

SANOFI-AVENTIS (formerly known as	}	IPC NO. 14-2007-00359
SANOFI-SYNTHELABO),	}	Case Filed on: 17 December 2007
<i>Opposer,</i>	}	
	}	Opposition to:
	}	
-versus-	}	Appln. Ser No. : 4-2007-002868
	}	Date Filed : 19 March 2007
	}	Trademark : "FINTOP"
GLENMARK PHARMACEUTICALS, LTD.,	}	
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2009-97

DECISION

For decision is the Notice of Opposition filed by Sanofi-Aventis, (hereinafter referred to as Opposer), a corporation organized and existing under 174 Avenue de France, 75013, Paris, France against Application Serial No. 4-2007-002868 for the mark FINTOP covering goods under class 5 namely: "Pharmaceutical preparation & substance for treatment of the following dermatophytoses; interdigital tinea pedis (athlete's foot); tinea corporis (ringworm); tinea cruris (jock itch) due to *E. floccosum*, *T. Mentagrophytes*, *T. Rubrum* & *T. Tonsurans*", filed on 19 March 2007 in the name of Glenmark Pharmaceuticals, Ltd., (hereinafter referred to as Respondent-applicant), with address at Plot No. E-37 to 39, D-Road, M.I.D.C., Sapur, Nasik-422007.

The grounds for opposition are as follows:

- "1. Opposer SANOFI-AVENTIS is a foreign corporation duly organized and existing under the laws of France, with principal address at 174 Avenue de France, 75013, Paris France. Notices and processes relative to the instant case may be served to the undersigned counsel as Opposer's duly authorized representative. The duly executed and authenticated "Subdelegations de Pouvoirs" (Subdelegation of Powers) authorizing Ms. Josee Sanchez to sign any document required for the filing of opposition cases is attached hereto as Exhibit A. The duly executed and authenticated Special Power of Attorney executed by Ms. Josee Sanchez in favor of the undersigned counsels is attached hereto as Exhibit B. The authenticated Verification and Certification against Forum Shopping executed by Russel S. Alabado is hereto attached as Exhibit C.

- "2. The Regulations on Inter Partes Proceedings, particularly, Rule 2, Section 4 thereof, provides that:

Section 4. Rights of foreign corporation to sue in trademark or service mark enforcement action. – Any foreign national or judicial person whether or not engaged in business in the Philippines may bring a petition for opposition, cancellation or compulsory licensing; Provided, That the country of which he or it is a national, or domiciled or has a real and effective industrial establishment, is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law


- “3. Opposer has its real and effective commercial establishment in France, which country is a member of the Paris Convention of which the Philippines is a signatory by virtue of Senate Resolution No. 89 dated May 10, 1965. Opposer therefore has a right to oppose Respondent-Applicant’s application for registration of the trademark FINTOP, notwithstanding that it is not doing business in the Philippines.
- “4. Respondent-Applicant purports to be an Indian corporation with address of records as above-stated, where it may be served with the notices and processes of this Honorable Office. However, Respondent-Applicant’s juridical personality and capacity to act have not been established in the Philippines.
- “5. On March 19, 2007, Respondent-Applicant filed the application for the mark FINTOP under Application No. 4-2007-002868, covering the goods in Class 05 specifically for “*pharmaceutical preparation & substance for treatment of the following dermatophytoses; interdigital tinea pedis (athlete’s foot); tinea corporis (ringworm); tinea cruris (jock itch) due to e. floccosum, t. mentagrophytes, t. rubrum & t. tonsurans.*” This application was published for opposition in the e-Gazette on August 17, 2007.
- “6. In accordance with the Rules and Regulations on Inter Partes Proceedings, Opposer filed with this Honorable Office three (3) successive Motions for Extension of Time to File Verified Notice of Opposition, all of which were granted. Thus, Opposer has until December 15, 2007 within which to file Verified Notice of Opposition to the application for the mark FINTOP in the name of Respondent-Applicant. Considering that December 15, 2007 falls on a Saturday, the deadline was automatically moved to the next working day Monday, December 17, 2007. Opposer believes that it would be damaged by the registration of the mark FINTOP in the name of Respondent-Applicant.

