



NOVARTIS AG,  
Opposer,

-versus-

QUALIFIRST HEALTH, INC.,  
Respondent-Applicant.

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IPC No. 14-2010-00099  
Opposition to:  
Appln No. 4-2009-007863  
Date Filed: 07 August 2009  
TM: "ANADOL"

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**NOTICE OF DECISION**

**E. B. ASTUDILLO & ASSOCIATES**

Counsel for the Opposer  
10<sup>th</sup> Floor Citibank Center  
8741 Paseo De Roxas  
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**OCHAVE & ESCALONA**

Counsel for Respondent-Applicant  
No. 66 United Street  
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**GREETINGS:**

Please be informed that Decision No. 2015 - 68 dated May 05, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 05, 2015.

For the Director:

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



NOVARTIS AG,

Opposer,

-versus-

QUALIFIRST HEALTH, INC.,

Respondent-Applicant.

IPC No. 14-2010-00099

Case Filed: 17 May 2010

Opposition to:

Application No. 4-2009-007863

Date Filed: 07 August 2009

Trademark: "ANADOL"

Decision No. 2015- 68

DECISION

NOVARTIS AG<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2009-007863. The application, filed by Qualifirst Health, Inc.<sup>2</sup> ("Respondent-Applicant"), covers the mark "ANADOL" for use on "analgesic/antipyretic pharmaceutical preparations" under Class 05 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x x x

"LEGAL GROUNDS FOR THE OPPOSITION"

"6. The trademark ANADOL being applied for by respondent-applicant is confusingly similar to opposer's trademark ELADOL, as to be likely, when applied to or used in connection with the goods of respondent-applicant, to cause confusion, mistake and deception on the part of the purchasing public.

"7. The registration of the trademark ANADOL in the name of respondent-applicant will violate Section 123.1, subparagraph (d) of the Intellectual Property Code of the Philippines, to wit:

x x x

"8. The registration of the trademark ANADOL in the name of respondent-applicant is contrary to other provisions of the Intellectual Property Code of the Philippines.

"IN SUPPORT OF THE OPPOSITION"

x x x

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

<sup>2</sup> With address at Unit 902 Citystate Condominium Corporation, 709 Shaw Blvd., Oranbo, Pasig City.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"9. It needs no exhaustive examination of the mark ELADOL of oppose and the mark ANADOL of respondent-applicant to see their confusing similarity. For comparative purposes, the two (2) marks are placed side by side, as follows:

x x x

"10. The mark ANADOL of respondent-applicant Qualifirst Health, Inc. is confusingly similar with the trademark ELADOL of oppose Novartis AG since:

- a. "Majority of the letters in the mark of respondent-applicant is also present in opposer's mark. Only the first two (2) letters in opposer's mark as well as respondent-applicant's mark is different from each other.
- b. "The letters A-D-O-L in respondent-applicant's mark are present in Novartis' mark.
- c. "The letters A-D-O-L in respondent-applicant's mark are in the same order as Novartis' mark.
- d. "Due to the identity of the four (4) letters, both marks "look" alike when viewed from a distance.

"11. Indubitably, opposer's and respondent-applicant's marks are confusingly similar. The case of American Wire and Cable Co. vs. Director of Patents (G.R. No. L-26557, February 18, 1970) where the Supreme Court found that DURAFLEX and DYNAFLEX are confusingly similar, finds application in the instant case, to wit:

x x x

"12. The prefix EL in opposer's mark and the prefix AN in respondent-applicant's mark do not negate confusing similarity between these marks of oppose and respondent-applicant. The test of confusing similarity which would preclude the registration of a trademark is not whether the challenged mark would actually cause confusion, mistake or deception in the minds of the purchasing public but whether the use of such mark would likely cause confusion or mistake. The law does not require that the competing marks must be so identical as to produce actual error or mistakes. It is sufficient that the similarity between the two marks be such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it. (Acoje Mining Co., Inc. vs. Director of Patents, 38 SCRA 480 [1971]).

"13. Moreover, it is settled jurisprudence that identity or similarity in the dominant features of two (2) competing marks will cause mistake or confusion in the minds of the purchasing public. The case of Co Tiong Sa vs. Director of Patents (95 Phil. 1 [1954]) categorically held, as follows:

x x x

"14. It has also been held in the case of Phil. Nut Industry, Inc. vs. Standard Brands, Inc. (G.R. No. L-23035, 31 July 1975, 65 SCRA 575) that:

x x x

"15. The dominancy test was applied by the Supreme Court in many other cases including *Lim Hoa vs. Director of Patents* (100 Phil 214 [1956]), *Converse Rubber Corporation vs. Universal Rubber Products, Inc.* (G.R. No. L-27906, 08 January 1987, 147 SCRA 154) and *Asia Brewery, Inc. vs. Court of Appeals* (G.R. No. 103543, 05 July 1993, 224 SCRA 437).

"16. In the recent case of *McDonald's Corporation, et. al. vs. L.C. Big Mak Burger, et. al.* (G.R. No. 143993, August 18, 2004), the Supreme Court likewise applied the test of dominancy in determining that the mark BIG MAC of McDonald's Corporation and the mark BIG MAK of L.C. Big Mak Burger are confusingly similar. The Court ruled, as follows:

x x x

"17. The reasoning in the McDonald's case (supra) applying the Dominancy Test is relevant in the instant case. The dominant feature in opposer's mark ELADOL is the suffix LADOL which which is practically identical to the dominant feature, NADOL of respondent-applicant's mark ANADOL. The difference in the first letter-syllable "E" of opposer's trademark and the first letter-syllable "A" of respondent-applicant's trademark is inconsequential. This marginal distinction does not sufficiently distinguish the two marks from each other as they are similar in pronunciation, syntax sound and appearance. As such, the two (2) marks are, for all intents and purposes, practically identical and confusingly similar. The purchasing public will easily recognize and remember the common letters: A-D-O-L, and hence, it is very easy to mistake respondent-applicant's products bearing the mark ANADOL for opposer's goods bearing the mark ELADOL.

x x x

"18. Opposer's mark and respondent-applicant's mark both cover similar and competing goods under international Class 5.

Opposer's mark ELADOL covers:

*"Pharmaceutical veterinary and sanitary preparations.  
Dietetic substances adapted for medical use, food for babies. Plasters,  
materials for dressings. Material for stopping teeth, dental wax."*

While respondent-applicant's mark ANADOL covers:

*"Analgesic/antipyretic pharmaceutical preparations.."*

Evidently, both marks are used on similar and competing goods. Both cover pharmaceutical goods for human use under the same classification (International Class 5). Both are also sold, marketed and/or found in the same channels of business and trade, namely pharmacies, clinics hospitals and/or doctor's offices. Hence, confusion will be more likely to arise in the minds of the purchasing public.

"19. In the case of *Esso Standard Eastern, Inc. vs. Court of Appeals, et al.* (G.R. No. L-29971, August 31, 1982), the Supreme Court held that:

x x x

"20. In view of the similarity of the covered goods under International Class 5, the purchasing public will most likely be deceived to purchase respondent-applicant's goods in the belief that they are purchasing opposer's goods. This will thus result to damage to the public and to opposer's established business and goodwill, which should not be allowed.

x x x

"21. A boundless choice of words, phrases and symbols is available to a person who wishes to have a trademark sufficient unto itself to distinguish its products from those of others. There is no reasonable explanation therefore for respondent-applicant to use the mark ANADOL for "Analgesic/antipyretic pharmaceutical preparations" under the same Class 5 when the field for its selection is so broad. Respondent-applicant obviously intends to pass off its product as those of opposer.

"22. In the case of American Wire & Cable Co. vs. Director of Patents (G.R. No. L-26557, February 18, 1970), the Supreme Court held that:

x x x

"23. Moreover, it has been held in many other cases, like the foregoing that:

x x x

"24. Indubitably, the registration and use of the trademark ANADOL by respondent-applicant will deceive and/or confuse purchasers into believing that respondent-applicant's goods and/or products bearing the trademark ANADOL emanate from or are under the sponsorship of oppose Novartis AG, the rightful owner of the trademark ELADOL in the Philippines and around the world.

"25. In view of the foregoing, opposer's mark ELADOL which is legally protected under Philippine laws bars the registration in the Philippines of the confusingly similar mark ANADOL of respondent-applicant Qualifirst Health, Inc.

The Opposer's evidence consists of a copy of the duly authenticated corporate secretary's certificate issued by Monika Matti, Corporate Secretary of Novartis AG; legalized joint affidavit-testimony of Marcus Goldbach and Andrea Felbermeir and pages from Novartis AG's Annual Report for the year 2009.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 03 June 2010. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark ANADOL?

<sup>4</sup> Marked as Exhibits "A" to "C", inclusive.

It is emphasized that 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>5</sup>

Thus, Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

Sec. 123. Registrability. -- 123.1. A mark cannot be registered if it:

x x x

- (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;"

This Bureau takes cognizance via judicial notice of the fact that, based on the records of the Intellectual Property Office of the Philippines, the Opposer filed a trademark application for ELADOL on 02 July 2009. The application covers pharmaceutical, veterinary and sanitary preparations, dietetic substances adapted for medical use, food for babies, plasters, materials for dressings, material for stopping teeth, dental wax under Class 05. On the other hand, the Respondent-Applicant filed the trademark application subject of the opposition on 07 August 2009.

But, are the competing marks, as shown below, resemble each other such that confusion, or even deception is likely to occur?

**ELADOL**

Opposer's trademark

**ANADOL**

Respondent-Applicant's mark

This Bureau noticed that the products covered by the marks have different preparations. Designated as ANADOL, Respondent-Applicant's pharmaceutical

<sup>5</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, GR. No. 114508, 19 November 1999, citing *Etheba v. Director of Patents*, *supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

products are intended to provide pain relief or work to reduce or prevent fever. Opposer's products covered under ELADOL include pharmaceutical, veterinary and sanitary preparations. However, confusion is likely in this instance because of the close resemblance between the marks and that the goods belong to Class 05, Medicines and Pharmaceutical preparations. Both marks have the same number of letters and syllables: /E/LA/DOL for Opposer's and /A/NA/DOL for Respondent-Applicant's. It could result to mistake with respect to perception because the marks sound so similar. Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"<sup>6</sup>, "SAPOLIN" and LUSOLIN"<sup>7</sup>, "CELDURA" and "CORDURA"<sup>8</sup>, "GOLD DUST" and "GOLD DROP". The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, to wit:


Two letters of "SALONPAS" are missing in "LIONPAS": the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance...."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.<sup>9</sup>

In conclusion, the subject trademark application is covered by the proscription under Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-007863 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 05 May 2015.

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

<sup>6</sup> *MacDonalds Corp, et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

<sup>7</sup> *Sapolin Co. v. Balmaceda and Germann & Co.*, 67 Phil, 705.

<sup>8</sup> *Co Tiong SA v. Director of Patents*, G.R. No. L- 5378, 24 May 1954; *Celanes Corporation of America vs. E. I. Du Pont de Nemours & Co.* (1946), 154 F. 2d 146 148.)

<sup>9</sup> *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297, 22 Dec. 1966.