

NOVARTIS AG,
Opposer,

-versus-

CIPLA LIMITED,
Respondent-Applicant.

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}	IPC No. 14-2016-00525
}	Opposition to:
}	Appln. Ser. No. 4-2016-005992
}	Date Filed: 27 May 2016
}	
}	
}	TM: SERDEP

NOTICE OF DECISION

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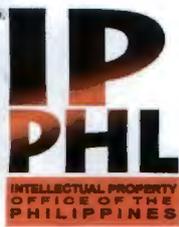
GREETINGS:

Please be informed that Decision No. 2017 - 329 dated 05 September 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, 07 September 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



NOVARTIS AG,
Opposer,

- versus -

CIPLA LIMITED,
Respondent-Applicant.

X-----X

IPC No. 14-2016-00525
Opposition to:

Appln. No. 4-2016-005992
Date Filed: 27 May 2016
Trademark: "SERDEP"

Decision No. 2017 - 329

DECISION

NOVARTIS AG ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2016-005992. The application, filed by CIPLA LIMITED ("Respondent-Applicant")², covers the mark "SERDEP" for use under class 05, particularly as *"pharmaceutical and veterinary preparations, specifically, the pharmaceutical preparations for the product sertraline used for treatment of anxiety; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides"* of the International Classification of Goods.³

The Opposer alleges the following grounds for opposition:

"12. The trademark SERDEP being applied for by respondent-applicant is confusingly similar to opposer's trademark SIMDEP 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.

"13. The registration of the trademark SERDEP 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 (IP Code), to wit:

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

² A corporation duly organized and existing under and by virtue of the laws of India, with business address at Cipla House, Peninsula Business Park, Ganpatrao Kadam Marg, Lower Parel, Mumbai 400 013, India.

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.

Sec. 123. Registrability. - 123.1. 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; [Emphasis supplied.]

"14. The registration and use by respondent-applicant of the mark SERDEP will diminish the distinctiveness and dilute the goodwill of opposer's trademark SIMDEP.

"15. The registration of the mark SERDEP in the name of respondent-applicant is contrary to other provisions of the IP Code of the Philippines."

In support of this instant case, the Opposer submitted a copy of the Certificate of Registration No. 4-2015-004422 for the mark SIMDEP, the Novartis AG's Annual Report for the year 2015, and the Corporate Secretary's Certificate appointing the Law Firm of E.B. Astudillo and Associates as counsel for the Opposer.

On 14 February 2017, this Bureau issued and served upon the Respondent-Applicant a Notice to Answer. Respondent-Applicant however, was declared in default for failure to file an Answer⁴.

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

Section 123.1 paragraph (d) of R.A. No. 8293, also known as the Intellectual Property Code ("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 if it nearly resembles such mark as to be likely to deceive or cause confusion.

Records show that the Opposer has Certificate of Registration No. 4-2015-004422 falling under Class 05 for the trademark SIMDEP dated 13 August 2015⁵. On the other hand, Respondent-Applicant applied for trademark registration of SERDEP on 27 May 2016. Unquestionably, the Opposer's application and registration preceded that of Respondent-Applicant's.

⁴ Order of Default dated 13 July 2017.

⁵ Exhibit "A" of Opposer.

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

SIMDEP

SERDEP

Opposer's Trademark

Respondent-Applicant's Trademark

The competing marks' similarity are the initial letter S, and the suffix DEP. On the other hand, the difference of the marks are presented in Opposer's trademark SIMDEP, which consists of the middle letters "I" and "M", as against Respondent-Applicant's trademark SERDEP, which consists of the middle letters "E" and "R". This difference, particularly the R consonant sound which probably has the hardest sounds among the alphabet, create a stark difference in the marks. It gives a divergent visual and aural character of the marks that can easily distinguish one from the other.

This Bureau also underscores the fact that although they belong to the same classification of goods, the pharmaceutical products are distinct in nature and different in use and purpose. The registration of Opposer's SIMDEP covers pharmaceutical preparations for human use⁶; whereas, Respondent-Applicant's SERDEP particularly covers pharmaceutical and veterinary preparations, specifically, the pharmaceutical preparations for the product sertraline used for treatment of anxiety; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides⁷. There can be no mistake in distinguishing the competing products. Respondent-Applicant's medicine is more specific in the illness it is intended to treat, and any buyer will exercise great degree of care and caution in purchasing medicines for the treatment of this kind of illness. Moreover, Respondent-Applicant's SERDEP is not an over-the-counter type of medicine, compared to Opposer's SIMDEP product.

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 SERDEP 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 SIMDEP. It is unlikely for one when confronted with the mark SERDEP to be reminded of the mark SIMDEP and *vice versa*.

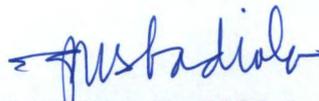
⁶ Id. at 5.

⁷ File wrapper files.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**.
Let the filewrapper of Trademark Application Serial No. 4-2016-005992 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 05 SEP 2017



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs