

NOVARTIS AG,  
Opposer,

-versus-

BIOMAXX PHARMACEUTICALS (PHILS)  
CORP.,  
Respondent- Applicant.

x-----x

}  
} **IPC No. 14-2011-00175**  
} Opposition to:  
} Appln. Serial No. 4-2010-007330  
} Date Filed: 07 July 2010  
} **TM: "BIOVIT"**

**NOTICE OF DECISION**

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**BIOMAXX PHARMACEUTICALS (PHILS.) CORP.**  
Respondent-Applicant  
Blk. 4, Lot 5 Burgos Street, Phase 4  
Vista Verde Executive Village  
Cainta, Rizal

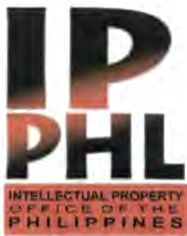
**GREETINGS:**

Please be informed that Decision No. 2016 - 201 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 30, 2016.

For the Director:

**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



NOVARTIS AG,

*Opposer,*

-versus-

BIOMAXX PHARMACEUTICALS (PHILS) CORP.,

*Respondent-Applicant.*

IPC No. 14-2011-00175

Opposition to:

Application No. 4-2010-007330

Date Filed: 07 July 2010

Trademark: "BIOVIT"

Decision No. 2016- 201

**DECISION**

NOVARTIS AG<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-007330. The application, filed by Biomaxx Pharmaceuticals (Phils) Corp.<sup>2</sup> ("Respondent-Applicant"), covers the mark "BIOVIT" for use on "pharmaceutical preparation" under Class 05 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x x x

**"LEGAL GROUNDS FOR THE OPPOSITION**

"6. The trademark BIOVIT being applied for by respondent-applicant is confusingly similar to opposer's trademark BIOCLAVID, 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.

"7. The registration of the trademark BIOVIT in the name of respondent-applicant will violate Section 123.1, subparagraph (d) of the Intellectual Property Code of the Philippines, to wit:

x x x

"8. The registration of the trademark BIOVIT in the name of respondent-applicant is contrary to other provisions of the Intellectual Property Code of the Philippines.

**"IN SUPPORT OF THE OPPOSITION**

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

<sup>2</sup> A domestic corporation organized and existing under the laws of the Republic of the Philippines with address at Unit 3/F Saiyo Bldg., Imelda Avenue, Karangalan Village, Pasig City.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

x x x

"9. The mark BIOCLAVID of opposer and the mark BIOVIT of respondent-applicant appear and look confusingly similar when placed side by side, as follows:

x x x

"10. The mark BIOVIT of respondent-applicant Biomaxx Pharmaceutical (Phils.) Corp. is confusingly similar with the trademark BIOCLAVID of opposer Novartis AG since:

- a. "Majority of the letters, i.e. B, I, O, V and I in the mark of respondent-applicant is also present in opposer's mark. Only the last letter T in respondent-applicant's mark is different from Novartis' mark.
- b. "The first two syllables BI-O in opposer's mark and respondent-applicant's mark are identical; the last syllable VID of opposer's mark vis-à-vis VIT of respondent-applicant's mark sound alike; the letters D and T also sound alike; thus, compounding the likelihood of confusion between opposer's mark BIOCLAVID and respondent-applicant's mark BIOVIT.
- c. The presence of the syllable CLA in opposer's mark BIOCLAVID does not negate confusing similarity with respondent-applicant's mark BIOVIT considering that majority of the syllables in opposer's and respondent-applicant's mark are similar, such that opposer's mark actually appear and look as BIOVID more than Bioclavid. Hence, BIOVIT is confusingly similar to opposer's mark which may be read as BIOVID.
- d. Because of the near unanimity in the letters and syllables of the two (2) marks, the syntax, the sound and the pronunciation of the words are the same. Phonetically therefore, the two (2) marks are confusingly similar.
- e. Both marks are wordmakrs in plain letterings and not stylized. Neither are in color nor are compounded with a unique device or design. Hence, the similarity between the two (2) marks is even more pronounced or enhanced.

"11. Indubitably, opposer's and respondent-applicant's marks are confusingly similar. The case of American Wire and Cable Co. vs. Director of Patents (G.R. No. L-26557, February 18, 1970) where the Supreme Court found that DURAFLEX and DYNAFLEX are confusingly similar, finds application in the instant case, to wit:

x x x

"12. The first two syllables BI-O in opposer's mark and the first two syllables BI-O in respondent-applicant's mark do not negate confusing similarity between these marks of opposer and respondent-applicant. The test of confusing similarity which would preclude the registration of a trademark is not whether the challenged mark would actually cause confusion, mistake or deception in the minds of the purchasing public but whether the use of such mark would likely cause confusion or mistake. The law does not require that the competing marks must be so identical as to produce actual error or mistakes. It is sufficient that the similarity between the two marks be such that

there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it. (Acoje Mining Co., Inc. vs. Director of Patents, 38 SCRA 480 [1971]). ‘

