



UNAHCO, INC.,
Opposer,

-versus-

PASTEUR PHARMACEUTICALS, INC.,
Respondent- Applicant.

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}
} IPC No. 14-2010-00197
} Opposition to:
} Appln. Serial No. 4-2010-000437
} Date filed: 13 January 2010
} TM: "VENACIN"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 238 dated December 09, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 09, 2013.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



UNAHCO, INC.,

Opposer,

IPC No. 14-2010-00197

Opposition to:

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Appln. Serial No. 4-2010-000437

Date Filed : 13 January 2010

PASTEUR PHARMACEUTICALS, INC.,

Respondent-Applicant.

Trademark: "VENACIN"

x ----- x

Decision No. 2013 - 238

DECISION

UNAHCO, INC. (Opposer)¹, filed an opposition to Trademark Application Serial No. 4-2010-000437. The application, filed by PASTEUR PHARMACEUTICALS, INC. (Respondent-Applicant)², covers the mark "VENACIN" for use on "*pharmaceutical pds - powder for injection*" under class 5³.

The Opposer interposes the following grounds for opposition:

"7. The mark 'VENACIN' owned by Respondent-Applicant so resembles the trademark 'VETRACIN' owned by Opposer and duly registered with this Honorable Bureau prior to the publication for opposition of the mark 'VENACIN'.

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

"9. The registration of the mark 'VENACIN' in the name of the Respondent-Applicant will violate Sec. 123 of the IP Code."

The facts are provided as follows:

"11. Opposer is the registered owner of the trademark 'VETRACIN'.

11.1. Opposer is engaged in the marketing and sale of a wide range of veterinary, feeds and preparations, agricultural and related products. The trademark application for the trademark 'VETRACIN' was filed with the Philippine Patent Office on 18 December 1967 by Opposer and was approved for registration on 2 September 1969 to be valid for a period of twenty (20) years, or until 2 September 1989. x x x

¹ A domestic corporation duly organized and existing under the laws of the Philippines, with principal business address at 86 Mayflower Street, Mandaluyong City.

² A domestic corporation with principal business address at 1/FSGS Foundation Building, No. 1335 G. Araneta Avenue, Quezon City.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

11.2. Before the expiration of the registration, Opposer filed an application for renewal with the Philippines Patent Office, which was accordingly granted to be valid for another period of twenty (20) years, or until 2 September 2009.

11.3. On 8 July 2009, prior to the expiration of the renewed registration, Opposer filed another application for renewal of the registration of the trademark 'VETRACIN' with the IPO, which was accordingly granted to be valid for another period of ten (10) years from 2 September 2009, or until 2 September 2019.

x x x

"12. The trademark 'VETRACIN' has been extensively used in commerce in the Philippines.

x x x

"13. By virtue of the foregoing, there is no doubt that Opposer has acquired an exclusive ownership over the trademark 'VETRACIN' to the exclusion of all others.

"14. 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 good or services and those that are related thereto specified in the certificate.'

"15. The registration of Respondent-Applicant's mark 'VENACIN' will be contrary to Section 123.1 (d) of the IP Code. 'VENACIN is confusingly similar to Opposer's trademark 'VETRACIN'.

x x x

"16. To allow Respondent-Applicant to continue to market its products bearing the mark 'VENACIN' undermines Opposer's right to its trademark 'VETRACIN'. As the lawful owner of the trademark 'VETRACIN', Opposer is entitled to prevent the Respondent-Applicant from using a confusingly similar mark in the course of trade where such would likely mislead the public.

x x x

"17. The registration and use of Respondent-Applicant's confusingly similar mark 'VENACIN' on its goods will enable the latter to obtain benefit from Opposer's reputation, goodwill and advertising and will tend to deceive and/or confuse the public into believing that Respondent-Applicant is in any way connected with the Opposer.

