

NOVARTIS AG,
Opposer,

-versus-

DAWOONG PHARMA PHILIPPINES, INC.,
Respondent- Applicant.

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IPC No. 14-2013-00045
Opposition to:
Appln. Serial No. 4-2012-011306
Date Filed: 14 September 2012
TM: DIOCTA

NOTICE OF DECISION

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

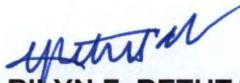
DAWOONG PHARMA PHILIPPINES, INC.
Respondent-Applicant
Unit 2811, One Corporate Center
Julia Vargas corner Meralco Avenue
Ortigas Center, Pasig City

GREETINGS:

Please be informed that Decision No. 2017 - 105 dated April 10, 2017 (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, April 17, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

NOVARTIS AG,
Opposer,

-versus-

DAEWOONG PHARMA PHILIPPINES, INC.,
Respondent-Applicant.

} **IPC NO. 14-2013-00045**

} Opposition to:

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} Appln. Ser. No. 4-2012-011306

} Date Filed: 14 September 2012

} Trademark: **DIOCTA**

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X-----X } Decision No. 2017- *105*

DECISION

NOVARTIS AG, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2012-011306. The application, filed by DAEWOONG PHARMA PHILIPPINES, INC., (Respondent-Applicant)², covers the mark “DIOCTA”, for use on “Anti-diarrheal pharmaceutical preparation” under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

“The registration of the trademark DIOCTA in the name of the respondent-applicant is contrary to Section 123.1(d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (‘IP Code’).

- A. Respondent-applicant’s mark DIOCTA is confusingly similar to opposer’s registered mark DIOVAN, as to likely, when applied to or used in connection with goods of respondent-applicant, cause confusion, mistake and deception on the part of the purchasing public.
- B. The goods covered by respondent-applicant’s mark DIOCTA are similar and competing with the goods covered by opposer’s mark DIOVAN such that respondent-applicant’s use of its mark will most likely cause confusion in the minds of the purchasing public.

As the prior registrant and user of DIOVAN, opposer has the superior and exclusive rights over said mark and other marks confusingly similar thereto, to the exclusion of any third party.”

¹ A corporation organized and existing under the laws of the Switzerland with address at CH4002 Basel, Switzerland

² A corporation organized and existing under the laws of the Philippines with address Unit 2811, One Corporate Center, Julia Vargas, corner Meralco Ave., Ortigas center, Pasig 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 concluded in 1957.

The Opposer alleges, among other things, the following:

“12. A plain examination of the contending marks show that the mark DIOCTA is confusingly similar to DIOVAN.

“12.1. The marks have the same number of letters and syllables. Four (4) out of the (6) letters in respondent-applicant’s mark and opposer’s mark, i.e. D,I, O, are identical.

“12.2. The marks are composed of three (3) syllables each,i.e., DI-OC-TA for respondent-applicant’s mark and DI-O(V)-VAN for opposer’s mark, wherein the first and second syllables are practically alike due to the same vowels in each syllable. The last syllable does not negate confusingly similarity. xxx

“As prior registrant of DIOVAN, opposer has the superior and exclusive rights over said mark and other marks confusingly similar thereto, to the exclusion of any third party.”

To support its opposition, the Opposer submitted as evidence the following:

1. Copy of Certificate of Registration No. 4-1996-109408 dated 23 June 2000 for the mark “DIOVAN” for goods under class 5; medicines, pharmaceutical preparations, namely cardiovascular products
2. Secretary’s Certificate dated 11 March 2013;
3. Legalized and authenticated Affidavit-Testimony of Mireille Valvason dated 13 March 2013; and
4. Copy of Novartis AG Annual Report for 2008⁴

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 17 April 2013. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 24 June 2015 Order No. 2015-902 declaring the Respondent-Applicant to have waived its right to file an Answer.

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

Records show that at the time Respondent-Applicant applied for registration of the mark “DIOCTA” the Opposer already registered the mark DIOVAN under Certificate of Registration No. 4-1996-109408⁵ dated 23 June 2000. The goods covered by the Opposer’s trademark registration are also under Class 05, same as indicated in the Respondent-Applicant’s trademark application.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

⁴ Exhibit “A” to “D”

⁵ Exhibit “A”

The competing marks are reproduced below:

DIOVAN

Opposer's mark

DIOCTA

Respondent-Applicant's mark

The marks are similar with respect to the prefix ("DIO") and the vowel, "A" in their suffix. Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. Both marks start with the letters or syllables "DIO". However, the last three letters in the Respondent-Applicant's mark - ("CTA") is clearly different in looks and in sound from the last three letters in the Opposer's ("VAN"). It is unlikely that on account of the similarity in the first three letters ("DIO"), the public would be vulnerable to confusion much less deception. It is noteworthy that the Opposer's drug are "medicines, particularly, cardiovascular products", while the respondent-applicant's mark is used as "antidiarrheal". Because the marks are used on products of different nature, confusion and deception is unlikely. It is improbable for one who is buying or dispensing "DIOCTA" products to be reminded of the mark "DIOVAN".

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-011306 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 APR 2017


ATTY. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs