NOVARTIS AG, Opposer, **-versus-** **ATTY. AMBROSIO V. PADILLA III,** Respondent- Applicant.	} } } } } } } } }	**IPC No. 14-2012-00167** Opposition to: Appln. Serial No. 4-2011-014733 Date Filed: 12 December 2011 **TM: "GLIPIDIN"**

x----------x

NOTICE OF DECISION

E.B. ASTUDILLO & ASSOCIATES
Counsel for the Opposer
10th 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. 2016 - 233 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 01, 2016.

For the Director:

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

NOVARTIS AG,

Opposer,

- versus -

ATTY. AMBROSIO V. PADILLA,

Respondent-Applicant.

x----------x

IPC NO. 14 – 2012 - 00167

Opposition to:
Trademark Application Serial No. 4-2011-0014733

TM: "GLIPIDIN"

DECISION NO. 2016 - 233

D E C I S I O N

NOVARTIS AG (Opposer)[1] filed an Opposition to Trademark Application Serial No. 4-2011-0014733. The trademark application filed by ATTY. AMBROSIO V. PADILLA, (Respondent-Applicant)[2], covers the mark GLIPIDIN for services under Class 5 of the International Classification of Goods[3] particularly, *"(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 (NIDDM; type ii) formerly known as maturity –onset diabetes, after an adequate trial of dietary therapy has proved unsatisfactory."*

The Opposition is based on the following grounds:

1. The trademark GLIPIDIN being applied for by Respondent-applicant is confusingly similar to Opposer's trademark GLIMIDIN 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.

2. The registration of the trademark GLIPIDIN in the name of Respondent-Applicant will violate Section 123.1, subparagraph (d) of Respondent-Applicant will violate Section 123.1, subparagraph (d) of Republic Act No. 8293.

3. The registration and use by Respondent-Applicant of the trademark GLIPIDIN will diminish the distinctiveness and dilute the goodwill of Opposer's trademark GLIMIDIN.

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[1] A corporation duly organized and existing under the laws of Switzerland with Business Address at 4002 Basel, Switzerland.

[2] A natural person with address at Unit 1001, 88 Corporate Center, 8741 Paseo de Roxas, Makati City.

[3] *The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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. The registration of the trademark GLIPIDIN in the name of Respondent-Applicant is contrary to other provisions of the Intellectual Property Code of the Philippines.

To support its Opposition, the Opposer submitted the following evidence:

Exhibit "A" – Copy of the Certificate of Registration No. 4-2009-006553 for the Trademark GLIMIDIN;

Exhibit "B" – Joint Affidavit-Testimony of Susane Groeschel-Jofer and Andrea Felbermeir; and

Exhibit "C" – Novartis AG's Annual Report for 2011;

This Bureau served a Notice to Answer to the Respondent-Applicant on 4 December 2012. However, the Respondent-Applicant did not file an Answer to the Opposition. In view of the failure to file an Answer, an Order dated 27 March 2013 was issued declaring the Respondent-Applicant in default. Consequently, this case was deemed submitted for decision.

The issue in the present case is whether to allow the registration of herein Respondent-Applicant "GLIPIDIN" trademark.

The instant opposition is primarily grounded on Section 123.1, paragraph (d), of the IP Code which 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 trademarks subject of the instant case are reproduced below for examination.

GLIMIDIN	Glipidin
Opposer's Trademark	Respondent – Applicant's Trademark

Upon perusal of the two competing trademarks and the evidence submitted by the Opposer, this Bureau finds the Opposition meritorious.

Seven (7) of the eight (8) letters of the competing wordmarks, specifically, "G", "L", "I", "I", "D", "I" and "N", are the same. In fact, the only difference between the two marks is one (1) letter. Furthermore, the two competing marks are both composed of three (3) syllables that sound virtually identical – GLI-PI-DIN *vis-à-vis* GLI-MI-DIN. The close similarities in the syllables and phonetic effects of the two trademarks may confuse or deceive the buying public. The minimal differences are not enough to distinguish the two word marks from each other.

Our Supreme Court has consistently held that trademarks with *idem sonans* or similarities of sounds are sufficient ground to constitute confusing similarity in trademarks.[4] The Court has ruled that the following words: Duraflex and Dynaflex;[5] Lusolin and Sapolin;[6] Salonpas and Lionpas;[7] and Celdura and Cordura[8] are confusingly similar. In addition, the Supreme Court, citing Unfair Competition and Trade Marks, 1947, vol. 1 by Harry Nims, recognized the confusing similarities in sounds of the following trademarks: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jazz-Sea"; "Silver Flash" and "Supper-Flash"; "Cascarete" and Celborite"; "Celluloid and Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and Fermetex"; and "Zuso" and "HooHoo."[9] Evidently, the subject trademarks "GLIPIDIN" and "GLIMIDIN" fall squarely within the purview of this *idem sonans* rule.

Moreover, this Bureau also finds that the goods subject of trademarks, are not only similar and/or closely related but competing goods. Records show that both of the trademark cover anti-diabetic pharmaceutical preparations.[10] Undoubtedly, there is very likelihood that the product of the Respondent-Applicant may be confused with the Opposer's. The public may even be deceived that Respondent-Applicant's products originated from the Opposer, or that there is a connection between the parties and/or their respective goods.

The field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of design available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.[11]

Time and again, it has been held in our jurisdiction that 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.[12] Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.[13] Because the respondent-applicant will use his mark on goods that are similar and/or closely related to the opposer's, the consumer is likely to assume that the respondent-applicant's goods originate from or sponsored by the opposer or believe that there is a connection between them, as in a trademark licensing agreement. 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:[14]

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[4] Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966
[5] American Wire & Cable Company vs. Director of Patents and Central Banahaw Industries, G.R. L-26557 18 Fenruary 1970
[6] Sapolin Co. vs. Balmaceda, 67 Phil 795
[7] Marvex Commercial Co., Inc. vs. Petra Hawpa and Co, G.R. No. L-19297, 22 December 1966
[8] Co Tiong vs. Director of Patents, 95 Phil 1
[9] Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966
[10] Exhibit A of Opposer and Respondent-Aplicant's Application Form
[11] American Wire & Cable Company vs. Dir. Of Patent , G.R. No. L-26557, February 18, 1970.
[12] American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970
[13] Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992
[14] Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987

> 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.

WHEREFORE, premises considered, the instant opposition to Trademark Application Serial No. 42011014733 is hereby **SUSTAINED.** Let the filewrapper of Trademark Application Serial No. 42011014733 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 30 JUN 2016

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