

SANOFI-AVENTIS,
Opposer,
-versus-
MEGA LIFESCIENCES CO., LTD.,
Respondent-Applicant.
x-----x

IPC NO. 14-2008-00148
Case Filed : 04 July 2008
Opposition to:
Serial No. : 4-2007-014339
Filed : 30 April 2007
Trademark : "VALIX"

Decision No. 2009-80

DECISION

For decision is an Opposition filed by Sanofi-Aventis, a corporation duly organized and existing under the laws of France, with principal business address at 174, Avenue de France, 75013 Paris, France, against the registration of the trademark "VALIX" for pharmaceutical products under Class 05 with Application Serial No. 4-2007-014339 and filed on 30 April 2007 by Mega Lifesciences Co., Ltd. of 384 SO1 6 Pattan 3 Road Bangpoo Industrial Estate Samutprakarn, Thailand.

The subject application was published for opposition in the E-Gazette on 07 March 2008. The Oppositor filed their Verified Notice of Opposition on 07 July 2008.

The grounds for opposition to the registration of the trademark VALIX are as follows:

"1. Under existing law, rules and jurisprudence, the mark VALIX should not be registered by this Honorable Office because the registration of the mark subject of this opposition is contrary to Section 123.1 (d) of the Intellectual Property Code, which prohibits the registration of a mark that:

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;"*

x x x

"2. The Opposer has not consented to the Respondent-Applicant's use and registration of the mark VALIX, or any other mark identical or similar to its PLAVIX mark for that matter.

"2.1 That the Respondent-Applicant adopted the mark VALIX for its products also in Class 05 is clearly an attempt to trade unfairly on the goodwill, reputation and awareness of the Opposer's PLAVIX mark that was previously registered by this Honorable Office on May 21, 1996 and which has been registered and applied for registration worldwide.

"3. The Respondent-Applicant's mark VALIX is confusingly similar to the Opposer's mark and is applied for the same class of goods as that of the Opposer's registration, which would be likely to deceive or cause confusion as to the origin of the goods.

“3.1 Goods are closely related when they belong to the same class of have the same descriptive properties or when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality.

“3.2 Both marks are grouped under Class 05 as pharmaceutical products which would likely cause confusion, such confusion can be dangerous to the consumer of the products since the goods involved relate to medicinal products which, when used improperly, may cause, the patient more harm than good.

“4. Respondent-Applicant’s mark resembles the Opposer’s PLAVIX mark in terms of spelling, pronunciation and appearance as to be likely to deceive or cause confusion. Hence, the registration of said mark violates Section 123.1 (d) of the Intellectual Property Code.

“4.1 Both marks consist of two syllables which substantially sound the same.

“4.2 Both marks end with the letters I and X.

“4.3 Out of the six (6) letters of which the Opposer’s mark is imposed, Respondent-Applicant’s mark contains five (5) of them, namely: L, A, V, I and X.

“4.4 Both marks are all in capital letters.

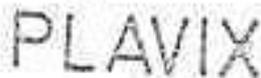
“5. By the Respondent-Applicant’s use of the mark VALIX, the Respondent-Applicant takes advantage of the goodwill and reputation which the Opposer has established throughout the years, resulting in the diminution of the value of the trademark PLAVIX.

“6. Evidently, the Respondent-Applicant’s mark cause confusion in the minds of the consumers by usurping the mark PLAVIX, a mark legally owned by the Opposer, and passing off its own products as those made by the Opposer.

“7. The denial of Application No. 4-2007-004339 for the mark VALIX by this Honorable Office is authorized under other provisions of the Intellectual Property Code.

Opposer relied on the following facts to support their contentions in this Opposition:

“2. The Opposer is the owner of the mark PLAVIX, to wit:



Which was registered by this Honorable Office on 21 May 1996 under Registration No. 63004 covering goods in Class 05, specifically for pharmaceutical products for the prevention and treatment of cardio-vascular disorders.”

