NOVARTIS AG, Opposer, **-versus-** **ATTY. AMBROSIO PADILLA III,** Respondent-Applicant.	}	**IPC No. 14-2014-00548** Opposition to: Appln. Serial No. 4-2014-011704 Date filed: 22 September 2014 TM: **"METHERIN"**

NOTICE OF DECISION

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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. 2015 - ____ dated July 24, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 24, 2015.

For the Director:

Atty. JOSEFINE C. ALON
Bureau of Legal Affairs

NOVARTIS AG,
Opposer,

versus-

ATTY. AMBROSIO PADILLA III,
Respondent-Applicant.
x----------x

IPC NO. 14-2014-00548

Opposition to:
Appln. Ser. No. 4-2014-011704
Filing Date: 22 September 2014
Trademark: **METHERIN**

Decision No. 2015 - _ _ _

DECISION

NOVARTIS AG, [1] ("Opposer") filed on 23 February 2015 an Opposition to Trademark Application Serial No. 4-2014-0011704. The application, filed by ATTY. AMBROSIO PADILLA III[2] ("Respondent-Applicant") covers the mark METHERIN for use on *"pharmaceutical product - pharmaceutical product used for the prevention and control of postpartum hemorrhage"* under Class 05 of the International Classification of goods[3].

The Opposer alleges the following grounds:

> "10. The mark METHERIN being applied by respondent-applicant is confusingly similar to opposer's mark **METHERGIN** covered by Trademark Application No. 4-2013-009899 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 METHERIN in the name of respondent-applicant will violate Sec. 123.1, subparagraph (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code) to wit:
>
> x x x
>
> "12. The registration and use by respondent-applicant of the mark METHERIN will diminish the distinctiveness and dilute the goodwill of opposer's trademark **METHERGIN**.
>
> "13. The registration of the mark METHERIN in the name of respondent-applicant is contrary to the provisions of the IP Code of the Philippines."

The Opposer's evidence consists of the following:

1. Exhibit "A" - Copy of Trademark Application No. 4-2013-009899 filed on 16 August 2013;

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[1] A corporation duly organized and existing under the laws of Switzerland with principal office located at 4002 Basel, Switzerland.
[2] A Filipino citizen with address at Unit 1001, 88 Corporate Center, Sedeno corner Valero Streets, Salcedo Village, Makati City.
[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.

2. Exhibit "B" – Copy of the product information of the goods bearing the trademark METHERGIN;
3. Exhibit "C" - Photographs of the product packaging for goods bearing the mark METHERGIN;
4. Exhibits "D" - Legalized Affidavit of Martine Roth dated 30 January 2015;
5. Exhibit "E" - Legalized Corporate Secretary's Certificate dated 02 February 2015; and
6. Exhibits "F" – Novartis AG Annual Report for the year 2013.

This Bureau issued on 02 March 2015 a Notice to Answer and served a copy thereof to the Respondent-Applicant's address on 06 March 2015. The Respondent-Applicant, however, did not file an Answer. On 13 July 2015, the Order of Default was issued. Accordingly, the pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark "METHERIN"?

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.[4] Thus, Sec. 123.1 (d) of the 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 a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its application for the mark METHERIN on 22 September 2014, the Opposer already has an existing application for registration for its trademark METHERGIN filed on 16 August 2013, covering goods falling under Class 05, namely, *"pharmaceutical preparations for use in obstetrics and gynaecology"*.[5] **Obstetrics** is a "branch of medicine concerned with child birth and the treatment of women before and after childbirth."[6] On the other hand, the Respondent-Applicant's trademark application is used on *""pharmaceutical product - pharmaceutical product used for the prevention and control of postpartum hemorrhage"* also under Class 05 . **Postpartum hemorrage** is a condition where there is blood loss of more than 500 ml within 24 hours after birth and one of the leading causes of maternal deaths.[7] As such, the goods of Respondent-Applicant is covered by Opposer's goods, therefore, the contending marks are used on closely related if not identical goods.

But are the competing marks, as shown below, identical or similar or resemble each other such that confusion, mistake or deception is likely to occur?

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[4] See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.
[5] *Opposer's trademark METHERGIN was registered on 26 June 2014 as per the IPOPHL Trademark Database.*
[6] *See Definition of Obstetrics, available at http://dictionary.reference.com/browse/obstetrics* (last accessed 14 July 2015)
[7] See WHO Recommendations for the Prevention and Treatment of Postpartum Haemorrhage, *available* at http://apps.who.int/iris/bitstream/10665/75411/1/9789241548502_eng.pdf (last accessed 14 July 2015)

METHERGIN

Opposer's Mark *Respondent-Applicant's Mark*

Confusion is likely in this instance because of the resemblance of the competing trademarks. Both marks contain three syllables, ME/THER/GIN for Opposer's while ME/THE/RIN for Respondent-Applicant. Both marks contain almost the same letters except the letter "G" in Opposer's mark which was omitted in Respondent-Applicant's mark. Although the marks are not entirely the same, there are no appreciable disparities between the two marks so as to avoid the likelihood of confusing one for the other. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other[8]. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article[9].

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, 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.[10] The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:[11]

> Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

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[8] See *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.
[9] See *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.
[10] See *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.
[11] See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

It has been held time and again that in cases of grave doubt between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.[12]

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-011704, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 24 July 2015.

Atty. NATH NIEL S. AREVALO
Director IV
Bureau of Legal Affairs

[12] See *Del Monte Corporation et. al. v. Court of Appeals*, GR No. 78325, 25 Jan. 1990.