In support of the opposition, it submitted the following evidence:

EXHIBIT	DESCRIPTION
“A”	<i>Subdelegation de Pouvoirs</i>
“B”	Special Power of Attorney
“C”	Verification and Certification
“D”	Copy of Registration No. 4-2005-000596
“E”	Schedule of worldwide registrations
“F”	Print-out of web pages

A Notice to Answer dated 16 January 2008 was served upon respondent-applicant but it failed to file any Answer.

The issue for consideration is whether the mark FINTOP is confusingly similar to opposer’s mark WINTHROP both used for goods under class 5. The marks of the contending parties are reproduced below for comparison.

Opposer's mark	Respondent-Applicant's mark
<p>WINTHROP</p>	

The Intellectual Property Code states:

“Section – 123.1. A mark cannot 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”

In determining whether the two marks are confusingly similar, the Supreme Court developed two tests. In *McDonald’s Corporation v. L.C. Big Mak Burger, Inc.*, G.R. No. 143993, dated 18 August 2004, the Supreme Court held:

“In determining likelihood of confusion, jurisprudence has developed to tests, the dominance test and the holistic test. The dominance test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion. In contrast, the holistic test requires the court to consider the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity. xxx

This Court, however, has relied on the dominance test rather than the holistic test. The dominance test considers the dominant features in the competing marks in determining whether they are confusingly similar. under the dominance test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences.”

Likewise, the Supreme Court in *Mighty Corporation and La Campana Fabrica de Tabaco, Inc. vs. E. & J. Gallo Winery and the Andersons Group, Inc.*, G.R. No. 154342. July 14, 2004 held:

“Jurisprudence has developed two tests in determining similarity and likelihood of confusion in trademark resemblance:

- (a) the Dominance test applied in *Asia Brewery, Inc. vs. Court of Appeals and other cases* and
- (b) the Holistic or Totality Test used in *Del Monte Corporation vs. Court of Appeals and its preceding cases*.

The Dominance Test focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception, and thus infringement. If the competing trademark contains the main, essential or

dominant features of another, and confusion or deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate. The question is whether the use of the marks involved is likely to cause confusion or mistake in the mind of the public or deceive purchasers.”

In *American Wire & Cable Co. vs. Director of Patents*, 31 SCRA 544, the Supreme Court held:

“In fact, even their similarity in sound is taken into consideration, where the marks refer to merchandise of the same descriptive properties, for the reason that trade *idem sonans* constitutes violation of trade mark patents.”

The Bureau notes that the dominant feature of the mark is the word mark itself, WINTHROP (Exhibit “D”, “F”). A comparison of the marks shows that the prefix and suffix of both marks when pronounced are distinct. Although the prefixes both end with the letters IN, WIN and FIN produce totally different sounds. Moreover, even if both marks similarly end in the letters OP, THROP and TOP are phonetically distinct. When the syllables are combined, the marks are aurally different and visually distinct as well.

Assuming for the sake of argument that the opposer’s mark WINTHROP is well-known does not bolster its cases for the simple reason that applying the dominancy test, the marks of the contending parties are different from each other hence the likelihood of confusion is remote.

Moreover, in determining whether there is a likelihood of confusion in the contemporaneous use of the marks, the type of purchaser and attendant circumstances to the sale must be considered. In *Dy Buncio v. Tan Tiao Bok* 42 Phil 190 (1921), court noted that:

“the “purchaser” is not the “completely unwary consumer” but is the “ordinarily intelligent buyer” considering the type of product involved.”

Giving due regard to the goods’ usual purchaser’s profile or character and attitude in purchase of pharmaceutical products and considering further that the word marks are not the same, the Bureau believes that a customer will not mistake or confuse goods bearing FINTOP as the products of the oppose bearing the mark WINTHROP, hence both marks may co exist.

WHEREFORE, premises considered the OPPOSITION filed by opposer, Sanofi-Aventis is, as it is hereby, DISMISSED. Accordingly, Application Serial No. 4-2007-002868 for the mark FINTOP filed by Respondent-Applicant, Glenmark Pharmaceuticals, Ltd., is, as it is hereby given DUE COURSE.

Let the filewrapper of “FINTOP”, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 19 August 2009.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office