

NOVARTIS AG,
Opposer,

-versus-

CLARIS LIFESCIENCES
PHILIPPINES, INC.,
Respondent- Applicant.

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IPC No. 14-2015-00060
Opposition to:
Appln. Serial No. 4-2014-004232
Date Filed: 04 April 2014
TM: "TAMIN"

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NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES
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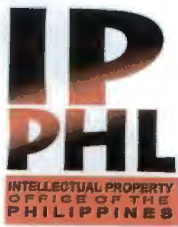
GREETINGS:

Please be informed that Decision No. 2017 - 229 dated June 19, 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, June 19, 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



NOVARTIS AG,
Opposer,

IPC No. 14-2015-00060
Opposition to:

- versus -

Appln. No. 4-2014-004232
Date Filed: 04 April 2014
Trademark: "TAMIN"

CLARIS LIFESCIENCES
PHILIPPINES, INC.,
Respondent-Applicant.

Decision No. 2017 - 229

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DECISION

NOVARTIS AG ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2014-004232. The application, filed by CLARIS LIFESCIENCES PHILIPPINES, INC. (Respondent-Applicant)², covers the mark "TAMIN" for use under class 05, particularly as "*pharmaceutical preparations for IV infusion*" of the International Classification of Goods.³

The Opposer alleges the following grounds for opposition:

"10. The mark TAMIN being applied for by respondent-applicant is confusingly similar to opposer's trademark TAZIM, covered by Certificate of Registration No. 4-2008-001149, 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 TAMIN 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,

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 corporation duly organized and existing under the laws of the Philippines with principal office address at 1108, 11F Cityland Herrera Tower, 98 VA Rufino St., cor. Valero St., Salcedo Village, Makati City, Metro Manila.

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.

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.]"

The Opposer's evidence consists of the following:

1. Copy of Certificate of Registration No. 4-2008-001149 for the trademark TAMIN issued by the Intellectual Property Office of the Philippines;
2. Novartis AG's Annual Report for the year 2014;
3. Certified true copy (Ctc) of Corporate Secretary's Certificate dated 10 May 2012; and,
4. Notarized and legalized Joint Affidavit-Testimony of witnesses Susanne Groeschel-Jofer and Britta Chamberlain dated 16 March 2015.

On 16 June 2015. Respondent-Applicant filed its Answer. It alleges that TAMIN is a clear intravenous infusion solution of Paracetamol. It contains 10mg/ml of Paracetamol. TAMIN comes in sterile, non-pyrogenic, isotonic, single dose container of 100 ml. TAMIN falls under the Antipyretic Analgesia, not the Anti-infectives, product category of Claris that is used to reduce fever and relieve pain.

According to Respondent-Applicant, it has been manufacturing and distributing TAMIN in various countries for several years now and has registered the same with pertinent government agencies in Georgia, Ghana, Kenya, Tajikistan, Tanzania, Turkmenistan, Uganda and Uzbekistan. In the Philippines, Claris registered and secured license to import and distribute TAMIN in the Philippines with the Food and Drug Administration, thus, promoting, importing and selling TAMIN products.

Respondent-Applicant argues that the Opposition is unverified and hence, must be dismissed outright. Further, there is neither confusing similarity nor likelihood of confusion in this instant case because TAMIN and TAZIM are not competing marks which refer to totally and absolutely different products.

The Respondent-Applicant's evidence consists of the following:

1. Screenshots of the Claris' website showing pharmaceutical information on TAMIN;
2. Certificate No. 014632 issued by the Ministry of Labour, Health and Social Affairs of Georgia on 29 October 2014;
3. Letter dated 04 January 2013 on the approval of Registration No. FDB/SD.133-1005 for TAMIN INTRAVENOUS INFUSION;
4. Registration of Drugs Certificate No. H2014/CTD1428/295 issued by the Pharmacy and Poisons Board on 24 June 2014, Kenya;
5. Certificate No. 005082, Tajikistan (no English translation);
6. Certificate of Drug Registration No. TZ13H150 issued by the Ministry of Health and Social Welfare dated 06 June 2013;
7. Certificate No. 010090, Turkmenistan (no English translation);

8. Letter from the National Drug Authority, Uganda;
9. Certificate No. 250-95 48014, Uzbekistan (no English translation);
10. Certificate of Product Registration No. DB-008479 of TAMIN issued by the Good and Drugs Administration (FDA) dated 18 September 2013;
11. Certification issued by the FDA dated 09 September 2014;
12. Various purchase orders, sales invoices and packing list evidencing importation and sale of TAMIN;
13. Various brochures, packages, bottle, ballpen and eco bag showing use of TAMIN;
14. Registrability Report dated 20 June 2014 and Response dated 20 October 2014;
15. Notice of Allowance for TAMIN;
16. Official Receipt No. 0537440 issued by the IPO on 17 December 2014; and,
17. Affidavit-Testimony of Rakesh U. Nair, Country Representative and Sales Head of Claris LifeSciences Philippines, Inc.;

The Preliminary Conference was held and terminated on 04 August 2016. Thereafter, the parties submitted their respective position papers⁴. Hence, this instant case is submitted for decision.

