

THERAPHARMA, INC.,
Opposer,

-versus-

AMVAC AG,
Respondent-Applicant.

}
} **IPC No. 14-2013-00268**
} Opposition to:
} Appln. Serial No. 4-2011-010330
} Date Filed: 31 August 2011
} **TM: "AMVAC"**
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 25 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. DATING
Director III
Bureau of Legal Affairs

THERAPHARMA, INC.,

Opposer,

-versus-

AMVAC AG,

Respondent-Applicant.

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IPC No. 14-2013-00268

Opposition to Trademark

Appl. No. 4-2011-010330

Date Filed: 31 August 2011

Trademark: "AMVAC"

Decision No. 2016- 25

DECISION

Therapharma, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-010330. The contested application, filed by Amvac AG² ("Respondent-Applicant"), covers the mark "AMVAC" for use on *"pharmaceutical and veterinary preparations (with exception of animal flea collars), in particular chemical, biochemical, molecular biological and biological preparations for medical and hygienic purposes; medicines; vaccines; disinfectants for medical and sanitary purposes; contraceptives; plasters, materials for dressings; sanitary preparations for medical purposes, in particular sanitary napkins and tampons; dietetic substances adapted for medical use"* under Class 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"). The Intercontinental Marketing Services ("IMS") acknowledged and listed "AMVASC" as one of the leading brands in the Philippines in the category "C08A – Calcium Antagonists Plain and C08B – Calcium Antagonists Combs" in terms of market share and performance.

The Opposer 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 executor on

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 A Swiss company with address at Metallstrabe 4, 6300 Zug, Switzerland.

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.

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

1. copy of Decision No. 2009-67 of the BLA dated 15 June 2009;
2. copy of the Entry of Judgment/Execution of Decision dated 15 November 2011;
3. copy of the Respondent-Applicant's trademark application;
4. certified true copy of Certificate of Registration No. 4-2006-000470;
5. certified true copies of its DAUs;
6. sample product label bearing the mark "AMVASC";
7. certified true copy of the Certificate of Listing of Identical Drug Product issued by BFAD; and
8. copy of the certification issued by the IMS.

The Respondent-Applicant filed its Answer on 30 September 2013 alleging that Decision No. 2009-67 is not applicable since the opposed trademark application therein is for "AMVAC" word mark presented in block letters while the opposed mark in the instant case is stylized with the letter "V" as the prominent feature and carries the phrase "Innovative Vaccines". For the same reason, it refutes that the competing marks herein are confusingly similar. It asserts that "AMVASC" and "AMVAC" are pronounced differently and that "VASC" is an abbreviation of "vascular" while "VAC" is for "vaccine". According to the Respondent-Applicant, "AMVAC" is not only a trademark but also its corporate name. Also, it claims that the coloring and pictorial schemes are different. The Respondent-Applicant's evidence includes the following:⁵

1. certified extract from the Commercial Register of Switzerland stating that it is a stock company organized and recorded on 09 December 2005;
2. copies of its registrations and applications for the its stylized mark "AMVAC";
3. copies of its registrations and applications for the word mark "AMVAC";
4. list of all its registrations and applications; and
5. copy of the advertising material of its marks.

The Preliminary Conference was conducted and terminated on 11 March 2014 wherein the parties were directed to file their respective Position Papers within ten days therefrom. After the submission thereof, the case is deemed submitted for resolution.

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

⁴ Marked as Exhibits "A" to "I".

⁵ Marked as Exhibits "1" to "21", inclusive.

Records show that in IPC Case No. 14-2008-00124⁶ entitled "**Therapharma, Inc. vs. Amvac AG**", this Bureau already rendered a decision⁷, the dispositive portion of which provides:

"Pursuant to the aforequoted 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 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 'AMVA' 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 was issued stating:

"The Decision became final and executory on 30 October 2011 and accordingly, is hereby recorded in this Bureau's Book of Entries of Judgment."

⁶ Biomedis, Inc. vs. Mylan Pharmaceuticals Private Limited.

⁷ Decision No. 2009-67 dated 15 June 2009.

Noteworthy, the IPC Case No. 14-2008-00124 similarly involves the same parties and mark "AMVAC". With the finality of the said decision, this Bureau finds no cogent reason to deviate therefrom.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-010330 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