



NOVARTIS AG,  
Opposer,

-versus-

ATTY. AMBROSIO V. PADILLA III,  
Respondent –Applicant.

X-----X

}  
} IPC No. 14-2012-00140  
} Opposition to:  
} Appln. Serial No. 4-2011-014734  
} Date Filed: 12 December 2011  
} TM: "GLIPEX"

### NOTICE OF DECISION

**E. B. ASTUDILLO & ASSOCIATES**  
Counsel for the Opposer  
10<sup>th</sup> Floor Citibank Center  
8741 Paseo de Roxas, Makati City

**ATTY. AMBROSIO V. PADILLA III**  
Respondent-Applicant  
Unit 1001, 88 Corporate Center  
Sedeno corner Valero Streets  
Salcedo Village, Makati City

#### GREETINGS:

Please be informed that Decision No. 2014 - 86 dated March 28, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 28, 2014.

For the Director:

*Edwin Q. Dating*  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



NOVARTIS AG,  
*Opposer,*

**-versus-**

ATTY. AMBROSIO V. PADILLA III,  
*Respondent-Applicant.*

X -----X

IPC No. 14-2012-00140

Appln. Serial No. 4-2011-014734

Filing Date: 12 December 2011

Trademark: "GLIPEX"

Decision No. 2014 - 86

### DECISION

NOVARTIS AG ("Opposer")<sup>1</sup> filed an opposition to Trademark Application Serial No. 04-2011-014734. The application, filed by ATTY. AMBROSIO V. PADILLA III ("Respondent-Applicant")<sup>2</sup>, covers the mark "GLIPEX" for use on "pharmaceutical product – anti-diabetic, in tablet form, indicated as an adjunct to diet for the control of hyperglycemia and its associated symptomatology in patient with non-insulin-dependent diabetes mellitus (NIDDM; type II), formerly known as maturity-onset diabetes, after an adequate trial of dietary therapy has proved unsatisfactory" under class 05 of the International Classification of Goods and Services<sup>3</sup>.

The Opposer alleges among other things the following:

"6. The trademark GLIPEX being applied for by respondent-applicant is confusingly similar to opposer's trademark GLIVEC, 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.

"7. The registration of the trademark GLIPEX 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.

"8. The registration and use by respondent-applicant of the trademark GLIPEX will diminish the distinctiveness and dilute the goodwill of opposer's trademark GLIVEC.

"9. The registration of the trademark GLIPEX in the name of respondent-applicant is contrary to other provisions of the Intellectual Property Code of the Philippines.

"10. Opposer's mark GLIVEC and respondent-applicant's mark GLIPEX are confusingly similar with each other:

x x x

"12. Four (4) letters in both marks are identical. The differences in respondent-applicant's mark vis-a-vis opposer's mark do not negate confusing similarity. The test of confusing similarity which would preclude the registration of a trademark is not whether the challenged mark would

<sup>1</sup> A corporation duly organized and existing under the laws of Switzerland with principal office located at 4002 Basel, Switzerland.

<sup>2</sup> A Filipino citizen with address at Unit 1001, 88 Corporate Center, 8741 Paseo de Roxas, Makati City.

<sup>3</sup> The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

actually cause confusion, mistake or deception in the minds of the purchasing public but whether the use of such mark would likely cause confusion or mistake. The law does not require that the competing marks must be so identical as to produce actual error or mistakes. It is sufficient that the similarity between the two marks be such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.

x x x

“18. Respondent-applicant’s mark and opposer’s mark cover similar goods under International Class 5.

Opposer’s mark GLIVEC under Registration No. 4-1996-115901 covers:  
‘Pharmaceutical preparation to be used in oncology.’

and its other registered GLIVEC under Registration No. 4-2004-001984 covers:

‘Pharmaceutical preparations for the prevention and/or treatment of disorders of the nervous system, the immune system, the cardiovascular system, the respiratory system, the musculo-skeletal system, the genitourinary system, for the treatment of inflammatory disorders, for use in dermatology, in hematology, in ophthalmology, for use in the gastroenterological area and the prevention and treatment of ocular disorders or diseases; anti-infectives, anti-bacterials, antivirals, antibiotics, anti-fungals.’

while respondent-applicant’s mark GLIPEX covers:

