



NOVARTIS AG,  
Opposer,

-versus-

GETZ PHARMA (PVT.) LTD.,  
Respondent-Applicant.

x-----x

} IPC No. 14-2013-00047  
} Opposition to:  
} Appln. Serial No. 4-2012-011694  
} Date Filed: 21 September 2012  
} TM: "DIORA"

### NOTICE OF DECISION

**E. B. ASTUDILLO & ASSOCIATES**  
Counsel for the Opposer  
10<sup>th</sup> Floor, Citibank Center  
8741 Paseo de Roxas, Makati City

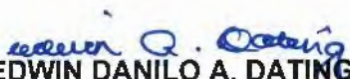
**GETZ PHARMA (PVT.) LTD.**  
Respondent-Applicant  
2/F Ortigas Bldg., Ortigas Avenue  
Pasig City

#### GREETINGS:

Please be informed that Decision No. 2015 - 191, dated September 16, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 16, 2015.

For the Director:

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



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GETZ PHARMA (PVT.) LTD.,  
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IPC NO. 14-2013-00047

Opposition to:

Appln. Ser. No. 4-2012-011694

Filing Date: 21 September 2012

Trademark: **DIORA**

Decision No. 2015 - 191

## DECISION

NOVARTIS AG<sup>1</sup> ("Opposer") filed on 14 August 2013 a Verified Opposition to Trademark Application No. 4-2012-011694. The application, filed by GETZ PHARMA (PVT.) LTD.<sup>2</sup> ("Respondent-Applicant") covers the mark **DIORA** for use on "*pharmaceutical products (diacerein) for the treatment of osteoarthritis*" under Class 5 of the International Classification of goods<sup>3</sup>.

The Opposer alleges the following grounds for the opposition:

### I.

"The registration of the trademark **DIORA** in the name of respondent-applicant is contrary to Section 123.1 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code").

"A. Respondent-applicant's mark **DIORA** is confusingly similar to opposer's registered mark **DIOVAN**, as to likely, when applied to or used in connection with the goods of respondent-applicant, cause confusion, mistake and deception on the part of the purchasing public.

"B. The goods covered by the respondent-applicant's mark **DIORA** are similar and competing with the goods covered by opposer's mark **DIOVAN** such that respondent-applicant's use of its mark will most likely cause confusion in the minds of the purchasing public.

### II.

As the prior registrant of **DIOVAN**, opposer has the superior and exclusive rights over said mark and other marks confusingly similar thereto, to the exclusion of any third party."

The Opposer's evidence consists of the following:

1. Exhibit "A" -copy of Certificate of Reg. No. 4-1996-109408 for the trademark **DIOVAN**;
2. Exhibits "B" and sub-markings - authenticated copy of the Corporate's Secretary's Certificate;
3. Exhibit "C" and sub-markings - legalized copy of Affidavit-Testimony of Mireille Valvason;
4. Exhibits "D" - copy of Novartis AG's Annual Report for the year 2012.

<sup>1</sup> A corporation duly organized and existing under the laws of Switzerland with principal office at CH-4002 Basel, Switzerland.

<sup>2</sup> A corporation duly organized and existing under the laws of Pakistan with business address at 29-30/27, Korangi Industrial Area, Karachi 74900, Pakistan.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE

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This Bureau issued on 12 April 2013 a Notice to Answer and personally served a copy thereof to the Respondent-Applicant's business address here in the Philippines on 17 April 2013. The Respondent-Applicant, however, has not filed his Answer. On 09 September 2013, an Order was issued declaring Respondent-Applicant in default for failing to file the Answer. Accordingly, 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 DIORA?

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.<sup>4</sup> 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 DIORA on 21 September 2012, the Opposer already has an existing registration for the trademark DIOVAN issued on 23 June 2000. Opposer's registration covers goods falling under Class 05 for "*medicines, pharmaceutical preparations, namely cardiovascular products*". On the other hand, Respondent-Applicant's mark covers "*pharmaceutical products (diacerein) for the treatment of osteoarthritis*" under Class 5 also. It appears that the parties' goods are different although they belong to the same class.

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

DIOVAN

*Opposer's Mark*

Diora

*Respondent-Applicant's Mark*

Confusion is likely in this instance because the marks closely resemble each other. Respondent-Applicant copied the prefix "DIO" of Opposer's mark and replaced the letters "V-A-N" with "R-A". Based on the Trademark Database, the prefix "DIO" is not a commonly used prefix in pharmaceutical products. In fact, it is only Opposer who has been using it since 1996 when they applied for registration of the mark DIOVAN, up to the present. Because of the resemblance of the marks as to likely cause confusion or mistake on the consumers, it does not matter if the pharmaceutical product where the marks will be used are different because it may happen that the pharmacist may misread the prescription and dispense one in lieu of the other or vice versa due to the similarity of the mark.

<sup>4</sup>See *Pribidas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

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 ingenious 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<sup>5</sup>. 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<sup>6</sup>.

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.<sup>7</sup> 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:<sup>8</sup>

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.

It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.<sup>9</sup>

Accordingly, this Bureau finds 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. 4-2012-011694 , together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 16 September 2015.

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

<sup>5</sup> See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

<sup>6</sup> See *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

<sup>7</sup> See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

<sup>8</sup> See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

<sup>9</sup> See *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990.