

NOVARTIS AG,
Opposer,

-versus-

ATTY. AMBROSIO V. PADILLA III,
Respondent-Applicant.

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IPC No. 14-2014-00549
Opposition to:
Appln. Serial No. 4-2014-011703
Date filed: 22 September 2014
TM: "METHERMAX"

NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES

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ATTY. AMBROSIO V. PADILLA III

Respondent-Applicant
Unit 1001 88 Corporate Center
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Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 289 dated December 23, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 23, 2015.

For the Director:


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

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Decision No. 2015 - 289

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DECISION

NOVARTIS AG ("Opposer"),¹ filed an opposition to Trademark Application Serial No. 4-2014-011703. The application, filed by AMBROSIO V. PADILLA III ("Respondent-Applicant")², covers the mark "METHERMAX" for use on goods under class 05³, namely: *pharmaceutical product used for the prevention and control of postpartum hemorrhage.*

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The Opposer alleges the following grounds for the opposition:

"10. The mark METHERMAX being applied for by respondent-applicant is confusingly similar to opposer's mark METHERGIN covered by Trademark Application No. 4-2013-009899 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 METHERMAX 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.

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

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

The Opposer's evidence consists of the following:

1. Trademark Application No. 4-2013-009899 for METHERGIN;
2. Copy of product information of the goods bearing the trademark METHERGIN;
3. Photographs of product packaging bearing the trademark METHERGIN;
4. Affidavit-Testimony of Martine Roth;
5. Corporate Secretary's Certificate dated 02 February 2015; and,
6. Novartis AG's Annual Report for 2013.

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

² With registered address at Unit 1001, 88 Corporate Center Sedenon corner Valero Sts., Salcedo Village, Makati City, Metro Manila.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 06 March 2015. Respondent-Applicant however, failed to file his Answer. Thus, in Order No. 2015-1111, Respondent-Applicant was declared in default and this instant case is deemed submitted for decision.⁴

Should the Respondent-Applicant be allowed to register the trademark METHERMAX?

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 out into the market a superior 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.⁵

Sec. 123.1 (d) R.A. No. 8293, also known as the Intellectual Property Code ("IP Code") provides:

Sec. 123. Registrability. - 123.1. A mark cannot be registered if it:

x x x

(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;
- (Emphasis Supplied)

The records and evidence show that at the time the Respondent-Applicant filed his trademark application on 22 September 2014⁶, the Opposer has prior-dated application for registration of the mark METHERGIN on 16 August 2013⁷ in the Philippines; which ripened into registration on 26 June 2014.⁸ It remains active under the name of herein Opposer up to the present by proof of current distribution in the Philippine market.⁹

A comparison of the Opposer's mark with the Respondent-Applicant's is depicted below:

METHERGIN

Opposer's Trademark

Methermax

Respondent-Applicant's Trademark

⁴ Dated 29 July 2015.

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

⁶ Filewrapper records.

⁷ Exhibit "A" of Opposer.

⁸ IPPhil Trademark Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 22 December 2015).

⁹ Exhibits "B", "C", "D" and "E" of Opposer.

The similarity of the marks consisting of the syllables "ME" and "THER" are starkly apparent. The visual and aural similarities of the marks depicts no significant individuality except that METHERGIN is in bold font. The aural effect when the marks are pronounced, despite the difference in the last syllable, creates perplexity because of the prevailing similarities in its letter component.

Further, a scrutiny of the goods covered by the mentioned marks show the similarity and relatedness of the pharmaceutical products covered by the marks in class 05. Opposer's METHERGIN covers pharmaceutical preparations for use in obstetrics and gynaecology. On the other hand Respondent-Applicant's METHERMAX covers pharmaceutical product for the prevention and control of postpartum hemorrhage. Both pharmaceutical products relate to obstetrics and gynaecology. They are sold in the same channels of trade and may create potential confusion on the target consuming public. They are intended for the same or related illness, thus, it may happen that these medicines are disposed by the pharmacist by mistake committed either in reading the prescription, or simply by disposing in case they are sold as over-the-counter type of medicine.

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 ingenuous 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.¹⁰ Colorable imitation does not mean such similitude as amount 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 tradename with that of the other mark or tradename 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.¹¹

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, 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.¹² 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:¹³

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 on 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 of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, 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.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code. It must be emphasized that the Respondent-Applicant was given opportunity to defend its trademark application. He, however, failed to do so.

¹⁰ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

¹¹ Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.

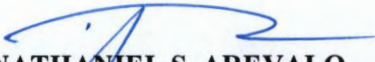
¹² American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.

¹³ Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-011703 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 December 2015.



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