NOVARTIS AG, Opposer, **-versus-** **PHIL SHIN POONG PHARMA INC.,** Respondent-Applicant.	}	**IPC No. 14-2013-00147** Opposition to: Appln No. 4-2012-009601 Date Filed: 03 August 2012 TM: **"ACZEBRI"**

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NOTICE OF DECISION

E. B. ASTUDILLO & ASSOCIATES
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8741 Paseo De Roxas
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PHIL SHIN POONG PHARMA, INC.
Respondent-Applicant
Unit 2314 Medical Plaza, Ortigas Building
San Miguel Avenue, Ortigas Center
Pasig City

GREETINGS:

Please be informed that Decision No. 2015 - 44 dated April 01, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 01, 2015.

For the Director:

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

NOVARTIS AG,

Opposer,

-versus-

PHIL SHIN POONG PHARMA INC.,

Respondent-Applicant.

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IPC No. 14-2013-00147
Opposition to Trademark
Application No. 4-2012-009601
Date Filed: 03 August 2012
Trademark: **"ACZEBRI"**

Decision No. 2015-44

DECISION

Novartis AG[1] ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-009601. The contested application, filed by Phil Shin Poong Pharma Inc.[2] ("Respondent-Applicant"), covers the mark "ACZEBRI" for use on *"pharmaceutical praparations – non steroidal anti-inflammatory agent"* under Class 05 of the International Classification of Goods[3].

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 maintains that it is the owner of the mark "SEEBRI", which it has registered under Certificate of Registration No. 4-2011-000891 issued on 19 May 2011. It contends that "SEEBRI" and "ACZEBRI" look alike when viewed from a distance and that they are almost identical when read. It asserts that the letter "Z" in the Respondent-Applicant's mark can easily be mistaken for the letter "E" and in which case, the mark "ACZEBRI" can be misread as "ACEEBRI", therefore, making it even more easily confused with "SEEBRI". It moreover posits that since both marks cover similar goods under Class 05, confusion is more likely to arise as to the source if goods bearing each mark. It furthermore states that the goods flow in the same channels of business and trade.

In support of its Opposition, the Opposer submitted the following as evidence:[4]

1. notarized and legalized Affidavit-Testimony of Mireille Valvason;
2. its Annual Report for 2012;
3. list of "SEEBRI" trademark registrations;
4. brief history of "SEEBRI" including the date(s) and place(s) first used;
5. copies of media releases; and

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

[2] With known address at Unit 2314 Medical Plaza Ortigas Building, San Miguel Ave., Ortigas Center, Pasig City, Philippines.

[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 "B" to "G", inclusive.

6. countres where goods and services bearing the "SEEBRI" mark are sold.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 26 june 2013. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 24 October 2013 Order No. 2013-1478 declaring the Respondent-Applicant in default and submitting the case for decision.

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

Section 123.1(d) of the IP Code, relied upon by Opposer, provides that:

> ***"Section 123.1. A mark cannot be registered if it:***
>
> ***xxx***
>
> ***(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 x x x"*** (Emphasis supplied.)

Records reveal that the Opposer was issued registration for its mark "SEEBRI" as early as 19 May 2011. The Respondent-Applicant, on the other hand, filed its application for the mark "ACZEBRI" only on 03 August 2012.

A comparison of the competing marks, depicted below:

SEEBRI ACZEBRI

Opposer's mark *Respondent-Applicant's mark*

shows that both end with the letters and/or syllable "BRI", which is neither generic nor descriptive to the products they cover. Also, the syllables "SEE" and "ZE" sound similar. Notwithstanding the fact that the Respondent-Applicant put the letters "AC" before "ZEBRI", confusion is likely in this instance. 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 purchased as to cause him to purchase the one supposing it to be the other.[5]

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[5] Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, April 4, 2001.

Taken in their entirety, the competing marks reverberate practically the same sound when pronounced. In this connection, the ruling in **Marvex Commercial Co. vs. Peter Hawpia**[6] applies, to wit:

> ***"The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that 'SALONPAS' and 'LIONPAS' are confusingly similar in sound: 'Gold Dust' and 'Gold Drop'; 'Jantzen' and 'Jazz-Sea'; 'Silver Flash' and 'Supper-Flash'; 'Cascarete' and 'Celborite'; 'Celluloid' and 'Cellonite'; 'Chartreuse' and 'Charseurs'; 'Cutex' and 'Cuticlean'; 'Hebe' and 'Meje'; 'Kotex' and 'Femetex'; 'Zuso' and 'Hoo Hoo'. Leon Amdur, in his book 'TradeMark Law and Practice', pp. 419-421, cites, as coming within the purview of the idem sonans rule, 'Yusea' and 'U-C-A', 'Steinway Pianos' and 'Steinberg Pianos', and 'Seven-Up' and 'Lemon-Up. In Co Tiong vs. Director of Patents, this Court unequivocally said that 'Celdura' and 'Cordura' are confusingly similar in sound; this Court held in Sapolin Co. vs. Balmaceda, 67 Phil. 795 that the name 'Lusolin' is an infringement of the trademark 'Sapolin', as the sound of the two names is almost the same.***
>
> ***In the case at bar, 'SALONPAS' and 'LIONPAS', when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see Celanese Corporation of America vs. E. I. Du Pont, 154 F. 2d. 146, 148)."***

The likelihood of confusion is underscored by the fact that the trademark "ACZEBRI" is used or to be used for pharmaceutical products that are similar and/or closely related to those covered by the Opposer's trademark registration particularly, *pharmaceutical preparations for treatment of inflammatory disorders and for use in dermatology, oncology, hematology and in tissue and organ transplantation, in ophthalmology and for gastroenterological disorder; pharmaceutical preparations for the prevention and treatment of ocular disorders and diseases, bacteria-based diseases or disorders, autoimmune diseases or disorders, kidney diseases or disorders, and diabetes; antifungal preparations; anti-infectives; antivirals and antibiotics*.

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 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

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[6] G.R. No. L-19297, 22 December 1966.

and defendant which, in fact, does not exist."[7] Thus, the consumers may have the notion that Opposer expanded business and manufactured a new product by the name "ACZEBRI", which could be mistakenly assumed a derivative or variation of "SEEBRI".

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.[8] Respondent-Applicant's trademark fell short in meeting this function.

Accordingly, this Bureau finds and concludes that 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 filewrapper of Trademark Application Serial No. 4-2012-009601 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 01 April 2015.

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

[7] Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.
[8] Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.