

SANOFI-AVENTIS (formerly  
known as SANOFI-SYNTHELABO)  
Opposer,  
-versus-

IPC NO. 14-2009-00029  
Case Filed: 26 January 2009  
Opposition to:  
Appln. Serial No. 4-2004-011401  
Date Filed: 25 November 2004  
Trademark: "GUARDIAN & DEVICE"

DAIRY FARM ESTABLISHMENT  
Respondent-Applicant.  
x-----x

Decision No. 2011- 47

## DECISION

Sanofi-Aventis (Opposer) filed on 26 January 2009, an opposition to Trademark Application Serial No. 4-2004-011401. The application, filed by Dairy Farm Establishment ("Respondent-Applicant"), covers the mark "GUARDIAN & DEVICE" for use on pharmaceutical and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, material for dressings; disinfectants; analgesics; antihelmintics, anti-rheumatism bracelets and rings; antiseptics; balms for medical purposes; lip balms; therapeutic preparations for baths, medicated bath preparations bath salts for medical purposes; bismuth preparations for pharmaceutical purposes; p reparations for the treatment of burns; capsules for medicines, capsules for pharmaceutical purposes; medicines for alleviating constipation, hemorrhoid preparations, laxatives, suppositories; contact lens cleaning preparations; eye-was& antiseptic cotton; cotton for medical purposes; surgical dressing; adhesive tapes for medical purposes; gauze for dressing; plasters for medical purposes; bandages for dressings; pharmaceutical preparations for treating dandruff; articles for headache; stomach medicine; insect repellents; moth balls; petroleum jelly for medical purposes; lecithin for medical purposes; lotion for pharmaceutical purposes; magnesia for pharmaceutical purposes; medicinal akoho4 anti acid medicine; medicines for human use; medicinal oils; cod liver oi4 nutritional additives for medical purposes; salts for medical purposes; pharmaceutical preparations for skincare; sunburn ointments; sunburn p reparations for pharmaceutical purposes; thymol for pharmaceutical purposes; tincture of iodine vitamin preparations, medicinal chewing gums/medicated confectionery, herbs and tonics; health food supplements, medical p reparations for slimming purposes; foods for babies; deodorants other than for personal use; air freshening preparations; first aid box, vulnerary sponges; contraceptives; impregnated tissues for cleaning (medicated); sanitary pads under Class 05.

The Opposer alleges among other things the following:

"8. Opposer believes that, as the leading pharmaceutical company in the world and owner of the registered and internationally and locally well-known mark, 'GARDAN' also for Class 5, it would be damaged by the registration of the marks 'GUARDIAN and Device' in the name of Respondent-Applicant.

"9. Opposer also believes that the registration of the mark 'GUARDIAN and Device' in the name of Respondent-Applicant is contrary to the provision of section 123.1 pars (d) (e) and (g) of RA 8293 also known as the Intellectual Property Code of the Philippines, to wit:

x x x

"The Opposer relies on the following facts:

"10. Opposer was formed in 2004 when Sanofi-Synthelabo merged with Aventis, thereby creating one of the world's leading companies, and in fact, Europe's number 1, in the

pharmaceutical business. It is present in 100 countries throughout the world. As of 2007, Opposer has about 100, 000 employees worldwide and a sales force of 35,000 medical visitors, It has consolidated sales of 28 Billion Euros and has spent more than 4 billion Euros in research and development.

“11. Opposer is the owner of the trademark ‘GARDAN’ which has been in the Philippine market for more than 70 years. In the 1950s, ‘GARDAN’ was very strong among dentists, because it used to have a more potent formulation (DIPYRONE which is no longer marketed now). In the 1970’s, ‘GARDAN’ was reformulated.

In the late 1990’s, GARDAN was widely publicized through television advertising. In 2002, the very popular ‘GARDAN Angel’ ad campaign was launched.

“12. Opposer’s well-known mark, GARDAN is registered with the Intellectual Property Office (IPO) of the Philippines x x x A copy of Registration No. 4-2003-009091 is attached herewith as Exhibit C.

