

NOVARTIS AG,
Opposer,

-versus-

ALOHA R. AGUILAR,
Respondent-Applicant.

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IPC No. 14-2014-00373

Opposition to:

Appln. Serial No. 4-2014-005375

Date filed: 02 May 2014

TM: "OXIMAX"

NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES

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ALOHA R. AGUILAR

Respondent-Applicant
Blk. 4, Lot 7 Phase 3
Villa Barcelona Sindalan
City of San Fernando
Pampanga

GREETINGS:

Please be informed that Decision No. 2015 - 296 dated December 22, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 22, 2015.

For the Director:


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

NOVARTIS AG,

Opposer,

IPC NO. 14 – 2014 - 00373

Case Filed on: 23 October 2014

- versus -

Opposition to:

Appln Serial No. 42014005375

Date filed: 2 May 2014

TM: "OXIMAX"

ALOHA R. AGUILAR,

Respondent-Applicant.

X-----X

DECISION NO. 2015 - 296

DECISION

NOVARTIS AG. (opposer)¹ filed an opposition to Trademark Application No. 4-2014-005375. The application filed by Ms. Aloha R. Aguilar (respondent-applicant)², covers the mark "OXIMAX" for goods under Class 5 of the International Classification of Goods³ particularly, "*food supplement*"

The Opposer alleges that it is the registered owner of the trademark "XORIMAX" registered with the Intellectual Property Office of the Philippines ("IPO") under Trademark Registration No. 4-2003-000660.

The Opposer's grounds in the Opposition are quoted as follows:

9. The trademark OXIMAX being applied for by respondent-applicant is confusingly similar to opposer's trademark XORIMAX under Trademark Registration No. 4-2003-000660 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 OXIMAX 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), to wit:

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

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

² Filipino with business address at Blk 4 Lot 7 Phase 3 Villa Barcelona Sindalan City of San Fernando Pampanga, Philippines.

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

(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

11. The registration and use by respondent-applicant of the trademark OXIMAX will diminish the distinctiveness and dilute the goodwill of opposer's trademark XORIMAX
12. The registration of the trademark OXIMAX in the name of respondent-applicant is contrary to other provision of the Intellectual Property Code of the Philippines.

To support its Opposition, the Opposer further alleges that:

1. Respondent-applicant's mark OXIMAX, being applied for registration, is confusingly similar to opposer's mark XORIMAX, as to be likely, when applied to or used in connection with the goods of respondent-applicant, to cause confusion, mistake and deception on the part of the purchasing public.
2. The goods covered by respondent-applicant's mark OXIMAX are the exact same goods and competing with the goods covered by opposer's mark XORIMAX such that respondent-applicant's use of its mark will most likely cause confusion in the minds of the purchasing public.
3. Respondent-applicant obviously intends to pass off its products as those of opposer since there is no reasonable explanation for respondent-applicant to use the mark OXIMAX when the field for its selection is so broad.

The Opposer presented the following pieces of evidence:

1. Exhibit "A" – Copy of the Certificate of Registration No.4-2003-000660 for the trademark XORIMAX issued by the Intellectual Property Office of the Philippines;
2. Exhibit "B" – Copy of the Certificate of Product Registration No. DR-XY36007 issued by the Food and Drug Administration;
3. Exhibit "C" – Copy of the Certificate of Product Registration No. DR-XY30706 issued by the Food and Drug Administration;
4. Exhibit "C-1" Copy of the Certificate of Product Registration No. DR-XY30705 issued by the Food and Drugs Administration;
5. Exhibit "D" – Product packaging of the goods bearing the mark XORIMAX;
6. Exhibit "E" – Product leaflet featuring the goods bearing the mark XORIMAX;
7. Exhibit "F", "G" and "H" – Promotional Materials showing the mark XORIMAX;
8. Exhibit "I" and "J" Airway Bills for 2011 for products bearing the mark XORIMAX;



9. Exhibit “K” – Certified True Copy of the Corporate Secretary’s Certificate dated 10 May 2012;
10. Exhibit “L” Notarized and legalized Affidavit-Testimony of witness Susanne Groeschel-Jofer and Andrea Felbermeir dated 29 September 2014; and
11. Exhibit “M” – Novartis AG’s Annual Report for the year 2013.

This Bureau issued a Notice to Answer on 4 November 2014 and served a copy to the respondent-applicant on 8 November 2014. However, the respondent-applicant did not file an answer to the Opposition. In view thereof, an Order dated 20 February 2015 was issued declaring the respondent-applicant in default. Consequently, this case was submitted for Decision.

The issue to resolve in the present case is whether the respondent - applicant should be allowed to register the trademark “OXIMAX.”

The instant opposition is anchored on Section 123.1, paragraph (d), of the IP 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 or if it nearly resembles such mark as to be likely to deceive or cause confusion.

The competing marks are reproduced below for comparison:

XORIMAX

OXIMAX

Opposer’s Trademark

Respondent’s – Applicant’s
Trademark

Upon careful examination of the two competing trademarks and the evidence submitted by the opposer, this office finds merit to the contentions of the Opposer that the respondent-applicant’s mark OXIMAX is confusingly similar with the trademark XORIMAX of the Opposer.

It is worthy to note that both competing word marks have five (5) out of the seven (7) letters which are identical with each other, namely, the letters “O”, “I”, “M”, “A” and “X.” In addition, considering both from a visual and aural standpoints, the two word marks closely resemble each other since they are both composed of three (3) syllables (O-XI-MAX vs. XO-RI-MAX) with almost identical sounds.

Our jurisprudence is consistent that trademarks with *idem sonans* or similarities of sounds are sufficient ground to constitute confusing similarity in trademarks.⁴

In addition, this office also finds that the products subject of the competing trademarks, are closely related goods. The product of the respondent-applicant is food supplement while that of the opposer is a pharmaceutical preparation both falling under the same Class 05 of the Nice Classification of Goods and Services. There is high probability that the product of the respondent-applicant may be confused with the opposer's product or the public may be deceived that respondent-applicant's product may have originated from the opposer, or at the very least there is a connection between them.

Verily, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of design available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁵

Time and again, it has been held in our jurisdiction that 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.⁶ Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.⁷ Because the respondent-applicant will use his mark on goods that are similar and/or closely related to the opposer's, the consumer is likely to assume that the respondent-applicant's goods originate from or sponsored by the opposer or believe that there is a connection between them, as in a trademark licensing agreement. 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:⁸

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 one 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 former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are

⁴ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

⁵ American Wire & Cable Company vs. Dir. Of Patent, G.R. No. L-26557, February 18, 1970.

⁶ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

⁷ Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

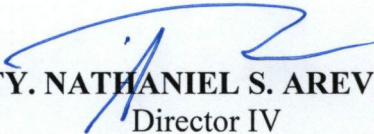
⁸ Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987

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.

WHEREFORE, premises considered, the instant opposition to Trademark Application Serial No. 42014005375 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42014005375 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 22 December 2015


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