“13. Moreover, it is settled jurisprudence that identity or similarity in the dominant features of two (2) competing marks will cause mistake or confusion in the minds of the purchasing public. The case of Co Tiong Sa vs. Director of Patents (95 Phil. 1 [1954]) categorically held, as follows:

x x x

“14. It has also been held in the case of Phil. Nut Industry, Inc. vs. Standard Brands, Inc. (G.R. No. L-23035, 31 July 1975, 65 SCRA 575) that:

x x x

“15. The dominancy test was applied by the Supreme Court in many other cases including Lim Hoa vs. Director of Patents (100 Phil 214 [1956]), Converse Rubber Corporation vs. Universal Rubber Products, Inc. (G.R. No. L-27906, 08 January 1987, 147 SCRA 154) and Asia Brewery, Inc. vs. Court of Appeals (G.R. No. 103543, 05 July 1993, 224 SCRA 437).

“16. In the recent case of McDonald’s Corporation, et. al. vs. L.C. Big Mak Burger, et. al. (G.R. No. 143993, August 18, 2004), the Supreme Court likewise applied the test of dominancy in determining that the mark BIG MAC of McDonald’s Corporation and the mark BIG MAK of L.C. Big Mak Burger are confusingly similar. The Court ruled, as follows:

x x x

“17. The reasoning in the McDonald’s case (supra) applying the Dominancy Test is relevant in the instant case. The dominant feature in opposer’s mark BIOCLAVID is the mark itself, five (5) letters of which are identical to those of respondent-applicant’s mark BIOVIT. The difference in the last letter ‘D’ of opposer’s trademark and the last letter of respondent-applicant’s trademark as well as the presence of the syllable CLA in opposer’s mark is inconsequential. This marginal distinction does not sufficiently distinguish the two marks from each other as they are similar in pronunciation, syntax sound and appearance. As such, the two (2) marks are, for all intents and purposes, practically identical and confusingly similar. In fact the last syllable VID of opposer’s mark vis-à-vis VIT of respondent-applicant’s mark sound alike, thus, compounding the likelihood of confusion between the marks BIOCLAVID and BIOVIT. The purchasing public will easily recognize and remember the common letters B-I-O-V-I, and hence, it is very easy to mistake respondent-applicant’s products bearing the mark BIOVIT for opposer’s goods bearing the mark BIOCLAVID.

“18. Opposer’s mark and respondent-applicant’s mark both cover similar and competing goods under International Class 5.

Opposer’s mark BIOCLAVID covers:

*“antibiotics”*

while respondent-applicant’s mark BIOVIT covers:

*"Pharmaceutical preparation"*

Evidently, both marks are used on similar and competing goods. Both cover pharmaceutical goods for human use under the same classification (International Class 5). Both are also sold, marketed and/or found in the same channels of business and trade, namely pharmacies, clinics hospitals and/or doctor's offices. Hence, confusion will be more likely to arise in the minds of the purchasing public.

"19. In the case of *Esso Standard Eastern, Inc. vs. Court of Appeals, et al.* (G.R. No. L-29971, August 31, 1982), the Supreme Court held that:

x x x

"20. In view of the similarity of the covered goods under International Class 5, the purchasing public will most likely be deceived to purchase respondent-applicant's goods in the belief that they are purchasing opposer's goods. This will thus result to damage to the public and to opposer's established business and goodwill, which should not be allowed.

"21. In the Philippines, opposer is the owner/registrant of the mark BIOCLAVID, the particulars of which are, as follows:

|                |   |                   |
|----------------|---|-------------------|
| Trademark      | : | BIOCLAVID         |
| Registrant     | : | Novartis AG       |
| Certificate of |   |                   |
| Reg. No.       | : | 4-1995-101316     |
| Date Issued    | : | November 14, 2000 |
|                |   |                   |
| Appln. No.     | : | 99178             |
| Date Filed     | : | March 21, 1995    |
|                |   |                   |
| Goods          | : | Antibiotics       |
| Class          | : | 5                 |

"A copy of Certificate of Registration No. 4-1995-101316 is enclosed herewith as Annex 'A' and made an integral part hereof.

"22. Opposer, through one of its local subsidiaries, Sandoz Philippines Corporation, has also registered its products bearing the mark BIOCLAVID with the Bureau of Food & Drugs. A copy of Certificate of Product Registration No. DRP-1612 is enclosed herewith as Annex 'B' and made integral part hereof.

"23. The trademark BIOCLAVID was first used as early as November 1, 1998 in Sweden and in August 1, 2004 in the Philippines. The trademark BIOCLAVID is also extensively used in Denmark, Greece, Finland and Romania. Sample of the product packaging of the goods bearing the trademark BIOCLAVID as distributed in the Philippines in enclosed herewith as Annex 'C' and made integral part hereof.

"24. Moreover, a copy of invoice for the products bearing the mark BIOCLAVID is enclosed herewith as Annex 'D' and made integral part hereof.

