

SANOVI – AVENTIS  
Opposer,

- versus -

METRO PHARMA PHILS., INC.,  
Respondent-Applicant.  
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IPC No. 14-2009-00216  
Opposition to:

Appln. Serial No. 4-2008-013016  
Date Filed: 23 October 2008

Trademark: "PRAVOX"  
Decision No. 2010-81

## DECISION

SANOVI-AVENTIS ("Opposer"), a corporation organized and existing under the laws of the Republic of France, with principal business address at 174, Avenue de France, 75013 Paris, France, filed on 28 August 2009 an opposition to Trademark Application Serial No. 4-2008-013016. The trademark application, filed by METRO PHARMA PHILS., INC. ("Respondent-Applicant"), a domestic corporation with address at No. 600 Shaw Boulevard, Pasig City, on 23 October 2008, covers pharmaceutical drug used in the treatment of a wide range of infections, including lower respiratory tract infections, skin and soft tissue infections, typhoid and paratyphoid fever and urinary infections, under Class 5 of the International Classification of Goods.<sup>1</sup>

The Opposer alleges the following:

"1. Under existing law, rules, and jurisprudence, the mark PRAVOX 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:

(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)

"2. The Respondent-Applicant's mark PRAVOX is confusingly similar to the Opposer's mark, in that:

- 2.1. Both marks consist of two syllables which substantially sound the same.
- 2.2. The first letter of both marks is the letter P.
- 2.3. The third letter of both marks is letter A.
- 2.4. The fourth letter of both marks is the letter V.
- 2.5. Both marks end with letter X.
- 2.6. Out of the six (6) letters composing the Opposer's mark, the Respondent-Applicant's mark contains four (4) of them, namely: P, A, V and X.
- 2.7. Both marks are even used on goods of the same class, i.e; pharmaceutical products.

"3. The Respondent-Applicant's selection of the mark PRAVOX may take advantage of the worldwide reputation of the mark PLAVIX that the Opposer gained by ingenious and

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<sup>1</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a multi-lateral 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 purposes of the registration of Marks concluded in 1957.

persistent marketing efforts and the expenditure of large sums of money therefore. The registration of the Respondent-Applicant's mark and use in commerce in the Philippines will likely confuse and mislead or deceive the public that the Respondent-Applicant's products are those being sold or approved by or origination from the Opposer.

"4. Furthermore, the use and registration of the Respondent-Applicant's mark PRAVOX will dilute the distinctive character of the Opposer's valuable registered mark PLAVIX.

"5. The Respondent-Applicant seeks to register the mark PRAVOX which is confusingly similar to Opposer's mark PLAVIX, as to be likely, when applied to the goods of the Respondent-Applicant, to cause confusion, mistake or deception on the public as to its source. Such will inevitably falsely suggest a trade connection between the Opposer and the Respondent-Applicant.

"6. Moreover, of all the words or combinations of letters available to the Respondent-Applicant, the Respondent-Applicant knowingly chose to use a confusingly similar mark to that of the Opposer's mark on the same products and products that flow through the same channels of trade as those of the Opposer's. For the above reasons, the Opposer will surely be damaged by the registration of the mark PRAVOX.

"In support of this Opposition, Opposer will rely upon and prove the following facts:

"1. The Opposer is the owner of the mark PLAVIX which was registered by this Honorable Office on May 21, 1996 under Registration No, 63004 covering goods in Class 05. A certified copy of Certificate of Registration No. 63004 is hereto attached as Annex A and made integral part hereof.

"1.1. The Opposer obtained trademark registrations or has applied for registration for its PLAVIX mark in numerous countries. Copies of some registration certificates for the mark PLAVIX obtained by the Opposer in other countries are hereto attached as Annex B.

"2. The Opposer has extensively been promoting its pharmaceutical product bearing its PLAVIX mark in the Philippines and in other countries and has been doing so prior to the filing of the Respondent-Applicant's trademark application for PRAVOX with this Honorable Office.

"3. The Opposer's pharmaceutical product bearing its PLAVIX mark is widely available throughout the Philippines.

"4. As a result of the advertising and sales of the Opposer's products bearing the PLAVIX mark and the Widespread use of the product in the Philippines, such product has come to be, and now is, well and favorably known to the Filipino consuming public. Moreover, the mark PLAVIX has become distinctive for the Opposer's pharmaceutical products sold in commerce throughout the Philippines.

"5. Due to the extensive sales of the Opposer's pharmaceutical product bearing its PLAVIX mark in the Philippines and because of the excellence and quality associated by the Filipino consuming public with the said product, the Opposer has built and now enjoys valuable goodwill in the business as represented by its PLAVIX mark.

"6. Notwithstanding the Opposer's long use and prior registration of its PLAVIX mark, on October 23, 2008, the Respondent-Applicant filed with this Honorable Office Trademark Application No. 4-2009-013016 for its mark PRAVOX also for pharmaceutical products in Class 05.

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

The Opposer's evidence consists of the following:

1. Exhibit "A" -Copy of Certificate of Registration No. 63004 for the trademark PLAVIX issued on 21 May 1996;
2. Exhibit "B" -Copies of PLAVIX registrations obtained by Opposer in other countries;
3. Exhibit "C" -Copies of marketing materials;
4. Exhibit "D" -Copies of several sales invoices issued by Opposer to Metro Drug Inc. and Mercury Drug Corporation;
5. Exhibit "E" -List of pharmacies, drugstores, clinics and hospitals where the Opposer's PLAVIX are being sold;
6. Exhibit "F" -Authenticated Affidavit of Sylvie Guillas;
7. Exhibit "G" -Affidavit of Eduardo Tadeo Hagad;
8. Exhibit "H" -Affidavit of Lalivette Carag;
9. Exhibit "I" -Affidavit of Gloria Meñano; and
10. Exhibit "J" -Authenticated copy of Special Power of Attorney issued to Cesar C. Cruz & Partners Law Offices.

On 12 January 2010, the Respondent-Applicant filed its Answer to Opposition alleging the following special and affirmative defenses:

"3. This opposition is nothing more than a pure harassment and intimidation perpetrated by a huge billion-dollar French multinational company against a small and lowly Filipino pharmaceutical company that is trying to eek out a business in this poor country of ours.

"4. This bullying can be readily seen at the flimsy and shallow grounds it cooked up by alleging that PRAVOX and PLAVIX are confusingly similar. By the mere pronunciation alone, even if the Opposer says it a million times, PRAVOX does not sound anything like PLAVIX. Maybe in French it does but not in English or Tagalog by a Filipino in the Philippines. On this mundane ground alone, this opposition is unconvincing.

"5. On its paragraph 12.1 the Opposer alleges that both marks consist of two syllables which allegedly substantially sound the same. We beg to disagree. Unless the person speaking has a speech impediment it does not in any way sound the same. PRA is along way off from PLA and VOX is no way near VIX. The insistence by the Opposer that the same is similar is utterly pathetic.

"6. Opposer arrogantly presumes that Respondent-Applicant alleged selection of the mark PRAVOX is to take advantage of the worldwide reputation of the mark PLAVIX. The allegation insults the intelligence of the Respondent-Applicant. As if Respondent-Applicant needs to copy alleged famous names to come up with its own.

So how did the Respondent-Applicant come up with the name PRAVIX?

The first three letters of its product comes from the initials of the name of its President, Pedro R. Ayson or PRA. That is the plain, simple and honest reason for the first three letters of the subject product, nothing more.

The second syllable VOX is derived from its generic name LEVOFLOXACIN. As we can see from the said generic name, there is the letter V and there is the letter O and there is the letter X, hence, VOX and not VIX.

Thus, the allegation of the Opposer that Respondent-Applicant is taking advantage of its so called reputation is a mere paranoia, a baseless fear.

"7. With the above solid and incontrovertible basis for the name PRAVIX, the insinuation by the Opposer on its par. 16 that: Moreover, of all the words or combinations of letters available to the Respondent-Applicant, the Respondent-Applicant knowingly chose to use a confusingly similar mark to that of the Opposer's mark... literally blow on its face. Opposer should be ashamed of its baseless, if not impertinent and rude allegations.

"8. The Opposer alleges in its par. 13 that: The registration of the Respondent-Applicant's mark and use in commerce in the Philippines will likely confuse and mislead or deceive the public that the Respondent-Applicant's products are those being sold or approved by or originating from the Opposer. This self-righteous and haughty statement deserves scant attention because the same has no substantial argument to back it up. This is because the Opposer is merely engaging in a game of sounds like (the products do not even sound alike).

"9. x x x

"9.1. The drugs are of totally different kinds.

PRAVOX is antibacterial. Its indications read: Levofloxacin is the optically active S-(-) - isomer of the f1ouoroquinolone antibacterial agent of ofloxacin. It is generally considered to be twice as potent as ofloxacin with a wider spectrum of activity. It has been used in the treatment of a wide range of infections including lower respiratory tract infections, skin and soft tissue infections, typhoid and paratyphoid fever and urinary tract infection.

We were told that PLAVIX is for the heart and it is not an antibiotic.

How can therefore two distinct and totally different products "confuse and mislead or deceive the public?

"9.2. The drugs can only be administered via prescription.

What is the likelihood that a cardiologist will prescribe PRAVOX to treat a specifically diagnosed heart condition? What are the odds that the pulmo specialist or urologist or an internist will prescribe PLAVIX to combat a bacterial infection? It is practically zero and yet the Opposer alleges that the products will likely confuse and mislead or deceive the public.

Again, how can the public be "confused, mislead or deceived" if the subject products are administered by specialists? And based on the Generics Act, the physician writes the generic name and not the brand name."

On 22 January 2010, the Opposer filed its Reply stating that:

"3. Contrary to the allegation in paragraph 3 of the Answer that the present Opposition is a pure harassment and intimidation perpetrated by the Opposer against a small and lowly Filipino pharmaceutical company that is trying to eek (*sic*) out a business in this poor country of ours, the Opposer's claim is genuine and legitimate, and has basis in law.

"4. The Respondent-Applicant fails to realize that confusion may be likely notwithstanding the fact that the goods on which similar marks are employed are non-competing. Mere dissimilarity of goods does not preclude relief where the junior user's goods are not too different or remote from any that the prior user would be likely to manufacture or sell. In the instant case, the goods involved are not entirely unrelated or remote. The Opposer's PLAVIX mark and the Respondent-Applicant's proposed PRAVOX mark are both used for goods in Class 3, that is, pharmaceutical products. Moreover, the pharmaceutical product being manufactured, sold and distributed by the Respondent-Applicant cannot be said to be beyond the Opposer's zone of

natural and logical operation and expansion. Hence, to allow the Respondent-Applicant to use and register the proposed PRAVOX mark will create an impression to the Filipino consuming public that the proposed PRAVOX mark is derived from the Opposer's PLAVIX mark, when in fact, it is not. Additionally, the same association may be drawn as to the origin of the proposed mark PRAVOX.

"5. In its Answer, the Respondent-Applicant's counsel, instead of proving that his client's use of the proposed mark PRAVOX is in good faith and without any intent to cause confusion to the general public, embarked upon a long-winded discourse which, in essence, proved absolutely nothing. Instead of basing its arguments on clear facts and provisions of law, the Respondent-Applicant chose to argue on the basis of misplaced emotion and nationalism, which clearly is impossible to be the foundation of a trademark application before this Honorable Office. Noteworthy is the fact that apart from the Respondent-Applicant's tirade, the Respondent-Applicant has not presented any evidence which under the Intellectual Property Code and the Rules and Regulations on Inter Partes Proceedings, it was duty-bound to do.

"6. The Respondent-Applicant, being a corporation, can only act through its board of directors and/or duly authorized officers or agents. Physical actions such as the signing and delivery of documents may be performed on behalf of the corporate entity, only by specifically authorized individuals. Here, the corporate secretary who prepared and filed the Answer for the Respondent-Applicant does not appear to be authorized by the Respondent-Applicant to do so. The corporate secretary who signed the Answer failed to show any competent proof that it is duly authorized to act for and on behalf of the Respondent-Applicant in this instant action. Hence, the corporate secretary is bereft of authority to file the Answer for and on behalf of Metro Pharma Phils. Inc.

"7. While a lawyer owes devotion to the interest of the party he represents, a lawyer should always be reminded of his lawyer's oath or conducting himself with courtesy, fairness and candor toward his professional colleagues and shall not, in his professional dealings, use language which is abusive, offensive or otherwise improper, such as what the counsel for the Respondent-Applicant has done in his Answer."

On 18 February 2010, this case was set for preliminary conference, however; only the counsel for the Opposer appeared. In view thereof, this Bureau issued an Order<sup>2</sup> stating, among other things, that the Respondent-Applicant waived its right to submit position paper pursuant to Section 14.3 of Office Order No. 79<sup>3</sup> The subsequent Motion for Reconsideration filed by Respondent-Applicant was likewise denied by this Bureau in a Resolution dated 20 September 2010.

Should the Respondent-Applicant be allowed to register the mark PRAVOX?

The Opposer anchors its opposition on Sec. 123.1 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

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

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<sup>2</sup> Order No. 2010-284 dated 22 February 2010.

<sup>3</sup> Sec. 14.3. x x x A party who fails to attend the preliminary conference shall be deemed to have waived the right to submit position papers and draft decision.

(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

x x x

The competing marks are reproduced below for comparison:



Obviously, the competing marks are not identical. Firstly, Opposer's mark appears in capital letters while Respondent-Applicant's are in small and bold letters. Secondly, Opposer's mark ends with letters V, O and X while Respondent-Applicant's mark ends with V, I and X, which obviously are pronounced and sound differently. While it may be argued that both marks consist of two syllables, such fact is not sufficient to establish the likelihood of confusion.

Also, while the goods involved pertain to pharmaceutical products under Class 05, these drugs are different in compositions and are intended for different purposes. The pharmaceutical product under the mark PLAVIX is used for the prevention and treatment of cardiovascular disorders. On the other hand, PRAVOX is a brand for treatment of a wide range of infections or is used as an antibacterial.

Moreover, aside from the fact that the pharmaceutical products on which the competing marks are used are prescription drugs, the difference in the illness or disorders on which the drugs are applied to, makes the consumers more cautious and wary in buying the right product and brands. The situation is not the same as when two competing brands cater to or treat the same or related diseases. It is unlikely that the consumers will associate the Respondent-Applicant's mark with that of Opposer's and vice versa. As such, adverse effect on the reputation or goodwill of the Opposer's mark cannot be fairly inferred.

Accordingly, this Bureau finds no cogent reason to believe that the Opposer will likely be damaged by the registration of the Respondent-Applicant's mark.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby, DENIED. Let the filewrapper of Trademark Application No. 4-2008013016 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Makati City, 9 December 2010.

NATHANIEL S.AREVALO  
Director, Bureau of Legal Affairs  
Intellectual Property Office