



**NOVARTIS AG,**

Opposer,

IPC No. 14-2010-00028

-versus-

Opposition to Trademark

Application No. 4-2009-003942

Date Filed: 21 April 2009

**SUHITAS PHARMACEUTICALS, INC.,**

Respondent-Applicant.

Trademark: "DOGREL"

X ----- X

Decision No. 2014-267

### DECISION

Novartis AG<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2009-003942. The contested application, filed by Suhitas Pharmaceuticals, Inc.<sup>2</sup> ("Respondent-Applicant"), covers the mark "DOGREL" for use on "*pharmaceutical (anti-thrombotic)*" under Class 05 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the provision of Section 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines (IP Code). It alleges that its mark "CARDOGREL" and Respondent-Applicant's mark "DOGREL" are confusingly similar for the following reasons:<sup>4</sup>

- a. All the letters D-O-G-R-E-L in Respondent-Applicant's mark are present in Novartis' mark.
- b. The letters D-O-G-R-E-L in Respondent-Applicant's mark are in the same order as Novartis' mark.
- c. Due to the identity of the six letters, both marks "look" alike when viewed from a distance.
- d. Aside from the first syllable CAR in Novartis' mark, the syllables DO-GREL or DOG-REL in both marks are identical.
- e. Because of the near unanimity in the letters and syllables of the two (2) marks, the syntax, the sound and the pronunciation of the words are the same. Phonetically, therefore, the two marks are confusingly similar.

The Opposer avers that its mark "CARDOGREL" has been applied and registered in various countries including the Philippines. It claims that its mark

<sup>1</sup> A corporation duly organized and existing under and by virtue of the laws of Switzerland, with business address at CH-4002 Basel, Switzerland.

<sup>2</sup> A corporation organized and existing under and by virtue of the laws of the Philippines with office address at 3<sup>rd</sup> Floor Centerpoint Building, Pasong Tamo corner Export Bank Drive, Makati City.

<sup>3</sup> 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.

<sup>4</sup> See Verified Opposition, p. 6.



sufficiently met the requirements to be declared well-known. It contends that the purchasing public will most likely be deceived to purchase the Respondent-Applicant's goods in belief that they purchasing that of its own company in view of the similarity of the goods covered by the competing mark. It believes that this will result to damage to the purchasing public and to its own business and goodwill.

In support of its Opposition, the Opposer submitted the following as evidence:

1. certified true copies of the Peruvian Certificate of Registration No. 00153795, Uzbekistani Certificate of Registration No. 17814 and Albanian Certificate of Registration No. 12282 for the mark "CARDOGREL", the originals of which are on file in IPC Case No. 14-2009-000217 entitled "Westmont Pharmaceuticals, Inc. vs. Novartis AG";
2. copy of the Opposer's worldwide trademark portfolio for the mark "CARDOGREL";
3. legalized Joint Affidavit-Testimony of witnesses Marcus Goldbach and Andrea Felbermeir; and
4. pages from Novartis AG Annual Report for the year 2008.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 26 February 2010. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 19 August 2014 Order No. 2014-1089 declaring the Respondent-Applicant in default and the case submitted for decision.

The primordial issue in this case is whether the trademark "DOGREL" should be allowed.

The Opposer anchors its opposition on Section 123.1 (d) of the IP Code which provides:

**"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; xxx"**

Records show that at the time the Respondent-Applicant filed its trademark application, the Opposer already has an existing application for the mark "CARDOGREL" (No. 4-2008-015373) filed on 19 December 2008. The application



covers "pharmaceutical veterinary and sanitary preparations; dietetic substance adapted for medical use, food for babies; plasters, material for dressing; material for stopping teeth, dental wax".

Both parties use the word "DOGREL" in their trademarks making the Respondent-Applicant's applied mark appear as if it is merely a variation of the Opposer's trademark "CARDOGREL". The likelihood of confusion is high especially that both marks pertain to pharmaceutical products.

But the more compelling reason not to allow the Respondent-Applicant to register the mark is the fact that it is just a part of the generic or international nonproprietary name (INN) *clopidogrel*. To allow Respondent-Applicant to register "DOGREL" is tantamount to giving the said company an undue advantage over its competitors and cause confusion among the consumers who would be easily deceived that what they are buying is a generic drug.

Succinctly, Section 123 of the IP Code provides, in part, that a mark cannot be registered if it:

"x x x

**(h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;**

**(i) Consists 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 established trade practice;**

**(j) Consists exclusively of signs or of 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; x x x"**

Generic names 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 a 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 of powers of perception or imagination.<sup>5</sup>

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<sup>5</sup> Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.



Significantly, this Bureau takes judicial notice of Inter Partes Case No. 14-2009-000249 entitled "Sanofi-Aventis vs. Ranbaxy Laboratories Limited". This Bureau decided the cited case by sustaining the opposition to the application for the registration of the mark "IRBESAR" on the ground that it is confusingly similar to and is a virtual replication of "IRBESARTAN", which is the generic name for a drug mainly used for treating hypertension. The Director General sustained this Bureau's ruling in his decision dated 17 December 2012, to wit:

***"As correctly pointed out by the Appellee (Sanofi-Aventis):***

***3.1. All the letters in Respondent-Applicant's mark IRBESAR form part of the INN 'IRBESARTAN'. In fact, all the seven (7) letters in the Respondent-Applicant's IRBESAR mark constitute the first seven (7) letters of the INN o generic name 'IRBESARTAN'.***

***3.2. The last three letters of the Respondent-Applicant's IRBESAR mark, namely, the letters S, A and R, consist of a substantial part of the common stem- SARTAN of the INN system.***

***3.3. It bears stressing that the INN 'IRBESARTAN' and the Respondent-Applicant's mark IRBESAR are both used for pharmaceutical products, the former being the generic name of the latter.***

***"Accordingly, the similarities in IRBESAR and IRBESARTAN are very obvious that to allow the registration of IRBESAR is like allowing the registration of a generic term like IRBESARTAN. Their similarities easily catches one's attention that the purchasing public may be misled to believe that IRBESAR and IRBESARTAN are the same and one product.***

***"A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate. Significantly, the registration of IRBESAR would give the Respondent-Applicant the exclusive right to use this mark and prevent others from using similar marks including the generic name and INN IRBESARTAN. This cannot be countenanced for it is to the interest of the public that a registered mark should clearly distinguish the goods of an enterprise and that generic names and those confusingly similar to them be taken outside the realm of registered marks. x x x"***

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.<sup>6</sup> Respondent-Applicant's trademark fell short in meeting this function.

While it is true that the Opposer's mark also appropriated "DOGREL", this is used in conjunction with the syllable "CAR". The addition of the prefix "CAR" to "DOGREL" rendered distinctive property, although weak, on the Opposer's mark.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-003942 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 24 October 2014.



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

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<sup>6</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.