“13. Opposer has also obtained and continues to obtain registrations for its well known trademark ‘GARDAN’ from the Intellectual Property Offices of various countries around the world. Attached hereto as Exhibit D is a copy of the duly notarized and authenticated Affidavit-Direct Testimony of Josee Sanchez, Lawyer of Opposer. Likewise attached as Exhibit ‘E’ is a copy of the Affidavit of Ms. Zenaida Ponce, Quality and Regulatory Affairs Director of Sanofi Aventis Philippines dated March 29, 2007 and her Supplemental affidavit as Exhibit ‘F’, proving the allegations contained herein.

“14. The mark ‘GARDAN’ is registered and/or has pending applications in Afghanistan, Antigua and Barbuda, Bahamas, Bangladesh, Barbados, Bermuda, Burundi, Cambodia, Chile, China, Costa Rica, Dominica, Dominican Republic, El Salvador, Guatemala, Honduras, Hong-Kong, Indonesia, Jamaica, Laos, Myanmar, Nicaragua, Pakistan, Paraguay, Philippines, Sainte Lucie, Sri Lanka, Taiwan, Trinidad and Tobago, United Kingdom, Uruguay and Vietnam. Attached as Exhibit G is a schedule of the worldwide active registrations and pending applications of the mark ‘GARDAN’ in the name of Opposer.

“15. Opposer also maintains the website <http://en.sanofi-aventis.com/> where information about the company’s history, range of products (including ‘GARDAN’), research and development efforts, among others, are all outlined for easy access by consumers all over the world. Attached as Exhibits H to L are various printouts of the aforementioned web site.

“16. Opposer, has also spent significant amounts of money in advertising and promoting products bearing the ‘GARDAN’ trademark. As a result of Opposer’s extensive efforts in advertising and promoting its products bearing the mark ‘GARDAN’, and its marketing strategy, Opposer has captured a substantial market share in pharmaceutical products. Attached as Exhibits M to T are invoices showing proof of sale of ‘GARDAN’ products in the Philippines.

“17. In view of the above multi-country registration, extensive marketing and advertisement efforts and dense market penetration, there is no doubt that Opposer’s mark ‘GARDAN’ is well-known, both in the Philippines and abroad.

“18. Clearly, the registration of the trademark ‘GUARDIAN and Device’ in the name of Respondent-Applicant will violate Section 123.1 pars (d) (e) and (g) of R.A. 8293 which provides:

19. The mark 'GUARDIAN and Device', used or applied in Respondent-Applicant's goods, is practically identical both in its spelling and pronunciation to Opposer's registered and well-known mark 'GARDAN'. The aural and visual similarity between Respondent-Applicants 'GUARDIAN and Device' mark and the registered and well-known trademark 'GARDAN' of Opposer is very likely to deceive the purchasers of goods on which the marks are being used, not only as to the origin or sponsorship of said goods, but also as to the nature, quality and characteristics of the goods to which the mark is affixed.

"20. It should be noted that the contending marks not only have practically the same spelling but also practically identical in sound. x x x

"21. It should be noted that it is not necessary that the trademark be exactly copied in order for it to be considered as confusingly similar. The dominancy test is applied to determine confusing similarity. This test focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitute infringement."

x x x

"22. In the case at bar, the contending marks are virtually identical except the presence of the insignificant letter U and I. This insignificant difference, however, disappears when the marks are written in long hand, as would be in a prescription, rendering confusion extremely likely.

"24. It should be remembered that doctors prescribe medicines using longhand. Prescriptions of doctors for the drug gardan may be misread not only by the patient but also by pharmacists as gardan, not only taking away the sales that properly pertains to Opposer, but more important, puts at risk the life and health of the patient. It should be noted that the contending marks are to be used in pharmaceutical products under Class 5, thus there is the heightened risk of confusion.

"25. In addition to the practical identity of the contending marks as printed in labels and as written in a prescriptions the contending marks 'GARDAN' and 'GUARDIAN' are likewise aurally identical, thus confusion becomes a practical certainty.

"26. The imminent confusion is compounded by the fact that Opposer has identified its 'GARDAN' product with the word 'GUARDIAN'.

"27. As clearly shown by the affidavits of Ms. Ponce and its attachments, Opposer has identified their product with the word 'GUARDIAN', as early as 2002, long before Respondent-Applicant's attempt to register the mark 'GUARDIAN', through its extensive advertising campaign using the 'GARDAN ANGEL' concept and the tagline 'sa matinding sakit i-GARDAN ANGEL mo'. Attached herewith as Exhibits I to M are just some of the advertising materials for 'GARDAN' using the 'GARDAN ANGEL' concept.

"28. As a result of the close similarity of the mark 'GARDAN' and the word 'GUARDIAN' and the easy recall of the phrase 'GUARDIAN ANGEL', Opposer adopted the 'GARDAN ANGEL' concept to enhance the name recall of its mark and adopted the phrase sa matinding sakit, i-GARDAN ANGEL mo'. Thus, creating in the mind of the consuming public a belief that, 'GARDAN' and 'GUARDIAN' are one and the same.

"29. It would be unjust to Opposer and dangerous to the public, not to mention the fact that it is expressly proscribed by Section 123.1 pars (d) (e) and (g) of RA 8293, otherwise known as the Intellectual Property Code of the Philippines, to allow the registration of the mark 'GUARDIAN' in the name of Respondent-Applicant.

“30. Confusion on pharmaceutical products, unlike ordinary consumer products, it should be noted, would result to dire consequences on patient and public safety. Hence, extra precautions should be adopted to prevent confusion and to safeguard the consuming public from the fatal effects of taking the wrong medication.

“31. In view thereof, the mark ‘GUARDIAN’ should not be allowed registration.

“32. It has often been said that ‘While dealing with cases relating to passing off, one of the important tests which has to be applied in each case is whether the misrepresentation made by the defendant is of such a nature as is likely to cause an ordinary consumer to confuse one product for another due to similarity of marks and other surrounding factors. xxx However, the test to be applied for adjudging the violation of trademark law may not be at par with cases involving non-medicinal products. A stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by the consumer. While confusion in the case of non-medicinal products may only cause economic loss to the plaintiff, confusion between two medicinal products may have disastrous effects on health and in some cases life itself xxx The confusion as to the identity of the product itself could have dire effects on the public health.’

The Opposer’s evidence consists of the following:

1. Exh. “A” - Original Copy of the duly executed and authenticated Special Power of Attorney;
2. Exh. “B” - Verification and Certification against Forum Shopping executed by Ruby Monte, an associate of Vera Law;
3. Exh. “C” - A copy of Reg. No. 4-2005-009091;
4. Exh. “D” to “D-2” - Copy of the duly notarized and authenticated Affidavit Direct Testimony of Josee Sanchez, Lawyer of Opposer;
5. Exh. “E” - Copy of the Affidavit of Ms. Zenaida Ponce, Quality and Regulatory Affairs Director of Sanofi-Aventis Philippines;
6. Exh. “F” - Supplemental affidavit of Ms. Zenaida Ponce;
7. Exh. “G” - schedule of the worldwide active registrations and pending applications of the mark GARDAN;
8. Exh. “H” to “L”- various printouts of [http://en.sanofi\\_aventis.com](http://en.sanofi_aventis.com); and
9. Exh. “M” to “T” - invoices showing proof of sale of GARDAN products in the Philippines.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 16 March 2009. The Respondent-Applicant, however, did not file an Answer. Under Rule 2, Sec. 11 of the Regulations on Inter Partes Proceedings, as amended, if the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the opposition, the affidavits of the witnesses and the documentary evidence submitted by the Opposer.

Is the Opposer’s mark a well-known mark?

