

LAVERANA GMBH & CO. KG,
Opposer,

-versus-

MERCK KGAA,
Respondent- Applicant.

x-----x

IPC No. 14-2015-00420
Opposition to:
Appln. Serial No. 4-2014-506009
Date Filed: 22 December 2014
TM: VIVERA

NOTICE OF DECISION

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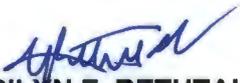
JDF LAW
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GREETINGS:

Please be informed that Decision No. 2017 - III dated April 11, 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, April 17, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

LAVERANA GMBH & CO. KG,
Opposer,

-versus-

MERCK KGAA,
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X ----- X

IPC No. 14-2015-00420
Opposition to Trademark
Application No. 4-2014-506009
Date Filed: 22 December 2014

Trademark: **"VIVERA"**

Decision No. 2017- ///

DECISION

Laverana GMBH & Co. KG¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2014-506009. The contested application, filed by Merck KGAA² ("Respondent-Applicant"), covers the mark "VIVERA" for use on *"pharmaceutical preparations; dietetic preparations and food supplements for medical use; sanitary preparations; vitamin preparations for medical use, minerals for medical use, probiotic preparations for medical use, disinfectants"* under Class 05 of the International Classification of Goods³.

The Opposer alleges, among others, that its company was founded in 1987 by Thomas Haase with the flagship brand "LAVERA". The company name "LAVERANA" is a symbiosis from "LAVERA", which means "truth", and "NA", for "natural cosmetics". In 1988, Haase partnered with Klara Ahlers, who opened the world's first natural cosmetics specialty shop in Gottingen, Germany. It advertises the "LAVERA" mark and goods in the Philippines and abroad. It has also secured registrations for the mark worldwide. In the Philippines, it has been issued Certificates of Registration Nos. 13958 and 652 issued on 05 March 2015 and 17 December 2007, respectively. It also owns domain name registration for the mark. The Opposer thus contends that the Respondent-Applicant's mark "VIVERA" should not be allowed registration for being confusingly similar with "LAVERA". In support of their Opposition, the Opposer submitted the following:

1. printout of its milestones as published from its website;
2. affidavit of its Managing Director, Thomas Haase, with annexes;
3. website printout showing the answer to the question, "Where does the name 'LAVERA' come from?";

¹ A corporation organized and existing under the laws of Germany with office address at Am Weingarten 4, 30974 Wennigsen, Germany.

² With known address at Frankfurter Str. 250 Darmstadt, 64293 (DE).

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. copy of the September 2007 Preview Magazine clipping featuring "LAVERA" products;
5. copy of the October 2007 The Philippine Star clipping featuring "LAVERA" products;
6. copy of the Philippine Daily Inquirer clipping featuring "LAVERA" products;
7. copy of the August 2007 United Daily Newspaper clipping featuring "LAVERA" products; and
8. copies of the records of Registration Nos. 4-2014-013958 and 4-2007-000652.⁴

A Notice to Answer was issued and served upon the Respondent-Applicant. The latter filed an Answer on 09 March 2016 without the requisite Verification, Certificate of Non-Forum Shopping and Special Power of Attorney ("SPA"). It thereafter complied with the directive to submit the lacking documents. Upon perusal of the SPA, however, this Adjudication Officer found that the same was authenticated only on 04 April 2016, or after filing of the Answer. Consequently, the Adjudication Officer issued Order No. 2016-1405 dated 23 August 2016 declaring the Respondent-Applicant in default and requiring the Opposer to submit and/or present the originals or certified true copies of the evidence attached to the Opposition. After which, the case is deemed submitted for decision.

The issue to be resolved in this case is whether the Respondent-Applicant's trademark application for "VIVERA" should be allowed.

The Opposer anchors its Opposition on Section 123.1 subparagraphs (a), (d), (e) and (f) of RA 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), which provides that:

"123.1. A mark cannot be registered if it:

(a) Consists of immoral, deceptive or scandalous matter, or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute;

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;

⁴ Marked as Exhibits "C" to "Q", inclusive.

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;

xxx."

Records reveal that at the time the Respondent-Applicant filed its application for registration of the mark "VIVERA" on 22 December 2014, the Opposer has already registered the mark "LAVERA" under Certificate of Registration Nos. 4-2014-013958 and 4-2007-000652 issued on 05 March 2015 and 17 December 2007.

But are the marks, as shown below, confusingly similar?

