

NOVARTIS AG,
Opposer,

-versus-

MYLAN PHARMACEUTICAL PRIVATE LIMITED,
Respondent-Applicant.

X-----X

}
}
}
}
}
}
}
}

IPC No. 14-2014-00198
Opposition to:
Appln. Serial No. 4-2014-000660
Date Filed: 15 January 2014

TM: ATOREG

NOTICE OF DECISION

E.B. ASTUDILLO LAW OFFICES

Counsel for Opposer
Citibank Center, 10th Floor
8741 Paseo de Roxas,
Makati City

NICOLAS & DE VEGA LAW OFFICES

Counsel for Respondent- Applicant
16th Floor, Suite 1607 AIC Burgundy Empire Tower
ADB Avenue corner Sapphire & Garnet Roads,
Ortigas Center, Pasig City

GREETINGS:

Please be informed that Decision No. 2017 - 260 dated 28 June 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, 29 June 2017.

MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634 Philippines • www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph

NOVARTIS AG,

Opposer,

- versus -

MYLAN PHARMACEUTICAL
PRIVATE LIMITED,

Respondent-Applicant.

IPC NO. 14 – 2014 - 00198

Opposition to:
Trademark Application Serial No.
42014000660

TM: "ATOREG"

DECISION NO. 2017 - 260

x-----x

D E C I S I O N

NOVARTIS AG. (Opposer)¹ filed an Opposition to Trademark Application Serial No. 4-2012-013852. The trademark application filed by MYLAN PHARMACEUTICAL PRIVATE LIMITED (Respondent-Applicant)², covers the mark ATOREG for "*pharmaceutical preparations for cardiovascular system*" under Class 5 of the International Classification of Goods and Services³.

The Opposer in its Opposition alleges:

7. The trademark ATOREG being applied for by respondent-applicant is confusingly similar to opposer's trademark TAREG filed under Trademark Application No. 4-2012-010918, 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.

8. The registration of the trademark ATOREG 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**, in respect of:
(i.) The same goods or services, or
(ii.) Closely related goods or services,

¹A corporation organized under the laws of Switzerland with business address at 4002 Basel, Switzerland.

² A corporation organized under the laws of India with business address at One India Bulls Centre Tower 2-B, 7th Floor, 841 Senapati Bapat Marg, Elphinstone Road (West), Mumbai-400 013, India

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.

or

(iii.) If it nearly resembles such a mark as to be likely to deceive or cause confusion:[Emphasis supplied]

9. The registration and use by respondent-applicant of the trademark **ATOREG** will diminish the distinctiveness and dilute the goodwill of opposer's trademark **TAREG**.

10. The registration of the trademark **ATOREG** in the name of resident-applicant is contrary to other provisions of the Intellectual Property Code of the Philippines. x x x

11. The mark **ATOREG** of respondent-applicant is confusingly similar with the mark **TAREG** of oppose as shown by the following:

a.) Five (5) out of six (6) letters, i.e. A-T-R-E-G, in the mark of respondent-applicant are also present in opposer's mark.

b.) Due to the identity of the five (5) letters, both marks "look" alike when viewed from a distance.

c.) Absent the single first letter/ syllable "A", **ATOREG** would readily appear and read as **TOREG** which is confusingly similar with the opposer's mark **TAREG**. The dominant element in the mark **ATOREG** is **TOREG**, the first letter/syllable "A" being more as an appendage.

d.) Moreover, positioning or locating the letter "A" in **ATOREG** before the letter "T" rather than after is a clever, if not malicious and intentional, ploy to avoid the appearance of confusion. Hence, instead of TA, as in **TAREG**, the respondent-applicant's mark reads as AT as in **ATOREG**. Nevertheless, **ATOREG** and **TAREG** are confusingly similar due to the dominance of the syllables **TOREG** and **TAREG**.

e.) **TAREG** and **ATOREG** are exactly alike in sound, appearance and connotation. The identity of the two words in terms of appearance and spelling is therefore not only very strong, but dominant. Being alike in appearance and spelling, they are also practically phonetically the same having the same sound and pronunciation. x x x

20. Significantly, respondent-applicant's trademark application for **ATOREG** covers "pharmaceutical preparations for cardiovascular system," while opposer's **TAREG** trademark covers the similar "pharmaceutical preparation for use in the cardiovascular field, in the field of diabetes and in the field of metabolism diseases., " both in Class 05.

21. Evidently, both sets of goods are closely-related and fall under the same international Class 05. The confusion between pharmaceutical goods bearing the respective confusingly similar words **ATOREG** and **TAREG** is most likely and pronounced.

22. Both goods therefore are sold in the same channels of business and trade. Hence, the potential confusion on the consuming public is greater. In view of the similarity of the covered goods, the purchasing public will most likely be deceived to purchase the goods of the respondent-applicant labelled **ATOREG** in the belief that they are purchasing opposer's products bearing the label **TAREG**.

