



NOVARTIS AG,
Opposer,

-versus-

EXTRA EXCEL INTERNATIONAL
(PHILS.), INC.,
Respondent-Applicant.

X-----X

} IPC No. 14-2011-00540
} Opposition to:
} Appln. No. 4-2011-005663
} Date Filed: 18 May 2011
} TM: "MENOVIÉ"

NOTICE OF DECISION

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


BRITANICO SARMIENTO & RINGLER LAW OFFICE
Counsel for Respondent-Applicant
7th Floor, BDO Plaza
8737 Paseo de Roxas, Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 231 dated October 22, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 22, 2015.

For the Director:


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



NOVARTIS AG,
Opposer,

-versus-

**EXTRA EXCEL INTERNATIONAL
(PHILS.), INC.,**

Respondent-Applicant.

x ----- x

IPC No. 14-2011-00540

Opposition to Trademark
Application No. 4-2011-005663
Date Issued: 18 May 2011

Trademark: "**MENOVIE**"
Decision No. 2015- 231

DECISION

Novartis AG¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-005663. The contested application, filed by Extra Excel International (Phils.), Inc.² ("Respondent-Applicant"), covers the mark "MENOVIE" for use on "*pharmaceutical as a food supplement capsule*" all under Class 05 of the International Classification of Goods.³

The Opposer anchors its opposition on Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It claims that its mark "MENVEO" is confusingly similar to the Respondent-Applicant's mark "MENOVIE" for the following reasons:⁴

1. Without the letter "O" in the middle of the word of the Respondent-Applicant's mark, it will read as "MENVIE" which is very close to "MENVEO". The words "MENVIE" and "MENVEO" are almost alike.
2. Both marks consist of similar first syllables, i.e. MEN. All of the letters of its mark are present in the published mark.
3. The last syllable "VEO" in its mark vis-à-vis "VIE" of the published mark are confusingly similar.
4. Likewise, because the letters, syllables and the sequence of the letters and syllables of the two marks are practically the same, they therefore "look" alike.
5. Both marks are wordmarks in plain letterings and not stylized. Neither are in color nor are compounded with a unique device or design. Hence, the similarity between the two marks is even more pronounced or enhanced.

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

² With address at 23F Rufino Pacific Tower, 6784 Ayala Avenue, Makati City 1226.

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, pp. 4-5.

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center
Fort Bonifacio, Taguig City 1634 Philippines
T: +632-2386300 • F: +632-5539480 • www.ipophil.gov.ph

The Opposer asserts that the confusion will be more likely to occur as the goods covered by the marks are similar and competing and that they are sold, marketed and/or found in the same channels of trade, namely pharmacies, clinics, hospitals and/or doctor's office. It avers that the Respondent-Applicant intends to pass off the latter's goods as those of its own.

In support of its Opposition, the Opposer submitted the legalized affidavit-testimony of John Ward⁵ and its Annual Report for 2010⁶.

The Respondent-Applicant filed its Verified Answer alleging that the instant Opposition must be dismissed for the Opposer's failure to timely the same. The Respondent-Applicant also avers that the certification of non-forum shopping is by virtue of a SPA dated 20 December 2011 but the attached Power of Attorney in the Opposer's Compliance submitted on 13 March 2012 is dated 16 December 2011. It asserts that the said Power of Attorney and Secretary's Certificate do not show Ward's authority to sign the verification and certification on non-forum shopping. It further states that the Power of Attorney is not acknowledged before the notary public.

The Respondent-Applicant denies that there is likelihood of confusion arguing that the goods that the marks cover differ in physical characteristics, administration, purpose dosage, source of purchase/supply and prospective buyers. It also disagrees that the marks are confusingly similar visually and aurally. It explains that "MENOVIÉ" is derived from "MENO", from the word "menopause" and which in medical dictionary means a combining form used with reference to menstruation in the formation of compound words such as "menopause" or "menorrhagia", and "VIÉ", which is a French word for life.

The Respondent-Applicant submitted as evidence the affidavit of Sandra Leh, with attachments.⁷

In the Preliminary Conference was held on 03 May 2013, only the Respondent-Applicant appeared and was directed to submit a position paper within ten days therefrom. For the Opposer's failure to appear, it is considered to have waived its right to submit its position paper.

The issues to be resolved are as follows:

- (a) Whether this Opposition should be dismissed for (1) being filed out of time and/or (2) failure to present John Ward's authority to sign the verification and certificate on non-forum shopping; and

⁵ Marked as Exhibit "B".

⁶ Marked as Exhibit "C".

⁷ Exhibit "1".

(b) Whether Respondent-Applicant's applied mark "MENOVIE" should be allowed registration.

