



NOVARTIS AG,
Opposer,

-versus-

EON PHARMATEK INC.,
Respondent-Applicant.

}
} IPC No. 14-2013-00444
} Opposition to:
} Application No.4-2013-05100
} Date filed: 03 May 2013
} TM: "EOPLATIN"
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NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES

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8741 Paseo de Roxas, Makati City

EON PHARMATEK, INC.


Respondent-Applicant
Unit 703 AIC Burgundy Empire Tower
ADB Avenue, Ortigas Center
Pasig City

GREETINGS:

Please be informed that Decision No. 2015 - 30 dated March 12, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 12, 2015.

For the Director:


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



NOVARTIS AG,

Opposer,

IPC No. 14-2013-00444

-versus-

Opposition to Trademark

Application No. 4-2013-05100

Date Filed: 03 May 2013

EON PHARMATEK INC.,

Respondent-Applicant.

Trademark: **"EOPLATIN"**

x ----- x Decision No. 2015- 30

DECISION

Novartis AG¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-005100. The contested application, filed by EON Pharmatek Inc.² ("Respondent-Applicant"), covers the mark "EOPLATIN" for use on *"pharmaceuticals-antineoplastic tablet, suspension capsule, solution for injection (I.V.), solution, cream, ointment"* under Class 05 of the International Classification of Goods³.

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 "EBEPLATIN" and the Respondent-Applicant's mark "EOPLATIN" are confusingly similar for the following reasons:⁴

- a. EOPLATIN share seven of eight letters, E-P-L-A-T-I-N of Opposer's trademark, EBEPLATIN. The common seven of eight letters in EOPLATIN are arranged in the same order, E--P-L-A-T-I-N as in Opposer's mark EBEPLATIN. x x x
- b. EOPLATIN also has the same three syllables, E-o-PLA-TIN vis-à-vis E-be-PLA-TIN. There is hardly any difference in sound and pronunciation. x x x
- c. Viewed from the distance, EBEPLATIN and EOPLATIN "look" alike. EBEPLATIN and EOPLATIN are exactly alike in sound, appearance and connotation. The identity of the two words in terms of appearance and spelling is therefore not only very strong, but dominant. Being alike in appearance and spelling, they are also practically and phonetically the same having the same sound and pronunciation.

The Opposer avers that the goods covered by both marks are closely-related and fall under the same Class 05. It claims that these are sold in the same channels of business and trade; hence, the confusion on the consuming public is greater. It

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 corporation organized and existing under and by virtue of the laws of the Philippines with address at Unit 703, AIC Burgundy Empire Tower, ADB Avenue, Ortigas Center, 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 See Verified Notice of Opposition. **Republic of the Philippines**

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contends that in view of the similarity of the covered goods, the purchasing public will most likely be deceived to purchase "EOPLATIN" in the belief that they are purchasing its product "EBEPLATIN".

In support of its Opposition, the Opposer submitted the following as evidence:⁵

1. copy of Trademark Registration No. 4-2013-00458 for "EBEPLATIN";
2. certified true copy of Corporate Certificate dated 10 May 2012;
3. notarized and legalized joint affidavit-testimony of witnesses Susanne Groeschel-Jofer and Andrea Felbermeir; and
4. Novartis AG Annual Report for 2012.

This Bureau issued a Notice to Answer dated 27 January 2014 and served a copy thereof upon the Respondent-Applicant. However, Respondent-Applicant failed to comply. Accordingly, the Hearing Officer issued on 15 May 2014 Order No. 2014-635 declaring the Respondent-Registrant in default and the case submitted for decision.

The primordial issue in this case is whether the Respondent-Applicant's trademark application for the mark "EOPLATIN" should be allowed registration.

Records reveal that the Opposer filed an application for its mark "EBEPLATIN" on 16 January 2013. The Trademark Registry, which this Bureau can take judicial notice, shows that Certificate of Registration No. 4-2013-458 was eventually issued to it on 16 May 2013. On the other hand, the Respondent-Applicant filed the contested application for its mark "EOPLATIN" only on 03 May 2013.

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 Opposer and Respondent-Applicant are confusingly similar, the two are shown hereafter for comparison:

⁵ Exhibits "A" to "D".

EBEPLATIN EOPLATIN

Opposer's mark

Respondent-Applicant's mark

The marks are apparently similar with respect to its final syllable "PLATIN". The term *platin*, however comes from the generic name stem for antineoplastics⁶, which is the kind of products the marks cover. 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 one when one sees or hears a mark or brand name of antineoplastics of which the "platin" is a part of is the very concept or idea of the goods. As such, the Opposer cannot claim exclusive use or protection on the mere fact that another trademark appropriates "platin".

What will set apart or distinguish such mark from another which also includes the term "platin" is the letters, syllable or words that come before or after the generic name. In this case, the Opposer's mark begins with "EBE" while that of the Respondent-Applicant's with "EO". Clearly, they are confusingly similar visually and aurally. In effect, the Respondent-Applicant merely dropped the "BE" in the Opposer's mark and substituted the same with the letter "O". Just the same, the marks appear and sound almost identical. The Respondent-Applicant failed to introduce any element that would make the mark it seeks to register clearly distinctive or distinguishable from the Opposer's. 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 purchasers as to cause him to purchase the one supposing it to be the other.⁷

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two types 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*: "Here though the goods of the parties are different, the defendant's product is such as might

⁶ <http://druginfo.nlm.nih.gov/drugportal/jsp/drugportal/DrugNameGenericStems.jsp>

⁷ *Societe des Produits Nestle, S.A. vs. Court of Appeals*, GR No. 112012, 04 April 2001.

reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁸

In this case, it is noteworthy that the Respondent-Applicant's mark cover "*pharmaceuticals-antineoplastic tablet, suspension capsule, solution for injection (I.V.), solution, cream, ointment*" while the Opposer's registration is '*pharmaceutical preparations for human use*', both under Class 05. As the goods are closely-related, if not the same, it is highly likely that the purchasing public may be misled, confused or deceived that "EOPLATIN" is affiliated to, sponsored by or in any way connected to the Opposer.

Finally, 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.⁹ This Bureau finds that Respondent-Applicant's trademark consistent with this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-005100 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 12 March 2015.


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

⁸ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

⁹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November, 1999.