2/10/00

This will thus result to damage to the public and to opposer's business and goodwill over its products bearing the mark TAREG. x x x

25. In the Philippines, opposer is the prior applicant for registration of the trademark TAREG, the particulars of which are as follows:

Trademark: TAREG
Applicant: Novartis AG
Appln No.: 4-2012-010918
Date Filed: 06 September 2012
Goods: *pharmaceutical preparation for us in the cardiovascular field, in the field of diabetes and in the field of metabolism diseases*
Class: 05

26. Opposer is the owner-registrant of the mark TAREG in Mexico; Guatemala; Nicaragua; Panama; Bolivia; Brazil; Chile; Colombia; Ecuador; Paraguay; Peru; Uruguay; Venezuela; Denmark; Ireland; Russian Federation; Sweden; Switzerland; Turkey; United Kingdom; Israel; Syria; Hong Kong; India; Japan; Malaysia; South Korea; Taiwan; Thailand; Australia; and New Zealand. Copies of these Foreign of Registrations are enclosed herewith as Exhibit "B" and made integral parts hereof.

27. Opposer also has pending applications for the registration of the mark TAREG in Costa Rica; El Salvador; Honduras; Argentina; Brazil; Dominican Republic; Greece; Jordan; Kuwait; Lebanon; Saudi Arabia; Angola; Ghana; Kenya; Nigeria; South Africa; Tunisia; Indonesia; and Pakistan.

28. Opposer first registered the mark TAREG in France on June 1, 1997. Since then, Opposer has actively and vigorously promoted and advertised its marks all over the world. x x x

29. By virtue of opposer's prior trademark application for TAREG in the Philippines, its various foreign trademark applications and registrations for the mark TAREG, and its active advertisement of it mark all over the world, TAREG has become distinctive of opposer's goods and business.

34. The registration and use of the trademark ATOREG by respondent-applicant will deceive and/or confuse purchasers into believing that respondent-applicant's goods and/or products bearing the trademark ATOREG emanate from or are under the sponsorship of oppose, owner and registrant of the mark TAREG.

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

Exhibit "A" – Copy of the database information on Trademark Registration No. 4-2012-010918;

Exhibit "B" to "B-6" – Certificates of Foreign Registrations for the mark TAREG;

Exhibit "C" – Opposer's brochures and/or promotional materials;

Exhibit "D" – Product packaging of the goods bearing the mark TAREG;

Exhibit "E" – Notarized and legalized Corporate Secretary's Certificate dated 19 June 2014;

Exhibit "F" – Notarized and legalized Affidavit-Testimony of witness Mireille Valvason and Nazuki Hughes dated 26 June 2014; and

Exhibit "G" – Novartis AG's Annual Report for the year 2013;

This Bureau issued a Notice to Answer on 18 July 2014 and served a copy to the Respondent-Applicant on 24 July 2014. However, the Respondent-Applicant did not file an Answer. In view thereof, an Order dated 3 August 2015 was issued declaring the Respondent-Applicant in default and thereby making this case deemed submitted for decision.

The issue to be resolved in the instant case is whether to allow Respondent-Applicant to register the trademark "ATOREG."

The Opposition is primarily grounded on Section 123.1, par (d), of the Intellectual Property Code of the Philippines (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.

At the outset, it is worthy to point out that when the Respondent-Applicant filed her trademark application for "ATOREG" mark on 15 January 2014, the Opposer has already a prior and existing trademark registration for the mark "TAREG" used for closely related if not outright identical goods to the Respondent's products, namely, "pharmaceutical preparation for use in the cardiovascular filed, in the field of diabetes and in the field of metabolism diseases."⁴ Thus, there is a need to determine whether the earlier registered trademark of the Opposer is similar to the Respondent-Applicant mark, as to cause deception or confusion on the consumers.

The contending marks are depicted below for comparison:

Atoreg

Respondent – Applicant's Mark

TAREG

Opposer's Mark

⁴ Exhibit A


An examination of the two competing wordmarks readily show that all of the letters in the Opposer's wordmark, particularly, "A" "T" "R" "E" and "G" can be found in the Respondent-Applicant's mark. Although the Respondent-Applicant's trademark has three syllables and the Opposer's trademark has only two syllables, the visual and the aural characteristics of the two word marks are closely similar. The phonetic composition of the Opposer's mark TA – REG is almost identical to the last two syllables of the Respondent-Applicant's trademark TO – REG. The existence of an additional letter "A" at the beginning of the Respondent-Applicant does not negate the confusing similarity of the two wordmarks.

It has been held consistently in our jurisdiction that the 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 a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁵ Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.⁶

WHEREFORE, premises considered, the instant opposition to Trademark Application Serial No. 42014000660 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42014000660 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 28 JUN 2017


Atty. **Leonardo Oliver Limbo**
Adjudication Officer
Bureau of Legal Affairs

⁵ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

⁶ Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992