

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

IPC No. 14-2007-00333  
Case Filed on:

Opposition to:

- versus -

Appln. Ser. No.: 4-2007-001122  
Date Filed: 02 February 2007  
Trademark: "ANACIN"  
Class: 5 "analgesic preparations"

WYETH,  
Respondent-Applicant,  
x-----x

Decision No. 2009-104

## DECISION

For decision is the Notice of Opposition filed by Sanofi-Aventis (formerly Sanofi-Synthelabo), (hereinafter referred to as Opposer), a corporation organized and existing under the laws of France, with address at 174 Avenue de France, 75013, Paris, France, against Application Serial No. 4-2007- 001122 for the mark ANACIN, covering goods under Class 5, namely "Analgesic preparations" in the name of Wyeth, (hereinafter referred to as Respondent-Applicant), a corporation organized under the laws of Delaware, U.S.A.

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. A copy of the duly notarized Special Power of Attorney and Related Secretary's Certificate in favor of the undersigned attached herewith as Exhibit A. The authenticated Verification and Certification against Forum Shopping executed by Kristoffer G. De Jesus of VERALAW (Del Rosario Bagamasbad and Raboca) Law Offices, executed pursuant to the Special Power of Attorney, is hereto attached as Exhibit B.
2. Opposer is not doing business in the Philippines but has capacity to sue under Section 160, in relation to Section 3, of Republic Act No. 8293, known as the Intellectual Property Code of the Philippines. Opposer's home country, France, extends by treaty, conventions or law to persons or nationals of the Philippines the privilege to bring an action in that country for infringement, unfair competition, or false designation of origin and false description without need of a license to do business in that country.
3. Opposer has its real and effective commercial establishment in France, which country and the Philippines are member-signatories to the WTO (Uruguay Round) - TRIPS Agreement. Under Article 2.1, in relation to Article 16 and 42 of said Agreement, "members shall make available to right holders civil judicial procedures concerning the enforcement of intellectual property rights." Said Agreement further provides that "each member shall accord the nationals of other members treatment no less favorable than it accord to its own nationals with regard to the protection of intellectual property rights, subject to the exemptions already provided in, respectively, the Paris Convention of which the Philippine is a signatory by virtue of Senate Resolution No. 89, dated 10 May 1965." Article 42 of the agreement further provides that: "Defendants shall have the right to written notice which is timely and contains sufficient detail, including the basis of the claims. Parties shall be allowed to be represented by independent legal counsel, and procedures shall not impose overly burdensome requirements concerning mandatory personal appearances. All

parties to such procedures shall be duly entitled to substantiate their claims and to present all relevant evidence.”

4. The aforesaid provisions of the TRIPS Agreement have been carried into effect by Section 3 of Republic Act No. 8293, as follows:

Section 3. International Conventions and Reciprocity. - Any person who is a national or who domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition to which the Philippines by law, shall be entitled to the benefits to extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property rights is otherwise entitled by this Act.”

5. Opposer is the owner of the mark “AFAXIN”. It has registered its AFAXIN mark in the Philippines under Certificate of Registration No. 000518 for goods under Class 05: “Vitamin A preparation for the prevention and treatment of deficiencies of growth-promoting and antiophthalmic vitamin A”, originally issued on September 11, 1941. It should be noted that Opposer’s trademark and Respondent-Applicant’s trademark application covers the same class of goods (Class 05). Opposer adopts the certified true copy of certificate of registration No. 000518 submitted in the case of Sanofi-Synthelabo vs. Gamot Philippines, Inc., (MNO No. 2007-218) as part of its exhibit in the instant case, a copy of which is attached hereto as Exhibits “C”, “C-1” to “C-5”.
6. Respondent-Applicant is a foreign corporation with address on records as above-stated, and where Respondent-Applicant may be served with notices and processes of this Honorable Office.
7. On February 2, 2007, Respondent-Applicant filed an application for the mark “ANACIN” covered by Application No. 42007001122, covering the goods in Class 05: “Analgesic Preparations,” which application was published for opposition in the e-Gazette on July 27, 2007. A Copy of Respondent-Applicant’s trademark application is attached herewith as Exhibit “0”.
8. On August 28, September 25 and October 25, 2007, Opposer, in accordance with the Rules and Regulations on Inter Partes Proceedings, 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 had until November 24, 2007 within which to file its Verified Notice of Opposition. Considering, however, that November 24, 2007 is a Saturday, Opposer has until the next working day, or on November 26, 2007 within which to file its opposition.
9. Opposer believes that it would be damaged by Respondent-Applicant’s registration of a mark “ANACIN”.

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

EXHIBIT	DESCRIPTION
“A”	Verification and certification against Forum Shopping
“B”	Special Power of Attorney
“C”	Copies of registration of the mark AFAXIN

“D”	(none)
“E”	various affidavits of use
“F”	Affidavit of Jennifer D. Fajelagutan
“G”	Print-out of website

A Notice to Answer was received by the respondent-applicant on 14 January 2008 but no Answer was filed. The issues for consideration which will be simultaneously discussed is whether the mark ANACIN is registrable and whether ANACIN and AFAXIN are confusingly similar.

Evidence show that opposer through its predecessor in interest Winthrop-Stearns, Inc. has registered the mark AFAXIN on April 5, 1949 under Registration No. 1230-S (Exhibit “C”-5), and Certificate of Renewal No. 518 (Exhibit “C”-1) in the name of Sterling Drug Inc. of New York As shown in the certification by IPO (Exhibit “C”), certificate of renewal of registration 518 of the trademark AFAXIN states that its registrant is Sterling Drug, Inc. and assigned to Sanofi Pharmaceuticals, Inc. and name of new owner as Sanofi-Synthelabo, Inc. Various affidavits of use (Exhibit “E”). The Affidavit of use filed in May 30, 2003, was filed by opposer indicating several outlets such as Mercury Drug, Emmaflor Pharmacy, Emilene’s Pharmacy. These evidence prove opposer’s right to file the instant opposition and the continued use of the mark AFAXIN in the Philippines.

The marks of the contending parties are reproduced hereunder for comparison:

Opposer’s mark	Respondent-Applicant’s mark
	

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”

The Supreme Court in Mighty Corporation and La Campana Fabrica de Tabaco, Inc. vs. E. & J. Gallo Winery and the Andresons 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 Dominancy 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 Dominancy 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.”

Upon examination of the marks, it appears that both marks consist of six literal elements and of the six letters, there are four identical letters. The first letter A and last two letters, IN, are the same. As regards to the suffix, CIN and XIN, when pronounced sound the same. The letters X and C when pronounced both sound like S. Hence, the last syllables of the marks although seemingly different, XIN and CIN actually are phonetic equivalents. The only difference in pronunciation would be the letters F and N in the words ANACIN and AFAXIN considering that X and C are pronounced with an S sound. Therefore, the use of ANACIN for goods under the same category of goods under class 5 namely “Pharmaceutical products” would lead to a likelihood of confusion.

WHEREFORE, premises considered the OPPOSITION filed by opposer, Sanofi-Aventis (formerly Sanofi -Synthelabo) is, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 4-2007-001122 for the mark ANACIN for goods covering class 5 namely “analgesic preparations” filed by respondent-applicant, Wyeth, is, as it is, hereby given REJECTED.

Let the filewrapper of “ANACIN”, 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, 24 August 2009.

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