



BIOMEDIS INC.,  
Opposer,

-versus-

YUHAN CO. LTD.,  
Respondent-Applicant.

}  
} IPC No. 14-2008-00353  
} Opposition to:  
} Appln No. 4-2008-008628  
} Date Filed: 18 July 2008  
} TM: "REVAZAN"  
}

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### NOTICE OF DECISION

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#### GREETINGS:

Please be informed that Decision No. 2015 - 25 dated March 10, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 10, 2015.

For the Director:

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





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Trademark : "REVAZAN"

Decision No. 2015 - 25

## DECISION

BIOMEDIS INC. ("Opposer"),<sup>1</sup> filed a verified opposition to Trademark Application Serial No. 4-2008-008628. The application, filed by YUHAN CO.LTD. ("Respondent-Applicant")<sup>2</sup>, covers the mark "REVAZAN" for use on *"agents for activating the metabolism, pharmaceutical products for combating metabolic disorders; pharmaceutical products for the treatment of dysfunctions of metabolism; preparations for the treatment of disorders of lipid metabolism; medicines for the treatment of digestive maladies, antiallergic medicines; medicines for the treatment of disorders of the peripheral nervous system; pharmaceutical preparations for the central nervous system; medicines for the treatment of disorders of the respiratory tract; antibiotic preparations; cardiovascular medicines"* under class 05 of the International Classification of Goods<sup>3</sup>

The Opposer alleges the following:

"1. The trademark 'REVAZAN' so resembles 'REVALAN' trademark owned by Opposer, registered with this Honorable Office prior to the publication for opposition of the mark 'REVAZAN'. The trademark 'REVAZAN', which is owned by Respondent, will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'REVAZAN' is applied for the same class of goods as that of trademark 'REVALAN', i.e. Class (5).

"2. The registration of the trademark 'REVAZAN' in the name of the Respondent will violate Sec. 123 of Republic Act No. 8293, otherwise known as the 'Intellectual Property Code of the Philippines', x x x

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.

"3. Respondent's use and registration of the trademark 'REVAZAN' will diminish the distinctiveness and dilute the goodwill of Opposer's trademark 'REVALAN'.

<sup>1</sup> A corporation duly organized and existing under the laws of the Philippines with principal office located at 750 Shaw Boulevard, Mandaluyong City.

<sup>2</sup> A foreign corporation with principal office address at 49-6 Daebang-Dong, Dongjack-Gu, Seoul, Korea.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.



"4. Opposer, the registered owner of the trademark 'REVALAN', is engaged in the marketing and sale of a wide range of pharmaceutical products. The Trademark Application for the trademark 'REVALAN' was filed with the Philippine Patent Office on 31 July 1972 by Opposer and was approved for registration by this Honorable Office on 8 November 1973 and valid for a period of twenty (20) years. Prior to its expiration, Opposer filed an application for renewal which was approved by the same Office and valid for another period of twenty (20) years starting from 8 November 1993 or until 8 November 2013. Hence, Opposer's registration of the "REVALAN" trademark subsists and remains valid to date.

"5. The trademark 'REVALAN' has been extensively used in commerce in the Philippines.

"6. There is no doubt that by virtue of the above-mentioned Certificate of Registration, the uninterrupted use of the trademark 'REVALAN' and the fact that it is well known among consumers, the Opposer has acquired an exclusive ownership over the 'REVALAN' mark to the exclusion of all others.

"7. 'REVAZAN' is confusingly similar to 'REVALAN'.

"8. Moreover, Opposer's intellectual property right over its trademark is protected under Section 147 of Republic Act No. 8293. x x x

"9. To allow Respondent to continue to market its products bearing the 'REVAZAN' mark undermines Opposer's right to its marks. As the lawful owner of the mark 'REVALAN', Opposer is entitled to prevent the Respondent from using a confusingly similar mark in the course of trade where such would likely mislead the public.

"10. By virtue of Opposer's prior and continued use of the trademark 'REVALAN', the same have become well-known and established valuable goodwill to the consumers and the general public as well. The registration and use of Respondent's confusingly similar trademark on its goods will enable the latter obtain benefit from Opposer's reputation, goodwill and advertising and will tend to deceive and/ or confuse the public into believing that Respondent is in any way connected with the Opposer.

The Opposer's evidence consist of the following:

1. Exhibit "A" - List of Trademarks published for opposition;
2. Exhibit "B" - Copy of Certificate of Registration No. 020555;
3. Exhibit "C"&"D"- Copies of Affidavits of Use
4. Exhibit "E" - Sample of product label bearing the trademark "REVALAN";
5. Exhibit "F" - Certificate of Product Registration issued by the BFAD; and,
6. Exhibit "G" - Certification and Sales Performance.

On 02 June 2009, Respondent-Applicant filed its Answer containing among others the following allegations:

"2. Respondent-Applicant has been engaged in the chemical and pharmaceutical business since June 20, 1926 and has been listed in the Korea Stock Exchange since 1962. It is a leading provider of pharmaceutical products worldwide. It has also expanded its business to include veterinary medicines, household products, dietary supplements, personal care products and even computer information technology.

