

BIOFARMA,
Opposer,

-versus-

ULTRAMED PHARMA, INC.,
Respondent-Applicant.

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} **IPC No. 14-2014-00298**
} **Opposition to:**

} **Appln. Serial No. 4-2013-010637**
} **Date Filed: 05 September 2013**

} **TM: VASTAZID**

NOTICE OF DECISION

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Ultramed Pharma, Inc.
141 Scout de Guia Street,
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GREETINGS:

Please be informed that Decision No. 2017 - 120 dated 07 April 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 18 April 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

BIOFARMA,

Opposer,

-versus-

ULTRAMED PHARMA, INC.,

Respondent-Applicant.

X ----- X

IPC No. 14-2014-00298

Opposition to Trademark

Application No. 4-2013-010637

Date Filed: 05 September 2013

Trademark: **"VASTAZID"**

Decision No. 2017- 120

DECISION

Biofarma¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-010637. The contested application, filed by Ultramed Pharma, Inc.² ("Respondent-Applicant"), covers the mark "VASTAZID" for use on "*pharmaceutical preparations - anti-anginal drug*" under Class 05 of the International Classification of Goods³.

According to the Opposer, "VASTAREL", used for the pharmaceutical products known as *trimetazidine*, has been marketed and made available in the Philippines since 1998. The said brand is also available in higher formulation under the mark "VASTAREL MR". It has registered the mark in France as early as 1958. In the Philippines, it registered the mark under Certificate of Registration No. 4-1984-409920 (Old File No. 037793) issued as early as 11 January 1988.

The Opposer anchors its opposition on Section 123.1 (d) of the Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). It contends that the Respondent-Applicant's mark "VASTAZID" will likely cause confusion, mistake and deception on the part of the purchasing public, most especially that the said mark is applied for the same class and goods as that of its own registered mark "VASTAREL". It asserts that the word "VASTAREL" has no meaning or logical relation to the medication *trimetazidine* and therefore considered fanciful. In support of its opposition, the Opposer submitted the following:⁴

1. certified true copies of the trademark registration and renewal certificates for "VASTAREL";

¹ A corporation duly organized and existing under and by virtue of the laws of France, with office address at 50 Rue Carnot 92284 Suresnes Cedex, France.

² With known address at 141 Scout de Guia St., Kamuning, Metro Manila.

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.

⁴ Marked as Exhibits "B" to "PP", inclusive.

2. copies of the Respondent-Applicant's SEC Certificate with Articles of Incorporation and General Information Sheet;
3. copy of the trademark application for "VASTAZID";
4. printout of the e-Gazette showing the details of "VASTAZID";
5. printout of the Food and Drug Administration showing the details of the registration;
6. copy of the cease and desist letter sent by the Opposer's counsel to the Respondent-Applicant; and,
7. affidavit of its Legal Counsel and Proxy, Aurelie Boissaye, with annexes.

A Notice to Answer was issued and served upon the Respondent-Applicant on 12 September 2014. The latter, however, did not file an Answer. Thus, on 11 May 2015, the Adjudication Officer issued Order No. 2015-706 declaring the Respondent-Applicant in default and submitting the case for decision.

Records reveal that at the time the Respondent-Applicant filed the contested application on 05 September 2013, the Opposer already registered its mark "VASTAREL" issued as early as 11 January 1988.

Section 123.1(d) of the IP Code provides that:

"Section 123.1. A mark cannot be registered if it:

(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"***

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown below for comparison:

VASTAZID

VASTAREL

Opposer's mark

Respondent-Applicant's mark

The marks are apparently similar with respect to the beginning letters "VASTA". The Opposer's product description and the Respondent-Applicant's application show that the competing marks cover medicines for cardiovascular diseases. From this information, it can be inferred that this is where the syllable "VAS" in the marks was derived from.

A mark or brand name itself gives away or tells the consumers the goods or service and/or the kind, nature, use or purpose thereof. Succinctly, what easily comes to the mind one when one sees or hears a mark or brand name for treatment for cardiovascular diseases wherein "VAS" is a part of is the very concept or idea of the goods. As such, the Opposer cannot claim exclusive use or protection on the mere fact that another trademark appropriates "VAS". The Supreme Court explained in **Societe des Produits Nestle vs. Court of Appeals**⁵ that:

"Generic terms are those which constitute 'the common descriptive name of an article or substance,' or comprise the 'genus of which the particular product is a species'" or are 'commonly used as the name or description of a kind of goods,' or 'imply reference to every member of a genus and the exclusion of individuating characters,' or 'refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product,' and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it 'forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is,' or 'if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods,' or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination."

What will set apart or distinguish such mark from another which also includes the term "VAS" is the letters, syllable or words that come before or after the generic name. In this case, however, it appears that the Respondent-Applicant adopted the second syllable "TA" and merely replaced the last three letters "REL" in the Opposer's mark for "ZID". Overall, the competing marks bear resembling visual appearance, pronunciation and impression. 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.⁶

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

⁵ G.R. No. 112012, 04 April 2001.

⁶ Ibid.

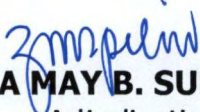
ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion 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."⁷ Thus, the consumers may have the notion that Opposer expanded business and manufactured a new product by the name "VASTAZID", which could be mistakenly assumed a derivative or variation of "VASTAREL".

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.⁸ The Respondent-Applicant's trademark failed to meet this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-010637 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 APR 2017.


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

⁷ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.