

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

-versus-

**ALLIED PHARMACEUTICALS
MARKETING CORPORATION,**
Respondent- Applicant.

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IPC No. 14-2012-00154
Opposition to:
Appln. Serial No. 4-2011-001280
Date Filed: 04 February 2011
TM: "VIGORIC"

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NOTICE OF DECISION

OCHAVE AND ESCALONA
Counsel for Opposer
No. 66 United Street
Mandaluyong City

RIVERA LAW OFFICE & ASSOCIATES
Counsel for the Respondent- Applicant
Villa Rivera-Jocson, Mabiga
Mabalacat, Pampanga

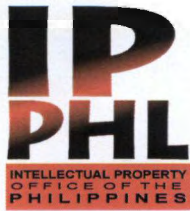
GREETINGS:

Please be informed that Decision No. 2016 - 101 dated April 01, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 01, 2016.

For the Director:

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



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PHARMACEUTICALS, INC.,**
Opposer,

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Respondent-Applicant.

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IPC No. 14-2012-00154
Opposition to:

Appln. No. 4-2011-001280
Date Filed: 04 February 2011
Trademark: **"VIGORIC"**

Decision No. 2016 - 101

DECISION

UNITED AMERICAN PHARMACEUTICALS, INC. ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2011-001280. The application, filed by ALLIED PHARMACEUTICALS MARKETING CORPORATION ("Respondent-Applicant")², covers the mark "VIGORIC" for use on goods under class 05³ namely: *"pharmaceutical product - erectile dysfunction."*

The Opposer alleges the following grounds for opposition:

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

"8. The mark 'VIGORIC' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark 'VIGORIC' 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 as pharmaceutical product.

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

"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."

¹ A domestic corporation duly organized and existing under the laws of the Philippines with office address at 132 Pioneer Street, Mandaluyong City, Philippines.

² A domestic corporation with office address at Lot 1 Blk 1 Rockwood homes, Mc Arthur Highway, Brgy. Saguin, City of San Fernando, Philippines.

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.

The Opposer's evidence consists of the following:

1. Copies of pertinent pages of the IPO E-Gazette;
2. Certified true copy (Ctc) of Certificate of Registration No. 48755 for the trademark VIGOR-ACE;
3. Ctc of the Certificate of Renewal of Registration No. 048755 for the trademark VIGOR-ACE;
4. Ctc of Affidavits of Use of the trademark VIGOR-ACE; and,
5. Sample product label bearing the trademark VIGOR-ACE.

On 01 June 2012, Respondent-Applicant filed its Answer alleging, among others, the following:

"The trademark VIGORIC will not cause confusion or deception to the consumers of VIGOR-ACE.

"1. x x x The word 'vigor' means vitality, enthusiasm, physical or mental strength, energy or force. The word 'vigor' is merely descriptive; it is generic; it furnishes to the buyer no indication of the origin of the goods; it is open for appropriation by anyone. It is accordingly barred from registration as trademark. Considering that 'vigor' by itself cannot thus be used exclusively to identify one's goods, it may properly become the subject of a trademark by combination with another word or phrase. And this union of words is reflected in Opposer's 'Vigor-Ace' and Respondent-Applicant 'Vigoric', the first with suffix 'Ace' and the second with suffice 'ic'.

Worthy of note, is the two words do not sound alike - when pronounced. Opposer asserts that there is confusion insofar as the word 'VIGOR' is concerned; however, Opposer cannot claim monopoly over the same being merely descriptive.

The two labels are entirely different in colors, contents, arrangement of word thereon, sizes, shapes and general appearance. The contrast in pictorial effects and appeals to the eye is so pronounced that the label of one cannot be mistaken for that of the other, not even by persons unfamiliar with the two trademarks.

x x x

Although, the two trademarks belong to the same class and goods for both are pharmaceutical product, confusion is in fact very remote considering that 'VIGORIC' cannot be purchased by the public without prescription while 'VIGOR-ACE' can be purchased by the public even without prescription considering that it is merely a multivitamins-minerals."

The Respondent-Applicant's evidence consists of the following:

1. Actual sample packaging of VIGOR-ACE; and,
2. Actual sample packaging of VIGORIC.

During the scheduled Preliminary Conference on 15 October 2012, Respondent-Applicant failed to appear despite notice.⁴ Thus, the said conference is terminated⁵, and the Respondent-Applicant has deemed to waived its right to submit position paper. Opposer on its part, submitted its position paper on 24 October 2012. Hence, this instant case is submitted for decision.

⁴ Notice of Preliminary Conference dated 12 September 2012.

⁵ Minutes of the Hearing dated 15 October 2012.

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

Section 123.1 paragraph (d) of R.A. No. 8293, also known as the Intellectual Property Code ("IP Code") 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 if it nearly resembles such mark as to be likely to deceive or cause confusion.

Records show that the Opposer has Certificate of Registration No. 48755 falling under Class 05 for the trademark VIGOR-ACE dated 03 August 1990⁶, which was validly renewed of its registration on 03 August 2010⁷. Opposer filed the Affidavits of Use for its mark VIGOR-ACE.⁸

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

VIGOR-ACE

Opposer's Trademark

VIGORIC

Respondent-Applicant's Trademark

The competing marks' similarity is the letters V, I, G, O and R, which appears as the word VIGOR. The Opposer's mark has the word VIGOR, followed by hyphen (-) and the word ACE. On the other hand, Respondent-Applicant's mark consists of only one word VIGORIC. The difference, particularly the ending word "ACE" of Opposer's mark, as against the ending syllable "IC" of Respondent-Applicant create stark difference in the marks, giving a divergent visual and aural characters of the marks that can easily distinguish one from the other.

This Bureau also underscores the fact that the foregoing marks cover distinct goods and/or pharmaceutical products. The registration of Opposer's VIGOR-ACE covers medicinal preparations containing vitamins, minerals and lecithin⁹; whereas, Respondent-Applicant's VIGORIC particularly covers treatment for erectile dysfunction. There can be no mistake in distinguishing the competing products. Respondent-Applicant's medicine is more specific in the illness it is intended to treat, and any buyer will exercise great degree of care and caution in purchasing medicines for the treatment of this kind of illness. Moreover, Respondent-Applicant's VIGORIC is not an over-the-counter type of medicine, compared to Opposer's VIGOR-ACE multivitamins and minerals product.

Corollarily, the likelihood of the consumers being deceived, mistaken or confused is remote because of the highly sensitive nature of Respondent-Applicant's drugs. The sheer disparity in the nature

⁶ Exhibit "B" of Opposer.

⁷ Exhibit "C" of Opposer.

⁸ Exhibits "D", "D-1" and "D-2" of Opposer.

⁹ Id. at 7.

and purposes of the goods and the manner by which the Respondent-Applicant's goods under the mark VIGORIC are sold or dispensed precludes the probability of confusion or mistake. Moreover, because of the difference in the goods or pharmaceutical products, the Respondent-Applicant cannot be said to have the intent to ride in the goodwill of the mark VIGOR-ACE. It is unlikely for one when confronted with the mark VIGORIC to be reminded of the mark VIGOR-ACE and *vice versa*.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-001280 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 01 April 2016.


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