“3. On April 30, 2007, Respondent-Applicant filed with this Honorable Office Trademark Application No. 4-2007-004339 for VALIX in Class 05, specifically for “pharmaceutical preparation containing root of valerian extract and other ingredients for promoting sleep for medical use” to wit:

VALIX

With the following description:

The mark consists of five capital roman letters written in special font style and all of letters are capitalized.

This Bureau sent a Notice to Answer dated 14 July 2008 informing Respondent-Applicant’s agent, Ms. Rachel G. Redobla, that a Verified Notice of Opposition was filed against the registration of her mark VALIX under Application Serial No. 4-2007-014339 and requiring to file her Verified Answer to the said Opposition within thirty (30) days from receipt thereof. Despite receipt of the Notice to Answer, Respondent-Applicant neither filed her Verified Answer nor any motion relative thereto. Thus, considering that no Answer has been filed, this Bureau issued Order No. 2009-865 which considered the case submitted for decision based on the Opposition, affidavits of the witnesses and documentary evidence submitted by the Opposer.

In a Manifestation/Compliance dated 04 July 2008, Opposer submitted their evidences in support of the instant Opposition, namely:

1. Original Verified Notice of Opposition - *Exhibit “A”*
2. Original Verified Affidavit of Ms. Beatrice Hammerer consisting of 2 pages with attachments - *Exhibit “B”*
3. Original Verified Special Power of Attorney - *Exhibit “C”*

Briefly the main issue posited for resolution of this Bureau is the propriety of Application Serial No. 4-2007-004339; whether or not Respondent-Applicant is entitled to register the trademark VALIX covering goods under Class 05 specifically for pharmaceutical preparation containing root of valerian extract and other ingredients for promoting sleep for medical use.

After close scrutiny and careful evaluation of the records and evidence presented, this Bureau finds substantiation on the grounds relied upon to sustain this instant Opposition.

A cursory reading of paragraph (d) of R.A. 8293 with emphasis on prior registration and/or application of the same mark involving same or similar goods/services states that:

“Section 123. Registrability. – 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;”*

xxx

The preceding section provides that it is the owner of a registered mark or an owner of a mark with an earlier filing date or priority date that can oppose an application for registration of another mark involving the same or related goods or services. The purpose of the Trademark Law is to provide protection not only to the owner of the trademark or proprietor of a mark with an earlier filing or priority date in exact adherence to the First-to-File Rule as one important factor of registrability under R.A. 8293 likewise, and more importantly, to the unwary public that they may not be confused, mistaken or deceived by goods they buy or services they avail. Records will show that as between the parties, Opposer’s application has an earlier filing date. Opposer’s trademark PLAVIX was filed on 21 January 1994 while Respondent-Applicant’s application for substantially the same mark VALIX came more than a decade after or specifically on 30 April 2007. Respondent-Applicant’s later application for substantially the same mark VALIX was for the same pharmaceutical products. Specifically, Opposer’s goods under Registration No. 063004 cover the following:

Pharmaceutical products for the prevention and treatment of cardio-vascular disorders (Class 05).

while, Respondent-Applicant’s pharmaceutical products subject of the instant suit include the following:

Pharmaceutical preparation containing root of valerian extract and other ingredients for promoting sleep for medical use. (Class 05).

On the basis of the evidence presented, there is shown clear and convincing proof that the two (2) competing trademarks, PLAVIX of Opposer and Respondent-Applicant’s VALIX are confusingly similar. The style in which the letters are written and spelled are almost the same, both marks contain the letters V, A, L, I, and X, which dominates the whole appearance of Applicant’s mark and which letters V, A, L, I and X can all be found in Opposer’s PLAVIX, thus, similarities in the dominant feature of both marks are not lost. It is noteworthy to cite at this juncture the ruling of the Supreme Court in the cases of *Co Tiong Sa v. The Director of Patents* (95 Phil 1 (1954); *Sapolin Corp. vs. Balmaceda* (67 Phil. 705); and *Forbes Nurma & Co. vs. Ang San To* (40 Phil. 272) which applied the dominancy test in determining the existence of confusing similarity between trademarks, that “if there is similarity with the essential or dominant feature of the trademark, despite some differences or variations in detail, *there is infringement.*”

Below is a side-by-side comparison between Opposer’s PLAVIX and Respondent-Applicant’s VALIX word marks, subject of this instant suit and/or opposition. Applicant copied the printing style and the choice of adopting a word mark without any accompanying device for use on pharmaceutical preparations, thus:

The image shows the word "PLAVIX" in a light, faded, sans-serif font, appearing as if it were a watermark or a very light print on a textured background.

*Opposer’s PLAVIX trademark
under Application Serial No. 063004*

The image shows the word "VALIX" in a bold, black, serif font with wide letter spacing, presented in a clean, high-contrast style.

*Respondent-Applicant’s VALIX mark
under Application No. 42007004339*

In an effort to make registrable and otherwise unregistrable trademark because it is confusingly similar to a prior or previously registered trademark of Opposer, Respondent-Applicant jumbled the letters V, A, L, I and X and removed the letter P, however. Such effort or attempt is insignificant as to yield a distinct appearance for Applicant's VALIX mark, considering that all the letters V, S, L, I, X are found in Opposer's PLAVIX trademark and both marks bear the same suffixes, IX.

The Court observed in *Philippine Refining Co, Inc., vs. Dir. Of Patents and Sparklets Corp. vs. Walter Kidde Sales Co.*, 104 F. 2d 396, that "a trademark is designed to identify the user. It should be so distinctive and sufficiently original as to enable those who come into contact with it to recognize instantly the identity of the user. It must be affirmative and definite, significant and distinctive, capable to indicate the origin." Likewise, our trademark law does not require identity, confusion is likely if the resemblance is so close between two trademarks. Bolstering this observation is the pronouncement by the court in the case of *Forbes, Munn & Co. (Ltd.) vs. Ang San To*, 40 Phil. 272, 275) where it states that *the test was similarity or "resemblance between the two (trademarks) such as would be likely to cause the one mark to be mistaken for the other. . . . [But] this is not similitude as amounts to identity."*

Having thoroughly discussed and resolved issues on confusion and priority in use and application, we shall now be delving on the goods involved.

The goods involved are the same, they pertain to pharmaceutical products all falling under Class 05 of the International Classification of Goods/Services. Thus, applying these competing marks to the same pharmaceutical products and marketed similarly, may lead to confusion in trade and would damage Opposer's goodwill or reputation which it has painstakingly earned and established for quite and/or considerable period of time.

In like manner, the Supreme Court made the following pronouncements to the effect that:

"The tradename "LIONPAS" for medicated plaster cannot be registered because it is confusingly similar to "SALONPAS", a registered trademark also for medicated plaster. x x x Although the two letters of "SALONPAS" are missing in "LIONPAS", the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. "(Marvex Commercial Co vs Hawpia & Co., 18 SCRA 1178),

"The similarity between the two competing trademarks, DURAFLEX and DYNAFLEX is apparent. Not only are the initial letters and the last half of the appellations identical but the difference exists in only two out of the eight literal elements of the designations. Coupled with the fact that both marks cover insulated flexible wires under Class 20; x x x no difficulty is experienced in reaching the conclusion that there is a deceptive similarity that would lead the purchaser to confuse one product with the other." (American Wire and Cable Co. vs Director of Patents, 31 SCRA 544),

Opposer is the registered owner, originator, prior applicant and user of the trademark PLAVIX for pharmaceutical products. The use and adoption by Applicant of the mark as subsequent user can only mean that Applicant wishes to reap on the goodwill and benefit from the advertising value and reputation of Opposer's PLAVIX trademark.

In the case of *American Wire & Cable Co. vs. Director of Patents*, 31 SCRA 544, it was observed that:

"Why of the million of terms and combination of letters and designs available the appellee had to choose a mark so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark"

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, application bearing Serial No. 4-2007-004339 filed by Mega Lifesciences Co., Ltd., on 30 April 2007 for the registration of the mark Respondent-Applicant "VALIX" for pharmaceutical for promoting sleep for medical use under Class 05 is, as it is hereby REJECTED.

Let the filewrapper of VALIX, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, 15 June 2009.

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