



NOVARTIS AG,
Opposer,

-versus-

TORRENT PHARMA PHILIPPINES, INC.,
Respondent-Applicant.

X-----X

IPC No. 14-2008-00054

Opposition to:

Appln. Serial No. 4-2007-007688

Date filed: 19 July 2007

TM: "FELIZ"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 - 98 dated June 15, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 15, 2012.

For the Director:


Fa Atty. JOSEPHINE C. ALON
Hearing Officer, BLA



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Decision No. 2012 - 98

DECISION

NOVARTIS AG¹ ("Opposer") filed on 10 March 2008 an opposition to Trademark Application Serial No. 4-2007-007688. The application, filed by TORRENT PHARMA PHILIPPINES, INC.² ("Respondent-Applicant"), covers the mark FELIZ for use on "*pharmaceutical preparation – antidepressant*" under Class 05 of the International Classification of goods.³

The Opposer alleges, among other things, that FELIZ is confusingly similar to its trademark "FELIM" 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. According to the Opposer, the registration of the mark FELIZ in favor of the Respondent-Applicant will violate Sec. 123.1, subparagraphs (d) and (e), and other provisions of Rep. Act. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") and Sec. 6bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and Switzerland are parties. The Opposer also claims that the registration and use of the mark FELIZ will diminish the distinctiveness and dilute the goodwill of the mark FELIM.

To support its opposition, the Opposer submitted as evidence the legalized Joint Affidavit-Testimony of Marcus Goldbach and Christian Rueller and certified copies of the certificates of registration or extract of trademark registers for the mark FELIM in Malaysia, Russia, Belarus, Thailand, Lithuania, most of which with English translations.⁴

The Respondent-Applicant filed its Verified Answer on 31 July 2008 alleging, among other things, that the Opposer's claim that FELIZ and FELIM are confusingly similar has no basis in fact and in law. According to the Respondent-Applicant, the likelihood of confusion is made even more remote especially with the enactment of the Generics Act of 1988 which mandates that the labeling and prescription of drugs shall be in generic or scientific nomenclature. The Respondent-Applicant claims that

¹ A corporation duly organized and existing under and by virtue of the laws of Switzerland, with business address at CH-4002 Basel, Switzerland.

² A domestic corporation with address on record at Unit 401-C ITC Building, 337 Sen. Gil Puyat Avenue, Makati City.

³ Under Class 32 of the International Classification of Goods.

⁴ Marked as Exhs. "A" to "G". Under Cert. of Reg. No. 01008952 (Malaysia), No. 250771 (Russia), No. 19254 (Belarus), No. 44709 (Lithuania) No. 761491 (International Registration), No. 167666 (Thailand), No. 36454 (Estonia).

Administrative Order No. 65, series of 1989 ("Guidelines on Advertisement and Promotion to Implement Generics Act of 1988") even expressly prohibits advertisement or promotion of Prescription Drugs except through medical journals, publications and/or literature solely intended for medical and allied professions. The Respondent-Applicant also argues that the "*Idem Sonans Rule*" only finds application where the goods are advertised over the radio.

The Respondent-Applicant's evidence consists of samples packaging of FELIZ and FELIM marks, copy of a decision rendered by United States District Court in the case of *Pharmacia Corporation v. Alcon Laboratories, Inc.*; affidavit of Maddali Srinivas Chakravarthy and proof of the authority of said person to sign the pleadings in this case; certified copies of Cert. of Product Registration issued by Bureau of Food and Drugs, Trademark Application No. 4-2007-007688, Notice of Allowance dated 31 October 2007; and the Declaration of Actual Use filed on 27 November 2007.⁵

Sec. 123.1 (d) of the Intellectual Property Code ("IP Code) provides that 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; or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion;

In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 19 July 2007, the Opposer already has an existing trademark registration for FELIM issued as early as 05 August 2004.

However, it is obvious that the mark FELIZ is not identical to FELIM. Corollarily, this Bureau finds that FELIZ does not resemble FELIM as to be likely to deceive or cause confusion. While the mark FELIZ differs from FELIM only with respect to the last letter, this variance has rendered FELIZ perceptive qualities that make it distinct from FELIM.

The letter "Z" is comprised of two parallel horizontal lines with their opposite ends joined together by a diagonal line. The letter "M" on the other hand, consists of two parallel vertical lines with their upper points or ends joined together by two diagonal lines that meet at the middle. The difference in the respective configurations of the letters "Z" and "M" gives the mark FELIZ a visual property that enables the eyes to easily distinguish it from FELIM, and *vice-versa*.

Also, because FELIZ ends in letter "Z", it sounds so different from FELIM. The "*hissing*" sound of "*liz*" is in stark contrast to the "*hmmmm*" sound of "*lim*".

That mistake, confusion or even deception is unlikely is highlighted by the fact that the application for the mark FELIZ indicates pharmaceutical preparation for "*antidepressant*". This is not similar or closely related to the goods covered by the registration for the FELIM, particularly, for the "*prevention and/or treatment of disorders of*

⁵ Marked as Exhibits "1" to "8" with sub-markings.

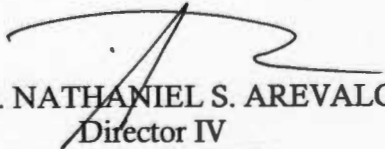
the nervous system, the immune system, the cardiovascular system, the respiratory system, the musco-skeletal, the genitourinary system, for the treatment of inflammatory disorders, for use in dermatology, in oncology, in ophthalmology, for use in the gastroenterological area and the prevention and treatment of ocular disorders or diseases". The Respondent-Applicant's goods are different from the Opposer's with respect to compositions and intended purposes. Thus, aside from the fact that the pharmaceutical products on which the competing marks are used are prescription drugs, the difference in the illnesses or disorders on which the drugs are applied to, makes the consumers more cautious and wary in buying the right product and brands. The situation is not the same as when two competing brands cater to or treat the same or related diseases. It is even unlikely, therefore, for the consumers to associate the Respondent-Applicant's mark with that of Opposer's and vice versa. As such, adverse effect on the reputation or goodwill of the Opposer's mark, cannot be fairly inferred. Accordingly, this Bureau finds no cogent reason to believe that the Opposer will likely be damaged by the registration of the Respondent-Applicant's mark.

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.⁶ This Bureau finds the Respondent-Applicant's mark sufficient to serve this purpose.

WHEREFORE, premises considered, the instant opposition is hereby DISMISSED. Let the filewrapper of Trademark Application no. 4-2007-007688 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 June 2012.


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

⁶ *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents*, *supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).