



NOVARTIS AG,
Opposer,

-versus-

VIDA NUTRISCIENCE, INC.,
Respondent-Applicant.

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}
} IPC No. 14-2012-00611
} Opposition to:
} Appln. Serial No. 4-2011-005082
} Date Filed: 04 May 2011
} TM: "UREX"
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}

NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES

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8741 Paseo de Roxas
Makati City

VIDA NUTRISCIENCE, INCORPORATED

Respondent-Applicant
#5 Ilang- Ilang Street
Barangay Bahay Toro, Quezon City

GREETINGS:

Please be informed that Decision No. 2015 - 207 dated September 28, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 28, 2015.

For the Director:


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



NOVARTIS AG,

Opposer,

-versus-

VIDA NUTRISCIENCE, INC.,

Respondent-Applicant.

x ----- x

IPC No. 14-2012-00611

Opposition to Trademark

Application No. 4-2011-005082

Date Filed: 04 May 2011

Trademark: "UREX"

Decision No. 2015- 207

DECISION

Novartis AG¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-005082. The contested application, filed by Vida Nutriscience, Inc.² ("Respondent-Applicant"), covers the mark "UREX" for use on "*pharmaceutical preparations, food supplement powder and capsule*" 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 "NUBEX" and Respondent-Applicant's mark "UREX" are confusingly similar for the following reasons:⁴

"(a) The dominant element in respondent-applicant's mark is the word UREX itself, which is confusingly similar to Novartis AG's mark NUBEX.

(b) The marks have the same number of syllables each. Four (4) out of six (6) letters in respondent-applicant's mark and Novartis AG's mark, i.e U-R-E-X, are identical.

(c) The marks are composed of two (2) syllables each, i.e. NUB-REX for respondent-applicant's mark and U-REX for Novartis' make, wherein the syllables are practically alike due to the same vowels U and E in each syllable.

(d) Likewise, because the letters, syllables and sequence of the letters and syllables are practically the same, the marks 'look' alike.

(d) Phonetically, therefore, the marks are also almost identical."

According to the Opposer, since "UREX" and "NUBEX" are used on the same and competing goods as both belong under Class 05 and are sold, marketed and/or found in the same channels of trade, confusion is more likely to arise in the minds of

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

² With address at #5 Ilang-Ilang Street, Brgy. Bahay Toro, Quezon City.

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 See Notice of Opposition, p. 5.

Republic of the Philippines

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the purchasing public. It asserts that as owner and prior applicant of the mark "NUBREX", it has superior and exclusive rights thereto to the exclusion of any third party.

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

1. copy of the Certificate of Registration No. 4-2008-004865;
2. copies of sales invoices showing sales of products bearing the mark "NUBREX" in the Philippines;
3. sample marketing material for the promotion of products bearing "NUBREX";
4. joint affidavit-testimony of Susanne Groeschel-Jofer and Andrea Febermeir; and,
5. Annual Report for 2011.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 24 October 2013. The latter, however, did not comply. Thus, the Hearing Officer issued Order No. 2015-900 on 17 June 2015 declaring the Respondent-Applicant in default and the case is deemed submitted for decision.

The issue to be resolved is whether the Respondent-Applicant's mark "UREX" 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 "UREX", the Opposer has an existing registration for the mark "NUBREX", issued on 11 August 2008 under Certificate of Registration No. 4-2008-004865. But are the competing marks, depicted below, confusingly similar?

Nubrex

UREX

Opposer's mark

Respondent-Applicant's mark

⁵ Marked as Exhibits "A" to "E".

What is common between the two is the syllable "REX". This notwithstanding, one mark can be easily distinguished from the other. What is immediately noticeable in the Opposer's mark is the syllable "NUB", such that when placed side-by-side, it is unlikely for one to confuse one mark for the other. There is no likelihood that one upon encountering "UREX", will be reminded of or associate it with the Opposer's "NUBREX", and vice-versa.

That confusion, much less deception, is unlikely in this instance is bolstered by the fact that in the Trademark Registry of this Office, the contents of which this Bureau can take judicial notice of, there are other registered marks for goods under Class 05 that belong to different proprietors containing the suffix "REX" such as "V-REX" under Certificates of Registration No. 4-2011-007367 and "EPREX" under Certificate of Registration No. 048632, issued to Unahco Feeds, Inc. and Jassen Pharmaceutica N.V., respectively. Thus, the Opposer cannot claim exclusive right over the use thereof.

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.⁶ The Respondent-Applicant's mark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-005082 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 September 2015.


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

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.