



THERAPHARMA, INC.,
Opposer,

-versus-

NOVARTIS AG,
Respondent- Applicant.

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} IPC No. 14-2012-00080
} Opposition to:
} Appln. Serial No. 4-2011-013361
} Date Filed: 08 Nov. 2011
} TM: "THERAFLU"

NOTICE OF DECISION

OCHAVE & ESCALONA

Counsel for Opposer
66 United Street
Mandaluyong City

E.B. ASTUDILLO & ASSOCIATES

Counsel for Respondent-Applicant
10th Floor, Citibank Center
8741 Paseo de Roxas
Makati City

GREETINGS:

Please be informed that Decision No. 2014 - 253 dated October 10, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 10, 2014.

For the Director:

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



IPC NO. 14 - 2012- 00080

THERAPHARMA, INC.,

Opposer,

- versus -

NOVARTIS AG,

Respondent-Applicant.

Opposition to:

Trademark Application Serial No.

42011013361

Date filed: 08 November 2011

TM: "THERAFLU"

X-----X

DECISION NO. 2014 - 253

DECISION

THERAPHARMA, INC. (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-013361. The trademark application filed by NOVARTIS AG (Respondent-Applicant)², covers the mark THERAFLU for services under Class 5 of the International Classification of Goods³ particularly, "*pharmaceutical and veterinary preparations, sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.*"

The Opposer based its opposition on the following grounds:

1. The trademark THERAFLU so resembles the mark THERAPHARMA, INC. owned by the Opposer and will likely cause confusion, mistake and deception on the purchasing public;
2. The registration of the trademark THERAFLU will violate Sec. 123 of Republic Act No. 8293 also known as the Intellectual Property Code of the Philippines (IP Code); and
3. Respondent-Applicant's use and registration of the trademark THERAFLU will diminish the distinctiveness and dilute the goodwill of the Opposer's mark THERAPHARMA.

In support of its opposition, the Opposer submitted the following:

1. Exhibit "A" – A copy of the IPO E-Gazette which was release on 16 January 2012;
2. Exhibit "B" – A copy of the Certificate of Renewal of Registration of Trademark Registration No. 012614;

¹ A corporation organized and existing under the laws of Philippines with office address located at Bonaventure Plaza, Ortigas Ave. Greenhills, San Juan City.

² A foreign corporation organized and existing under the laws of Switzerland with business address at 4002 Basel, Switzerland.

³ *The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.*

3. Exhibit "C" – A copy of the Certificate of Registration No. 012614;
4. Exhibit "D" – A copy of the Declaration of Actual Use;
5. Exhibit "E" – A copy of Affidavit of Use filed on 3 January 2002;
6. Exhibit "F" – A copy of Affidavit of Use filed on 31 January 1997;
7. Exhibit "G" – A Copy of Affidavit of Use filed on 7 January 1992;
8. Exhibit "H" – Petition for Renewal of Registration filed on 14 August 1986;
9. Exhibit "I" – A copy of the Affidavit of Use filed on 10 December 1981; and
10. Exhibit "J" – A sample of the product label bearing the trademark THERAPHARMA.

This Bureau issued on 23 February 2012, a Notice to Answer to the Respondent-Applicant. On 6 June 2012 Respondent-Applicant filed its Answer denying all the material allegations of the Opposition and asserting the following:

1. THERAFLU is not confusingly similar with Opposer's mark THERAPHARMA, INC.;
2. Confusion is highly unlikely since THERAFLU covers "good" or "merchandise" in Class 5 while, the Opposer's mark cover services in Class 42;
3. "THERA" is a common prefix for trademarks for goods in Class 5, thus consumer will focus on the suffix; and
4. It has no intention to benefit from opposer's alleged reputation, goodwill and advertising.

The Respondent-Registrant's evidence consist of the following:

1. Exhibit "A" – Copies of trademark registrations in the Philippines with the prefix "THERA";
2. Exhibit "B" – Joint Affidavit – Testimony of Mary F. Leheny and Nazuki Hughes
3. Exhibit "C" – Novartis AG's Annual Report for 2011;
4. Exhibit "D" – A copy of the global portfolio of Respondent-Applicant for the mark THERAFLU; and
5. Exhibit "E" – Saegis Pharma-In-Use Report showing the use of the mark THERAFLU in countries all over the world.

