



NOVARTIS AG,
Opposer,

-versus-

ZYDUS PHILIPPINES, INC.,
Respondent-Applicant.

x-----x

} IPC No. 14-2013-00172
} Opposition to:
} Appln No. 4-2012-014254
} Date Filed: 22 November 2012
} TM: "ZYPRIDE"

NOTICE OF DECISION

E. B. ASTUDILLO & ASSOCIATES
Counsel for Opposer
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ZYDUS PHILIPPINES, INC.
Respondent-Applicant
Unit Penthouse 1, 19th Floor Loop Tower A
Escriva Drive, Barangay San Antonio
Ortigas Center, Pasig City

GREETINGS:

Please be informed that Decision No. 2015 - 182 dated September 07, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 07, 2015.

For the Director:

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



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ZYDUS PHILIPPINES, INC.,
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IPC No. 14-2013-00172

Opposition to:

Appln. No. 4-2012-014254

Date Filed: 22 November 2012

Trademark : "ZYPRIDE"

Decision No. 2015 - 182

DECISION

NOVARTIS AG ("Opposer"),¹ filed a verified opposition to Trademark Application Serial No. 4-2012-014254. The application, filed by ZYDUS PHILIPPINES, INC. ("Respondent-Applicant")², covers the mark "ZYPRIDE" for use on goods under class 05³ namely: Amisulpride (pharmaceutical preparation product: antipsychotics).

The Opposer alleges the following grounds for opposition:

"1. The trademark ZYPRIDE being applied for by respondent-applicant is confusingly similar to opposer's trademark MIPRIDE under Trademark Application No. 4-2012-013223 filed on 29 October 2012, 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.

"2. The registration of the trademark ZYPRIDE 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.

"3. The registration and use by respondent-applicant of the trademark ZYPRIDE will diminish the distinctiveness and dilute the goodwill of opposer's trademark MIPRIDE.

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

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 18 October 2013. However, this Bureau did not receive an Answer. Respondent-Applicant is therefore declared in default and this case is deemed submitted for decision.⁴

The Opposer's evidence consists of the following:

1. Joint Affidavit-Testimony of Tanya Fickerscher-Leonard and Andrea Felbermeir;
2. Novartis AG's 2011 Annual Report; and,

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

² With address at Unit Penthouse 1, 19th Floor, Gold Loop Tower A, Escrivá Drive, Barangay San Antonio, Ortigas Center, Pasig City, Metro Manila.

³ 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.

⁴ Order No. 2014-106 dated 22 January 2014.

3. Certificate of Trademark Registration No. 1133582 issued by CGPDTM.

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

Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property Code ("IP Code") provides:

A mark cannot be registered if it:

x x x

(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;

Records show that the Opposer has a pending registration for the mark MIPRIDE falling under Class 05 for pharmaceutical preparations for human use dated 29 October 2012.⁵ It has registration for the same mark in India dated 16 September 2002.⁶

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

MIPRIDE

ZYPRIDE

Opposer's Trademark

Respondent-Applicant's Trademark

The competing marks each consists of two syllables - Opposer's "**MI-PRIDE**" and Respondent-Applicant's "**ZY-PRIDE**". The similarity of the word marks lies in the ending syllable "**PRIDE**". However, the first syllable "**MI**" for the Opposer's, which may either be pronounced as "mi" or "my", are starkly different from the "**ZY**" in the Respondent-Applicant's. This distinction stand out giving the said mark visual character that can easily be distinguished from one another. Further, it appears that the word "**PRIDE**" is a common suffix or stem for pharmaceutical products, with definition or substem of sulpiride derivatives.⁷ Hence, to sustain this opposition solely on the ground that the competing marks both consist of "**PRIDE**" would have the unintended effect of giving the Opposer exclusive use of the same.

⁵ IPOPHI Trademarks Database available at <http://www.wipo.int/branddb/ph/en/> (last accessed 07 September 2015).

⁶ Exhibit "C" of Opposer.

⁷ International Nonproprietary Names (INNs) Common Stems available at <http://www.drugs.com/inn-stems.html> (last accessed 10 September 2015).

This Bureau also underscore the fact that the foregoing marks cover distinct goods and/or pharmaceutical products. The registration of Opposer's "**MIPRIDE**" covers pharmaceutical preparations; whereas, Respondent-Applicant's "**ZYPRIDE**" covers pharmaceutical product, particularly antipsychotics. The latter is more specific in the illness it is intended to treat which refers to several types of mental distress or disorder - mainly schizophrenia and manic depression (bipolar disorder). It can also be used to help severe anxiety or depression.⁸ Thus, anti-psychotic medications are highly regulated through physician's medical prescription and treatment and in drugstore dispensation. The misuse of this type of drug can cause risk of injury, harm and death not only to the adults, but studies revealed that a growing number of teenagers and young adults are being prescribed anti-psychotic drugs.⁹

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 "**ZYPRIDE**" 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 "**MIPRIDE**". It is unlikely for one when confronted with the mark "**ZYPRIDE**" to be reminded of the mark "**MIPRIDE**" and *vice versa*.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-014254 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 September 2015.


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

⁸ Royal College of Psychiatrists, available at <http://www.rcpsych.ac.uk/healthadvice/treatmentwellbeing/antipsychoticmedication.aspx> (last accessed 07 September 2015).

⁹ Mail Online, Lizzie Parry, available at <http://www.dailymail.co.uk/health/article-3159058/Rising-number-teenagers-given-anti-psychotic-drugs-study-reveals.html> (last accessed 07 September 2015).