



NOVARTIS AG,
Opposer,

-versus-

SUN PHARMA PHILIPPINES, INC.,
Respondent-Applicant.

x-----x

IPC No. 14-2013-00315
Opposition to:
Appln. Serial No. 4-2012-00012292
Date filed: 05 October 2012
TM: "ANABREZ"

NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES

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SUN PHARMA PHILIPPINES, INC.

Respondent-Applicant
604 6th Floor, Liberty Center Building
104 H.D. Dela Costa Street
Salcedo Village, Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 297 dated December 23, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 23, 2015.

For the Director:

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

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Date Filed: 05 October 2012

Trademark : "ANABREZ"

Decision No. 2015 - 297

DECISION

NOVARTIS AG, ("Opposer")¹ filed a verified opposition to Trademark Application Serial No. 4-2012-00012292. The application, filed by SUN PHARMA PHILIPPINES, INC., ("Respondent-Applicant")², covers the mark "ANABREZ" for use of goods under class 05³ namely: pharmaceutical preparations.

The Opposer alleges the following grounds for opposition:

"9. The trademark ANABREZ being applied for by respondent-applicant is confusingly similar to opposer's trademarks ONBREZ and ONBREZ BREEZHALER under Trademark Registration No. 4-2007-011995 and Trademark Registration No. 4-2010-010189, respectively, 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.

"10. The registration of the trademark ANABREZ 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 (IP Code).

"11. The registration and use by respondent-applicant of the trademark ANABREZ will diminish the distinctiveness and dilute the goodwill of opposer's trademarks ONBREZ and ONBREZ BREEZHALER."

The Opposer's evidence consists of the following:

1. Corporate Secretary's Certificate dated 28 August 2013;
2. Affidavit-Testimony of Mireille Valvason;
3. Trademark Registration No. 4-2007-011995 for ONBREZ;
4. Trademark Registration No. 4-2010-010189 for ONBREZ BREEZHALER (IN COLORS);
5. Novartis AG's Annual Report for the year 2012.

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

² A corporation formed and existing under the laws of the Philippines, with office address at 604 6th Floor, Liberty Center Building, 104 HV Dela Costa St., Salcedo Village, Makati City.

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 21 October 2013. Respondent-Applicant however, did not file an answer. Thus, it is declared in default and this case is deemed submitted for decision.⁴

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

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property 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 filing or priority date, in respect of the same goods or services or closely related goods or services if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 05 October 2012⁵, the Opposer has already an existing trademark registration for the marks ONBREZ bearing Registration No. 4-2007-011995 issued on 26 May 2008⁶; and ONBREZ BREEZHALER bearing Registration No. 4-2010-010189 issued on 31 December 2010⁷ in the Philippines. Unquestionably, the Opposer's application and registration preceded that of Respondent-Applicant's.

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

ONBREZ

Opposer's Trademarks

ANABREZ

Respondent-Applicant's Trademark

The foregoing marks contain the prominent ending syllable "BREZ". They only differ in their beginning letters - *O* and *N* in Opposer's ONBREZ, as against *A*, *N* and *A* in Respondent-Applicant's ANABREZ. Such that, if either of the marks are spoken, they create an apparent aural similarity creating the likelihood of confusion of one mark as against the other.

⁴ Order No. 2014-107 dated 22 January 2014.

⁵ Filewrapper records.

⁶ Exhibit "C" of Opposer.

⁷ Exhibit "D" of Opposer.

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 ONBREZ covers pharmaceutical preparations for the treatment of and prevention of disorders of the nervous system, the immune system, the cardio-vascular system, the respiratory system, the musculo-skeletal system, the genitourinary system, for the treatment of inflammatory disorders, diabetes and metabolic diseases, for use in dermatology, in oncology, in hematology, in transplantation, in ophthalmology, for use in the gastroenterological area and in the prevention and treatment of ocular disorders and diseases; pharmaceutical preparations for treating bacteria-based diseases, anti-infectives, anti-bacterials, antivirals, anti-biotics, anti-fungals, diagnostic preparations for medical and veterinary use vaccines.⁸ On the other hand, Respondent-Applicant's ANABREZ covers pharmaceutical preparations. Without specification of the diseases treated by Respondent-Applicant's ANABREZ, it could be 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 because these are 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.⁹ 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.¹⁰

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.¹¹ 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:¹²

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.

⁸ Id. at 6.

⁹ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

¹⁰ Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.

¹¹ American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.

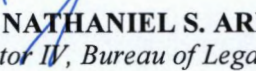
¹² Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.

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. It, however, failed to do so.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-00012292 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