



BIOFEMME INC.,
Opposer,

-versus-

NOVARTIS VACCINES AND
DIAGNOSTICS GMBH & CO., KG,
Respondent-Applicant.

X-----X

} IPC No. 14-2010-00024
} Opposition to:
} Appln. Serial No. 4-2009-004935
} Date Filed: 19 May 2009
} Trademark: "FLUCELA"

NOTICE OF DECISION

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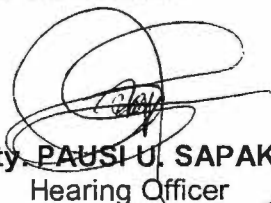
E. B. ASTUDILLO & ASSOCIATES
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10th Floor, Citibank Center
8741 Paseo de Roxas
Makati City

GREETINGS:

Please be informed that Decision No. 2012 – 170 dated September 12, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 12, 2012.

For the Director:


Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs

CERTIFIED TRUE COPY


MARILYN F. RETUAL



BIOFEMME INC.,
Opposer,

-vs-

NOVARTIS VACCINES AND
DIAGNOSTICS GMBH & CO., KG,
Respondent-Applicant.

x-----x

Inter Partes Case No. 14-2010-000024
Opposition to:

Appl'n. Serial No.: 4-2009-004935
Date Filed: 19 May 2009
Trademark: "FLUCELA"

Decision No. 2012 - 170

DECISION

BIOFEMME INC. ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2006-005819. The application, filed by NOVARTIS VACCINES AND DIAGNOSTICS GMBH & CO., KG² ("Respondent-Applicant") covers the mark "FLUCELA" for "*vaccines for human use*" under Class 5 of the International Classification of goods.

The Opposer alleges, among other things, that FLUCELA so resembles its registered mark "FUNZELA". According to the Opposer, this will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed trademark is applied for the same class and goods as that of the mark FUNZELA, i.e. Class (5) which includes "*anti-fungal pharmaceutical preparation*". Hence, the Opposer argues, the registration of the FLUCELA in the name of the Respondent-Applicant will violate Sec. 123 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). The Opposer also cites this Bureau's Decision No. 2008-91 dated 20 May 2008 on Inter Partes Case No. 14-2007-00240.

In support of its opposition,, the Opposer submitted as evidence a copy of this Bureau's Decision No. 2008-91 and subsequent Resolution No. 2009-18 (D) dated 04 March 2009 in Inter Partes Case No. 14-2007-00240, copy of the Order of the Director General dated 01 June 2009 on Appeal No. 14-09-31 dismissing the appeal on Decision No. 2008-91, printout of E-Gazete showing trademarks published for opposition with releasing date of 26 October 2009, copy of Cert. of Reg. 4-2003-010821, Declaration of Actual Use of FUNZELA, sample box/product label for FUNZELA, and certification dated 03 December 2009 from the Country Manager of IMS Health Philippines, Inc. showing sales data on systemic antifungal agents.³

On 22 June 2010, the Respondent-Applicant filed its Answer denying all the material allegations in the opposition. According to the Respondent-Applicant, the marks are not confusingly similar to each other and that the decision in Inter Partes Case No. 14-2007-00240 cannot be applied in this instance. The Respondent-Applicant's evidence consists of an electronic copy of the duly notarized Power of Attorney in favor of John F. Ward, duly notarized Affidavit-Testimony of John F. Ward, a copy of Trademark Reg. No. 3,302,828 issued by the U.S. Patent and Trademark Office for FLUCELA, copy of Columbian Trademark Reg. No. 332549 for FLUCELA, copy of German Trademark Reg. No. 305 72 079 for FLUCELA, copy of International Trademark Reg. NO. 892 097 for FLUCELA, and a copy of Japanese Trademark Reg. No. 982097 for FLUCELA.⁴

¹ A corporation duly organized and existing under and by virtue of the laws of the Philippines with principal office located at 2nd Floor Bonaventure Plaza, Greenhills, San Juan City.

² A foreign corporation with principal address at Emil Von-Behring-Strasse, 76, Postfach 1630, Marburg 35006, Germany

³ Marked as Exhibits "A" to "H".

⁴ The Respondent-Applicant also marked its evidence in alphabetical order, "A" to "G" inclusive.

The Opposer anchors its case on Sec. 123.1 (d) of the IP Code, which provides:

Sec. 123. *Registrability*— 123.1. *A mark cannot be registered if it:*

- (d) Is identical with a registered mark belonging to a different proprietor or 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;

Records and evidence show that at the time the Respondent-Applicant filed its trademark application, the Opposer has an existing trademark registration for FUNZELA.

In this regard, the issue of whether the mark FLUCELA is confusingly similar to FUNZELA has already been passed upon by this Bureau in Inter Partes Case No. 14-2007-00240. In the cited case, the Opposer contested the Respondent-Applicant's Trademark Application Serial No. 4-2006-005819 the subject of which is also the mark FLUCELA. This Bureau sustained the opposition with a conclusion that FLUCELA is confusingly similar to FUNZELA.

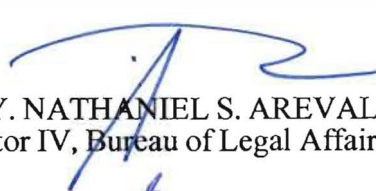
Aptly, this Bureau finds untenable the Respondent-Applicant's argument that the decision cannot be applied in the instant case because the trademark application subject of this opposition is a different one and covers goods that are different from those indicated in Trademark Application Serial No. 4-2006-005819. Trademark Application Serial No. 4-2006-005819 also involves the mark FLUCELA for use on "*pharmaceutical and veterinary preparations, vaccines, and adjuvants for vaccines*".

The Respondent-Applicant appealed this Bureau's Decision (No. 2008-91 promulgated on 20 May 2008) to the Director General. The Director General, however, issued an Order dated 01 June 1989 dismissing the appeal on the ground that it was filed out of time. Accordingly, this Bureau finds no cogent reason to deviate from the said rulings.

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2009-004935 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 12 September 2012.


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