

VERTEX PHARMACEUTICALS INCORPORATED, }
Opposer, }

-versus- }

AMBICA INTERNATIONAL TRADING CORP., }
Respondent-Applicant. }

X-----X

IPC No. 14-2013-00432
Opposition to:
Appln. Serial No. 4-2013-005718
Date Filed: 20 May 2013

TM: VENTEK

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 255 dated 28 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, 29 June 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

<p>VERTEX PHARMACEUTICALS INCORPORATED, Opposer,</p> <p>-versus</p> <p>AMBICA INTERNATIONAL TRADING CORPORATION, Respondent-Applicant.</p> <p>x-----x</p>	<p>} IPC NO. 14-2013-00432</p> <p>} Opposition to:</p> <p>}</p> <p>} Appln. Ser. No. 4-2013-005718</p> <p>} Date Filed: 20 May 2013</p> <p>}</p> <p>} Trademark: "VENTEK"</p> <p>}</p> <p>}</p> <p>} Decision No. 2017- 255</p>
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DECISION

VERTEX PHARMACEUTICALS INCORPORATED, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2013-005718. The application, filed by AMBICA INTERNATIONAL TRADING CORPORATION, (Respondent-Applicant)², covers the mark "VENTEK", for use on "pharmaceutical preparations namely: Antiasthma" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

"a. Opposer is the owner of the well-known and registered trademarks VERTEX and VERTEX AND DEVICE ('VERTEX marks'). Thus, VENTEK which is confusingly similar and nearly identical to the VERTEX marks should not be allowed to be registered as this will be in violation of Secs. 123.1 (d), (e), (f) and 147.1 of Republic Act 8294 or the Intellectual Property Code of the Philippines (or 'IP Code').

"b. VENTEK in medicine will confuse the public to mistake it for Opposer's pharmaceutical products under the VERTEX marks and vice versa, or to associate it as belonging to Opposer's pharmaceutical business, and hence, registration for VENTEK is barred pursuant to 123.1 (g) of the IP Code.

¹ A corporation organized and existing under the laws of the State of Massachusetts, with principal office at 130 Waverly Street, Cambridge Massachusetts 021394242, United States of America

² A Philippine corporation with address at 9 Amsterdam Extension, Merville Park Subdivision, Paranaque 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.



“c. VERTEX marks, are already identified in the public mind as the mark used on Opposer’s products, and hence, they are therefore, entitled to protection as against the confusingly similar VENTEK, pursuant to 168.1.

“d. VERTEX is the corporate name of Opposer and hence, it must be protected as against VENTEK under Section 165 of the IP Code.

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

“7. Established in 1989 under the name and style of ‘VERTEX PHARMACEUTICAL INCORPORATED.’ Opposer is a global biotechnological company committed to the discovery and development of breakthrough small molecule drugs for serious diseases.

“8. Opposer discovers, develops and commercializes innovative therapies. It is one of the first biotech firms to use explicit strategy of national drug design rather than combinatorial chemistry. Its product pipeline includes preparatories for the treatment of viral diseases, cystic fibrosis, inflammation, autoimmune diseases and cancer.

“9. Using the trade name, VERTEX, Opposer collaborates with major pharmaceutical companies. In the 2004-2005 period, Opposer developed the HIV protease inhibitor Lexiva, with GlaxoSmithKiline, and in may 2011 launched INCIVEK, its widely heralded medicine for the treatment of hepatitis C, which was developed and commercialized with Johnson & Johnson. In connection with these collaborations, Opposer has received hundreds of millions of dollars in Royalty Revenues, and over a billion dollars from its own sales. Xxx

“12. Opposer maintains its Corporate Headquarters in Massachusetts, U.S.A. Opposer’s International Headquartrs is in Eysins Switzerland. Opposer also has R&D Sites in the United States (Massachusetts, California and Iowa) and in Canada and the UK. Opposer maintains Commercial Offices in Sydney, Australia; Ontario, Canada; Paris, France; Munich, Germany, Haarlem, The Netherlands; Madrid, Spain and Herts, UK. Opposer has ongoing worldwide research programs and employs over 1800 people. Opposer has ongoing worldwide research programs and employs over 1800 people. Opposr has continually been recognized as one of the industry’s top workplaces by leading publications such as Science Magazine, The Boston Globe, Boston Business Journal, San Diego Business Journal and The Scientist.

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“13. Opposer maintains a website www.vrtx.com which can be accessed in any part of the world. The website is regularly updated with information on the products and services being offered by the Opposer.

