F. HOFFMANN-LA ROCHE AG, Opposer, **-versus-** **ATTY. AMBROSIO V. PADILLA III,** Respondent-Applicant.	}	**IPC No. 14-2012-00096** Opposition to: Application No. 4-2011-013175 Date filed: 03 November 2011 TM: **"RIVODIN"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 42 dated March 31, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 31, 2015.

For the Director:

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

F. HOFFMANN-LA ROCHE AG, Opposer, -versus- **ATTY. AMBROSIO PADILLA III,** Respondent-Applicant.	}	**IPC NO. 14-2012-00096** Opposition to: App.Serial No. 4-2011-013175 Date Filed: 03 November 2011 **TM: "RIVODIN"**
x----------x		**DECISION NO. 2015-** 42

DECISION

F. HOFFMANN-LA ROCHE AG ("Opposer"),[1] filed an opposition to Trademark Application Serial No. 4-2011-013175. The application, filed by ATTY.AMBROSIO PADILLA III ("Respondent-Applicant"),[2] covers the mark "RIVODIN" for use on *"(pharmaceutical product) - a first-line drug for the treatment of typical absences, a typical absences such as lennox-gastaut syndrome, myoclonic seizures and atonic seizures such as drop syndrome; as a third-line drug for the treatment of tonic-clonic seizures, simple and complex partial seizures and in secondary generalized tonic-clonic seizures; for the treatment of panic disorder, with or without agoraphobia"* under Class 05 of the International Classification of Goods. [3]

The Opposer alleges, among others, the following:

"1. Opposer is the first user and true owner of the trademark **RIVOTRIL**, which is registered in its name in the Philippines under Reg. No. 32394 issued on August 11, 1983 and which covers "anti-epileptic preparations" in Class 5. Moreover, Opposer has been using the trademark **RIVOTRIL** specifically in respect of preparations for the "treatment of epilepsy in infants and children, in particular typical and atypical absences (Lennox syndrome), nodding spasms, primary or secondary generalized tonic-clonic seizures" since the approval of its product launching by the then Bureau of Food and Drugs even prior to 2000, long before the applicant appropriated the mark **RIVODIN** for use on identical preparations. Opposer has been actively promoting and selling **RIVOTRIL** in the Philippines since its launching date, it remains to be one of the most recognized and accepted preparations for the treatment of epilepsy and related symptoms by doctors and patients in the country.

"2. Applicant's trademark **RIVODIN**, as used on pharmaceutical preparations for the treatment of the treatment of typical absences, atypical absence such as Lennox Gastaut syndrome, myclonic seizures and atonic seizures such as drop syndrome..." so closely, aurally

[1] A foreign corporation organized under the laws of Switzerland.
[2] A Filipino citizen with address at Unit 1001, 88 Corporate Center, Sedeno corner Valero Streets, Salcedo Village, Makati City.
[3] The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

and visually, resembles Opposer's trademark **RIVOTRIL** as also used on identical pharmaceutical preparations in Class 5 as to be likely, when applied to or used in connection with the goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public. The registration and use of a confusingly similar trademark by the Applicant will tend to deceive and/or confuse purchasers into believing that Applicant's product emanate from or are manufactured or distributed under the sponsorship of Opposer, for the following reasons:

i) the trademarks are closely and confusingly similar;
ii) the trademarks are applied on identical goods;
iii) the parties are engaged in competitive business; and
iv) the goods on which the trademarks are used are bought by the same class of purchasers and flow through the same channels of trade.

"3. The Applicant's adoption of the confusingly and deceptively similar trademark **RIVODIN** for its identical pharmaceutical preparations is very likely to mislead to the public into believing that his goods bearing the said trademark originate from, or are licensed or sponsored by Opposer, which has been identified in the trade and by consumers as the source of good trusted and reliable pharmaceutical preparations bearing the trademark **RIVOTRIL.**

"4. The registration and use by the Applicant of the trademark **RIVODIN** will diminish the distinctiveness and dilute the goodwill of Opposer's trademark **RIVOTRIL** , which is an arbitrary trademark for goods in Class 5, among others, and a registered mark protected under Sec 147 of the Intellectual Property Code ("IP Code"). Applicant's use of the published mark will obviously result in his trading on the Opposer's goodwill.

