

**UNITED AMERICAN PHARMACEUTICALS, INC.,** }  
Opposer, }

**-versus-** }

**ATC HEALTHCARE INTERNATIONAL CORP.,** }  
Respondent-Applicant. }

X-----X

**IPC No. 14-2015-00515**  
Opposition to:  
Appln. Serial No. 4-2015-00005970  
Date Filed: 03 June 2015

**TM: VIGORA**

**NOTICE OF DECISION**

**OCHAVE & ESCALONA**

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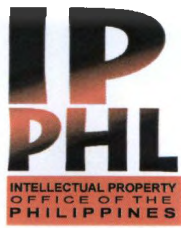
**GREETINGS:**

Please be informed that Decision No. 2017 - 285 dated 29 June 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, 03 July 2017.

  
**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs



UNITED AMERICAN  
PHARMACEUTICALS, INC.,

Opposer,

- versus -

ATC HEALTHCARE  
INTERNATIONAL CORPORATION,  
Respondent-Applicant.

IPC NO. 14 – 2015 - 00515

Opposition to:  
Trademark Application Serial No.  
4201500005970

TM: "VIGORA"

DECISION NO. 2017 - 285

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## DECISION

UNITED AMERICAN PHARMACEUTICALS, INC. (Opposer)<sup>1</sup> filed an Opposition to Trademark Application Serial No. 4-2015-00005970. The trademark application filed by ATC HEALTHCARE INTERNATIONAL CORPORATION (Respondent-Applicant)<sup>2</sup>, covers the mark VIGORA for "*pharmaceutical – a dietary supplement for men that contains Tangkat Ali, Panax Ginseng, medlar, Seawort, Cistanche deserticola, hunttunyniae herba and konjak*" under Class 5 of the International Classification of Goods and Services<sup>3</sup>.

On its Opposition, the Opposer alleges:

7. The mark "VIGORA" applied for by Respondent-Applicant so resembles the trademark "VIGOR-ACE" owned by Opposer and duly registered with this Honorable Bureau prior to the publication of the application for the mark "VIGORA".

8. The mark "VIGORA" will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark "VIGORA" is applied for the same class and goods as that of Opposer's trademark "VIGOR-ACE", i.e., Class 05 of the International Classification of Goods for pharmaceutical preparations.

9. The registration of the mark "VIGORA" in the name of the Respondent-Applicant will violate Sec. 123.1.(d) of the IP Code, which provides, in part, that a mark cannot be registered if it:

<sup>1</sup>A corporation organized and existing under the laws of Switzerland with Address at CH4002 Basel Switzerland.

<sup>2</sup> A domestic Corporation with address at 3F Centrepoint Bldg., Pasong Tamo Cor Export Bank Drive Makati City.

<sup>3</sup> 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.

Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE

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"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;

x x x"

10. 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.

11. Respondent-Applicants use and registration of the mark VIGORA will diminish the distinctiveness of Opposer's trademark "VIGOR-ACE".

12. Opposer is engaged in the marketing and sale of a wide range of pharmaceutical products and is the registered owner of the trademark "VIGOR-ACE".

12.1. The trademark application for the trademark "VIGOR-ACE" was originally filed with the Bureau of Patents, Trademarks and Technology Transfer on 25 January 1989 by Opposer and was approved for registration on 3 August 1990 to be valid for a period of twenty (20) years, or until 3 August 2010. x x x

12.2. Prior to the lapse of the twenty (20) year period, Opposer filed a renewal application for the trademark "VIGORACE" with the IPO, which was accordingly approved for another period of ten (10) years, or until 3 August 2020. x x x

12.3. Thus, the registration of the trademark "VIGOR-ACE" subsists and remains valid to date

13. The trademark "VIGOR-ACE" owned by Opposer has been extensively used in commerce in the Philippines.

13.1. Opposer has dutifully filed *Affidavits of Use* and a *Declaration of Actual Use* to maintain the registration of the trademark "VIGOR-ACE" in force and effect pursuant to the requirement of the law. x x x

13.2. In order to legally market, distribute and sell this pharmaceutical preparation in the Philippines, the product has been registered with the Food and Drug Authority. x x x

13.4. 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 one hundred (100)

countries, acknowledged and listed the brand "VIGOR-ACE" as one of the leading brands in the Philippines in the category of "AIIA Multivitamins + Minerals" in terms of market share and sales performance.

14. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark, "VIGOR-ACE" to the exclusion of all others.

15. As provided in Section 138 of the IP Code, "[a] certificate of registration of a mark shall be *prima facie* evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate."