The issue to be resolved is whether Respondent-Applicant's trademark THERAFLU should be allowed for registration.

The instant opposition is anchored on Section 123.1, paragraph (d), of the 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.

Records show that the Opposer has a prior and existing trademark registration when the Respondent-Applicant filed his trademark application. But Opposer's mark is used on goods under Class 42 of NICE Classification of Goods, specifically, "*sales and distribution of drugs and medicines.*"

The question now is, do the marks as shown below resemble each other such that mistake or confusion or even deception is likely to occur?

THERAPHARMA, INC.

THERAFLU

Opposer's Trademark

Respondent-Applicant's Trademark

The two word marks are similar in the first five letters forming the prefix "THERA." However, this Bureau finds merit to the argument of Respondent-Applicant that "THERA" is a common prefix for trademark in pharmaceutical industry as reflected by the following marks: THERA THERMAL CARE (Reg. No. 4-2004-005909) owned by Manila Herbal and Essential Oils Co. Inc.; THERABLOC (4-2001-007366) by the herein Opposer; THERACIM (Reg. No. 4-2007-012613) owned by Innogene Kalbiotech Pte Ltd.; THERAGRAN (Reg. No. 4-2009-001980) owned by Taisho Pharmaceutical Co. Ltd.; THERAGRAN (Reg. No. 4-1995-101395) owned by E. R. Squibb & Sons, Inc.; THERAHERB & DEVICE (Reg. No. 4-2004-011582) owned by Splash Corporation; THERALENS (Reg No. 4-2010-012034) owned by Johnsons & Johnsons; THERALENS (Stylized) (Reg No. 4-2011-011353) owned by Johnsons & Johnsons; THERA-MED (Reg No. 061336) owned by Henkel Kommanditgesellschaft Auf Aktien; THERAMOX (Reg No. 4-2003-011734) owned by herein Respondent-Applicant; THERANAL (Reg No. 016091) owned by the Opposer; THERAPLUS (Reg No. 4-2011-006826) owned by The Generics Pharmacy, Inc.; THERASOLVAN (Reg No. 4-1994-098187) owned by Opposer; THERAVANCE (Reg No. 4-2011-009257) owned by Theravance, Inc.; THERAVANCE (Reg No. 4-2005-003156) owned by Theravance, Inc; THERAVANCE (Reg No. 4-2008-010800) owned by Theravance, Inc; and THERAVISION (Reg No. 4-2010-012179) owned by Johnson & Johnson. From the enumeration, it is evident that the prefix "THERA" is widely used on pharmaceutical related trademarks by parties other than the Opposer.

Following from the above, there is sufficient reason to infer and conclude that the common prefix "THERA" is a contraction of the words "Therapy" or "Therapeutic" which generally means a cure or a medical treatment. Thus, the said trademark is a suggestive mark and therefore a weak mark with respect to medical goods or services as it gives away or tells the consumers the goods or service, and/or the kind, nature, use or purpose thereof.

Hence, what will set apart or distinguish two trademarks that both contain the prefix THERA and used on similar or related goods are the letters and/or syllables that follow or accompany the said prefix. In the instant case, Respondent-Applicant's mark ends with the single syllable "FLU" which is totally different in both visual appearance and phonetic effect from the separated phrasing of Opposer's mark, "PHARMA INC".

Undoubtedly, the clear differences in the suffixes of the contending word marks are sufficient safeguard in order not to misled or confused the consumer into believing that the Respondent-Applicant's goods came or originated from or connected to or associated with the Opposer's.

Time and again, it has been held in our jurisdiction that 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. This Bureau finds the Respondent-Applicant's mark consistent with this function.

WHEREFORE, premises considered, the instant Opposition to the Trademark Application No. 42011013361 is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 42011013361 be returned together with a copy of this **DECISION** to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 10 October 2014


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