NOVARTIS AG, Opposer, **-versus-** **EON PHARMATEK, INC.,** Respondent- Applicant.	}	**IPC No. 14-2012-00069** Opposition to: Appln. Serial No. 4-2011-011704 Date Filed: 29 September 2011 **TM: "DOXIMAX"**

NOTICE OF DECISION

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

EON PHARMATEK, INC.
Respondent-Applicant
Unit 703, AIC Building Empire Tower
ADB Avenue, Ortigas Center
Pasig City

GREETINGS:

Please be informed that Decision No. 2014 - 195 dated July 30, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 30, 2014.

For the Director:

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

NOVARTIS AG,	}	**IPC No. 14-2012-000069**
Opposer,	}	Opposition to:
	}	
-versus-	}	Appln. Serial No. 4-2011-011704
	}	Date Filed : 29 September 2011
EON PHARMATEK, INC.,	}	Trademark: " **DOXIMAX"**
Respondent-Applicant.	}	
x ---------- x		Decision No. 2014 - 195

D E C I S I O N

NOVARTIS AG, ("Opposer")[1] filed an opposition to Trademark Application Serial No. 4-2011-01174. The application, filed by EON PHARMATEK, INC., (Respondent-Applicant")[2], covers the mark "DOXIMAX" for use on "pharmaceuticals – antibacterial capsule" under class 05 of the International Classification of Goods and Services[3].

The Opposer alleged:

"Legal Grounds for the Opposition

"6. The trademark DOXIMAX being applied for by respondent-applicant is confusingly similar to opposer's trademark XORIMAX, as to be likely, when applied to or used in connection with the goods of respondent-applicant, to cause confusion, mistake and deception on the part or the purchasing public.

"7. The registration of the trademark DOXIMAX in the name of respondent-applicant will violate Section 123.1, subparagraph (d) of the Intellectual Property Code of the Philippines, x x x

"8. The registration of the trademark DOXIMAX in the name of respondent-applicant is contrary to other provision of the Intellectual Property Code of the Philippines.

"Facts and Circumstances In Support of the Opposition

"I. Respondent-applicant's mark DOXIMAX, being applied for registration, is confusingly similar to opposer's mark XORIMAX, as to be likely, when applied to or used in connection with the goods of respondent-applicant, to cause confusion, mistake and deception on the part of the purchasing public.

"II. The goods covered by respondent-applicant's mark DOXIMAX are similar, related to and competing with the goods of opposer's mark XORIMAX such that respondent-applicant's use of its mark will be more likely to cause confusion in the minds of the purchasing public.

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

2 A corporation duly organized and existing under the laws of the Philippines with office address at Unit 703, AIC Burgundy Empire Tower, ADB Avenue, Ortigas Center, Pasig City.

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.

Republic of the Philippines
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"III. Opposer, being the owner and registrant of the mark XORIMAX in the Philippines, has superior and exclusive rights over said mark and other marks similar thereto, to the exclusion of any third party.

"IV. Respondent-applicant obviously intends to pass off its products as those of oppose since there is no reasonable explanation for respondent-applicant to use the mark DOXIMAX when the field for its selection is so broad.

The Opposer submitted the following documentary consisting of Exhibits "A" to "M-3" inclusive of submarkings:

1. Certificate of Registration no. 4-2003-00060 for the trademark XORIMOX issued by the Intellectual Property Office of the Philippines;
2. Certificate of Product Registration No. DR-XY36007 issued by the Food and Drug Administration;
3. Certificate of Product Registration No. DR-XY30706 issued by the Food and Drug Administration;
4. Certificate of Product Registration No. DR-XY30705 issued by the Food and Drug Administration;
5. Product Packaging of the goods bearing the mark XORIMAX;
6. Product Leaflet featuring the goods bearing the mark XORIMAX;
7. Promotional Materials showing the mark XORIMAX;
8. Airway Bills for 2011 for products bearing the mark XORIMAX;
9. Certified true copy of the duly authenticated Corporate Secretary's Certificate, the original of which is in the possession of counsel;
10. Legalized Joint Affidavit-Testimony of Marcus Goldbach and Andrea Felabermeir; and,
11. Pages from Novartis AG's Annual Report for the year 2011.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 28 November 2012. Respondent-Applicant however, did not file an answer. Thus, on 30 January 2013, Order No. 2013-198 was issued declaring Respondent-Applicant in default and submitting this instant case for decision.

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

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 or 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.[4]

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

[4] Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 29 September 2011, the Opposer has already an existing trademark registration for the mark XORIMAX bearing Registration No. 4-2003-000660 issued on 28 August 2005.[5]

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

XORIMAX	DOXIMAX
Opposer's Trademark	Respondent-Applicant's Trademark

The foregoing marks show visual and aural similarities. The sound when pronounced is almost the same since the only difference between the marks is the beginning and middle letters "X" and "R" of the Opposer, as against that of Respondent-Applicant's "D" and "X" which respectively, are located in the same position. All other letters of the marks are identical.

A scrutiny of the Respondent-Applicant's trademark application shows further that the coverage of the mark DOXIMAX is broadly stated as pharmaceuticals – antibacterial capsule. Without further and particular qualification, this product is similar and/or related to that intended to address or apply to illnesses or diseases covered by the Opposer's trademark, indicated as "pharmaceutical preparations for the prevention and/or treatment of disorders of the nervous system, the cardio-vascular system, the respiratory system, the musculo-skeletal system, the genitourinary system, for the treatment of inflammatory disorders, for use in dermatology, in oncology, in ophthalmology, for us in the gastroenterological area and the prevention and treatment of ocular disorders or diseases.[6]

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 the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.[7] Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.[8]

Succinctly, because the coverage of the Respondent-Applicant's trademark application would allow using the mark DOXIMAX on goods or pharmaceutical products that are already dealt in by the Opposer using the mark XORIMAX, the changes in spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. The contending marks have identical sounds which make it not easy for one to distinguish one mark from the other. Trademarks are designed not only for the

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5 Exhibit "A" of Opposer.
6 Id.
7 Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.
8 Emerald Garment Manufacturing Corp. V. Court of Appeals, G.R. No. 100098, 29 December 1995.

consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound, however, is practically replicated when one pronounces the Respondent-Applicant's mark. There is the likelihood therefore that information, assessment, perception or impression about DOXIMAX-marked products delivered and conveyed through words and sounds and received by the ears may unfairly cast upon or attributed to XORIMAX-denominated products of the Opposer, and vice-versa.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent 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 or likelihood of the purchaser of the older brand mistaking the newer brand for it.[9] The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:[10]

> Callman notes two type s of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

The Respondent-Applicant in the instant opposition was given the opportunity to explain its side and to defend its trademark application. However, it failed to do so. Accordingly, 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 file wrapper of Trademark Application Serial No. 4-2011-011704 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 30 July 2014.

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

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9 American Wire and Cable Co. v. Director of Patents, et al., (31 SCRA 544) G.R. No. L-26557, 18 February 1970.
10 Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.