“14. Opposer’s products under the trademark VERTEX have been widely promoted through print and audio-visual media including television programs, advertisements, articles and write-ups appearing in leading newspapers, magazines, and journals, all of which enjoy a wide viewership, circulation and readership across the world. Many of these forms of media can be viewed by Filipinos who can travel abroad or subscribe to the same in the Philippines.

“15. Opposer was the first to adopt the trademark VERTEX in relation to pharmaceutical and medicinal preparations. xxx”

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

1. Affidavit of Jan Abigail L. Ponce;
2. Special Power of Authority;
3. Corporate Secretary’s Certificate executed by Kenneth L. Horton;
4. Certified true copy of Certificate of Registration No. 4-2011-000875;
5. Certified true copy of Certificate of Registration No.4-2011-000876;
6. Certified copy of Verified Notice of Opposition in IPC No. 14-2012-00004;
7. Affidavits of Stephen L. Nesbitt;
8. Copies of news, articles and marketing materials;
9. Print-out of Opposer’s database of trademark applications and registrations for VERTEX;
10. Affidavit of Anna Daley;
11. Copy of Articles of Incorporation of Opposer;
12. Certified copy of Decision in Jakarta;
13. Certified copies of trademark registrations in the United States of America; Australia; Israel; Italy; Japan; German; France; New Zealand; Switzerland; Korea; United Kingdom; European Union;
14. Affidavit of Amando S. Aumento;
15. Special Power of Attorney;
16. Print-out of website at www.vrtx.com;
17. Annual Reports for 2009, 2010 and 2011; and
18. Press releases for Opposer.⁴

This Bureau served on Respondent-Applicant a “Notice to Answer” on 23 January 2014. The Respondent-Applicant, however, did not file an Answer. Thus, this Bureau issued Order No. 2017-1303 dated 19 June 2017 declaring the Respondent-Applicant in default.

⁴ Exhibits “A” to “S” inclusive of submarkings

Records show that at the time Respondent-Applicant applied for registration of the mark "VENTEK" for goods under class 5, namely: "pharmaceutical preparations namely antiasthma:", the Opposer already registered Certificate of Registration No. 4-2011- 000875⁵ and Certificate of Registration No. 4-2011-000875⁶. The goods covered by the Opposer's trademark registration are similar or closely related, specifically "pharmaceutical preparations, namely: products for the treatment of viral diseases, inflammation, autoimmune diseases, cancer, cystic fibrosis, pain and bacterial infection".

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

VERTEX

VENTEK

Opposer's mark

Respondent-Applicant's mark

Section 123.1 (d) of Rep.Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides 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:
- (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.

VENTEK resembles VERTEX in looks and in sound. The resemblance between the marks is sufficient to cause the likelihood of confusion, or even deception. The substitution of the of the last letter "R" to "N" and the last letter "X" to "K", is negligible. When pronounced, the words VENTEK and VERTEX sound the same and are *idem sonans*. That the resemblance between the marks is likely to cause confusion is underscored by the fact that the Respondent-Applicant will use the mark VERTEX on pharmaceutical products which flow through drugstores and the same channels of trade. Consumers may even assume that VENTEK is just a variation of VERTEX. Thus, in *Marvex Commercial Co., Inc. v. Petra Hawpia*⁷, the Supreme Court held:

⁵ Exhibit "D"

⁶ Exhibit "D-1"

⁷ G.R. No. L--19297, 22 December 1966

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "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 "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "TradeMark Law and Practice", pp. 419-421, cites, as coming within the purview of the *idem* sonans rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.


The Bureau also takes into consideration that VERTEX forms part of the Opposer's trade name or corporate name. As such, it enjoys protection against the unauthorized appropriation of the same. The Supreme Court in *Philips Export B.V. v. Court of Appeals*⁸, has held:

As early as *Western Equipment and Supply Co. v. Reyes*, 51 Phil. 115 (1927), the Court declared that a corporation's right to use its corporate and trade name is a property right, a right *in rem*, which it may assert and protect against the world in the same manner as it may protect its tangible property, real or personal, against trespass or conversion. It is regarded, to a certain extent, as a property right and one which cannot be impaired or defeated by subsequent appropriation by another corporation in the same field (*Red Line Transportation Co. vs. Rural Transit Co.*, September 8, 1934, 20 Phil 549).

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-005718 is hereby **SUSTAINED**. Let the filer wrapper 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, 28 JUN 2017


ATTY. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs

⁸ G.R. No. 96161 February 21, 1992