



NOVARTIS AG,  
Opposer,

-versus-

SRS PHARMACEUTICALS PHILS., INC.,  
Respondent- Applicant.

X-----X

IPC No. 14-2013-00173

Opposition to:

Appln. Serial No. 4-2012-014294

Date Filed: 23 November 2012

TM: "SANTON"

### NOTICE OF DECISION

#### E.B. ASTUDILLO & ASSOCIATES

Counsel for the Opposer

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#### SRS PHARMACEUTICALS PHILIPPINES, INC.

Respondent-Applicant

Unit 1903, Jollibee Plaza Condominium

F. Ortigas Center, Pasig City

#### GREETINGS:

Please be informed that Decision No. 2016 - 166, dated June 02, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 02, 2016.

For the Director:

*Edwin A. Dating*  
Atty. EDWIN DANILO A. DATING

Director III

Bureau of Legal Affairs

Republic of the Philippines  
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**NOVARTIS AG,**

Opposer,

-versus

**SRS PHARMACEUTICALS PHILS., INC.,**

Respondent-Applicant.

IPC No. 14-2013-00173

Opposition to Trademark

Application No. 4-2012-014294

Date Filed: 23 November 2012

Trademark: **"SANTON"**

X ----- X

Decision No. 2016- 166

### DECISION

Novartis AG<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-014294. The contested application, filed by SRS Pharmaceuticals Phils., Inc.<sup>2</sup> ("Respondent-Applicant"), covers the mark "SANTON" for use on *"pharmaceutical and medical preparations for the treatment of infections and diseases, illness and ailments, health, food and dietary supplements, home remedy and herbal preparations, food products, medical devices, sanitary preparations; dietetic substances adapted for medical use, food for babies"* under Class 05 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the provision of Section 123.1 (d) of the Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). It alleges, among others, that "SANDOZ" is its generic pharmaceuticals division and is a worldwide leader in generics. It claims to have registered the said mark in the Philippines and in various other countries. It contends that the Respondent-Applicant's mark "SANTON" is confusingly similar with its "SANDOZ" mark visually and phonetically. It posits that confusion is even more likely since both trademarks cover similar goods under Class 05. In support of its Opposition, the Opposer submitted the following as evidence:<sup>4</sup>

1. joint affidavit-testimony of Tanya Fickenschler-Leonard and Andrea Felbermeir;
2. its 2011 Annual Report; and
3. list containing all "SANDOZ" trademarks around the world.

<sup>1</sup>A corporation duly organized and existing under the laws of Switzerland with business address at 4002 Basel Switzerland.

<sup>2</sup>With known address at UNIT 1903 Jollibee Plaza Condominium, F. Ortigas Road, Ortigas Center Pasig City, Metro Manila, Metro Manila, Philippines.

<sup>3</sup>The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

<sup>4</sup>Marked as Exhibits "A" to "C".

On 18 October 2013, a Notice to Answer was served to the Respondent-Applicant. The latter, however, failed to comply. Thus, the Hearing Officer issued Order No. 2014-358 on 17 March 2014 declaring the Respondent-Applicant in default and submitting the case for resolution.

The issue to be resolved is whether the Respondent-Applicant's mark "SANTON" should be allowed registration.

The Trademark Registry of this Office, which this Bureau can take judicial notice, reveals that the Opposer was issued registration for its mark "SANDOZ" on 22 January 2007 under Certificate of Registration No. 4-2003-004450. On the other hand, the contested trademark application of the Respondent-Applicant was filed only on 23 November 2012.

But are the competing marks, as shown below, confusingly similar?

**SANDOZ**

**SANTON**

*Opposer's mark*

*Respondent-Applicant's mark*

From the illustration, it can be observed that the marks are readily distinguishable from each other. The only similarity between the marks is the first syllable "SAN". However, this does not appear to be the prevalent feature of either marks; albeit, the marks should be appreciated in their entirety. The Opposer's mark is pronounced as /san-doz/ while the Respondent-Applicant's as /san-ton/. Even visually, the similar letters pale in significance because of the different impressions that the contending marks manifest when taken as a whole. Hence, it is highly unlikely that the purchasers of the Opposer's "SANDOZ" products will be confused, mistaken, much less deceived, that the Respondent-Applicant's mark "SANTON" is related to the former. Assuming en arguendo that the parties' respective goods are related, still the glaring differences between the marks make confusion, much more deception, unlikely.

Also, the Opposer failed to prove that its trademark "SANDOZ" is well-known for it to be conferred protection outside what is stated in its certificate of registration. Nor that its mark's fame could support the claim that the Respondent-Applicant's trademark application and use of the mark "SANTON" manifest the



latter's intent of riding in on the goodwill supposedly earned and enjoyed by the former.

Finally, it is emphasized that 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.<sup>5</sup> The Respondent-Applicant's trademark sufficiently met this requirement.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-014294 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 02 JUN 2016

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

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<sup>5</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.