"18. In case of grave doubt, the rule is that, '[a]s between a newcomer [Respondent-Applicant] who by confusion has nothing to lose and everything to gain and one [Opposer] who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer [Respondent-Applicant] inasmuch as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.'

x x x

"19. Respondent-Applicant's use of the mark 'VENACIN' in relation to any of the goods covered by the opposed application, if these goods are considered not similar or closely related to the goods covered by Opposer's trademark 'VETRACIN', will take unfair advantage of, dilute and diminish the distinctive character or reputation of the latter trademark. Potential damage to Opposer will be caused as a result of its inability to control the quality of the products put on the market by Respondent-Applicant under the mark 'VENACIN'. Thus, Opposer's interests are



likely to be damaged by the registration and use of the Respondent-Applicant of the mark 'VENACIN'. The denial of the application subject of this opposition is authorized under the IP Code.”

The Opposer's evidence consists of the following

1. Exhibit "A" - Amended Articles of Incorporation of UNAHCO, INC.;
2. Exhibit "B" - Downloaded copy of Trademarks Published for Opposition;
3. Exhibit "C" - Trademark Registration No. 15061 for VETRACIN;
4. Exhibit "D" - Certificate of Renewal of Registration No. 15061 for VETRACIN;
5. Exhibit "E" - Affidavit of Use/Non-Use dated October 1979;
6. Exhibit "F" - Affidavit of Use/Non-Use dated July 1984;
7. Exhibit "G" - Affidavit of Use dated September 1994;
8. Exhibit "H" - Affidavit of Use for 15th Anniversary;
9. Exhibit "I" - Affidavit of Use for 10th Anniversary;
10. Exhibit "J" - Actual Product Packaging for VETRACIN Soluble Powder; and,
11. Exhibit "K" - Certificate of Product Registration from the Bureau of Animal Industry, Department of Agriculture.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 27 September 2010. The Respondent-Applicant however, did not file an answer. Thus, the Respondent-Applicant was declared in default and the case deemed submitted for decision.

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

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 or 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.⁴

Thus, Section 123.1, paragraph (d), of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("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.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 13 January 2010, the Opposer has already an existing trademark registration for the mark VETRACIN bearing Registration No. 15061 issued on 02 September 1969⁵; and was granted renewal of registration from 02 September 2009 until 02 September 2019⁶.

But, are the contending marks, depicted below, resemble each other such that confusion, even deception, is likely to occur?

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

⁵ Exhibit "C" of Opposer.

⁶ Exhibit "D" of Opposer.

VETRACIN

VENACIN

Opposer's mark

Respondent-Applicant's mark

The only differences between the marks are the letters between the syllables "VE" and "ACIN". The marks look and sound similar.

In this regard, a scrutiny of the Respondent-Applicant's trademark application shows that the coverage of the mark VENACIN is broadly stated as pharmaceutical products, in powder form (for injection). Without any qualification, the term "pharmaceutical products" could include those intended to address or apply to illnesses/diseases afflicting both humans and animals.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. 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 purchaser as to cause him to purchase the one supposing it to be the other⁷. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁸.

Succinctly, because the coverage of the Respondent-Applicant's trademark application would allow using the mark VENACIN on goods or pharmaceutical products that are already dealt in by the Opposer using the mark VETRACIN, the changes in the spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. VENACIN and VETRACIN identical sounds which make it not easy for one to distinguish one mark from the other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound, however, is practically replicated when one pronounces the Respondent-Applicant's mark. There is the likelihood therefore that information, assessment, perception or impression about VENACIN-marked products delivered and conveyed through words and sounds and received by the ears may unfairly cast upon or attributed to VETRACIN-denominated products and the Opposer, and *vice-versa*.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, 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

⁷ Societe Des Produits Nestle , S.A v. Court of Appeals, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217.

⁸ Emerald Garment Manufacturing Corp. v. Court of Appeals. G.R. No. 100098, 29 Dec. 1995.

it.⁹ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court.¹⁰

Callman notes two types of confusion. The first is the confusion of goods in which event the 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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2010-000437 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 December 2013.


ATTY. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs

⁹ American Wire and Cable Co. v. Director of Patents et al., (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

¹⁰ Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 Jan. 1987.