LAVERA

VIVERA

Opposer's Marks

Respondent-Applicant's Mark

A practical approach to the problem of similarity or dissimilarity is to go into the *whole* of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in

which the words appear" may be considered.⁵ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The only similarity in the competing marks is the use of the ending syllables "VERA". The presentation of "VERA" in both marks, however, will not lead to a conclusion that the said syllables are the prevalent feature of the marks. When appreciated in their entirety, the marks "LAVERA" and "VIVERA" are distinguishable from each other. The beginning syllables "LA" and "VI" make the competing marks different visually, aurally and in impression that the common use of "VERA" pales in significance.

Moreover, the Trademark Registry, which this Adjudication Officer may take judicial notice, shows that there are other registered trademarks that appropriate the ending syllables "VERA" also for goods under Class 05 such as "ELOVERA" under Certificate of Registration No. 4-2010-500685 issued on 04 November 2010, "QUIVERA" under Certificate of Registration No. 4-2014-505665 issued on 02 April 2015 and "LAXOVERA" under Certificate of Registration No. 4-2013-011355 issued on 20 February 2014. As it appears that "VERA" has already been used in trademarks for goods under Class 05, similarity in this aspect alone is not enough to prevent a junior user registration of its mark provided that the later mark is endowed with other distinguishing features and characteristics such as that of the Respondent-Applicant's.

Furthermore noteworthy, the Trademark Registry also shows that the Opposer's 4-2007-000652 has been removed from the register for non-filing of the Declaration of Actual Use. Therefore, the only existing registration under the name of the Opposer is that under Certificate of Registration No. 4-2014-013958 for *"body and skin care and beauty preparations (not for medical purposes); milks, tonics, lotions, creams, emulsions, gels for the face and body; non-medicated cleansing preparations for the face and body; skin astringents not for medical purposes; body mist; non-medicated foot baths, depilatory creams; pumice stones for personal use; soaps; bubble bath; shower creams and gels; skin exfoliating products; make-up removing preparations for the face; talcum powder; shampoos; hair lotions, oils, conditioners and repair preparations; hair dyes; hair spray, gel and mousse; hair brighteners; hair mascaras; shaving creams and gels; after-shave gels and lotions; perfumery; deodorants for personal use; essential oils; bath beads; bath oils and salts; cosmetics; masks; foundation cream; blush; bronzing powder; make up powder; facial shimmer preparations; mascara; eyeliners; cosmetic eye and lip*

⁵ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

pencils; eye shadows; lip balms; lip gloss; lipsticks; make up removing preparations; nail polish; nail forms; false nails; nail polish remover; cuticle creams; preparations for strengthening nails; non-medicated concealer sticks; body glitter; sun-tanning lotions and creams for the face and body; fake tan lotions and creams for the face and body; sunscreen creams; after sun lotions and creams for the face and body; perfumes, eaux de toilette; bath and shower gels and salts not for medical purposes; toilet soaps; cosmetics, in particular creams, milks, lotions, gels and powders for the face, body and hands; sun-tanning milks, gels and oils and after-sun preparations (cosmetics); make up preparations; shampoos; gels, mousses, balms and preparations in aerosol form for hairdressing and haircare; hair lacquers; hair-colouring and hair-decolorizing preparations; preparations for waving and setting hair; cosmetics, decorative cosmetics; face creams and lotions; skin-cleansing lotions and creams, hand and body lotions and creams; tinted moisturizing creams, make-up, foundation, face powder and rouge; blemish stick, lip pencils, eyeliner pens and mascara, eye shadow; sun care preparations; foot-care preparations; foot creams and lotions; exfoliants; abrasive implements in the form of pumice stones; non-medicated powder and lotions for foot spas; body care products, shower gels, hair care products; shampoos and hair lotions, conditioning rinses (conditioners), combined shampoo and conditioner, hair sprays, styling mousse and gels; hair dyes; baby and infant care products; bath oils, shampoos, skin oils and creams; anti-wrinkle creams; massage oils; grooming products for men; shaving cream, after-shave balms products for oral hygiene (not for medical purposes); preparations for the mouth and for cleaning the mouth, breath-freshening and mouth-freshening preparations, mouth sprays, mouth rinses, dentifrices; toothpaste; antiperspirants" under Class 03. As these goods are clearly different from "pharmaceutical preparations; dietetic preparations and food supplements for medical use; sanitary preparations; vitamin preparations for medical use, minerals for medical use, probiotic preparations for medical use, disinfectants", covered by the Respondent-Applicant's application, confusion, mistake and deception are even more unlikely.

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.⁶ Based on the above discussion, Respondent-Applicant's trademark sufficiently met this function.

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2014-506009 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 11 APR 2017


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