

**NOVARTIS AG,**  
Opposer,

**-versus-**

**I.E. MEDICA INC.,**  
Respondent-Applicant.

X-----X

} **IPC No. 14-2013-00468**  
}  
} Opposition to:  
} Application No. 4-2013-005561  
} Date filed: 15 May 2013  
} **TM: "LETZOL"**

**NOTICE OF DECISION**

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

**I.E. MEDICA INC.,**  
Respondent-Applicant  
5/F RFM Corporate Center  
Pioneer Street, Mandaluyong City

**GREETINGS:**

Please be informed that Decision No. 2015 - 255 dated November 06, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 06, 2015.

For the Director:

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

**NOVARTIS AG,**

Opposer,

IPC No. 14-2013-00468

-versus-

Opposition to Trademark

Application No. 4-2013-005561

Date Filed: 15 May 2013

**I.E. MEDICA INC.,**

Respondent-Applicant.

Trademark: **"LETZOL"**

x ----- x Decision No. 2015- 255

### DECISION

Novartis AG<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-005561. The contested application, filed by I.E. Medica Inc.<sup>2</sup> ("Respondent-Applicant"), covers the mark "LETZOL" for use on "*finished pharmaceutical product (letrozole 2.5mg tablet)*" under Class 05 of the International Classification of Goods<sup>3</sup>.

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 "LESCOL" and the Respondent-Applicant's mark "LETZOL" are confusingly similar for the following reasons:<sup>4</sup>

- a. LESCOL and LETZOL have the same number of letters, six
- b. The contending marks are practically identical since four (4) out of six (6) letters in respondent-applicant's mark are also in opposer's mark.
- c. The arrangement of the common letters is the same, with both marks starting with the letters L-E and ending with the letters O-L.
- d. The letter S in (LES) in opposer's mark is also visually similar to the letter T in (LET) in respondent-applicant's mark. x x x
- e. Since the letters and the syllabic compositions of the contending marks LESCOL and LETZOL are almost the same, they are also almost identical in sound and pronunciation. in fact, LES in opposer's mark is phonetically alike as LETZ in respondent-applicant's mark. The syllable COL in opposer's mark and ZOL in respondent-applicant's mark are also phonetically similar in that both syllables fade in the end as OL. x x x

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

<sup>2</sup> A corporation organized and existing under and by virtue of the laws of the Philippines with office address at 5/F RFM Corporate Center, Pioneer Street, Mandaluyong City, Metro Manila.

<sup>3</sup> 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.

<sup>4</sup> See Verified Opposition, pp. 6-7.

Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,

Taguig City 1634 Philippines [www.ipophil.gov.ph](http://www.ipophil.gov.ph)

T: +632-2386300 • F: +632-5539480 • [mail@ipophil.gov.ph](mailto:mail@ipophil.gov.ph)

- f. Both marks are word marks in plain letterings and not stylized. Neither is in color or compounder with a unique device or design. Hence, the similarity between the two (2) marks is even more pronounced or enhanced.

The Opposer moreover avers that its mark "LESCOL" is for "*pharmaceutical preparations, namely a cardiovascular preparation*", which is similar or closely-related to the goods the Respondent-Applicant's mark is applied for. It contends that since the goods are sold in the same channels of trade, the potential confusion on the consuming public is greater, which will consequently result damage to the public and its own business and goodwill.

In support of its Opposition, the Opposer submitted the following as evidence:<sup>5</sup>

1. copy of Trademark Registration No. 055628;
2. certified true copy of Corporate Secretary's Certificate dated 05 December 2013;
3. notarized and legalized Affidavit-Testimony of Martine Roth dated 04 December 2013; and
4. pages from Novartis AG Annual Report for the year 2012.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 28 January 2014. The Respondent-Applicant, however, did not file an Answer. Accordingly, the Hearing Officer issued on 15 May 2014 Order No. 2014-634 declaring the Respondent-Applicant in default and the case submitted for decision.

The primordial issue to be resolved is whether the trademark "LETZOL" should be allowed.

