



NOVARTIS AG,
Opposer,

-versus-

HEALTH 2000 PHARMACEUTICAL
PHILS., CORP.,
Respondent-Applicant.

}
} IPC No. 14-2011-00142
} Opposition to:
} Appln No. 4-2010-007322
} (Filing Date: 07 July 2010)
} TM: "AMLO-5"
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NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES

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JEROME J. RAMOS

For the Respondent-Applicant
c/o Health 2000 Pharmaceutical Phils. Inc.,
3/F Saiyo Bldg. Imelda Avenue, Phase 2A
Karangalan Village, Pasig City

GREETINGS:

Please be informed that Decision No. 2014 - 206 dated August 13, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 13, 2014.

For the Director:

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



NOVARTIS AG,

Opposer,

- versus-

HEALTH 2000 PHARMACEUTICAL
PHILS., CORP.,

Respondent-Applicant.

X-----X

IPC NO. 14-2011-00142

Opposition to:

Appln. Serial No. 4-2010-007322

(Filing Date: 07 July 2010)

TM: "AMLO-5"

Decision No. 2014- 206

DECISION

NOVARTIS AG ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2010-007322. The application, filed by HEALTH 2000 PHARMACEUTICAL PHILS., CORP. ("Respondent-Applicant")², covers the mark "AMLO-5" for use on "*pharmaceutical preparation*" under Class 5 of the International Classification of Goods and Services³.

The Opposer alleges that the registration of AMLO-5 is proscribed under Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, AMLO-5 is a colourable imitation of and is confusingly similar to its registered mark "AMIO". To support its opposition, the Opposer submitted as evidence the copy of Cert. of Reg. No. 4-2008-004880 for the mark AMIO, copy of Cert. of Product Reg. No. DRP-1193 issued by the Bureau of Food and Drugs, advertising material and invoice for products or goods bearing the mark AMIO, duly authenticated Corporate Secretary's Certificate, legalized Joint Affidavit-Testimony of Marcus Goldbach and Andrea Felbermeir, and pages from the Opposer's Annual Report for the year 2010⁴.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 16 June 2011. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the mark AMLO-5?

Sec. 123.1(d) of the IP Code provides that a mark shall not 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 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 07 July 2010, the Opposer already has an existing trademark registration for the mark AMIO (Cert. of Reg. No. 4-2008-004880). The registration, issued on 11 August 2008, covers "*pharmaceutical preparations, namely antiarrhythmics*".

In this regard, AMLO-5 looks very similar to AMIO. The sound created by pronouncing AMLO is also hardly distinguishable from AMIO. Because the Respondent-Applicant's trademark application covers "*pharmaceutical preparations*", this would enable the Respondent-Applicant to use

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 domestic corporation with office address at 3rd Floor, Saiyo Bldg., Imelda Avenue, Phase 2A, Karangalan Village, Pasig City.

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.

⁴ Marked as Exhibits "A" to "G", inclusive.

the mark on broad range of products that could include the Opposer's. And, if the Respondent-Applicant does, there is the likelihood of confusion among the consumers.

The number "5" accompanying the word AMLO in the Respondent-Applicant's mark is inconsequential. 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 ingenious 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 other⁵ because the competing marks are confusing similar, consumers may also likely assume, that the Respondent-Applicant's mark is just a variation of or related to the Opposer's and/or the goods or services originate or provided by one party alone or the parties themselves are connected or associated with one another while in fact there is none. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origins thereof as held by the Supreme Court.⁶

This Bureau also noted that among the documents in the "filewrapper" of the subject trademark application is the Respondent-Applicant's Declaration of Actual Use supported by several photocopies of an actual label for the mark AMLO-5. Printed on the label above the mark AMLO-5 is the generic name "AMLODIPINE besilate", while below are the words/numbers "5 mg Tablet". It is stressed that an opposition to trademark application is essentially a review of the application in question, succinctly, on whether the requirements and/or the prohibitions under the law are complied with or observed. As such, this Bureau can take cognizance via judicial notice of the contents of the "filewrappers" and official records.

Sec. 123.1 of the IP Code provides, in part, that a mark cannot be registered if it:

- (h) Consist exclusively of signs that are generic for the goods or services that they seek to identify;
- (i) Consist exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and establishes trade practice;
- (j) Consist exclusively of signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services;

Generic terms are those which constitute "*the common descriptive name of an article or substance*", or comprise the "*genus of which the particular product is a species*", or are commonly used as the "*name or description of a kind of goods*", or imply reference to "*every member of a genus and the exclusion of individuating characters*", or "*refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product*", and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it "*forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is*", or if it clearly denotes what goods or services are provided in such a way that the customer does not have exercise powers of perception or imagination⁷.

Obviously, AMLO is just a shortened version of the generic name "AMLODIPINE". There is no other feature or component added to or accompanying AMLO that would at least render some distinctive property. "5" stands for the dosage ("5 mg"). In fact, "5" was disclaimed. Also, the mark is descriptive. Thus, consumers encountering the Respondent-Applicant's product readily see AMLO as a mere contraction of its generic name AMLODIPINE and 5 as the dosage indication.

⁵ *Societes Des Produits Nestle, S.A. v. Court of Appeals*, G.R. No. 112012, 4 Apr. 2001.

⁶ *Converse Rubber Corp. v. Universal Rubber Products, Inc. et.al.* G.R. No. L-27906, 08 Jan. 1987.


⁷ *Societe Des Produits, Nestle, S.A. v. Court of Appeals*, G.R. No. 112012, 4 Apr. 2001.

Thus, as far as using the mark on AMLODIPINE products is concerned, the Respondent-Applicant's trademark application should not be allowed. If the mark is registered in its favour, the Respondent-Applicant is conferred a monopoly or exclusivity of use of the mark or word "AMLO", giving it the right to prevent others even from or sue them for using or printing on their labels or package the generic name AMLODIPINE.

WHEREFORE, the instant opposition is hereby SUSTAINED on the grounds stated above. Let the filewrapper of Trademark Application Serial No. 4-2010-007322 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 13 August 2014.


NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs