



NOVARTIS AG,
Opposer,

-versus-

WESTFIELD PHARMACEUTICAL, INC.,
Respondent-Applicant.

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} **IPC No. 14-2015-00028**
} Opposition to:
} Application No.: 4-2014-012532
} Date filed: 10 October 2014
} **TM: "DOXAIR"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 217 dated October 19, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 19, 2015.

For the Director:


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



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TM: **DOXAIR**

Decision No. 2015- 217

DECISION

NOVARTIS AG ("Complainant")¹ filed an opposition to the Trademark Application Serial No. 4-2014-012532. The application filed by WESTFIELD PHARMACEUTICAL, INC.² ("Respondent-Applicant"), covers the mark "DOXAIR" for use on "*pharmaceutical preparations containing the following as active ingredients: doxofylline*" under Class 05 of the International Classification of Goods.

Opposer alleges, among others, the following:

"10. The mark DOXAIR being applied by respondent-applicant is confusingly similar to opposer's trademark XOLAIR covered by Certificate of Registration No. 4-2012-007747 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.

"11. The registration of the trademark DOXAIR in the name of respondent-applicant will violate Section 123.1, subparagraph (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines.

x x x

"12. The registration and use by respondent-applicant of the mark DOXAIR will diminish the distinctiveness and dilute the goodwill of opposer's trademark XOLAIR.

"13. The registration of the mark DOXAIR in the name of respondent-applicant is contrary to the provisions of the IP Code of the Philippines."

Opposer's evidence consists of the following:

- 1. Exhibit "A" - copy of Certificates of Registrations No. 4-2012-007747 for the mark XOLAIR issued by IPOPHL;

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

² A domestic corporation with address at #831-A Eugenio Lopez Street cor. EDSA, Quezon City.

2. Exhibit "B" to "L" - copy of certificates of registration for the mark XOLAIR issued in Australia, European Union, OHIM, Canada, Hong Kong, Malaysia, Singapore, New Zealand, and U.S.A.,
3. Exhibits "M" - copy of Novartis AG's Trademark Portfolio for the mark XOLAIR;
4. Exhibits "N" to "N-3" - photocopies of the packaging of XOLAIR product;
5. Exhibit "O" - copy of Philippine sales figures for XOLAIR;
6. Exhibit "P" - copy Novartis AG's Annual Report for 2014;
7. Exhibit "Q" - Legalized and authenticated Corporate Secretary's Certificate dated 02 February 2015; and
8. Exhibit "R" - Legalized and authenticated Affidavit-Testimony of Mireille Valvason;

On 19 March 2015, this Bureau issued a Notice to Answer and personally served a copy thereof to the Respondent-Applicant's counsel on 30 March 2015. However, Respondent-Applicant did not file the answer within the reglementary period. On 06 July 2015, this Bureau issued Order No. 2015-999 declaring Respondent-Applicant in default. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, 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 **DOXAIR**?

The records show that at the time the Respondent-Applicant filed its application for the mark DOXAIR on 10 October 2014, the Opposer has already been issued a registration for its trademark XOLAIR on 11 October 2012. The trademark XOLAIR of the Opposer is used on "pharmaceutical preparations for the prevention or treatment of diseases and disorders of the respiratory system; pharmaceutical preparations for use in dermatology" under Class 5. On the other hand, Respondent-Applicant's mark DOXAIR is used in "*pharmaceutical preparations containing the following as active ingredients: doxofylline*" also under Class 05. Doxofylline is a drug used for treatment of asthma and chronic obstructive pulmonary disease (COPD) which are also diseases of the respiratory system. As such, the goods of the parties are similar.

But, are the competing marks identical or confusingly similar as to likely deceive or cause confusion?

The marks are reproduced below for comparison:

XOLAIR

Opposer's Mark

DOXAIR

Respondent-Applicant's

Both Opposer's and Respondent-Applicant's marks contain the word "AIR" at the end but they differ in their first three letters, that is, "XOL" for Opposer's mark and "DOX" for Respondent-Applicant's. This Bureau finds that the presence of the similar word "AIR" in both marks is insufficient to establish a finding of confusing similarity between the competing marks to sustain the opposition. When pronounced, the marks are not phonetically the same. Also, the word "AIR" is commonly used in combination with other letters in pharmaceutical drugs used to treat asthma or respiratory diseases such as "KASTAIR" and "SINGULAIR" which have been registered with this Office. Opposer cannot claim that it has appropriated exclusively the use of the word "AIR" in pharmaceutical preparations for respiratory diseases. Moreover, the word "AIR" has also been used in combination with other letters and words as a trademark for goods belonging to different classes. As such, it is not very distinctive as to effectively identify the source of goods or services of one over the other.

It must be 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. The mark applied for registration by Respondent-Applicant meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2014-012532, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 October 2015.


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