

SANOFI-AVENTIS,  
Opposer,

- versus -

SHEILA MAE M. VELILLA,  
Respondent-Applicant.  
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IPC No. 14-2009-00084  
Case Filed: 18 March 2009  
Opposition to:  
Appln. Serial No. 4-2007-012670  
Date Filed: 14 November 2007  
Trademark: TICLEX

Decision No. 2010-78

## DECISION

Sanofi-Aventis (the "Opposer"), a corporation organized and existing under the laws of France, with principal address at 174 avenue de France, 75013 Paris, France, filed on 18 March 2009 an opposition to Trademark Application Serial No. 4-2007-012670 filed by Sheila Mae M. Velilla (the "Respondent-Applicant"). The Respondent-Applicant seeks to register the mark "TICLEX" for use on goods in Class 05 1, specifically pharmaceutical product, namely anti thrombotic drug.

The Opposer alleges the following:

"4. The Opposer is the owner of the mark I1CUD, which was registered by this Honorable Office on May 22, 1981, and effectively renewed on May 22, 2001 under Registration No. 029478 covering goods in Class 05, specifically for pharmaceutical products for the prevention and treatment of Thrombotic diseases.

"5. On November 14, 2008, the Respondent-Applicant filed with this Honorable Office Trademark Application No. 4-2007-012670 for I1CLEX in Class OS, specifically for 'pharmaceutical product, namely anti-thrombotic drug'.

'IV

## GROUND IN SUPPORT OF THIS OPPOSITION

"6. Under existing laws, rules, and jurisprudence, the mark TICLEX 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:

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"7. The Opposer has openly and continuously used the mark TICLID in the Philippines and elsewhere in the world, prior to the filing date of the Respondent-Applicant's trademark application for TICLEX on November 14, 2008. Moreover, the Opposer continues to use the TICLID mark in the Philippines and in numerous other countries.

"8. The Opposer likewise has extensively promoted the mark TICLID in the Philippines and in numerous other countries and has thus obtained significant goodwill for its pharmaceutical product upon which the mark TICLID is used.

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<sup>1</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and servicemarks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

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

'9.1. That the Respondent-Applicant adopted the mark TICLEX for its products also in Class 05 is clearly an attempt to trade unfairly on the goodwill, reputation and awareness of the Opposer's TICLID mark that was previously registered by this Honorable Office on May 22, 1981 and which has been registered and applied for registration worldwide. Such fact is even more apparent since the Respondent-Applicant is using her mark on the same indication as that of the Opposer's TICLID, that is, an anti-thrombotic drug.

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

"11. The Respondent-Applicant's mark resembles the Opposer's TICLID mark in terms of spelling, pronunciation, appearance and medical indication as to be likely to deceive or cause confusion. Hence, the registration of the mark TICLEX violates Section 123.1 (d) of the Intellectual Property Code.

'11.1 The two marks are confusingly similar based on the following factors:

'11.1.1 Both marks are composed of six (6) letters.

'11.1.2 Both marks consist of two syllables which substantially sound the same.

'11.1.3 Both marks begin with the letters T, I, C and L.

'11.1.4 Out of the six (6) letters of which the Opposer's mark is composed, the Respondent-Applicant's mark contains four (4) of them, namely: T, I, C and L.

'11.1.5 Both marks are in all capital letters.

'11.1.6 Both marks are purely word marks.

'11.1.7 When pronounced, emphasis of both marks is on the first syllable - "TIC"

'11.1.8 Both marks are in Class 5 and are used for pharmaceutical preparations.

'11.1.9 The medical indication on which both marks are used is exactly the same, that is, to treat thrombotic diseases.

"12. Both marks are not only grouped under the same class, i.e., Class 05, but the goods covered by the contending marks are pharmaceutical products used to treat the exact same indications, namely, Thrombotic diseases. Such confusion can be dangerous to the welfare of the general public since the goods involved relate to medicinal products which, when used improperly, may cause, the patient more harm than good.

"13. By the Respondent-Applicant's use of the mark TICLEX, 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 TICLID.

"14. Evidently, the Respondent-Applicant's mark may cause confusion in the minds of the consumers by usurping the mark TICLID, a mark legally owned by the Opposer, and by passing off its own pharmaceutical products as those made by the Opposer.

"15. The denial of Application No. 4-2007-012670 for the mark TICLEX by this Honorable Office is authorized under other provisions of the Intellectual Property Code.

The Opposer's evidence consists of the following:

1. Annex "A" -Original Verified Notice of Opposition;
2. Annex "B" -Notarized and Legalized Affidavit executed by Ms. Sylvie Guillas;
3. Annex "B-1" -Annex "A" of the Affidavit of Ms. Sylvie Guillas. (Copies of the certified copies of trademark registrations of the mark TICLID in France, Canada, Japan, Singapore, United Kingdom and United States of America);
4. Annex "C" -Notarized and Legalized Special Power of Attorney executed by Ms. Sylvie Guillas;
5. Annex "D" -Original Notarized Affidavit executed by Ms. Gloria L. Menano;
6. Annex "D-1" -Annex "A" of the Affidavit of Ms. Gloria L. Menano. (Copy of Certificate of Production Registration No. 002397 for the pharmaceutical product TICLID issued by the Bureau of Food and Drugs);
7. Annex "E" -Original Notarized Affidavit executed by Mr. Eduardo Tadeo Jover Hagad;
8. Annex "E-1" -Annexes "A" to "A-24" of the Affidavit of Mr. Eduardo Tadeo Jover Hagad (a listing the hospitals, clinics, drugstores and pharmacies where the pharmaceutical product TICLID is distributed and available in the Philippines); and
9. Annex "E-2" -Annexes "B" to "B-7" of the Affidavit of Mr. Eduardo Tadeo Jover Hagad (copies of sales invoices for the pharmaceutical product TICLID).

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 15 April 2009. The Respondent-Applicant, however, did not file an Answer. Thus, Rule 2, Sec. 11 of the Regulations on Inter Partes Proceedings, as amended, provides:

Sec. 11. *Effect of failure to file Answer* -In case the respondent fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the petition or opposition, the affidavits of the witnesses and the documentary evidence submitted by the petitioner or opposer.

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

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.<sup>2</sup>

In this regard, Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") states that a mark shall not 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:

- (i) The same goods or services; or

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<sup>2</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

- (ii) Closely related goods or services; or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion."

Records and evidence show that at the time the Respondent-Applicant filed her trademark application, the Opposer has already an existing trademark registration for the mark TICLID (Reg. No. 029478). The Opposer's trademark registration covers pharmaceutical products for the prevention and treatment of thrombotic diseases. The Respondent-Applicant's trademark application, on the other hand, also covers similar pharmaceutical product.

What remains to be resolved is whether the competing marks, as shown below, resemble each other that deception or confusion is likely to occur:

The word "TICLID" is written in a bold, black, sans-serif font. The letters are closely spaced and have a slightly irregular, hand-drawn appearance.

Opposer's mark

The word "TICLEX" is written in a bold, black, serif font. The letters are evenly spaced and have a classic, formal appearance.

Respondent-Applicant's mark

The only difference between the marks is the composition of their respective second syllables. Obviously, there was no ingenuity or originality on the part of the Respondent-Applicant in coining the mark TICLEX. The intent to make a colorable imitation of the Opposer's mark can be fairly inferred from the fact that the Respondent-Applicant's mark will be used on exactly the same pharmaceutical products as the Opposer's. The Opposer's mark having long been in the market, and the Respondent-Applicant dealing with the same goods, it is a reasonable conclusion that the latter is well-aware of the Opposer's products under the brand or mark TICLID. What the Respondent-Applicant did to make its mark appear different from TICLID is to replace the last two letters with "EX". At any angle, this modification made by the Respondent-Applicant failed to confer a character on its mark that is distinct from the Opposer's. Without a doubt, it is likely that the registration of the Respondent-Applicant's mark would cause damage to the Opposer. The Respondent-Applicant's pharmaceutical products bearing the "TICLEX" mark will be associated to the Opposer.

The Respondent-Applicant's attempt to register a mark that is a colorable imitation of the Opposer's mark is anathema to the above-cited principles and rationale of the trademark registration system. Indeed, as held by the Supreme Court in *American Wire & Cable CO. V5. Director of Patents.*<sup>3</sup>

"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"

To conclude, the Respondent-Applicant's application is proscribed under Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Let the filewrapper of Trademark Application No. 4-200702670 be returned together with a copy of this Decision to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Makati City, 25 November 2010.

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