

THERAPHARMA, INC.,
Opposer,

-versus-

AMVAC CHEMICAL CORPORATION,
Respondent-Applicant.

X-----X

IPC No. 14-2013-00056
Opposition to:
Appln. Serial No. 4-2011-501596
Date Filed: 25 October 2011
TM: "AMVAC"

NOTICE OF DECISION

OCHAVE & ESCALONA
Counsel for the Opposer
No.66 United Street
Mandaluyong City

VERA LAW (DEL ROSARIO RABOCA GONZALES GRASPARIL)
Counsel for Respondent-Applicant
2nd Floor, A & V Crystal Tower
105 Esteban St., Legaspi Village
Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 26 dated January 26, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 26, 2016.

For the Director:


Atty. EDWIN DANILO A. DATIN G
Director III
Bureau of Legal Affairs

THERAPHARMA, INC.,

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-versus-

AMVAC CHEMICAL CORPORATION,

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IPC No. 14-2013-00056

Opposition to Trademark

Appln. No. 4-2011-501596

Date Filed: 25 October 2011

Trademark: "AMVAC"

Decision No. 2016- 26

DECISION

Therapharma, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-501596. The contested application, filed by Amvac Chemical Corporation² ("Respondent-Applicant"), covers the mark "AMVAC" for use on *"chemicals used in industry, science, agriculture, horticulture and forestry; plant growth regulators for apples, pears, olives; plant growth regulators for citrus; hormones in solid or liquid form useful for the treatment of plants; chemical compositions for thinning fruits in order to enhance the quality of the remaining fruit, defoliant"* and *"insecticides; pesticides; fungicides; herbicides; preparations for destroying vermin; nematocides; molluscicides; slug and snail bait; plant growth inhibitor; antibiotic for control of bacterial diseases in fruits, vegetables and ornamentals; container with or without metering device for dispensing material from the container, sold as a component of pesticides for agriculture, sold filled; insecticides, herbicides and closed plastic container, sold as a unit, for dispensing herbicides and insecticides as part of an agricultural dispensing system; turf fungicide"* under Classes 01 and 05 of the International Classification of Goods³.

The Opposer maintains that it is the owner of the mark "AMVASC", which was registered on 19 March 2007 under Certificate of Registration No. 4-2006-000470. According to the Opposer, it has dutifully filed Declarations of Actual Use ("DAU") and has registered the product with the Bureau of Food and Drugs ("BFAD"). It asserts that the registration of the Respondent-Applicant's mark "AMVAC" is contrary to Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It cites this Bureau's Decision No. 2009-67 dated 15 June 2009 wherein it was held that "AMVAC" is confusingly similar with "AMVASC". The said decision became final and executory on 30 October 2011 as per Entry of

¹ A corporation organized and existing under the laws of the Philippines, with office address at 3rd Floor, Bonaventure Plaza, Ortigas Avenue, Greenhills, San Juan, Metro Manila, Philippines.

² With address at 4695 MacArthur Court, Suite 1250 Newport Beach, California 92660, United States of America.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio, Taguig City

1634 Philippines • www.ipophil.gov.ph

T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph

Judgment/Execution of Decision dated 15 November 2011. In support of its Opposition, the Opposer submitted the following:⁴

1. copy of the Respondent-Applicant's trademark application;
2. certified true copy of Certificate of Registration No. 4-2006-000470;
3. certified true copies of its DAUs;
4. sample product label bearing the mark "AMVASC"; and
5. certified true copy of the Certificate of Listing of Identical Drug Product issued by BFAD.

A Notice to Answer was issued on 14 March 2013 and a copy thereof was served upon the Respondent-Applicant. The latter, however, did not file its Answer. The Hearing Officer thus issued Order No. 2013-1563 on 19 November 2013 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue is whether the Respondent-Applicant's mark "AMVAC" should be allowed registration.

Records reveal that at the time the Respondent-Applicant the subject trademark application on 25 October 2011, the Opposer has a valid and existing registration of the mark "AMVASC" under Certificate of Registration No. 4-2006-000470 issued on 19 March 2007.