The Opposer anchors its opposition on Section 123.1 (d) of the IP Code which provides:

***"123.1. A mark cannot be registered if it:***

***(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:***

***(i) The same goods or services, or***

***(ii) Closely related goods or services, or***

***(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion; xxx"***

<sup>5</sup> Marked as Exhibits "A" to "D".

Records show that at the time the Respondent-Applicant filed its trademark application, the Opposer already has an existing registration for the mark "LESCOL" under Certificate of No. 4-1991-425147 issued on 09 July 1993. The registration covers "*pharmaceutical preparations namely; a cardiovascular preparations*" under Class 05.

The competing marks, as shown below,

LESCOL

*Opposer's mark*

LETZOL

*Respondent-Applicant's mark*

similarly begins with the letters "LE" and end with the letters "OL". They likewise comprise of two syllables and six letters. These resemblances in the Opposer's and Respondent-Applicant's marks are readily apparent such that the differences in their middle letters "SC" and "TZ, respectively, fade in significance. The likelihood of confusion is especially high in this case as both marks pertain to pharmaceutical products of the same nature.

Also, the mark applied for registration by the Respondent-Applicant is almost identical to the generic or international nonproprietary name (INN) *letrozole*, the goods indicated in the application. To allow Respondent-Applicant to register "LETZOL", which it obviously derived by merely omitting the letters "R, "O" and "E" from the generic name of its product, is tantamount to giving the said company an undue advantage over its competitors and cause confusion among the consumers who would be easily deceived that what they are buying is a generic drug.

Succinctly, Section 123 of the IP Code provides, in part, that a mark cannot be registered if it:

"x x x"

*(h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;*

*(i) Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;*

*(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services; x x x"*

Generic names are those which constitute "*the common descriptive name of an article or substance*", or comprise the "*genus of which the particular product is a species*", or are commonly used as the "*name or description of a kind of goods*", or

imply a reference to "every member of a genus and the exclusion of individuating characters", or "refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product", and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it "forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is", or if it clearly denotes what goods or services are provided in such a way that the customer does not have exercise of powers of perception or imagination.<sup>6</sup>

Significantly, this Bureau takes judicial notice of Inter Partes Case No. 14-2009-000249 entitled "Sanofi-Aventis vs. Ranbaxy Laboratories Limited". This Bureau decided the cited case by sustaining the opposition to the application for the registration of the mark "IRBESAR" on the ground that it is confusingly similar to and is a virtual replication of "IRBESARTAN", which is the generic name for a drug mainly used for treating hypertension. The Director General sustained this Bureau's ruling in his decision dated 17 December 2012, to wit:

***"As correctly pointed out by the Appellee (Sanofi-Aventis):***

***3.1. All the letters in Respondent-Applicant's mark IRBESAR form part of the INN 'IRBESARTAN'. In fact, all the seven (7) letters in the Respondent-Applicant's IRBESAR mark constitute the first seven (7) letters of the INN o generic name 'IRBESARTAN'.***

***3.2. The last three letters of the Respondent-Applicant's IRBESAR mark, namely, the letters S, A and R, consist of a substantial part of the common stem- SARTAN of the INN system.***

***3.3. It bears stressing that the INN 'IRBESARTAN' and the Respondent-Applicant's mark IRBESAR are both used for pharmaceutical products, the former being the generic name of the latter.***

***"Accordingly, the similarities in IRBESAR and IRBESARTAN are very obvious that to allow the registration of IRBESAR is like allowing the registration of a generic term like IRBESARTAN. Their similarities easily catches one's attention that the purchasing public may be misled to believe that IRBESAR and IRBESARTAN are the same and one product.***

***"A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate. Significantly, the registration of IRBESAR would give the Respondent-Applicant the exclusive right to use this mark and prevent others from using similar marks including the generic name and INN IRBESARTAN. This cannot be countenanced for it is to the interest of the***

<sup>6</sup> Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.


*public that a registered mark should clearly distinguish the goods of an enterprise and that generic names and those confusingly similar to them be taken outside the realm of registered marks. x x x"*

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.<sup>7</sup> Respondent-Applicant's trademark fell short in meeting this function.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-005561 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 06 November 2015.

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

---

<sup>7</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.