‘(Pharmaceutical product) – anti-diabetic; in tablet form, indicated as an adjunct to diet for the control of hyperglycemia and its associated symptomatology in patients with non-insulin-dependent diabetes mellitus (NDDM; type II), formerly known as maturity-onset diabetes, after an adequate trial of dietary therapy has proved unsatisfactory’

“19. Both marks are therefore used on the same and competing goods as both belong under the same classification (International Class 5). Both are sold, marketed and/or found in the same channels of business and trade, namely pharmacies, clinics, hospitals, and/or doctor’s offices. Hence, confusion will be more likely to arise in the minds of the purchasing public.

x x x

“23. Opposer’s registration and use for the mark GLIVEC was much earlier than respondent-applicant’s application for registration of the confusingly similar mark GLIPEX on December 12, 2011. In the United States, the mark GLIVEC was used as early as May 1, 2011 and in the Philippines, it was first used on June 18, 2001. Hence, opposer’s mark GLIVEC will bar the successful registration of respondent-applicant’s confusingly similar mark GLIPEX.”

The Opposer’s evidence consists of the following

1. Exhibit “A” - Certificate of Registration No. 4-2004-001984 for trademark GLIVEC issued by the Intellectual Property Office of the Philippines;
2. Exhibit “B” - Certificate of Registration No. 4-1996-115901 for the trademark GLIVEC issued by the Intellectual Property Office of the Philippines;
3. Exhibit “C” - List of countries holding trademark registration for GLIVEC;
4. Exhibit “D” - List of countries where GLIVEC are sold;

- 5. Exhibits "E"- "G" - Marketing and advertising materials featuring GLIVEC;
- 6. Exhibits "H"- "H-4" - Copies of sales invoices for GLIVEC;
- 7. Exhibit "I" - Samples of GLIVEC artwork marketed in the Philippines;
- 8. Exhibit "J" - Affidavit-Testimony of David Lossignol; and,
- 9. Exhibit "K" - Novartis AG's Annual Report for 2011.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 20 June 2012. Respondent-Applicant however, did not file an answer. Thus, Respondent-Applicant was declared in default and the case was deemed submitted for decision.

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

Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ('IP Code') 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.

The records and evidence show that at the time the Respondent-Applicant filed the subject trademark application on 12 December 2011, the Opposer has existing registrations for its mark GLIVEC, bearing Registration Nos. 41996115901 and 42004001984 issued on 26 July 2002 and 10 November 2005, respectively.<sup>4</sup> Thus, these registrations remain valid to date.

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

**GLIVEC**

Opposer's Trademark

**Glipex**

Respondents-Applicants' Trademark

The competing marks show that both contain the first syllable "GLI". This similarity however, is not sufficient to reach a conclusion that there is the likelihood of confusion, much less deception. The last syllable "PEX" in Respondent-Applicant's mark is visually and aurally different from the last syllable "VEC" in the Opposer's mark.

That confusion or mistake, much less deception, is unlikely in this instant is bolstered by the fact that the goods covered by the GLIVEC trademark registration are different from those indicated in the Respondent-Applicant's trademark application. The pharmaceutical products bearing the marks are not over-the-counter medicines or goods; these are drugs specific for a certain illness which are dispensed through a physician's prescription. The "VEC" from the Opposer's mark "GLIVEC" can easily be distinguished from the "PEX" of the Respondent-Applicant's mark "GLIPEX". It is therefore very remote for a pharmacist to commit mistake in reading the prescription.

<sup>4</sup> Exhibits "A" and "B" of Opposer.

Furthermore, it is doubtful if the consumers in encountering the mark GLIPEX will have in mind or be reminded of the mark GLIVEC. The Opposer has not established that GLIVEC is a well-known mark to support a claim that the Respondent-Applicant's trademark application and use of the mark GLIPEX manifest the latter's intent of riding in on the goodwill supposedly earned and enjoyed by the Opposer's mark. The Respondent-Applicant explained in its trademark application that the mark GLIPEX was coined from the generic drug "GLIPIZIDE". The changes in the spelling though, rendered the mark with distinctive property sufficient to make it registrable. This shows that the Respondent-Applicant's intention is to make its mark identified or associated with the generic term instead of the Opposer's mark.

It is emphasized that the essence of trademark registration is to give protection to the owners of the 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 or 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.<sup>5</sup> This Bureau finds that the mark GLIPEX meets this function.

**WHEREFORE**, premises considered, the Opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 04-2011-014734 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 28 March 2014.

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

---

<sup>5</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No., 115508, 19 Nov. 1999.