16. The registration of Respondent-Applicant's mark "VIGORA" will be contrary to Section 123.1.(d) of the IP Code.

In support of its Opposition, the Opposer submitted the following as evidence:

Exhibit "A" – Printout of IPO e-Gazette;

Exhibit "B" – certified true copy of the *Principal Register No. 48755* for the trademark "VIGOR-ACE";

Exhibit "C" – certified true copy of the Certificate of RENEWAL of Registration No. 048755 for the trademark "VIGOR-ACE";

Exhibit "D" to "G" – Copies of the Affidavits of Use and a Declaration of Actual Use;

Exhibit "H" – certified true copy of Certificate of Product Registration No. DR-XY31278;

Exhibit "I" – sample product label bearing the trademark "VIGOR-ACE" actually used in commerce; and

Exhibit "J" – original copy of the Certification and sales performance issued by the IMS.

This Bureau issued a Notice to Answer on 25 November 2015 and served a copy to the Respondent-Applicant on 13 January 2016. However, the Respondent-Applicant did not file an Answer to the Opposition. In view of the failure to file an Answer, an Order dated 1 July 2016 was issued declaring the Respondent-Applicant in default. Consequently, this case was deemed submitted for decision.

The issue to resolve in the present case is whether the Respondent - Applicant should be allowed to register the trademark "VIGORA"

Records show that when Respondent-Applicant filed its trademark application for VIGORA mark, the Opposer had already a prior and existing trademark registration for the mark VIGOR-ACE. The Opposer's registration covers "*medicinal preparations containing vitamins, minerals and lecithin*" under the same Class 5 of the International Classification of Goods and Services.

The competing marks are reproduced below for comparison:

**VIGOR-ACE**

Opposer's Trademark

**VIGORA**

Respondent-Applicant's Trademark

A careful examination of the above trademarks and the evidence submitted by the Opposer, this Bureau finds the Opposition meritorious.

The instant opposition is primarily based on Section 123.1, paragraph (d), of the IP Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

At the outset, it is evident that the whole wordmark VIGORA of the Respondent-Applicant can be found in the trademark VIGOR-ACE of the Opposer. In fact, the said similar portion composed 3/4 or seventy-five percent of the Opposer's mark. This identical portion definitely will create the same commercial impression on the buying public. The absence of the letters "C" and "E" from the Respondent's trademark does not provide enough differentiation and distinguishing characteristics from that of the Opposer's mark.

Moreover, the contending trademarks are composed of closely similar phonetic effect – VI-GO-RA *vis a vis* VI-GOR-ACE. Our jurisprudence has shown that trademarks with *idem sonans* or similarities of sounds are sufficient ground to constitute confusing similarity in trademarks.<sup>4</sup> Our Supreme Court has ruled that the following words: Duraflex and Dynaflex;<sup>5</sup> Lusolin and Sapolin;<sup>6</sup> Salonpas and Lionpas;<sup>7</sup> and Celdura and Cordura<sup>8</sup> are confusingly similar. In addition, the Supreme Court, citing Unfair Competition and Trade Marks, 1947, vol. 1 by Harry Nims, also recognized the confusing similarities in sounds of the following trademarks: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jazz-Sea"; "Silver Flash" and "Supper-Flash"; "Cascarete" and Celborite"; "Celluloid and Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and Fermetex"; and "Zuso" and "HooHoo."<sup>9</sup> The contending trademarks VIGORA and VIGOR-ACE definitely fall within these enumerated confusingly similar sounding trademarks.

<sup>4</sup> Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

<sup>5</sup> American Wire & Cable Company vs. Director of Patents and Central Banahaw Industries, G.R. L-26557 18 February 1970

<sup>6</sup> Sapolin Co. vs. Balmaceda, 67 Phil 795

<sup>7</sup> Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

<sup>8</sup> Co Tiong vs. Director of Patents, 95 Phil 1

<sup>9</sup> Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966


This Bureau also finds that the goods subject of trademarks, are similar and/or closely related goods since both of the subject marks are being used for pharmaceutical supplement for human body. Clearly, there is highly likely, that the product of the Respondent-Applicant may be confused by the public with the goods of the Opposer. The public may even be deceived that Respondent-Applicant's products originated from the Opposer, or that there is a connection between the parties and/or their respective goods.

It has been held consistently in our jurisdiction that the law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for purposes of the law that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.<sup>10</sup> Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.<sup>11</sup>

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application Serial No. 4201500005970 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4201500005970 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

**SO ORDERED.**

Taguig City, 29 JUN 2017

  
Atty. **Leonardo Oliver Limbo**  
Adjudication Officer  
Bureau of Legal Affairs

<sup>10</sup> American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

<sup>11</sup> Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992