Rule 102 of the Trademark Regulations sets forth the criteria for determining whether a mark is well-known, to wit:

Rule 102. Criteria, for determining whether a Mark is Well-known. In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- a. the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- b. the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- c. the degree of the inherent or acquired distinction of the mark;
- d. the quality-image or reputation acquired by the mark;
- e. the extent to which the mark has been registered in the world;
- f. the exclusivity of registration attained by the mark in the world;
- g. the extent to which the mark has been used in the world;
- h. the exclusivity of use attained by the mark in the world;
- i. the commercial value attributed to the mark in the world;
- j. the record of successful protection of the rights in the mark;
- k. the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- l. the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

The Opposer submitted a schedule or list of worldwide active registrations and pending trademark applications, various printouts of its website, and sales invoices of products involving the mark GARDAN. These, however, are insufficient to declare the mark well-known under Rule 2 of the Trademark Regulations. It is stressed that the law confers substantial rights in terms of protection to trademarks that are declared to be well-known. Thus, the process of declaring a mark well-known requires submission of competent evidence to show that at least a combination of the criteria set forth in the above-quoted rule concurs. Not even the personal knowledge on the subject trademark of the person who is deemed the "competent authority" to declare a mark well-known could supplant the required evidence or proof.

But, should the Respondent-Applicant be allowed to register the mark GUARDIAN?

It is emphasized that 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.

Records show that the Opposer filed an application for the registration of the mark GARDAN on 01 October 2003 and subsequently obtained registration thereof on 27 November 2006 under Trademark Reg. No. 4-2003-009091. The application, which preceded the Respondent-Applicant's and the registration cover the goods "analgesics", "antipyretics", and "anti-inflammatories".

In this regard, this Bureau noticed that the Respondent-Applicant's application covers goods that are similar or closely related to those indicated in the Opposer's registered trademark, particularly, analgesics, balms for medical purposes; lip balms; preparations for the treatment of burns; petroleum jelly for medical purposes; lotion for pharmaceutical purposes; magnesia for pharmaceutical purposes; medicines for human use; sunburn ointments; sunburn preparations for pharmaceutical purposes. With respect to the said goods, this Bureau finds that the resemblance of the competing marks, shown below, is likely to cause confusion or deception among the consumers:



Opposer's trademark



Respondent-Applicant's mark

Obviously, the only difference between the marks is the presence of the letters "U" and "I" and a device in the Respondent-Applicant's mark. When pronounced, the competing marks sound almost exactly the same such that when looking at them as written or printed, the eyes are likely to focus on the letters "G", "A", "R", "D", and "N". Because of these resemblance in looks and in sound, the Respondent-Applicant's mark is considered a colorable imitation of the Opposer's mark with respect to analgesics, balms for medical purposes, lip balms, preparations for the treatment of burns, petroleum jelly for medical purposes, lotion for pharmaceutical purposes, magnesia for pharmaceutical purposes, medicines for human use, sunburn ointments, and sunburn preparations for pharmaceutical purposes are concerned.

Colorable imitation does not mean such similitude as amounts to identity, nor does it require that all the details be literally copied. Colorable imitation refers to such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade-name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application for GUARDIAN & DEVICE, as far as analgesics, balms for medical purposes, lip balms, preparations for the treatment of burns, petroleum jelly for medical purposes, lotion for pharmaceutical purposes, magnesia for pharmaceutical purposes, medicines for human use, sunburn ointments, and sunburn preparations for pharmaceutical purposes, are concerned, is proscribed by Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), which states that a mark shall not be registered if it:

(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;

WHEREFORE, premises considered, the instant Opposition case is hereby SUSTAINED as far as analgesics, balms for medical purposes, lip balms, preparations for the, treatment of burns, petroleum jelly for medical purposes, lotion for pharmaceutical purposes, magnesia for

pharmaceutical purposes, medicines for human use, sunburn ointments, and sunburn preparations for pharmaceutical purposes are concerned. With respect to the other goods indicated in Trademark Application No. 4-2004-011401, the opposition is hereby DENIED.

Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 May 2011.