



NOVARTIS AG,
Opposer,

-versus-

ACTAVIS GROUP PTC EHF,
Respondent-Applicant.

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IPC No. 14-2008-00118

Opposition to:
Appln. Serial No. 4-2007-009687
(Filing Date: 03 Sept. 2007)

Trademark: **EBIVOL**

Decision No. 2012- 56

DECISION

NOVARTIS AG ("Opposer")¹ filed on 30 May 2008 an opposition to Trademark Application Serial No. 14-2007-009687. The application, filed by ACTAVIS GROUP PTC EHF ("Respondent-Applicant")², covers the mark "EBIVOL" for use on "*pharmaceutical preparations and substances for the treatment of hypertension*" under Class 05 of the International Classification of Goods³. The Opposer alleges that the registration of EBIVOL in favor of the Respondent-Applicant is proscribed under Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), because it is confusingly similar to the Opposer's mark "SEBIVO" for use on "*pharmaceutical preparations for the treatment of bacteria-based diseases; anti-infectives, antivirals, antibiotics, antifungals, vaccines*" under Class 5.

The Opposer submitted evidence consisting of the affidavit of its trademark advisor Antoinette Lachat, annual report for the year 2006, certified copies of foreign certificates of registration for SEVIBO, and certified copies of the Decision in the opposition case filed in Romania and of proof of sales of the mark SEBIVO in the Philippines.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 07 July 2008. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the mark EBIVOL?

It must be 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

¹ A corporation organized and existing under the laws of Switzerland, with address at 4002 Basel, Switzerland.

² A corporation organized and existing under the laws of Iceland with address at Reykjavikurvegi 76, 220 Hafnarfirdi, Iceland.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The Treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

⁴ Marked as Exhibits "A" to "H". The foreign certificates include registration in the European Union (Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, United Kingdom), Hong Kong, Malaysia, New Zealand.

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 of 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.⁵ Thus, Section 123.1 (d) of the Intellectual Property Code provides that a mark cannot be registered if its 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 a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 03 September 2007, the Opposer has an existing registration for the mark SEBIVO under Cert. of Reg. No. 4-2006-002611, issued on 23 July 2007. The Opposer's registration covers "*pharmaceutical preparations for the treatment of bacteria-based diseases; anti-infectives; antivirals, antibiotics, antifungals, vaccines*".

The only difference between the competing marks is that the Respondent-Applicant removed the first letter ("S") in SEBIVO and added a letter ("L") at the end, thus turning SEBIVO into EBIVOL. The "letter migration and transformation" notwithstanding, the substance of the Opposer's mark that draws the eyes and ring to the ears -EBIVO- is carried and retained by the Respondent-Applicant's. It is stressed that 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 original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.⁶ The law does not require actual confusion, it being sufficient that confusion is likely to occur.⁷ Corollarily, to constitute an infringement of a trademark 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 of likelihood of the purchaser of the older brand mistaking the new brand for it.⁸

The likelihood of confusion is compounded by the fact that SEBIVO is a unique mark, in the category of a fanciful mark. It has no meaning in any language, nor is a mark which is formed from different words, like chemical compounds, ingredients, or generic names which is not unusual for marks or brand names for pharmaceutical products. Also, the Respondent-Applicant's mark covers pharmaceutical products that are similar and/or closely related to the Opposer's. Aply, the ultimate ratio in cases of grave doubt is the rule that as between new comer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.⁹

⁵ See *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

⁶ See *Societe des Produits Nestle, S.A. v. Court of Appeals*, G.R. No. 112012, 04 April 2011, 365 SCRA 207, 217.

⁷ See *Philips Export B.V. et al. v. Court of Appeals et al.*, G.R. No. 96161, 21 Feb. 1992.

⁸ See *American Wire & Cable Co. v. Director of Patents, et al.*, G.R. No. 26557, 18 Feb. 1970, 31 SCRA 544.

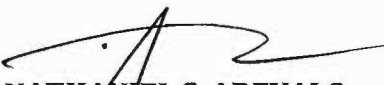
⁹ See *Del Monte Corporation et al. v. Court of Appeals*, G.R. No. 78325, 25 Jan. 1990.

To conclude, 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 filewrapper of Trademark Application Serial No.4-2007-009687 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 27 March 2012.


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