NOVARTIS AG, Opposer, **-versus-** **FIRMLINK PHARMA PHILS., CO.,** Respondent- Applicant.	}	**IPC No. 14-2014-00064** Opposition to: Appln. No. 4-2012-011336 Date Filed: 14 September 2012 **TM: "DU-TAZOP"**

NOTICE OF DECISION

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1286 Sen. Gil Puyat Avenue cor. Urban Avenue
Makati City

GREETINGS:

Please be informed that Decision No. 2017 - 60 dated March 06, 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, March 06, 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

NOVARTIS AG,
Opposer,

-versus-

FIRMLINK PHARMA PHILS., CO.,
Respondent-Applicant.
x ----------x

IPC No. 14-2013-00064

Opposition to Trademark
Application. No. 4-2012-011336
Date Filed: 14 September 2012
TM: **"DU-TAZOP"**

Decision No. 2017-60

DECISION

Novartis AG[1] ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-011336. The contested application, filed by Firmlink Pharma Phils., Co.[2] ("Respondent-Applicant"), covers the mark "DU-TAZOP" for use on *"pharmaceutical product"* under Class 05 of the International Classification of Goods[3].

According to the Opposer, it is the owner of the "AZOPT" mark, which was first registered with the Office on 15 January 2002 under the name Alcon Universal Ltd. (now Novartis AG) for goods under Class 05 bearing Certificate of Registration No. 4-1997-119297. It has also applied for registration of the said mark in over fifty (50) countries all over the world. It contends that the Respondent-Applicant's mark "DU-TAZOP" is confusingly similar to "AZOPT" especially that the goods involved are covered by the same class. In support its Opposition, the Opposer submitted the following as evidence:[4]

1. Trademark Application No. 4-2012-011336 as published in the IPO E-Gazette;
2. certified true copy of the Request for Recordal of Merger;
3. certified true copy of Certificate of Registration No. 4-1997-119297;
4. list of "AZOPT" registrations around the world;
5. affidavit of its authorized representatives/signatories, Catherine D. Murray and Denise Vivar; and,
6. certified true copies of the Declarations of Actual Use ("DAU") for the "AZOPT" mark.

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[1] A corporation duly organized and existing under and by virtue of the laws of Switzerland with office address at CH-4002 Basel, Switzerland.
[2] With known address at Unit 909, Phil. AXA Life Center Bldg., 1286 Sen. Gil Puyat Ave. corner Urban Ave., Makati City.
[3] 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.
[4] Marked as Exhibits "A" to "G".

A Notice to Answer was issued and served upon the Respondent-Applicant on 24 April 2013. The latter, however, did not file an Answer. On 29 October 2013, the Adjudication Officer issued Order No. 2013-1496 declaring the Respondent-Applicant in default and submitting the case for decision.

The primordial issue in this case is whether the trademark application by Respondent-Applicant for "DU-TAZOP" should be allowed.

Section 123.1(d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), relied upon by Opposer, provides that:

> ***"Section 123.1. A mark cannot be registered if it:***
>
> ***xxx***
>
> ***(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; x x x"***

Records reveal that at the time the Respondent-Applicant filed the contested application on 14 September 2013, the Opposer has a valid and existing registration for the marks "AZOPT" issued as early as 15 January 2002.

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown below for comparison:

AZOPT	DU-TAZOP
Opposer's mark	*Respondent-Applicant's mark:*

Perusing the competing marks, it appears that the Respondent-Applicant merely added the "DU-T" at the beginning of the Opposer's mark and omitted the last letter "T". These notwithstanding, the marks "AZOPT" and "DU-TAZOP" still leaves the same impression. Noteworthy, the DAU for the Opposer's mark shows that "AZOPT" is being used for a pharmaceutical product with a generic name

brinzolamide. Having no connection to the nature, quality or purpose of the goods "AZOPT" covers, the said mark is highly distinctive.

Succinctly, 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 purchased as to cause him to purchase the one supposing it to be the other.[5] Aptly, the Supreme Court held in the case of **Del Monte Corporation vs. Court of Appeals**[6], thus:

> ***"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspicious and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."***

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."[7]

Furthermore, it is noteworthy that both marks cover goods under Class 05. The Respondent-Applicant's application states that it intends to use or uses "DU-TAZOP" for *"pharmaceutical preparation".* Such term is broad enough to include *"ophthalmic pharmaceutical products"*, which is covered by the Opposer's registration for "AZOPT". Since the marks closely resemble each other, it is highly possible that one who encounters the Respondent-Applicant's mark will be led to believe that "DU-TAZOP" is sponsored by, affiliated with or any way connected to the Opposer. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitations, the unanswered riddle is why of the

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[5] Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.
[6] G.R. No. L-78325, 25 January 1990.
[7] Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

millions of terms and the combinations of letters and designs available, the Respondent-Applicant has 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.[8] The Respondent-Applicant was given an opportunity to explain how it arrived at its mark but it did not file Answer.

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.[9] The Respondent-Applicant's trademark failed to meet this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-011336 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 MAR 2017

Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

[8] American Wire & Cable Company vs. Director of Patents, G.R. No. L-26557, 18 February 1970.
[9] Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, November 19, 1999.