

OFFICE OF THE DIRECTOR GENERAL

L.R. IMPERIAL, INC.,
Opposer-Appellant,

APPEAL NO. 14-2012-0012
IPC No. 14-2008-00339
Opposition to:
Application No. 4-2006-0013725
Date Filed: 21 December 2006

-versus-

RANDRIL INTERNATIONAL CO., INC.,
Respondent-Appellee.

Trademark: VERZAT-ER

x-----x

L.R. IMPERIAL, INC.,
Opposer-Appellant,

APPEAL NO. 14-2012-0013
IPC No. 14-2008-00340
Opposition to:
Application No. 4-2006-0013713
Date Filed: 21 December 2006

-versus-

RANDRIL INTERNATIONAL CO., INC.,
Respondent-Appellee.

Trademark: VERZAT

x-----x

L.R. IMPERIAL, INC.,
Opposer-Appellant,

APPEAL NO. 14-2012-0014
IPC No. 14-2008-00341
Opposition to:
Application No. 4-2006-0013724
Date Filed: 21 December 2006

-versus-

RANDRIL INTERNATIONAL CO., INC.,
Respondent-Appellee.

Trademark: VERZAT-ER

x-----x

L.R. IMPERIAL, INC.,
Opposer-Appellant,

APPEAL NO. 14-2012-0015
IPC No. 14-2008-00342
Opposition to:
Application No. 4-2006-0013718
Date Filed: 21 December 2006

-versus-

RANDRIL INTERNATIONAL CO., INC.,
Respondent-Appellee.

Trademark: VERZAT

x-----x



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ATTORNEY V
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Fort Bonifacio, Taguig City 1634 Philippines
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L.R. IMPERIAL, INC.,
Opposer-Appellant,

-versus-

RANDRIL INTERNATIONAL CO., INC.,
Respondent-Appellee.

x-----x

APPEAL NO. 14-2012-0016
IPC No. 14-2008-00343
Opposition to:
Application No. 4-2006-0013719
Date Filed: 21 December 2006

Trademark: VERZAT

NOTICE

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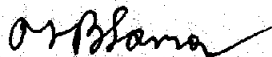
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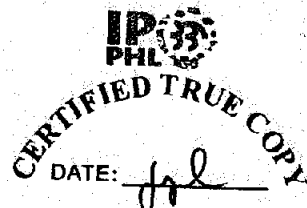
GREETINGS:

Please be informed that on 15 December 2014, the Office of the Director General issued a Decision in this case (copy attached).

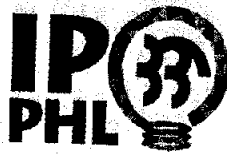
Taguig City, 15 December 2014.

Very truly yours,


ROBERT NEREO B. SAMSON
Attorney V



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ATTORNEY V
Office of the Director General



OFFICE OF THE DIRECTOR GENERAL

L.R. IMPERIAL, INC.,
Opposer-Appellant,

-versus-

Appeal No. 14-2012-0012
IPC No. 14-2008-00339
Opposition to:
Application No. 4-2006-013725
Date Filed: 21 December 2006
Trademark: "VERZAT-ER"

RANDRIL INTERNATIONAL CO., INC.,
Respondent-Appellee.

X-----X

L.R. IMPERIAL, INC.,
Opposer-Appellant,

-versus-

Appeal No. 14-2012-0013
IPC No. 14-2008-00340
Opposition to:
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Date Filed: 21 December 2006
Trademark: "VERZAT"

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X-----X

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Trademark: "VERZAT"

RANDRIL INTERNATIONAL CO., INC.,
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L.R. IMPERIAL, INC.,
Opposer-Appellant,

Appeal No. 14-2012-0016
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Opposition to:
Application No. 4-2006-013719
Date Filed: 21 December 2006
Trademark: "VERZAT"

-versus-

RANDRIL INTERNATIONAL CO., INC.,
Respondent-Appellee.

X-----X

DECISION

This is a consolidation of Appeals from corresponding Decisions Nos. 2012-22, 2012-23, 2012-24, 2012-25 and 2012-26, all dated February 14, 2012, of the Director of the Bureau of Legal Affairs (BLA), dismissing the corresponding Oppositions and giving due course to the Applications for registration of the label marks VERZAT-ER and VERZAT.

Before delving into the main issue of the Appeals, a discussion on the consolidation of the herein Appeals is in order. As the Intellectual Property Office Uniform Rules on Appeal¹ does not provide for any rule on consolidation of cases, the Rules of Civil Procedure shall apply suppletorily.² Rule 31, Section 1 thereof states that:

Sec. 1. Consolidation. When actions involving a common question of law or fact are pending before the court, it may order a joint hearing or trial of any or all the matters in issue in the actions; it may order all the actions consolidated; and it may make such orders concerning proceedings therein as may tend to avoid unnecessary costs or delay.

In the present Appeals, the parties involved are the same and the marks and issues involved are identical. Hence, the Office deems it expedient to resolve these Appeals as one.

¹ Office Order No. 12, Series of 2002, as amended by Office Order No. 12, Series of 2009.
² See Rule 1, Section 4, 1997 Rules of Civil Procedure.

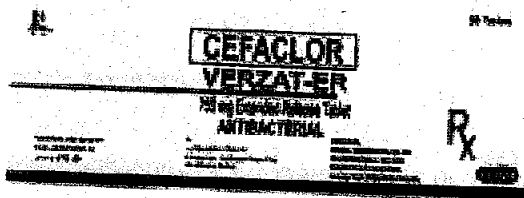
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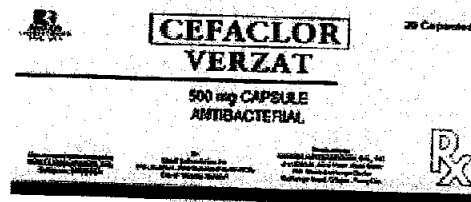
It is worthy to note that, time and again, the Supreme Court has held that proceedings must be conducted in such a manner as would assist the parties in obtaining a just, speedy, and inexpensive determination of every action and proceeding, and serves the orderly administration of justice.³ Consolidation of cases avoids multiplicity of suits, guards against oppression and abuse, prevents delay, clears congested court dockets, simplifies the work of the courts and seeks to attain justice with the least expense and vexation to litigants.⁴ Furthermore, it is a time-honored principle that when two or more cases involve the same parties and affect closely related subject matters, they must be consolidated and jointly tried, in order to serve the best interests of the parties and to settle expeditiously the issues involved.⁵ In other words, consolidation is proper wherever the subject matter involved and relief demanded in the different suits make it expedient for the court to determine all of the issues involved and adjudicate the rights of the parties by hearing the suits together.⁶

Having discussed the propriety of consolidation, we now turn to the main issue in the Appeals.

Opposer-Appellant, owner of the registered mark VERSANT, for an anti-hypertensive/calcium channel blocker pharmaceutical preparation under Nice Classification No. 5, opposed the applications⁷ of Respondent-Appellee for the following label marks, herein reproduced for better appreciation:



Application No. 4-2006-013725

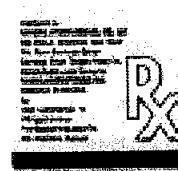
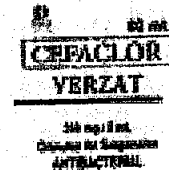
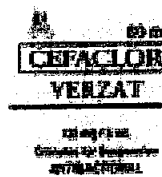


Application No. 4-2006-013713

³ *Active Wood Products Co., Inc. vs. Court of Appeals*, G.R. No. 86603, 05 February 1990.
⁴ *Bank of Commerce vs. Hon. Estela Perlas-Bernabe*, G.R. No. 172393, 20 October 2010, *citing* *Palanca vs. Querubin*, 141 Phil. 432, 439 (1969).
⁵ *Steel Corporation of the Philippines vs. Equitable PCI Bank, Inc.*, G.R. Nos. 190462 and 190538, 17 November 2010, *citing* *Zulueta v. Asia Brewery, Inc.*, G.R. No. 138137, March 8, 2001, 354 SCRA 100, 111.
⁶ *Ibid.*, *citing* 1A C.J.S. Actions § 259.
⁷ All applications were filed on December 21, 2006.

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Application No. 4-2006-013724

Application No. 4-2006-013718

Application No. 4-2006-013719

The Opposer-Appellant's mark is as follows:

Versant

The bases for the Oppositions⁸ narrow down to the following:

- a. The Respondent-Appellee's marks so resemble the Opposer-Appellant's mark as likely to cause confusion, mistake and deception on the part of the purchasing public considering that they belong to the same class of goods; and
- b. The Respondent-Appellee's use and registration of its marks will diminish the distinctiveness and dilute the goodwill of the Opposer-Appellant's mark.