On the procedural issues, records show that the Respondent-Applicant's mark was published on 02 November 2011. The motions for extension filed by the Opposer have been granted by this Bureau thereby until 31 January 2012 to file its Verified Notice of Opposition. On 16 January 2012, the Opposer filed the Verified Notice of Opposition but did not include the SPA and/or Secretary's Certificate showing Ward's authority to sign the verification and certificate of non-forum shopping. This Bureau issued Order No. 2012-183 requiring the submission of the said documents five days from receipt of the said Order. On 06 February 2012, the Opposer manifested that it received Order No. 2012-183 on 02 February 2012 and that the legalized certificate it previously submitted is a substantial compliance of the requirement of submission of the Corporate Secretary's Certificate as the same shows that a Power of Attorney dated 20 December 2010 was executed in favor of Ward. Finding the Manifestation insufficient, this Bureau issued Order No. 2012-280 giving the Opposer additional five days to submit the required documents in the interest of justice, which Order was received by the latter on 17 February 2012. On 22 February 2012, the Opposer filed a Motion for Extension of Time requesting for a period of twenty (20) days or until 13 March 2012. The Opposer filed the Compliance on 13 March 2012 attaching therewith documents entitled "Power of Attorney (US, UK, IT, DE, SG, CN)" and "Corporate Secretary's Certificate".

Scrutinizing the originally filed Certificate, it appears to be executed and signed by John Ward himself, claiming to be the authorized signatory of the Opposer by virtue of a certain Power of Attorney dated 20 December 2010. This Certificate, however, is self-serving. Ward cannot himself certify that he has the authority to prosecute the case without presenting the pertinent supporting documents. When this Bureau required the Opposer to submit the relevant document showing Ward's authority, it finally submitted the Power of Attorney and Corporate Secretary's Certificate.

The Power of Attorney submitted, however, is dated 16 December 2011 contrary to the statement in Ward's Certificate that his authority is by virtue of the Power of Attorney dated 20 December 2010. No explanation was offered by the Opposer in its Compliance with respect to the conflict of the dates. Moreover, it is stated in the submitted Power of Attorney that: *"To be legally binding upon the Company, all relevant documents require the signature of two employees of the Corporate Signatory as set out below ('Personal Signatories') authorized to sign for the respective Corporate Signatory."* In the verification, certificate of non-forum shopping and Certificate, however, only Ward's signature appears.

The Corporate Secretary's Certificate, on the other hand, cannot cure the deficiencies in the Power of Attorney as the document shows that the same was

signed on 24 February 2012 and legalized on 29 February 2012, which is after the filing of the Verified Opposition on 16 January 2012. Section 7 (b) of Office Order No. 99, Series of 2011 provides that:

"(b) x x x The verification and certification of non-forum shopping as well as the documents showing the authority of the signatory or signatories thereto, affidavits and other supporting documents, if executed and notarized abroad, must have been authenticated by the appropriate Philippine diplomatic or consular office. The execution and authentication of these documents must have been done before the filing of the opposition or petition."

The Supreme Court held that if a complaint is filed for and in behalf of the plaintiff who is not authorized to do so, the complaint is not deemed filed. An unauthorized complaint does not produce any legal effect. Hence, the court should dismiss the complaint on the ground that it has no jurisdiction over the complaint and the plaintiff.⁸ Failing to show Ward's authority to sign the verification and certificate on non-forum shopping, the case is dismissible outright.

Assuming arguendo that the Opposer met all the procedural requirements, the Opposition must still fail as this Bureau finds that the marks reproduced below are not confusingly similar:

MENVEO

Opposer's mark

MENOVIE

Respondent-Applicant's mark

Both marks similarly begin with the syllable "MEN". This notwithstanding, the Opposer's ending letters "VEO" is distinguishable from the Respondent-Applicant's "OVIE". This is especially because the Opposer's mark "MENVEO" is registered for "vaccines for human use" while the Respondent-Applicant's intends to use the mark "MENOVIE" for "pharmaceutical as a food supplement capsule". Although both falling under Class 05, it is highly unlikely for purchasers to confuse one for the other. Aply, the Supreme Court in **Mighty Corporation vs. E. & J. Gallo Winery**⁹ held:

"A very important circumstance though is whether there exists a likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. He is 'accustomed to buy, and therefore to some extent familiar with, the goods

⁸ Cosco Philippines Shipping, Inc. vs. Kemper Insurance Co., G.R. No. 179488, 23 April 2012.

⁹ G.R. No. 154342, 14 July 2004.

in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The simulation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase.”

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-005663 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 22 October 2015.


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