



NOVARTIS AG,
Opposer,

-versus-

KOHL INDUSTRIES CORPORATION,
Respondent- Applicant.

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}
} IPC No. 14-2011-00580
} Opposition to:
} Appln. Serial No. 4-2011-05104
} Date Filed: 04 May 2011
} TM: "ORAPRO"
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NOTICE OF DECISION

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


CARLOS LORENZO R. ATILANO
For Respondent-Applicant
Kohl Industries Corporation
68 East Service Road, C5 Avenue
Pasig City

GREETINGS:

Please be informed that Decision No. 2013 - 107 dated June 18, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 18, 2013.

For the Director:


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



NOVARTIS AG,

Opposer,

IPC No. 14-2011-00580

Opposition to Trademark

Application No. 4-2011-05104

(Filing Date: 04 May 2011)

Trademark: "ORAPRO"

-versus-

KOHL INDUSTRIES CORPORATION,

Respondent-Applicant.

X ----- X

Decision No. 2013- 107

DECISION

Novartis AG¹ ("Opposer") filed on 5 March 2012 an opposition to Trademark Application Serial No. 4-2011-005104. The application, filed by Kohl Industries Corporation² ("Respondent-Applicant"), covers the mark "ORAPRO" for use on "*oral antiseptic*" under Class 05 of the International Classification of Goods³.

The Opposer anchors its opposition on Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It alleges that its mark "OROFAR" and the Respondent-Applicant's mark ORAPRO are confusingly similar, for the following reasons:

- a. Both marks consists of six letters and three syllables;
- b. Five out of the six letters, i.e. O, R, O, A and R, in both marks are identical. Moreover, the letter P in Respondent-Applicant's mark looks almost the same as the letter F in Opposer's mark. Hence, when viewed from a distance, the marks look confusingly similar;
- c. Both marks consist of three syllables each with the first two syllables consisting of two letters each and the third syllable consisting of three letters each. The first syllables of both marks are identical. The second syllable RO in Opposer's mark is almost the same as the second syllable RA in Respondent-Applicant's mark. Moreover, the third syllable FAR in Opposer's mark is very similar to the third syllable PRO in Respondent-Applicant's mark. The potential confusion between the two marks is therefore real;
- d. Because of the near unanimity in the letters and syllables of the two marks, the syntax, the sound and the pronunciation of the marks are

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

² A Filipino corporation organized and existing under and by virtue of the laws of the Philippines with address at No. 68 East Service Road, C5 Avenue, Pasig City, Metro Manila.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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 Purpose of the Registration of Marks concluded in 1957.

- the same. Phonetically, therefore, the two marks are practically identical and confusingly similar; and
- e. both marks are word marks in plain, block letterings and not stylized. Neither is in color nor is compounded by a unique device or design. Hence, the similarity between the two marks is even more pronounced or enhanced.

The Opposer points out that both marks are used for "*oral antiseptics*" under International Class 05 and that they are sold, marketed and found in the same channels of business and trade. According to the Opposer, it filed its application for registration of the mark OROFAR as early as 09 March 2011, and has in fact owned registration of the mark OROFAR issued on 19 May 1989. To support its Opposition, the Opposer submitted the following as evidence:

1. Application No. 4-2011-002642;
2. Certificate of Registration No. 44750 for the mark OROFAR;
3. Certificate of Product Registration No. DRHR-1532 for the mark OROFAR;
4. Certificate of Product Registration No. DRHR-749 for the mark OROFAR;
5. product packaging of goods bearing the trademark OROFAR;
6. sales purchase orders, invoices, packing list/weight note, shipping advice and airway bill for products bearing the mark OROFAR;
7. Opposer's brochures and promotional materials;
8. Secretary's Certificate;
9. Joint Affidavit of witnesses Mary F. Leheny and Nazuki Hughes; and,
10. 2010 Annual Report.

For its part, the Respondent-Applicant asserts that pharmaceuticals are highly specialized and peculiar. It contends that ORAPRO is distinctive and that the said mark is in no way identical or closely similar to the Opposer's mark OROFAR.

The case was scheduled for Preliminary Conference but only the Opposer appeared. As a result, Order No. 2012-1138 dated 30 August 2012 was issued declaring that Respondent-Applicant has waived its right to file its position paper.

The primordial issue in this case is whether the trademark application by Respondent-Applicant should be allowed.

As culled from available records, the Bureau notes that the Opposer filed an application for the registration of the mark OROFAR as early as 09 March 2011. The Bureau takes judicial notice that the mark was eventually allowed registration on 07 July 2011. Subjects found in the Trademark Registry including the list of registered trademarks as well as pending applications and statuses are matters that can and

should be taken cognizance of even if not raised as an issue by the parties.⁴ Unquestionably, the Opposer's application preceded the Respondent-Applicant's.

Section 123.1(d) of the IP Code, relied upon by Opposer, provides that:

Section 123.1. 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

To determine whether the marks of the Opposer and the Respondent-Applicant are confusingly similar, the two are shown below for comparison:

OROFAR **oraPRO**

Upon observation of the subject trademarks, it can be readily gleaned that the only similarity that can be observed is the prefix "OR". In this regard, there is sufficient reason to infer and conclude that the prefix "OR" comes from the word "oral". It is noteworthy that both the Opposer's and the Respondent-Applicant's trademarks pertain to goods which are oral antiseptics. A trademark which appropriates the prefix "OR" and is used on oral antiseptics is a suggestive mark; therefore, a weak mark. A mark or brand name itself gives away or tells the consumers the goods or service and/or the kind, nature, use or purpose thereof.

Succinctly, what easily comes to the mind when one sees or hears a mark or brand name of oral antiseptics of which the prefix "OR" is a part of is the very concept or idea of the goods. What will set apart or distinguish such mark from another which also includes the same prefix on oral antiseptics are the letters that comes after "OR". In this case, it will be highly unlikely that the consumers will be misled, confused or deceived that the Respondent-Applicant's goods came from or are connected to or associated with that of the Opposer's. The Respondent Applicant's mark uses "APRO" after the prefix "OR" while that of Opposer's utilizes the letters or syllables "OFAR". Visually and aurally, "APRO" and "OFAR" are different. It can be gleaned from the illustration of the mark that the Respondent-Applicant highlights the word "pro" in its trademark by writing the same in capital

⁴ Appeal No. 14-08-31, 1 June 2009.

and block letters. Consequently, when one looks at the mark "ORAPRO", what remains in the eyes and mind is the word "pro".

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 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 This Bureau finds the Respondent-Applicant's trademark consistent with this function.

Moreover, taking into account that the only similarity between the two competing marks is the prefix "OR", sustaining the opposition would have the unintended effect of giving the Opposer the exclusive right to use "OR", which sufficiently describes the goods involved, i.e. oral antiseptics.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-005104 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 18 June 2013.



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

⁵ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November, 1999.