"3. Respondent-applicant filed an application for registration of the trademark 'REVAZAN' on July 18, 2008, bearing Application Serial No. 4-2008-008628 for goods under Nice Classification 5.



"4. Respondent-applicant has trademark registrations and pending application for registration for the same mark for goods under Nice Classification 5 with the trademark registry offices. x x x

"5. Respondent-applicant's trademark 'REVAZAN' is for the drug revaprazan hydrochloride, a pharmaceutical preparation developed by Yuhan as an anti-ulcer agent. It ingeniously coined the mark 'REVAZAN' from the first two and last syllables of revaprazan, which is the active ingredient of the anti-ulcer agent pharmaceutically formulated by Yuhan. Yuhan was never motivated to copy opposer's mark 'Revalan' and intend to market 'REVAZAN' worldwide as shown by the foregoing registrations. If Yuhan merely wanted to ride on the goodwill purportedly attained by opposer for its 'Revalan' products, Yuhan could simply have adopted 'REVAZAN' for use in the Philippines alone. But, this is not the case, as it is evident that Yuhan chose to use 'REVAZAN' worldwide on the basis of the name of its active ingredient revaprazan. Revaprazan was recently developed by Yuhan and labeled as YH-1885. x x x

The Respondent-Applicant's evidence consist of the following:

1. Exhibit "1" - Certificate of Registration of Yuhan Ltd.;
2. Exhibit "2" - Yuhan's webpage;
3. Exhibit "3-A-"3-F"- Trademark registration of REVALAN in the following countries: Peru, Dominican Republic, Belize, Mexico, South Korea, and WIPO;
4. Exhibit "4"-4-D" - Publication of clinical studies of Yuhan's product REVAPRAZAN;
5. Exhibit "5" - Printed copy of anti-ulcer drug "REVAPRAZAN";
6. Exhibit "5-A" - Printed copy of webpage of Yuhan Corp.;
7. Exhibit "6" - Notarized and authenticated joint affidavit of Choi Sang Hoo and KimYoon Seab;
8. Exhibit "7" - Notarized and authenticated affidavit of Sungyon Cho; and,
9. Exhibit "8" - Notarized affidavit of Ms. Theresa Paz B. Grecia Pascual.

Preliminary conference was conducted and terminated. Thereafter, position papers were submitted by the Opposer and Respondent-Applicant on 05 July 2010 and 09 July 2010, respectively. Hence, case is deemed submitted for decision.

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

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property 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 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 18 July 2008<sup>4</sup>, the Opposer has already an existing trademark registration for the mark REVALAN bearing Registration No. 20555 issued on 08 November 1973<sup>5</sup>, and has duly filed the

<sup>4</sup> Filewrapper records.  
<sup>5</sup> Exhibit "B" of Opposer.



Affidavit of Use for the 5th<sup>6</sup> and 10th<sup>7</sup> Anniversary Unquestionably, the Opposer's application and registration preceded that of Respondent-Applicant's.

A comparison of the Opposer's mark with the Respondent-Applicant's is depicted below:

**REVALAN**

Opposer's Trademark

**Revazan**

Respondent-Applicant's Trademark

The only difference between the marks is the letter *L* in *REVALAN*, and the letter *Z* in *REVAZAN*. Obviously, the marks appear visually and aurally similar.

Further, a scrutiny of the goods covered by the mentioned marks show that both are covered under classification no. 5 of the goods. While Opposer's *REVALAN* is a Non-Narcotic Analgesic<sup>8</sup>; and Respondent-Applicant's *REVAZAN* is for the treatment of the following: activating the metabolism, combating metabolic disorders; treatment of dysfunctions of metabolism, disorders of lipid metabolism, digestive maladies; disorders of the peripheral nervous system, respiratory tract; antiallergic medicines; pharmaceutical preparations for the central nervous system; antibiotic preparations; cardiovascular medicines", it may happen that these medicines are disposed by the pharmacist by mistake committed either in reading the prescription, or simply by disposing because Analgesics are over-the-counter type of medicine.

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>9</sup> Colorable imitation does not mean such similitude as amount 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>10</sup>

Succinctly, because the coverage of the Respondent-Applicant's trademark application would allow using the mark *REVALAN* on goods or pharmaceutical products that are already dealt in by the Opposer using the mark *REVAZAN*, the changes in spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. *REVALAN* and *REVAZAN* have identical sounds which make it not easy for one to distinguish one mark from the other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is

<sup>6</sup> Exhibit "D" of Opposer.

<sup>7</sup> Exhibit "C" of Opposer.

<sup>8</sup> Medications used to control pain and inflammations. Available at [http://www.breastcancer.org/treatment/pain/meds/non\\_narcotics](http://www.breastcancer.org/treatment/pain/meds/non_narcotics) (Last accessed 18 February 2015).

<sup>9</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

<sup>10</sup> Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.



the sound made in pronouncing it. The same sound, however, is practically replicated when one pronounces the Respondent-Applicant's mark.

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, 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>11</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>12</sup>

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 on 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 of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, 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.

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

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2008-008628 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 10 March 2015.

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

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<sup>11</sup> American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.  
<sup>12</sup> Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.