



JOHNSON & JOHNSON,
Opposer,

-versus-

RENOVO LIMITED,
Respondent-Applicant.

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IPC No. 14-2011-00356
Opposition to:
Appln. No. 4-2010-012072
Date Filed: 08 November 2010
TM: "JUVISTA"

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 248 dated November 04, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 04, 2015.

For the Director:


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



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IPC No. 14-2011-00356
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Date Filed: 08 November 2010

Trademark: "**JUVISTA**"

Decision No. 2015 - 248

DECISION

JOHNSON & JOHNSON ("Opposer"),¹ filed an opposition to Trademark Application Serial No. 4-2010-012072. The application, filed by RENOVO LIMITED ("Respondent-Applicant")², covers the mark "JUVISTA" for use on goods under class³ 05 for: *pharmaceutical preparations, namely, wound healing preparations, preparations for the prevention, reduction, inhibition or treatment of scarring, preparations for the treatment, reduction, inhibition or prevention of fibrosis, preparations for the treatment, inhibition or prevention of the development of fibrotic conditions, preparations for the purpose of prevention, reduction, inhibition or treatment of scarring in connection with surgery and trauma, treatment of nerves, surgery of nerves or trauma, preparations for the treatment, reduction, inhibition or prevention of dermal wounds, preparations for the treatment, reduction, inhibition or prevention of dermal, scarring, preparations for the treatment, reduction, inhibition or prevention of dermal fibrotic conditions, preparations for the treatment of damaged ligaments, tendons or cartilage, preparations for the promotion of re-epitheliazation, preparations for the treatment of chronic wounds, preparations for the treatment of burns, preparations for the treatment, reduction, inhibition of prevention of ulcers or pressure sores, preparations for the treatment, reduction, inhibition or prevention of adhesions and strictures, preparations for the treatment of cardiovascular and vascular restenosis, preparations for the purpose of prevention, reduction, inhibition or treatment of scarring in the treatment of eye, preparations for the purpose of prevention, reduction, inhibition or treatment of scarring in the treatment of nerves, surgery of nerves or trauma, topical and injectable pharmaceutical preparations for the reduction of scarring, fibrosis and fibrotic conditions in human tissue resulting from surgery or trauma, topical and injectable pharmaceutical preparations, namely formulations of proteins that can stimulate the growth of cells for the prevention, reduction, inhibition or treatment of dermal scarring or fibrosis; treatment, inhibition or prevention of the development of dermal fibrotic conditions, topical and injectable pharmaceutical preparations, namely formulations of proteins that can stimulate the growth of cells to aid in the optimal healing of incisions to epithelial and connective tissue after surgical incisions.*

¹ A corporation organized and existing under the laws of the U.S.A., with principal office at One Johnson & Johnson Plaza, New Brunswick, New Jersey.

² With address thru trademark agent, Sycip Salazar, Hernandez and Gatmaitan Law Offices, at SSHG Law Centre, 105 Paseo De Roxas, Makati City.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

The Opposer alleges the following:

"1. The proposed registration of the mark 'JUVISTA' in the name of the respondent applicant will run counter to the provisions of Sec. 122 and Sec. 123.1(d) of the Intellectual Property Code (Republic Act No. 8293) which protects earlier or previously registered trademarks such as 'JURNISTA' (Certificate of Registration Nos. 4-2005-006076 and 4-2008-010975 collectively 'JURNISTA Trademarks') of herein opposer, and will therefore cause great and irreparable damage and injury to herein opposer who is entitled to relief, pursuant to Section 134 of the Intellectual Property Code.

"2. Respondent-applicant's proposed mark 'JUVISTA,' is confusingly similar to the internationally well-known marks of opposer registered in the Philippines, which are entitled to protection as well-known trademarks under Article 6bis and other pertinent provisions of the Paris Convention for the Protection of Industrial Property and Sections 123.1(e) and (f) of the Intellectual Property Code.

