

NOVARTIS AG,
Opposer,

-versus-

MYLAN PHARMACEUTICALS PRIVATE LIMITED,
Respondent- Applicant.

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IPC No. 14-2014-00197
Opposition to:
Appln. Serial No. 4-2014-000663
Date Filed: 15 January 2014
TM: "XIOTAN PLUS"

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NOTICE OF DECISION

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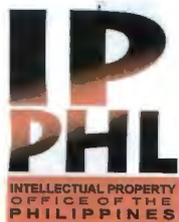
GREETINGS:

Please be informed that Decision No. 2016 - 488 dated December 23, 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, December 23, 2016.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



NOVARTIS AG,
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MYLAN PHARMACEUTICALS PRIVATE
LIMITED,
Respondent-Applicant.

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IPC NO. 14-2014-00197

Opposition to:
Appln. Ser. No. 4-2014-000663
Date Filed: 15 January 2014
Trademark: XIOTAN PLUS

Decision No. 2016 - 488

DECISION

NOVARTIS AG¹ ("Opposer") filed a Verified Opposition to Trademark Application No. 4-2014-000663. The application, filed by MYLAN PHARMACEUTICALS PRIVATE LIMITED² ("Respondent-Applicant") covers the mark XIOTAN PLUS for use on "Pharmaceutical preparations for cardiovascular system" under Class 5 of the International Classification of Goods³.

The Opposer alleges that the trademark XIOTAN PLUS being applied for by Respondent-Applicant is confusingly similar to Opposer's trademark DIOVAN under Trademark Application Serial No. 4-2013-015344 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. Opposer also posits that the registration of the trademark XIOTAN PLUS will violate Section 123.1, subparagraph (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines. According to Opposer, the registration and use by Respondent-Applicant of the trademark XIOTAN PLUS will diminish the distinctiveness and dilute the goodwill of Opposer's trademark DIOVAN.

The Opposer's evidence consists of the following:

1. Copy of Trademark Application No. 4-2013-015344 for the trademark DIOVAN;
2. Notarized and legalized Corporate Secretary's Certificate dated 19 June 2014;
3. Notarized and legalized Affidavit-Testimony of Mireille Valvason; and
4. Copy of Novartis Annual Report for the year 2013.

This Bureau issued on 18 July 2014 a Notice to Answer and served a copy thereof to the Respondent-Applicant's agent in the Philippines on 24 June 2014. The Respondent-Applicant, however, did not file an Answer. On 21 January 2016, Order No. 2016- 188 was issued declaring Respondent-Applicant in default for failure to file the Answer. Accordingly, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the

¹ A corporation duly organized and existing under the laws of Switzerland with principal office at CH-4002 Basel, Switzerland.

² A corporation duly organized and existing under the laws of India with address at One India Bulls Centre, Tower 2-B, 841 Senapati Bapat Marg, Elphinstone Road (West) Mumbai -400 013, India.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the 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 Purpose of the Registration of Marks concluded in 1957., 7th Floor

documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark XIOTAN PLUS?

Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

SECTION 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;

The records of this case will show that at the time Respondent-Applicant filed its application for registration of its mark XIOTAN PLUS on 15 January 2014, Opposer already has a pending application for its mark DIOVAN & Device filed on 20 December 2013. Opposer's DIOVAN mark is used on "*pharmaceutical preparations for the treatment of and prevention of disorders of the nervous system, the immune system, the cardiovascular system, the respiratory system, the musculoskeletal 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 infective, anti-bacterial, antiviral, antibiotics, antifungal*" under Class 5 while that of Respondent-Applicant's XIOTAN PLUS mark is used for "*Pharmaceutical preparations for cardiovascular system*" under Class 5 also. It appears that Respondent-Applicant's goods is covered by Opposer's goods and therefore, their goods are similar, closely related and competing.

But, are the competing marks, shown below, resemble each other such that confusion or even deception is likely to occur?

 **DIOVAN**

Opposer's Mark

Xiotan Plus

Respondent-Applicant's Mark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademark pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling and pronunciation, of words used; and the setting in which the words

appear" may be considered.⁴ Thus, confusion is likely between marks only if their overall presentation as to sound, appearance or meaning would make it possible for consumers to believe that the goods or products, to which the marks are attached, comes from the same source or are connected or associated with each other.

In this case, the contending marks are not confusingly similar. Opposer's mark is a composite mark which contain six letters, "D-I-O-V-A-N" and has a device. On the other hand, Respondent-Applicant's mark is a word mark which contains two words "XIOTAN PLUS" written in upper case letters. Opposer's and Respondent-Applicant's marks are also pronounced differently such that they cannot be confused with each other. Thus, it is very apparent that the parties marks are not only visually different but aurally as well. Thus, the likelihood of confusion, mistake or deception on the part of the purchasing public is very remote.

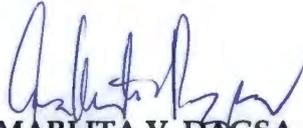
Aptly, the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article 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.⁵ The Respondent-Applicant's mark meet this function.

Accordingly, the registration of the mark XIOTAN PLUS is not contrary to the provision of Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby *DISMISSED*. Let the filewrapper of Trademark Application Serial No. 4-2014-000663, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 DEC 2016


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs

⁴ *Etepha A.G. v. Director of Patents*, G.R. No. L-20635, 31 March 1966.

⁵ See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.