



VERTEX PHARMACEUTICALS INC.,
Opposer,

-versus-

NEW MYREX LABORATORIES INC.,
Respondent-Applicant.

}
} **IPC No. 14-2012-00004**
} Opposition to:
} Application No.4-2011-005509
} Date filed: 16 May 2011
} **TM: "VENTREX"**
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NOTICE OF ORDER

FEDERIS & ASSOCIATES LAW OFFICES

Counsel for the Opposer
Suite 2005, 88 Corporate Center
141 Valero Street, Salcedo Village
Makati City

NEW MYREX LABORATORIES INC.

c/o DANIEL P. REGINO
Respondent-Applicant
44 Annapolis Street
Cubao, Quezon City

GREETINGS:

Please be informed that Order No. 2015 - 33 (D) dated March 03, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 03, 2015.

For the Director:

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



**VERTEX PHARMACEUTICALS
INCORPORATED,**

Opposer,

- versus -

NEW MYREX LABORATORIES INC.,
Respondent-Applicant.

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IPC NO. 14 - 2012- 00004

Opposition to:
Appln Serial No. 4-2011-005509
Date filed: 16 May 2011
TM: **VENTREX**

ORDER NO. 2015 - 33 (D)

ORDER

VERTEX PHARMACEUTICALS INCORPORATED (Opposer)¹ filed an Opposition to Trademark Application No. 4-2011-005509. The application filed by NEW MYREX LABORATORIES INC., (Respondent-Applicant)², covers the mark "VENTREX," for used on "*Medicine namely, anti-asthma, bronchodilator; expectorant preparations*" under Class 05 of the International Classification of Goods.³

The Opposer based its opposition on the following grounds: 1.) VENTREX is confusingly similar to Opposer's VERTEX and VERTEX AND DEVICE trademarks and hence under Section 123.1 (d) and 147.1 of the Intellectual Property Code (IP Code), it can no longer be registered by Respondent-Applicant; 2.) VENTREX on medicine will confuse the public to mistake it for Opposer's pharmaceutical products under the VERTEX and VERTEX AND DEVICE trademarks, and vice versa, or to associate it as belonging to Opposer's pharmaceutical business, and hence, registration for VENTREX is barred pursuant to 12.1(g) of the IP Code; 3.) VERTEX is Opposer's trade name and hence, registration of the confusingly similar VENTREX will violate Section 165.2 (a) and (b) of the IP Code which protects trade names; 4.) The registration of VENTREX will enable the Respondent-Applicant to unfairly profit commercially from goodwill, fame, and notoriety of Opposer and its trademark VERTEX contrary to Section 168.1 of the IP Code.

To support its opposition, the Opposer submitted the following:

Exhibit "A" – Affidavit of Stephen L. Nesbitt, Vice President and Chief Patent Counsel of Vertex Pharmaceuticals Incorporated;

¹ A corporation organized and existing under the laws of the United States of America, with business address at 130 Waverly Street, Cambridge, Massachusetts 021394242, U. S. A.

² A corporation organized and existing under the laws of the Philippines with business address at Catmon, Sta. Maria, Bulacan.

³ *The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.*

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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- Exhibit "B" – Original copies of news articles regarding the company, marketing materials and news articles;
- Exhibit "C" – Articles of Incorporation of Vertex Pharmaceuticals Incorporated.
- Exhibit "D" – Certified copies of representative trademark registrations for the mark VERTEX;
- Exhibit "E" – Affidavit and Certification of Anna Daley, Trademark Paralegal of Sunstein Kann Murphy & Timbers LLP;
- Exhibit "F" – Affidavit of Amando S. Aumento Jr.;
- Exhibit "G" – Special Power of Attorney;
- Exhibit "H" – Print out of pages from Opposer's website <http://www.vrtx.com>
- Exhibit "I" to "I-15" – Print out of websites where the mark VERTEX is featured or advertised;
- Exhibit "J" to "J-2" – Annual Reports of VERTEX PHARMACEUTICALS INCORPORATED for the years 2009, 2010, and 2011;
- Exhibit "K" – Certified copy of the trademark registration for VERTEX under Registration No. 4-2011-000875 filed on 26 January 2011 and issued on 12 May 2011;
- Exhibit "L" – Certified copy of the trademark registration for VERTEX AND DEVICE under Registration No. 4-2011-000876 filed on 26 January 2011 and issued on 12 May 2011;
- Exhibit "M" – Certified copy of the trademark registration for VERTEX under Registration No. 4-2008-000091 filed on 2 January 2008 and issued on 27 October 2008;
- Exhibit "N" – Certified copy of the trademark registration for VERTEX AND DEVICE under Registration No. 4-2008-000297 filed on 9 January 2008 and issued on 27 October 2008; and
- Exhibit "O" – Copy of the Decision issued by the Commercial Court at the District Court of Central Jakarta declaring VERTEX well-known mark.

This Bureau issued a Notice to Answer on 8 March 2012 and served a copy thereof to the Respondent-Applicant on 27 April 2012. However, the Respondent-Applicant did not file an answer to the Opposition. In view thereof, an Order dated 20 July 2012 was issued declaring the Respondent-Applicant to have waived the right to file an answer. Consequently, this case is deemed submitted for decision.

On 29 September 2014, the Opposer filed a Manifestation stating that a check with the Bureau of Trademark indicates that the Respondent – Applicant failed to file its 3rd year Declaration of Actual Use (DAU) for the trademark application of "VENTREX" covered by the Application No. 4-2011-005509. A certification to this effect dated 26 September 2014 issued by the Bureau of Trademark was submitted by the Opposer. This notwithstanding, this Bureau resolves the instant case on the merits.

The issue in the present case is whether to allow the registration of herein Respondent-Applicant's "VENTREX" trademark.

