



NOVARTIS AG,
Opposer,

-versus-

MEDITHIX INC.,
Respondent- Applicant.

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}
} IPC No. 14-2013-00487
} Opposition to:
} Appln. Serial No. 4-2013-005571
} Date Filed: 15 May 2013
} TM: "ATHERO"
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NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES
Counsel for the Opposer
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8741 Paseo de Roxas
Makati City

MEDITHIX INC.
Respondent-Applicant
506, 5th Floor, RFM Corporate Center
Pioneer St., Mandaluyong City

GREETINGS:

Please be informed that Decision No. 2016 - 199 dated June 27, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 27, 2016.

For the Director:

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

NOVARTIS AG,

Opposer,

- versus -

MEDITHIX INC.,

Respondent-Applicant.

IPC NO. 14 - 2013 - 00487

Opposition to:

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TM: "ATHERO"

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DECISION NO. 2016 - 199

DECISION

NOVARTIS AG, (Opposer)¹ filed an Opposition to Trademark Application No. 4-2013-005571. The application filed by MEDITHIX INC. (respondent-applicant)², covers the mark "ATHERO" for goods under Class 05 of the International Classification of Goods³ particularly, "*cholesterol lowering agent*"

The Opposer based its Opposition on the following grounds:

- 1.) Respondent-applicant's mark AATHERO being applied for registration, is confusingly similar to opposer's mark AATHEROPRIL covered by Trademark Application No. 4-2012-013292 as to be likely, when applied to or used in connection with goods of respondent-applicant, to cause confusion, mistake and deception on the part of the purchasing public.
- 2.) The registration of the trademark AATHERO 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)

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 domestic corporation with business address at 506 5th Floor, RFM Corporate Center, Pioneer St., Mandaluyong City.

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.

- 3.) The registration and use by respondent-applicant of trademark ATHERO will diminish the distinctiveness and dilute the goodwill of opposer's trademark ATHEROPRIL
- 4.) The registration of the trademark ATHERO in the name of respondent-applicant is contrary to other provisions of Intellectual Property Code of the Philippines.

To support its claims the opposer submitted the following evidence:

- 1.) Exhibit "A" – Copy of Corporate Secretary's Certificate dated 10 May 2012;
- 2.) Exhibit "B" – Duly signed, notarized and legalized Affidavit-Testimony of Meike Urban and Andrea Felbermeir dated 10 February 2014;
- 3.) Exhibit "C" – Certificate of Registration under the Intellectual Property Office Philippines of the mark "ATHEROPRIL"; and
- 4.) Exhibit "D" – Novartis AG's Annual Report for the year 2012.

This Bureau issued a Notice to Answer and served a copy to the Respondent-Applicant on 31 March 2014. However, the Respondent-Applicant did not file an Answer to the Opposition. In view thereof, an Order dated 10 July 2014 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 "ATHERO."

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.

Records show that the Opposer has a prior trademark application when the Respondent-Applicant filed his trademark application for the same and related goods under Class 5 of NICE Classification of Goods, specifically, "*pharmaceutical preparation for human use.*"

The question now is, do the marks as shown below resemble each other such that mistake or confusion or even deception is likely to occur?

ATHEROPRIL

ATHERO

Opposer's Trademark

Respondent-Applicant's Trademark

Upon perusal of the two competing trademarks and the evidence submitted by the opposer, this office finds merit to the contentions of the Opposer.

It is evidently clear that the whole wordmark being applied by the Respondent-Applicant forms part of the trademark already applied by Opposer. The ATHERO mark of Respondent-Applicant is the first six (6) letters of the Opposer's ATHEROPRIL mark. In addition, the Respondent-Applicant's wordmark constitutes the first three syllables of the four syllables composing the Opposer's wordmark. Verily, these similarities in the competing marks would undoubtedly results to confusion, mistake and deception on the part of the purchasing public. The additional last syllable – *pril* in ATHEROPRIL would not be sufficient to distinguish it from the mark ATHERO.

Our 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 merely a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁴ In fact, it does not require actual confusion, it is sufficient that confusion is likely to occur.⁵

In this instant case, since the respondents-applicants will use his mark on goods that are similar and/or closely related to the opposer's, the consuming public is likely to assume that the respondents-applicants 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:⁶

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 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.

⁴ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

⁵ Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

⁶ Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987

Time and again, the Supreme Court has held that a trademark is any distinctive word, name, symbol, emblem, sign or device, or any combination thereof, adopted and used by a manufacturer or merchant on his goods to identify and distinguish them from those manufactured, sold or dealt by others.⁷ Succinctly, the primary function of a trademark is to distinguish one's goods from that of the others. In this case, the mark ATHERO being applied for registration by the Respondents-Applicants does not meet this function.

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-005571 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 27 JUN 2016


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

⁷ Dermaline Inc. vs. Myra Pharmaceuticals Inc., G.R. No. 190065, 16 August 2010