The question is whether the competing marks, as shown below, are confusingly similar:

Amvasc

Opposer's mark

AMVAC

Respondent-Applicant's mark

The Respondent-Applicant's mark is almost identical to the Opposer's as it appears that the letter "S" in the latter's mark is merely omitted by the latter. Nevertheless, the competing marks look and sound alike. 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 purchased as to cause him to purchase the one supposing it to be the other.⁵

⁴ Marked as Exhibits "A" to "F".

⁵ Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

Succinctly, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 one 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 former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*: "Here 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁶

It may be argued that the Opposer's trademark pertains to "*medicinal preparation for the treatment of hypertension, chronic stable angina and myocardial ischemia due to vasospastic angina*" while the Respondent-Applicant's mark covers *chemicals used in industry, science, agriculture, horticulture and forestry; plant growth regulators for apples, pears, olives; plant growth regulators for citrus; hormones in solid or liquid form useful for the treatment of plants; chemical compositions for thinning fruits in order to enhance the quality of the remaining fruit, defoliant*" and "*insecticides; pesticides; fungicides; herbicides; preparations for destroying vermin; nematocides; molluscicides; slug and snail bait; plant growth inhibitor; antibiotic for control of bacterial diseases in fruits, vegetables and ornamentals; container with or without metering device for dispensing material from the container, sold as a component of pesticides for agriculture, sold filled; insecticides, herbicides and closed plastic container, sold as a unit, for dispensing herbicides and insecticides as part of an agricultural dispensing system; turf fungicide*". However, the resemblance between the marks could result into one committing mistake in the dispensation or application of the products. The likelihood of confusion, mistake and/or deception poses dangerous risks and tragic consequences in the health and safety of the consumers as "AMVAC" is not intended for human consumption.

Noteworthy, in IPC Case No. 14-2008-00124⁷ entitled "**Therapharma, Inc. vs. Amvac AG**", this Bureau already rendered a decision finding the mark "AMVAC" and "AMVASC" confusingly similar⁸, the pertinent portion of which provides:

"Pursuant to the aforementioned provision, the application for registration of the subject mark cannot be allowed. Opposer's mark 'AMVASC' is confusingly similar to Respondent-Applicant's mark 'AMVAC'. Similarly, 'is applied to goods that are closely related to Respondent-Applicant's goods under the following classes to wit: (i) Class 05 consisting of pharmaceutical

⁶ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

⁷ Biomedis, Inc. vs. Mylan Pharmaceuticals Private Limited.

⁸ Decision No. 2009-67 dated 15 June 2009.

and veterinary preparations such as chemical, biochemical, molecular biological and biological preparations for medical and hygienic purposes, medicines, vaccines, disinfectants, contraceptives, plasters, materials for dressings, sanitary preparations for medical purposes namely sanitary napkins and tampons and dietetic substances adapted for medical use, (ii) Class 10 namely surgical and medical apparatus and instruments, contraceptives and accessories therefore included in this class, (iii) Class 42 composed of scientific and technological services research specifically the field of chemical, biochemical, molecular biological and biological preparations for medical and hygienic purposes, medicines, vaccines and contraceptives, and (iv) Class 44 consisting of medical and veterinary services, hygienic and beauty care for human beings or animals.

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WHEREFORE, the opposition is **SUSTAINED**. Consequently, Application bearing Serial No. 4-2007-013532 filed on 08 December 2007, for the registration of the mark 'AMVAC' covering pharmaceutical-related goods *inter alia* is, as it is hereby, **REJECTED**.

Let the filewrapper of the trademark 'AMVAC' subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED."

On 13 September 2011, this Bureau issued Resolution No. 2011-22(D) declaring the motion for reconsideration moot. Consequently, on 15 November 2011, the Entry of Judgment/Execution of Decision. Although IPC Case No. 14-2008-00124 pertains to a different Respondent-Applicant, considering the goods involved and that the marks, i.e. "AMVAC" and "AMVASC", are almost identical and/or similar, this Bureau finds no cogent reason to deviate from the findings in the said case.

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. 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.⁹ Respondent-Applicant's trademark fell short in meeting this function.

⁹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-501596 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 26 January 2016.



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