In its Answers⁹, the Respondent-Appellee averred that the competing marks are not confusingly similar to each other as:

- a. Under the Generics Law, physicians are required to issue prescriptions primarily using the generic name (active ingredients), which are different for the subject products;
- b. Also under the said law, the generic name should be written as the dominant portion of the wrapper, contained within a rectangle;

⁸ See Verified Oppositions, pp. 2 to 3, all dated December 2, 2008.

⁹ See Answers, p. 2, all dated June 1, 2009.

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- c. It is very clear from the wrapper who distributed, manufactured and licensed the said products; and
- d. The competing marks have been in the market for a long time and there was no incidence of confusion among the buying public.

The BLA dismissed¹⁰ the Oppositions, on the ground that there is no confusing similarity, explaining that:

- a. The first syllable VER is not sufficient to establish the likelihood of confusion or deception;
- b. The differences between the contending marks accorded the Respondent-Appellee's marks visual properties or character that make it easy for one's eyes to distinguish one mark from the other:
 - 1. The configuration of the letter S in the second syllable of the Opposer's mark vis-à-vis the letter Z in the Respondent's mark;
 - 2. The presence of the letter N, increasing the distance between A and T in the Opposer's mark;
 - 3. The presence of the letters ER, as appended to the word VERZAT in the Respondent's mark.

The BLA also opined that it is very remote for the consumers to associate one mark with the other considering that, although both marks cover pharmaceutical preparations under Class No. 5, the Opposer's mark covers anti-hypertensive/calcium channel blocker pharmaceutical preparation while Respondent's application covers anti-bacterial pharmaceutical preparations used for prevention, alleviation and cure of infections.

Hence, these Appeals.

While the substantive issue is the alleged confusing similarity between the Appellee's marks and that of the Appellant's, the latter, though, raised the issue of the former's alleged failure to file the required Declaration of Actual Use (DAU) on appeal. Hence, the fact of the filing or non-filing thereof is crucial to the resolution this case.

A question may arise as to the propriety of raising the issue of the non-filing of the DAU only on appeal. The requirement for submission of the DAU is expressed in Sec. 124.2 of the IP Code, to wit:

¹⁰ See Decisions, all dated February 14, 2012.

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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.

That the said issue had been raised only on appeal can be explained by the fact that, based on the records¹¹, at the time of the filing of the verified oppositions on December 2, 2008, the requirement to submit the DAU has not yet arisen. As the filing of the applications were made on December 21, 2006, the requirement under the law to file the DAU within three years from said filing is on or before December 21, 2009. Thus, the raising of the DAU issue on appeal is in order.

Accordingly, since the applicant failed to submit the said DAU within three years from application, the same shall be refused, or if the mark had already been registered, the latter will be cancelled and removed from the registry.

The Trademarks Search section in the official website of the Intellectual Property Office of the Philippines indicates that all the subject Applications have the following status: "Refused for non-filing of DAU/DNU".¹² Such being the case, these Appeals are rendered moot and academic, there being no longer any application that can be subject of opposition. Consequently, there is no longer any need to rule on the merits or on the substantive issue of confusing similarity.

The Supreme Court of the Philippines had explained the nature of adjudication in this wise:


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.¹³

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 applications are now considered refused. It is unnecessary to indulge in academic discussion of a case presenting a moot question as a judgment

¹¹ See Verified Oppositions, all dated December 2, 2008.

¹² Application Nos. 42006013713, VERZAT; 42006013719, VERZAT; 42006013718, VERZAT; 42006013725, VERZAT-ER; and 42006013724, VERZAT-ER, available at <http://www.wipo.int/branddb/ph/en> (last accessed December 9, 2014).

¹³ Dean Jose Joya, v. Presidential Commission on Good Government, G. R. No. 96541, 24 August 1993.


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ATTORNEY V
Office of the Director General

thereon cannot have any practical legal effect or, in the nature of things, cannot be enforced.¹⁴

Wherefore, premises considered, the Appeals are hereby dismissed for the reasons discussed above.

Let a copy of this Decision as well as the trademark applications and records be furnished and returned to the Director of the Bureau of Legal Affairs and the Bureau of Trademarks for their information and appropriate action. Further, let also the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this decision for information, guidance, and records purposes.


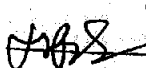
SO ORDERED.

DEC 15 2014 Taguig City.



RICARDO R. BLANCAFLOR
Director General

¹⁴ Gerardo O. Lanuza, Jr. v. Ma. Vivian Yuchengco, G.R. No. 157033, 28 March 2005.


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