"25. Opposer's application for the mark BIOCLAVID was filed on March 21, 1995, and subsequently registered on November 14, 2000, much earlier than respondent-applicant's application date for the confusingly similar mark BIOVIT on July 7, 2010. Hence, opposer's registration for the mark BIOCLAVID will bar the successful registration of respondent-applicant's confusingly similar mark BIOVIT.

"26. Opposer is the owner of and/or registrant of many trademark registrations in the mark BIOCLAVID in several countries such as Algeria, Argentina, Armenia, Austria, Belarus, Benelux, Bosnia-Herzegovina, Bulgaria, Chile, Croatia, Czech Republic, Denmark, Dominican Republic, Egypt, European Union, Finland, Germany, Greece, Guatemala, Hungary, Iceland, India, Italy, Kazakhstan, Kyrgyzstan, Liechtenstein, Macedonia, Moldova, Montenegro, Morocco, Poland, Romania, Russian Federation, Saudi Arabia, Serbia, Slovakia, Slovenia, Sudan, Sweden, Switzerland, Tajikistan, Ukraine and Uzbekistan for goods under International Class 5. Enclosed herewith as Annex 'E' and made an integral part hereof is the trademark portfolio for BIOCLAVID of opposer Novartis AG.

"27. By virtue of opposer's registration of the trademark BIOCLAVID in the Philippines and other foreign countries, said trademark has become distinctive of opposer's goods and business.

"28. A boundless choice of words, phrases and symbols is available to a person who wishes to have a trademark sufficient unto itself to distinguish its products from those of others. There is no reasonable explanation therefore for respondent-applicant to use the mark BIOVIT for "Pharmaceutical Preparation" under the same Class 5 when the field for its selection is so broad. Respondent-applicant obviously intends to pass off its products as those of opposer.

"29. In the case of American Wire & Cable Co. vs. Director of Patents (G.R. No. L-26557, February 18, 1970), the Supreme Court held that:

x x x

"30. Moreover, it has been held in many other cases, like the foregoing that:

x x x

"31. Indubitably, the registration and use of the trademark BIOVIT by respondent-applicant will deceive and/or confuse purchasers into believing that respondent-applicant's goods and/or products bearing the trademark BIOVIT emanate from or are under the sponsorship of oppose Novartis AG, the rightful owner of the trademark BIOCLAVID in the Philippines.

"32. In view of the foregoing, opposer's mark BIOCLAVID which is legally protected under Philippine laws bars the registration in the Philippines of the confusingly similar mark BIOVIT of respondent-applicant Biomaxx Pharmaceutical (Phils.) Corp.

The Opposer's evidence consists of a copy of Certificate of Registration No. 4-1995-10316 for the trademark BIOCLAVID issued on 14 November 2000; a copy of Certificate of Product Registration No. DRP-1612 for the brand name BIOCLAVID issued by the Bureau of Food and Drugs; product packaging of goods bearing the mark BIOCLAVID; copy of invoice for products bearing the mark BIOCLAVID; copy of the Corporate Secretary's Certificate issued by Opposer Novartis AG; the Joint Affidavit-Testimony of Marcus Goldbach and Andrea Felbermeir, Trademark Attorney and

Paralegal of Sandoz International GmbH, a wholly-owned affiliate of Novartis AG; and copies of pages from Novartis AG's Annual Report for the year 2010.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 22 January 2016. Said Respondent-Applicant, however, did not file an Answer.

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

Records show that at the time the Respondent-Applicant filed its trademark application on 07 July 2010, the Opposer has an existing trademark registration for the mark BIOCLAVID under Trademark Reg. No. 4-1995-101316 issued on 14 November 2000. The registration covers "antibiotics" under Class 05. On the other hand, Respondent-Applicant filed its trademark application for the mark BIOVIT for use as "pharmaceutical preparation" in Class 05.

In this regard, the Opposer anchors its opposition on Sec. 123.1, paragraph (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

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;"

Hence, the question, does BIOVIT resemble BIOCLAVID such that confusion or deception is likely to occur? The marks are shown below:

**BIOCLAVID**

Opposer's trademark

**BIOVIT**

Respondent-Applicant's mark

<sup>4</sup> Marked as Exhibits "A" to "G", inclusive.

This Bureau finds that confusion or deception is unlikely to occur in this instance. Although the contending marks have the same first two (2) syllables BI-O and the last syllable sound almost the same VIT/VID, the visual and aural properties in respect of the Respondent-Applicant's mark has rendered said mark a character that is distinct from the Opposer's. While the marks are common as to the letters "B", "I", "O", "V", "I", those in between these letters make it easier for the consumers to distinguish one from the other. Moreover, the pharmaceutical products covered by the marks treat different illnesses. BIOVIT are pharmaceutical preparation; used as food supplement while BIOCLAVID are antibacterial, specifically for the treatment of infections caused by susceptible organisms including upper and lower-respiratory tract infections, genito-urinary tract infections, skin and soft-tissue infections, bone and joint infections, and septicemia.<sup>5</sup>

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>6</sup> This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2010-007330 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 30 JUN 2016.

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

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<sup>5</sup>Exhibit "B" for the Opposer.

<sup>6</sup>Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.