"5. The approval of the Applicant's trademark **RIVODIN** is based on the misrepresentation that he is the originator, true owner and first user of the trademark, when in truth, it should be proscribed as it appears to be merely a copy or close derivative of the Opposer's prior registered trademark **RIVOTRIL,** which has been used exclusively not only in the Philippines but around the world and in accordance with law since the Opposer's products identified by such mark was launched prior to 2000. It is clear that Applicant's adoption of the trademark **RIVODIN** for his own preparations will obviously result in capitalization on the popularity and brand recall of Opposer's trademark **RIVOTRIL.** In this sense, the registration and use of **RIVODIN** will give undue trade advantage to the Applicant at the expense and to the prejudice of the Opposer."

The Opposer's evidence consist of the following:

1. Exhibit "A" – legalized and authenticated Affidavit of Mr. Tapio Blanc;
2. Exhibit "B"– certified copy of Certificate of Renewal of Registration No. 32394 for the mark **RIVOTRIL** renewed on 11 August 2003Legalized Joint Affidavit-Testimony of Marcus Goldbach and Andrea Felbermeir; and
3. Exhibit "C" and D– certified copies of Certificate of Product Registration issued by the Food and Drug Administration;
4. Exhibit "E" - list of customers' names
5. Exhibit "F" - photographs of the boxes of the **RIVOTRIL** 2mg tablet; and
6. Exhibit "G" - sample of medicine information for the medicine **RIVOTRIL Clonazepam.**

This Bureau issued on 4 May 2012 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant on 17 May 2012. The Respondent-Applicant, however, has not filed his Answer. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark **RIVODIN**?

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. Thus, Sec. 123.1 (d) of the 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 a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its application for the mark **RIVODIN** on 03 November 2011, the Opposer has already been issued a registration for its trademark **RIVOTRIL** on 11 August 1983[4], covering goods falling under Class 05 for "anti-epileptic preparations" under Registration No. 4-32394.

The contending marks of the parties are reproduced below:

Rivotril	Rivodin
Opposer's Mark	*Respondent-Applicant's Mark*

Both marks are "word marks" that appeal both to the visual and the aural senses. What draw one's attention and easily registers in the mind when looking at the Opposer's mark are first two syllables "RIVO". These syllables are identical with the first and second syllables of the Respondent-Applicant's word mark. These parts of the Respondent-Applicant's mark are what immediately strikes the eye. Also, when **RIVOTRIL** is pronounced the same sound is practically replicated when one pronounces the Respondent-Applicant's **RIVODIN** mark.

Moreover, the goods covered by both marks are classified under the same international classification 5. In fact, they are used on similar generic drug which is "clonazepam" which is for the treatment of "*typical absences, atypical absences such as Lennox-Gastaut syndrome, myoclonic*

[4] See Exhibit "B"

seizures and atonic seizures such as drop syndrome; as a third-line drug for the treatment of tonic-clonic seizures, simple and complex partial seizures and in secondary generalized tonic-clonic seizures; for the treatment of panic disorder, with or without agoraphobia."[5] Thus, the goods are identical and/ or similar.

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[6]. Colorable imitation does not mean such similitude as amounts 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 trade name with that of the other mark or trade name 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[7].

Succinctly, because the Respondent-Applicant, like the Opposer, will use or uses the mark RIVODIN on similar pharmaceutical products , the difference in the mark did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. There is the likelihood that information, assessment, perception or impression about RIVODIN products delivered and conveyed through words and sounds and received by the ears may unfairly cast upon or attributed to the RIVOTRIL products and 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.[8] 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:[9]

> 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 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.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

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[5] See Exhibit "D" of Complainant and Trademark Application of Respondent-Applicant.

[6] See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

[7] See *Emerald Garment Manufacturing Corp. v. Court of Appeals.* G.R. No. 100098, 29 Dec. 1995.

[8] See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

[9] See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-013175, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 March 2015.

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