

**NOVARTIS AG,**  
Opposer,

**-versus-**

**BIOLINK PHARMA,**  
Respondent-Applicant.

X-----X

} **IPC No. 14-2011-00170**  
}  
} Opposition to:  
} Appln. Serial No. 4-2010-012005  
} Date filed: 5 November 2010  
} TM: "BIOCLAV"

**NOTICE OF DECISION**

**E.B. ASTUDILLO & ASSOCIATES**

Counsel for the Opposer  
10<sup>th</sup> Floor, Citibank Center  
8741 Paseo de Roxas, Makati City

**FELICITO C. CORDERO**

Counsel for Respondent-Applicant  
Rm. 208, 2<sup>nd</sup> Floor Pasay City Hall  
F.B. Harrison St., Pasay City

**GREETINGS:**

Please be informed that Decision No. 2015 - \_\_\_\_ dated July 21, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 21, 2015.

For the Director:

**Atty. EDWIN DANILO A. DATII ;**  
Director III  
Bureau of Legal Affairs



NOVARTIS AG,	}IPC NO. 14-2011-00170
Opposer,	}Opposition to:
	}
-versus-	}Appln. Ser. No. 4-2010-012005
	}Date Filed: 5 November 2010
BIOLINK PHARMA,	}Trademark: BIOCLAV
Respondent-Applicant.	}
	}
x-----x	}Decision No. 2015-

**DECISION**

NOVARTIS AG, (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2010-012005. The application, filed by BIOLINK PHARMA, (Respondent-Applicant)<sup>2</sup>, covers the mark “BIOCLAV”, for use on “antibiotic drug” under Class 5 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the following grounds:

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

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

Section 123. Registrability.-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

<sup>1</sup> A corporation organized and existing under the laws of the Switzerland with address at 4002 Basel, Switzerland  
<sup>2</sup> A corporation organized and existing under Philippine laws with address at #35 Scout Lozano St., Brgy. Laging Handa, Quezon City  
<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion;

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

The Opposer also alleges the following:

"10. The mark BIOCLAV of the respondent-applicant Biolink Pharma is confusingly similar with the trademark BIOCLAVID of opposer Novartis AG since:

- a) All the letters, i.e. B, I, O, C, L, A and V in the mark of respondent are present in the opposer's mark.
- b) The first two syllables BI-O in opposer's and respondent's mark are identical; the third syllable CLAV of opposer's mark and respondent-applicant's mark is also identical, thus, compounding the likelihood of confusion between the opposer's BIOCLAVID and respondent-applicant's BIOCLAV.
- c) The presence of the last syllable VID in Novartis' mark BIOCLAVID does not negate confusing similarity with respondent-applicant's mark BIOCLAV considering all the syllables in respondent-applicant's mark are identical with opposer's mark. Xxx

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

Opposer's mark BIOCLAVID covers 'antibiotics' while the respondent-applicant's mark BIOCLAV covers 'antibiotic drug'

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 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. xxx

"23. The trademark BIOCLAVID was first used as early as November 1, 1998 in Sweden and on August 1, 2004 in the Philippines. The trademark BIOCLAVID is also extensively used in Denmark, Greece, Finland and Romania. xxx

"25. Opposer's application for the mark BIOCLAVID was filed on March 21, 1995 and subsequently registered on November 14, 2000, much earlier than respondent-applicant's application date for the

confusingly similar mark BIOCLAV on November 5, 2010. Hence, opposer's registration for the mark BIOCLAVID will bar the successful registration of respondent-applicant's confusingly similar mark BIOCLAV.

"26. Opposer is the owner of and/or registrant of many trademark registrations for the mark BIOCLAVID in several countries such as Algeria, Argentina, Armenia, Austria, Belarus, Benelux, Bosnia-Herzegovina, Bulgaria, Chile, Croatia, Czech Republic, Denmark, Dominican Republic, Egypt, European Union, Finland, Germany, Greece, Guatemala, Hungary, iceland, ireland, Undia, Italy, Kazahkstan, Krygystan, Liechtenstein, Macedonia, Moldova, Montenegro, Morroco, Poland, Romania, Russian Federation, Saudi Arabia, Serbia, Slovakia, Slovenia, Sudan, Sweded, Switzerland, Tajikistan, Ukraine and Uzbekistan for goods under International Class 5.xxx"

To support its opposition, the Opposer submitted as evidence the following:

1. Copy of Certificate of Registration No. 4-1995-101316 issued on 14 November 2000 for the mark "BIOCLAVID";
2. Copy of Certificate of Product Registration No. DRP -1612 issued by the Bureau of Food and Drugs;
3. Product Packaging of BIOCLAVID;
4. Copy of sales invoice indicating the product "BIOCLAVID";
5. Novartis AG's trademark portfolio;
6. Authenticated Corporate Secretary's Certificate dated 15 February 2010; and
7. Authenticated and notarized Joint Affidavit of Marcus Goldbach and Susanne Groschel-Jofer dated 28 April 2011.<sup>4</sup>

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 14 June 2011. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 24 June 2015 Order No. 2015-903 declaring the Respondent-Applicant to have waived its right to file an Answer.

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

Records show that at the time Respondent-Applicant applied for registration of the mark "BIOCLAV", the Opposer already registered the mark BIOCLAVID under Certificate of Registration No. 4-1995-101316 issued on 14 November 2000. The goods covered by the Opposer's trademark registration are also under Class 05, same as indicated in the Respondent-Applicant's trademark application.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

---

<sup>4</sup> Exhibits "A" to "G" inclusive of submarkings

The competing marks are reproduced below:

Opposer's mark

Respondent-Applicant's mark

It is reasonable to infer that "BIOCLAVID" is derived from the prefix "BIO" which is of common usage in the medical and pharmaceutical fields and from the generic name of the anti-biotic drug "CO-AMOXICLAV"<sup>5</sup>. However, the combination of "BIO" and "CLAV", plus the letters "ID", rendered the Opposer's mark distinctive property sufficient to acquire eligibility for registration, although as a suggestive mark. Thus, Opposer may have no exclusive use over the prefix "BIO" and the descriptive syllable "CLAV" but it does with respect to the resulting word or mark when "BIO" and "CLAV" are combined. In this regard, the Respondent-Applicant adopted the same combination of affixes/syllables, as a trademark for use on goods that are similar to the Opposer's. That the Respondent-Applicant dropped the letters "ID" from "BIOCLAVID" to become "BIOCLAV" is of no moment. Consumers will likely assume that one is just a variation of the other.

It also bears stressing that the Opposer's mark BIOCLAVID has been registered since 14 November 2000 under Registration No. 4-1995-101316<sup>6</sup> and registered with the Bureau of Food and Drugs under DRP-1612<sup>7</sup> since 2009. Succinctly, the public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. 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>8</sup> This Bureau finds that the mark applied for registration by the Respondent-Applicant does not meet this function.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2010-012005 is hereby **SUSTAINED**. Let the filewrapper of the

<sup>5</sup> Exhibit "B"

<sup>6</sup> Exhibit "A"

<sup>7</sup> Exhibit "B"

<sup>8</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Elepha 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).

subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 21 July 2015.

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