

MEDICHEM PHARMACEUTICALS, INC.,
Opposer,

-versus-

CATHAY YSS DISTRIBUTORS CO., INC.,
Respondent-Applicant.

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IPC No. 14-2014-00149
Opposition to:

Appln. Serial No. 4-2013-00014658
Date Filed: 09 December 2013

TM: VALTRUS

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 118 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

MEDICHEM PHARMACEUTICALS, INC.,	} IPC NO. 14-2014-00149
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2013-00014658
	} Date Filed: 9 December 2013
	}
CATHAY YSS DISTRIBUTORS CO., INC.,	} Trademark: "VALTRUS"
Respondent-Applicant.	}
x-----x	} Decision No. 2017- 118

DECISION

MEDICHEM PHARMACEUTICALS, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2013-00014658. The application, filed by **CATHAY YSS DISTRIBUTORS CO., INC.**, (Respondent-Applicant)², covers the mark "VALTRUS", for use on "pharmaceutical rosuvastatin" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"7. The mark 'VALTRUS' applied for by Respondent-Applicant so resembles the trademark 'VALPROS' owned by Opposer, and duly registered with this Honorable Bureau prior to the application for the mark 'VALTRUS'.

"8. The mark 'VALTRUS' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'VALTRUS' is applied for the same class and goods as that of Opposer's trademarks 'VALPROS', i.e. Class (5) of the International Classification of Goods for pharmaceutical preparations.

"9. The registration of the mark 'VALTRUS' in the name of the Respondent-Applicant will violate Sec. 123 of Republic Act 8293, otherwise known as the 'Intellectual Property Code of the Philippines', which provides, in part, that 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:

¹ A domestic corporation duly organized and existing under Philippine laws with address at 132 Pioneer Street, Mandaluyong City

² A domestic corporation with address at 2nd Floor Vernida I, Amorsolo St., Legaspi Village, Makati City

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

- (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;

Under the above-quoted provision, any mark, which is similar to a registered mark, shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

“3. Respondent-Applicant’s use and registration of the mark ‘VALTRUS’ will diminish the distinctiveness of Opposer’s trademark ‘VALTRUS’.

The Opposer also alleges, among others, the following facts:

“11. Opposer is the registered owner of the trademark ‘VALPROS’. It is engaged in the marketing and sale of a wide range of pharmaceutical products.

“11.1. The trademark application for the trademark ‘VALPROS’ was filed with the IPO on 19 June 2009 by Opposer and was approved for registration on 11 March 2010 to be valid for a period of ten (10) years, or until 11 March 2020. Thus, the registration of the mark ‘VALPROS’ subsists and remains valid to date.

“12. The trademark ‘VALPROS’ has been extensively used in commerce in the Philippines.

“12.1. Opposer has dutifully filed Declaration of Actual Use and Affidavit of Use pursuant to the requirement of the law to maintain the registration of the trademark.

“12.2. A sample of product label bearing the trademark ‘VALPROS’ actually used in commerce is hereto attached.

“12.3. No less than the Intercontinental Marketing Services (IMS) itself, the world’s leading provider of business intelligence and strategic consulting services for the pharmaceutical and healthcare industries with operations in more than 100 countries, acknowledged and listed the brand ‘VALPROS’ as one of the leading brands in the Philippines in the category of ‘N03A- Anti-epileptics’ in terms of market share and sales performance.

“12.4. In order to legally market, distribute and sell these pharmaceutical preparation in the Philippines, the product has been registered with the Bureau of Food and Drugs (now Food and Drugs Administration). Xxx”

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of IPO e-Gazette showing the Respondent-Applicant's trademark application;
2. Copy of Certificate of Registration 4-2009-006037 dated 11 March 2010 for the mark "VALPROS";
3. Copy of Declaration of Actual Use (no date of receipt by IPO);
4. Sample product label of "VALPROS";
5. Certification from Romeo Castro dated March 20, 2014; and
6. Copy of Certificate of Product Registration issued by the Bureau of Food and Drugs dated 19 August 2010⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 16 April 2014. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 13 August 2015 Order No. 2015-1164 declaring the Respondent-Registrant to have waived its right to file an Answer.

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

Records show that at the time Respondent-Applicant applied for registration of the mark "VALTRUS" the Opposer already registered the mark "VALPROS" under Registration No. 4-2009-006037 dated 11 March 2010. The goods covered by the Opposer's trademark registration are also under Class 05, namely: "anti-epileptic pharmaceutical preparation, while the Respondent-Applicant's trademark application indicates use as "pharmaceutical rosuvastatin".

The competing marks are reproduced below:

Valpros **VALTRUS**

Opposer's mark

Respondent-Applicant's mark

The marks are similar with respect to four letters "V"- "A"- "L" and "S". Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. The Opposer argues that the mark VALTRUS cannot be registered because it is confusingly similar to its mark VALPROS. Evidence reveal that the generic and/or descriptive term for the pharmaceutical product Opposer's mark identifies is VALPROIC ACID or SODIUM VALPROATE, as seen from its label.⁵ VALPROATE is a generic name and is listed in the WHO Chronicle as International Nonproprietary Names (INN) for Pharmaceutical Products⁶. The Opposer concocted the first two

⁴ Exhibits "A" to "E"

⁵ Exhibit "D"

⁶ Exhibit "H"

syllables to form the word VALPRO and added the letter "S", hence VALPROS. It is not uncommon, that registered owners of pharmaceutical products add, substitute letters, play on the syllables of the INN or generic names of drugs to create their brand name. On the other hand, the Respondent-Applicant appropriated two letters "VA" from its product's generic name, "Rosuvastatin" to coin its own unique mark. Between the parties, the Respondent-Applicant concocted a distinct mark. VALTRUS is creative and is not confusingly similar to Opposer's mark VALPROS, which is a play on its generic name, VALPROIC's first six letters, differing only in the substitution of the letters "IC" with "S". Therefore, the use of Respondent-Applicant of the mark VALTRUS will not result to a likelihood of confusion.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-00014658 is hereby **DISMISSED**. Let the filewrapper of the subject trademark 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. ADORACION U. ZARE, LL.M.

Adjudication Officer

Bureau of Legal Affairs