"3. As the owner of the internationally well-known 'JURNISTA' Trademarks which are registered in the Philippines, the opposer has the right to prevent the Respondent-applicant from using an identical or similar mark for similar goods or those of the same class (i.e. Class 5 goods). This protection extends even to goods or services not similar to those in respect of which opposer's marks are registered, consistent with Section 147.2 of the Intellectual Property Code.

"4. The 'JUVISTA' mark of Respondent-applicant creates the same overall impression as the internationally well-known 'JURNISTA' Trademarks of opposer registered in the Philippines. It is merely a derivative of the opposer's 'JURNISTA' Trademark. It is intended to ride on the popularity and goodwill of the latter's mark and to deceive and/or confuse the purchasing public to believe that respondent-applicant's business and goods are the same as or connected with the business and goods offered by opposer, its distributors, dealers, licenses and agents.

"5. The intention to usurp the goodwill of the opposer's mark is suggested by the fact that, if one goes by the definition in the dictionary that 'word', 'is a sound or combination of sound', then, out of the millions of possible combination of sounds represented by letters as symbols that can be used and chosen by respondent-applicant to make up its mark, respondent-applicant chose the very same dominant 'sounds' and its combinations that represent opposer's goods to use and adopt as its own mark to represent its own product which falls under the same class of goods as those of opposer's registered marks. Thus, respondent-applicant's mark, if allowed registration, will diminish the distinctiveness and dilute the goodwill of the opposer's internationally well-known 'JURNISTA' Trademarks registered in the Philippines.

"6. The approval of the application in question will cause great and irreparable damage and injury to herein opposer."

The Opposer's evidence consists of the following:

1. Certified true copy of Registration No. 4-2005-006076 for JURNISTA;
2. Certified true copy of Registration No. 4-2008-010975 for JURNISTA.
3. List of Trademark (JURNISTA) Registrations in various countries; and,
4. Certificates of Trademark Registration of JURNISTA in various countries.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 26 October 2011. Respondent-Applicant however, did not file an answer. Thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision.

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

Sec. 123.1 (d) R.A. No. 8293, otherwise known as the Intellectual Property Code ("IP Code") provides:

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;

The records and evidence show that at the time the Respondent-Applicant filed its trademark application for JUVISTA on 08 November 2010,⁴ the Opposer has already an existing trademark registrations for the mark JURNISTA bearing Registration Nos. 4-2005-006076⁵ and 4-2008-010975⁶, issued on 04 December 2006 and 13 April 2009, respectively. Unquestionably, the Opposer's application preceded that of Respondent-Applicant's.

But, are the contending marks, depicted below, resemble each other such that confusion, even deception, is likely to occur?

JURNISTA

Opposer's Trademark

JUVISTA

Respondent-Applicant's Trademark

The competing marks each consists of three syllables - Opposer's JUR-NIS-TA and Respondent-Applicant's JU-VIS-TA. The difference of the word marks is shown in the middle letters consisting of "R" and "N" in Opposer's JURNISTA; as against the middle letter "V" in Respondent-Applicant's JUVISTA. All other letters are identical, thus its phonetics and phonology create an apparent aural similarity creating the likelihood of confusion of one mark as against the other.

Further, a scrutiny of the goods covered by the mentioned marks show the relatedness of the pharmaceutical products covered by the marks in classification no. 5. Opposer's JURNISTA particularly covers human pharmaceuticals for treating conditions and disorders of the central nervous system⁷, and pharmaceutical preparations for human use.⁸ On the other hand, the enumeration of goods covered by Respondent-Applicant's JUVISTA shows that it is also intended for the treatment of nerves and surgery of nerves or trauma⁹.

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

⁴ Filewrapper records.

⁵ Exhibit "A" of Opposer.

⁶ Exhibit "A-1" of Opposer.

⁷ Id. at 5.

⁸ Id. at 6.

⁹ IPOPhil Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/>

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.¹⁰ 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.¹¹

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.¹² 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.¹³

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.

Finally, it must be emphasized that the Respondent-Applicant was given opportunity to defend its trademark application. It, however, failed to do so. 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. 4-2010-012072 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 04 November 2015.


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

¹⁰ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

¹¹ Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.

¹² American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.

¹³ Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.