The instant opposition is anchored on Sections 123.1 (d), 123.1(g), 147.1, 165.2, and 168.1 of the IP Code. The particular provisions are quoted as follows:

Section 123. Registrability. – 123.1. A mark cannot be registered if it:

x x x

(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:

- (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;

x x x

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

x x x

Section 147. Rights Conferred. – 147.1. The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

x x x

Section 165. Trade Names or Business Names. – x x x

165.2 (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

x x x

Section 168. Unfair Competition, Rights, Regulation and Remedies – 168.1 A person who has identified in the mind of the public the goods he manufactures or deals in, his business or services from those of others, whether or not a registered mark is employed, has a property right in the goodwill of the said goods, business or services so identified, which will be protected in the same manner as other property rights.

168.2. Any person who shall employ deception or any other means contrary to good faith by which he shall pass off the goods manufactured by him or in which he deals, or his business, or services for those of the one having established such goodwill, or who shall commit any acts calculated to produce said result, shall be guilty of unfair competition, and shall be subject to an action therefor.

168.3. In particular, and without in any way limiting the scope of protection against unfair competition, the following shall be deemed guilty of unfair competition:

- (a) Any person, who is selling his goods and gives them the general appearance of goods of another manufacturer or dealer, either as to the goods themselves or in the wrapping of the packages in which they are

contained, or the devices or words thereon, or in any other feature of their appearance, which would be likely to influence purchasers to believe that the goods offered are those of a manufacturer or dealer, other than the actual manufacturer or dealer, or who otherwise clothes the goods with such appearance as shall deceive the public and defraud another of his legitimate trade, or any subsequent vendor of such goods or any agent of any vendor engaged in selling such goods with a like purpose;

(b) Any person who by any artifice, or device, or who employs any other means calculated to induce the false belief that such person is offering the services of another who has identified such services in the mind of the public; or

(c) Any person who shall make any false statement in the course of trade or who shall commit any other act contrary to good faith of a nature calculated to discredit the goods, business or services of another.

168.4. The remedies provided by Sections 156, 157 and 161 shall apply mutatis mutandis.

The trademarks subject of the instant case are reproduced below for comparison:

VENTREX

VERTEX

Respondent-Applicant's mark

Opposer's Trademark

Upon examination of the two competing trademarks and the evidence submitted by the Opposer, this office finds merit to the contentions of the Opposer.

VENTREX is almost identical to VERTEX visually and aurally. The Respondent-Applicant's word mark contains all the letters of the Opposer's mark. The addition of letter "N" and the switching of the places of letters "R" and "T" in the Respondent-Applicant's mark did not provide sufficient distinction between the mark so as to eliminate the likelihood of confusion. Also, each of the competing marks is composed of two (2) syllables. The syllables "VEN" and "TRES" in the Respondent-Applicant's mark sound similar to the syllables "VER" and "TEX" of the Opposer's mark.

The Supreme Court has consistently held that trademarks with *idem sonans* or similarities of sounds are sufficient ground to constitute confusing similarity in trademarks.⁴ Thus, the Court ruled that the following words: Duraflex and Dynaflex;⁵ Lusolin and Sapolin;⁶ Salonpas and Lionpas;⁷ and Celdura and Cordura⁸ are confusingly similar. In addition, the Supreme Court, citing *Unfair Competition and Trade Marks*, 1947, vol. 1 by Harry Nims, recognized the confusing similarities in sounds of the following trademarks:

⁴ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

⁵ American Wire & Cable Company vs. Director of Patents and Central Banahaw Industries, G.R. L-26557
18 February 1970

⁶ Sapolin Co. vs. Balmaceda, 67 Phil 795

⁷ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

⁸ Co Tiong vs. Director of Patents, 95 Phil 1

“Gold Dust” and “Gold Drop”; “Jantzen” and “Jazz-Sea”; “Silver Flash” and “Supper-Flash”; “Cascarete” and Celborite”; “Celluloid and Cellonite”; “Chartreuse” and “Charseurs”; “Cutex” and “Cuticlean”; “Hebe” and “Meje”; “Kotex” and Fermetex”; and “Zuso” and “HooHoo.”⁹ Evidently, the subject trademarks “VENTREX” and “VERTEX” fall squarely within the purview of this *idem sonans* rule.

Furthermore, the goods subject of the competing trademarks are closely related goods. The products subject of the contending trademarks are both pharmaceutical preparations and there is high probability that the product of the Respondent-Applicant may be confused with the Opposer’s. The public may be confused, even deceived, to believe that Respondent-Applicant’s product may have originated from the Opposer, or at the very least there is a connection between them.

It has been held in our jurisdiction that 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.¹⁰ Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.¹¹ Because the Respondent-Applicant will use the mark “VENTREX” on goods that are similar and/or closely related to the Opposer’s, the consumer is likely to assume that the Respondent-Applicant’s goods originate from or sponsored by the Opposer or believe that there is a connection between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser’s perception of goods but on the origins thereof.¹²

Verily, the field from which a person may choose a trademark is practically unlimited. As in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of design available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another’s mark if there was no intent to take advantage of the goodwill generated by the other mark.¹³

The essence of trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the article 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 manufacturer against substitution and sale of an inferior and different article as his products.¹⁴ The trademark applied for registration by the Respondent-Applicant does not meet this function.

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 4-2011-005509 is hereby **SUSTAINED**. Let the filewrapper of

⁹ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

¹⁰ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

¹¹ Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

¹² Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987

¹³ American Wire & Cable Company vs. Dir. Of Patent, G.R. No. L-26557, February 18, 1970.

¹⁴ Mirpuri vs. Court of Appeals G.R. No. 114508, 19 November 1999

Trademark Application Serial No. 4-2011-7005509 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 3 March 2015


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

Copy furnished:

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