



GLAXOSMITHKLINE BIOLOGICALS S.A.,

Opposer,

-versus-

JOHNSON & JOHNSON,

Respondent-Applicant.

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IPC No. 14-2011-00457

Opposition to:

Appln Serial No. 4-2011-005550

Date Filed: 16 May 2011

TM: "VEDRIX"

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 184 dated September 04, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 04, 2015.

For the Director:

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



GLAXOSMITHKLINE BIOLOGICALS SA } IPC NO. 14-2011-00457
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JOHNSON & JOHNSON, } Appln. Ser. No. 4-2011-005550
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DECISION

GLAXOSMITHKLINE BIOLOGICALS SA¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-005550. The application, filed by Johnson & Johnson² ("Respondent-Applicant"), covers the mark "VEDRIX" for use on "*human pharmaceuticals for the treatment of infectious-related disease, auto-immune and inflammatory diseases, cardiovascular diseases, central nervous system diseases and pain, dermatologic disorders, metabolic diseases, anti-viral diseases, oncologic diseases, respiratory diseases, ophthalmic diseases, muscle dystonias, wrinkles and smooth muscle disorders, gastro-intestinal diseases; human pharmaceuticals for use as hemostatic agents*" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"The facts and grounds for the opposition are as follows:

"1. Opposer is the owner of the mark HAVRIX which has been registered by the Opposer in the Philippines even prior to Respondent-Applicant's application for the confusingly similar mark, VEDRIX for pharmaceutical products in the class 5.

"1.1. On April 21, 2003 a trademark application was filed by Opposer under Serial No. 4-2003-003543 for goods in Class 05, namely 'vaccinations for human use'.

"1.2 The mark HAVRIX was thereafter registered on April 14, 2005 and remains validly registered up to this date.

¹A foreign corporation organized and existing under and by virtue of the laws of Belgium, with address at Rue de L'Institut 89, B-1330 Rixensart, Belgium.

²A foreign corporation organized and existing under the laws of U.S.A. with address at New Brunswick, New Jersey 08933, U.S.A.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957

"1.3 On the other hand, Respondent-Applicant Johnson & Johnson filed its application to register its mark, VEDRIX on May 16, 2011, or more than eight (8) years after Opposer's trademark HAVRIX was filed in the Philippines, also for goods in class 05 namely, 'human pharmaceuticals for the treatment of infectious-related disease, auto-immune and inflammatory diseases, cardiovascular diseases, central nervous system diseases and pain, dermatologic disorders, metabolic diseases, anti-viral diseases, oncologic diseases, respiratory diseases, ophthalmic diseases, muscle dystonias, wrinkles and smooth muscle disorders, gastro-intestinal diseases; human pharmaceuticals for use as hemostatic agents'.

"1.4 The products covered by Opposer's mark HAVRIX and the products covered by Respondent-Applicant's trademark application for VEDRIX are similar as they refer to pharmaceutical products used to treat infections related diseases, auto-immune and inflammatory diseases.

"1.5 Moreover, both marks are visually and aurally similar, having the same syllabication and the same suffix consisting of the letters 'R', 'I', and 'X', and the letter 'V' in the prefix. The only difference in the spelling between the two marks is the presence of the letters 'H' and 'A' in HAVRIX, and the presence of the letters 'E' and 'D' in VEDRIX. Both marks are also composed of six letters. When handwritten, as in written prescriptions, the marks are undoubtedly confusingly similar as shown below:

x x x

"1.6 Since both marks fall under the same category of goods, that is Class 5, and VEDRIX nearly resembles the registered mark HAVRIX and are visually similar, the likelihood of confusion is very high. Respondent-Applicant's trademark application for VEDRIX should therefore be denied registration under Section 123.1 (d) of the Intellectual Property (IP) Code, to wit:

x x x

"2. It is well-settled that if the competing trademarks contain the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place.

"2.1 Duplication or imitation is not necessary; nor is it necessary that infringing label should suggest an effort to imitate. The ordinary customer does not scrutinize details of the label; he forgets and overlooks these, but retains a general impression, or a central figure, or a dominant characteristic.

"2.2 Further, the goods or services do not need to be identical or even competitive to justify a determination that there is likelihood of confusion. It is sufficient that the goods or services of the applicant and the registrant are related in some manner, or that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under the circumstances that would

give rise, because of the marks used thereon, to the mistaken belief that they originate from or are in some way associated with the same producer.

"2.3 Thus, any use of the mark VEDRIX which is a colorable imitation of the registered mark HAVRIX or, which contains the dominant features of the registered mark, constitutes trademark infringement under Sec. 155 of the IP Code, which provides:

x x x

"2.4 It is important to note that the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. Moreover, the use of the mark VEDRIX by the Registrant-applicant would not only dilute and blur the distinctiveness of the mark HAVRIX, but will also take advantage of the goodwill engendered by the said mark.

The Opposer's evidence consists of a copy of Certificate of Registration No. 42003003543 for the trademark HAVRIX, and, a copy of Certificate of Registration No. 42011005550 for the mark VEDRIX.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 02 February 2012. The Respondent-Applicant, however, did not file an Answer.

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

It is emphasized that 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 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 product.⁵

Thus, Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

Sec. 123. Registrability. - 123.1. A mark cannot be registered if it:

⁴ Marked as Exhibits "A" to "B".

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepe v. Director of Patents, supra. Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

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;"

Records show that at the time the Respondent-Applicant filed its trademark application, the Opposer already has an existing registration for the mark HAVRIX, under Reg. No. 4-2003-003543, issued on 14 April 2005. The registration covers "vaccines for human use".

But, are the competing marks, as shown below, resemble each other such that confusion, or even deception is likely to occur?

HAVRIX

VEDRIX

Opposer's trademark

Respondent-Applicant's mark

The contending marks are similar with respect to the suffix "RIX". However, the Opposer uses a different first syllable HAV, while the Respondent-Applicant uses the syllable VED in the same position, which when pronounced are phonetically dissimilar. In combination with the suffix "RIX", the resultant marks are visually and aurally different.

Moreover, although the marks are used for goods under class 05, the Opposer uses its HAVRIX mark for "vaccine, veterinary and sanitary preparations and substances", while the Respondent-Applicant uses its VEDRIX mark for "human pharmaceuticals for the treatment of infectious-related disease, auto-immune and inflammatory diseases, cardiovascular diseases, central nervous system diseases and pain, dermatologic disorders, metabolic diseases, anti-viral diseases, oncologic diseases, respiratory diseases, ophthalmic diseases, muscle dystonias, wrinkles and smooth muscle disorders, gastro-intestinal diseases; human pharmaceuticals for use as hemostatic agents". The illness or disease for which the drugs/medicines are intended are distinct to each other. Opposer's HAVRIX is for veterinary and sanitary use, whereas Respondent-

Applicant's VEDRIX is for human use. Thus, confusion, mistake and deception is unlikely among the purchasing public.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-005550 is hereby **DISMISSED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 04 September 2015.


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