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

Before proceeding to the main issue of this instant case, this Bureau seems proper to resolve the dispute raised by herein Respondent-Applicant that the opposition is unverified and, hence, must be dismissed outright.

An examination of the records will show that the Verification and Certification of Non-Forum Shopping is dated 16 March 2015, thus, executed prior to the date of the Opposition on April 2015. This Bureau finds no error in the execution and submission of the same. The Honorable Supreme Court held that, "the variance in dates does not necessarily contradict the categorical declaration made by petitioners in their affidavit that they read and understood the contents of the pleading"⁵. It was further held that, "what is important is that efforts were made to satisfy the objective of the Rule to ensure good faith and veracity in the allegations of a pleading thereby allowing the courts to act on the case with reasonable certainty that the petitioners real positions have been pleaded".⁶

Going on the substantive aspect, the instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property Code ("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 if it nearly resembles such mark as to be likely to deceive or cause confusion.

⁴ Opposer submitted position paper on 19 August 2015; Respondent-Applicant submitted position paper on 12 August 2016.

⁵ Spouses Alfredo D. Valmonte and Maria Lourdes Valmonte v. Clarita Alcala, John Doe or Jane Doe, G.R. 168667, 23 July 2008.

⁶ Id., citing *Quimpo v. Dela Victoria*, G.R. No. L-31822, July 31, 1972, 46 SCRA 139, 144, citing *Villasanta v. Bautista*, 36 SCRA 160, 170-171 [1970].

The records and evidence show that at the time the Respondent-Applicant filed its trademark application for the mark TAMIN on 04 April 2014⁷, the Opposer has already an existing trademark registration for the mark TAZIM bearing Registration No. 42008001149 issued on 29 September 2008⁸. Unquestionably, the Opposer's application and registration for TAZIM preceded that of Respondent-Applicant's application for the subject mark TAZIM.

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

TAZIM

Tamin

Opposer's Trademark

Respondent-Applicant's Trademark

The competing marks contain an identical suffix "TA". The difference in the marks is apparent on the suffixes "ZIM" and "MIN", respectively. These suffixes are not only distinct in visual appearance when written, they also differ in aural effects when sound is produced. Such difference create stark difference in the marks, giving a divergent character and impression that can easily distinguish one from the other.

This Bureau also underscores the fact that the foregoing marks cover distinct goods and/or pharmaceutical products. The registration of Opposer's TAZIM is used as antibiotics and anti-infectives⁹; whereas, Respondent-Applicant's TAMIN is a pharmaceutical preparation for IV infusion. TAZIM is an oral medication, in contrast to TAMIN which is a clear intravenous infusion solution of Paracetamol in peri and post-operative pain management for pediatric to adult surgical patients.¹⁰ TAMIN is therefore a prescription drug, being highly specialized medicine and which are dispensed by drug stores with more than the ordinary degree of care and caution. As to the purchasers, they too will buy with vigilance considering the nature and purpose of the medicine.

The absence of confusing similarity between the competing trademarks is further underscored by the difference in the generic names and ingredients of the product and product information indicated in the labels, leaflets and actual packaging of the medicines¹¹. Corollarily, the likelihood of the consumers being deceived, mistaken or confused is remote because of the highly sensitive nature of Respondent-Applicant's drugs. The sheer disparity in the nature and purposes of the goods and the manner by which the Respondent-Applicant's goods under the mark TAMIN 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 TAZIM. It is

⁷ Filewrapper records.

⁸ Exhibit "A" of Opposer.

⁹ Id.

¹⁰ Exhibits "1" and "6" of Respondent-Applicant.

¹¹ Exhibits "6-b", "6-c" and "8" of Respondent-Applicant.

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unlikely for one when confronted with the mark TAMIN to be reminded of the mark TAZIM and *vice versa*.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2014-004232 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. **T9 JUN 2017**



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs