



NOVARTIS AG,
Opposer,

-versus-

TARBOS PHARMA PVT. LTD.,
Respondent-Applicant.

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}
} **IPC No. 14-2013-00412**
} Opposition to:
} Appln. Serial No. 4-2013-005105
} Date filed: 06 May 2013
} TM: "ORIBRO"
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NOTICE OF DECISION

E. B. ASTUDILLO & ASSOCIATES
Counsel for the Opposer
Citibank Center, 10th Floor
8751 Paseo de Roxas, Makati City

TARBOS PHARMA PT. LTD.
c/o **CARMINA REGUDO**
Respondent-Applicant's Agent
5A-1 Gervasia Centre
152 Amorsolo Street, Legaspi Village
Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 157 dated July 27, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 27, 2015.

For the Director:

MARILYN S. RETUTAL
IPRS IV, Bureau of Legal Affairs



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- versus -

TARBOS PHARMA PVT., LTD.,
Respondent-Applicant,

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IPC NO. 14-2013-00412

Opposition to:

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Date Filed: 06 May 2013

TM: ORIBRO

Decision No. 2015- 157

DECISION

Novartis AG¹("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-005105. The contested application, filed by Tarbos Pharma Pvt., Ltd.² ("Respondent-Applicant"), covers the mark "ORIBRO" for use on "pharmaceutical product namely as antibacterial, third generation cephalosporin antibiotic" under Class 05 of the International Classification of Goods³.

The Opposer anchors its opposition on 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 "ULTRIBO" and Respondent-Applicant's mark "ORIBRO" are confusingly similar as both belong under Class 05 and are sold, marketed and/or found in the same channels of trade. According to the Opposer:⁴

"(a) Four (4) out of six (6) letters in the published mark, i.e. I, B, R, O, are identical to and are arranged.

"(b) The letters and syllables, I-BRO, in the mark ORIBRO are also present and consist the dominant features of Novartis trademark. ULTRIBO. x x x

"(c) The marks are visually similar. They share the common letters I-B-R-O. The last syllable in both marks, -BRO, are identical. Only the first syllable in each mark sets them apart. However, this is not sufficient to distinguish the marks.

"(d) Both marks consist of three (3) syllables, i.e. UL-TI-BRO and OR-I-BRO.

¹ A corporation organized and existing under the laws of the Switzerland with principal office located at 4002 Basel, Switzerland.

² With address at 32-1-C, Block 6, Pechs, Karachi (PK).

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 purposes of the Registration of Marks concluded in 1957.

⁴ See Notice of Opposition, pp 7-8.

“(e) Both marks are word marks in plain letterings and not stylized. Neither is in color or compounded with a unique device or design. Hence, the similarity between the two marks is even more pronounced or enhanced.

“(f) The syllable in the published mark, -BRO, are similar phonetically to Novartis’ trademark. There is hardly any difference in their sound and pronunciation. x x x

“(g) Because the letters, syllables and the sequence of the letters and syllables are practically the same, the marks ‘look’ alike. Furthermore, both marks are in plain block lettering without any distinguishing design or device accompanying each mark. hence, the marks are confusingly similar with each other in terms of over-all appearance.

“(h) The difference in the letters U, L and T vis-à-vis O and R is not sufficient to distinguish the mark ORIBRO from the mark ULTIBRO.

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

1. copy of the Certificate of Registration No. 4-2012-009860 for “ULTIBRO”;
2. affidavit-testimony of Mireille Valvason; and
3. its Annual Report for 2012.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 27 January 2014. The latter, however, did not file an Answer. Thus, the Hearing Officer issued Order No. 2014-636 on 15 May 2014 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved is whether the Respondent-Applicant’s mark “ORIBRO” should be allowed registration.

The instant opposition is anchored on Section 123.1(d) of the IP Code, which 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 priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

Records reveal that at the time Respondent-Applicant filed its application for its mark “ORIBRO” on 06 May 2013, the Opposer has an existing registration of the mark “ULTIBRO” issued as early as 10 August 2012 under Certificate of Registration No. 4-2012-009860.

But are the competing marks, as reproduced hereafter, confusingly similar?

⁵ Marked as Exhibits “A”, “B and “D”.

ULTIBRO

Opposer's mark

ORIBRO

Respondent-Applicant's mark

Upon observation of the subject trademarks, it can be readily gleaned that the two marks are confusingly similar. The Respondent-Applicant's mark also end with the letters "IBRO", which has no connection to cephalosporin antibiotics. It appears that the Respondent-Applicant merely replaced "OR" for the "ULT" in the Opposer's mark. Succinctly, 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.⁶

Noteworthy, the competing trademarks both refer to antibiotics under Class 05. Hence, they flow in the same channels of trade making confusion even more likely. Moreover, it has been time and again reiterated by the Supreme Court that the registered trademark owner may use his mark on the same or similar products, in different segments of the market, and at different price levels depending on variations of the products for specific segments of the market. The Court has recognized that the registered trademark owner enjoys protection in product and market areas that are the normal potential expansion of his business. Thus, the consumers may have the notion that Opposer expanded business and manufactured a new product by the name "ORIBRO", which could be mistakenly assumed a derivative or variation of "ULTIBRO".

Furthermore, 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 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."⁷

⁶ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, April 4, 2001.

⁷ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

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. 4-2013-005105 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 27 July 2015.


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

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.