



NOVARTIS AG,
Opposer,

-versus-

KUSUM HEALTHCARE PVT LTD.,
Respondent- Applicant.

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}
} **IPC No. 14-2015-00141**
} Opposition to:
} Appln. Serial No. 4-2014-00015275
} Date Filed: 15 December 2014
} **TM: "DIVANOL"**
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}
}
}

NOTICE OF DECISION

LAW FIRM OF E.B. ASTUDILLO & ASSOCIATES

Counsel for the Opposer
10th Floor, Citibank Center
8741 Paseo de Roxas, Makati City

KUSUM HEALTHCARE PVT LTD.

c/o **ANTONIO ROBLES**
Respondent-Applicant
Blk. 3, Lot 7B, Bigonia St.,
Anahaw Homes, Laguna

GREETINGS:

Please be informed that Decision No. 2016 - 175 dated June 08, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 14, 2016.

For the Director:

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

NOVARTIS AG,
Opposer,

- versus -

KUSUM HEALTHCARE PVT LTD.,
Respondent-Applicant.

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IPC No. 14-2015-00141

Opposition to:

Appln. No. 4-2014-00015275

Date Filed: 15 December 2014

Trademark : "DIVANOL"

Decision No. 2016 - 175

DECISION

NOVARTIS AG ("Opposer"),¹ filed on 15 May 2015 a verified opposition to Trademark Application Serial No. 4-2014-00015275. The application, filed by KUSUM HEALTHCARE PVT LTD. ("Respondent-Applicant"),² covers the mark "DIVANOL" for use on goods under class 05³ namely: *pharmaceutical preparation*.

The Opposer alleges the following grounds for opposition:

"10. The mark DIVANOL being applied for by respondent-applicant is confusingly similar to opposer's mark DIOVAN covered by Certificate of Registration No. 4-1996-109408 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 DIVANOL 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:

(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.]

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

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

² Local agent's address at 831-A Eugenio Lopez St. corner EDSA, Quezon 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.

"13. The registration of the mark DIVANOL 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. Copy of Trademark Registration No. 4-1996-109408 for DIOVAN;
2. Notarized and legalized Affidavit-Testimony of Marine Roth;
3. Notarized and legalized Corporate Secretary's Certificate; and,
4. Novartis AG's Annual Report for the year 2014.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer dated 19 May 2015 which was received by the Respondent-Applicant on 23 May 2015. However, this Bureau did not receive an answer and thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision.⁴

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

Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property Code ("IP Code") 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.

Records show that the Opposer has registration for the trademark DIOVAN falling under Class 05 for medicines, pharmaceutical preparations, namely cardiovascular products.⁵

But, are the contending marks, depicted below, resemble each other such that confusion, even deception, is likely to occur?

DIOVAN

Opposer's Trademark

DIVANOL

Respondent-Applicant's Trademark

The competing marks contain the letter "D" as its beginning letter. It also appears that they have identical letters composing their word marks. However, there are obvious differences which outweigh the stated similarities. Firstly, the Opposer's mark consists of two syllables, as compared to the Respondent-Applicant's mark which has three syllables. Moreover, the beginning and ending sound of the competing marks are starkly different from each other. In fact, the syllable "DIO" of DIOVAN cannot stand to cause confusion to the syllable "DI" of DIVANOL because they create distinct sounds when pronounced, even with the presence of the letters "D" and "I". In addition, the presence of the ending syllables of the competing marks consisting of "VAN" as against "NOL", create distinct visual and aural characters which negates the likelihood of confusion between the marks.

⁴ Order No. 2015-1536 dated 21 October 2015.

⁵ Exhibit "A" of Opposer.

This Bureau also underscore the fact that the foregoing marks cover distinct goods and/or pharmaceutical products. The registration of Opposer's DIOVAN particularly covers cardiovascular products; whereas, Respondent-Applicant's DIVANOL covers pharmaceutical preparations. Thus, the Opposer's medicine is more specific in the illness it is intended to treat, in particular heart and blood vessel disease also called heart disease which includes numerous problems, many of which are related to a process called atherosclerosis. Atherosclerosis is a condition that develops when a substance called plaque builds up in the walls of the arteries.⁶

Corollarily, the likelihood of the consumers being deceived, mistaken or confused is remote because of the highly sensitive nature of the Opposer's drugs. The sheer disparity in the nature and purposes of the goods and the manner by which the Opposer's goods under the mark DIOVAN are sold or dispensed precludes the probability of confusion or mistake. Moreover, because of the difference in the goods or pharmaceutical products, the Respondent-Applicant cannot be said to have the intent to ride in the goodwill of the mark DIOVAN. It is unlikely for one when confronted with the mark DIOVAN to be reminded of the mark DIVANOL and *vice versa*.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2014-015275 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 08 June 2016.


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

⁶ American Heart Association. What is Cardiovascular Disease. Available at http://www.heart.org/HEARTORG/Caregiver/Resources/WhatisCardiovascularDisease/What-is-Cardiovascular-Disease_UCM_301852_Article.jsp#.V1eS4IInJBw (last accessed 08 June 2016).