order to submit comment on the appeal. The Appellee did not file its comment and this Office issued another Order⁴ stating that the Appellee is considered to have waived its right to file comment on the appeal and that the case is deemed submitted for decision.

While this Office is drafting the decision on this appeal, it noticed in the records that there is no Declaration of Actual Use ("DAU") for VASCUGARD. Accordingly, this Office requested information from the Bureau of Trademarks on whether the required DAU for VASCUGARD was filed by the Appellee.⁵ On 30 July 2014, the Bureau of Trademarks issued a certification that no DAU had been filed for VASCUGARD.

³ Order No. 2012-927 dated 10 July 2012.

⁴ Order dated 28 May 2014

⁵ Memorandum dated 28 July 2014.

In this regard, the Appellee's application to register the mark VASCUGARD is considered refused for its failure to file the required DAU. Sec. 124.2 of the IP Code states that:

124.2. The applicant or the registrant shall file a declaration of actual use of the mark with evidence to that effect, as prescribed by the Regulations within three (3) years from the filing date of the application. Otherwise, the application shall be refused or the mark shall be removed from the Register by the Director.

Consequently, this appeal is now deemed moot and academic and the Office need not decide this case on the merits. The Appellant in filing the opposition to the registration of VASCUGARD seeks to prevent the registration of this mark in favor of the Appellee. However, in view of the certification issued by the Bureau of Trademarks showing the Appellee's failure to file the DAU, the Appellant's plea for the refusal of the Appellee's trademark application was practically granted.

In one case, the Supreme Court of the Philippines has ruled that:

For a court to exercise its power of adjudication, there must be an actual case or controversy - one which involves a conflict of legal rights, an assertion of opposite legal claims susceptible of judicial resolution; the case must not be moot or academic or based on extra-legal or other similar considerations not cognizable by a court of justice. A case becomes moot and academic when its purpose has become stale, such as the case before us.⁶

In this instance, no practical or useful purpose would be served by resolving the issues and merits in this case when the Appellee's trademark application is now considered refused. It is unnecessary to indulge in academic discussion of a case presenting a moot question as a judgment thereon cannot have any practical legal effect or, in the nature of things, cannot be enforced.⁷

Wherefore, premises considered, the appeal is hereby dismissed for the reasons discussed above.

Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Legal Affairs and the Bureau of Trademarks for their appropriate action and consideration of the Appellee's failure to file the required DAU. Further, let also the library of the Documentation, Information and


⁶ Dean Jose Joya, v. Presidential Commission on Good Government, G. R. No. 96541, 24 August 1993.

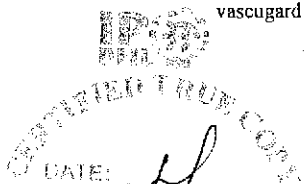

⁷ Gerardo O. Lanuza, Jr. v. Ma. Vivian Yuchengco, G.R. No. 157033, 28 March 2005.

Technology Transfer Bureau be furnished a copy of this decision for information, guidance, and records purposes.

SO ORDERED.

22 SEP 2014 Taguig City.


RICARDO R. BLANCAFLOR
Director General


DATE: 
ROBERT NEREO B. SAMSON
ATTORNEY AT LAW