



SANOFI PASTEUR,
Opposer,

- versus -

GETZ BROS. PHILIPPINES, INC.,
Respondent-Applicant.

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IPC NO. 14-2008-00232
Opposition to:
Appln. Serial No. 4-2007-009204
(Filing Date: 23 August 2007)

TM: COMAXIN

Decision No. 2012- 42

DECISION

SANOFI PASTEUR ("Opposer")¹, filed on 29 September 2008 an opposition to Trademark Application Serial No. 4-2007-009204. The application of GETZ BROS. PHILIPPINES, INC. ("Respondent-Applicant")² covers the mark "COMAXIN" for use on pharmaceutical products used for the "*treatment of infections in the upper and lower respiratory tract, ENT, skin and soft tissue, gut infections, osteomyelitis, septicaemia, peritonitis and post-op infections*" under Class 05 of the International Classification of Goods³.

The Opposer alleges that the registration of COMAXIN in favour of the Respondent-Applicant is proscribed under Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), because it is confusingly similar to the Opposer's mark "COMBAXIM" which was registered in the Philippines on 05 December 2007 (under Cert. of Reg. No. 4-2006-011002) for use on "*pharmaceutical preparations in the form of pediatric vaccines*" under Class 5. The Opposer's evidence⁴ consists of the affidavit of its corporate director Enguerrand Nardone, a copy of Philippine Cert. of Reg. No. 4-2006-011002, worldwide portfolio of the mark "COMBAXIM" in the name of Sanofi Pasteur, certified copies of foreign certificates of registration for "COMBAXIM"⁵, and the duly legalized, authenticated and notarized Special Power of Attorney executed by the Opposer in favour of the law firm Saludo Agpalo Fernandez Aquino & Taleon Law Offices..

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 12 November 2008. The Respondent-Applicant, however, did not file an Answer.

¹ A corporation organized and existing under the laws of France with principal office at 2 Avenue Pont Pasteur, 69007 Lyon France.

² A corporation organized and existing under the laws of the Philippines with business address at 5th Floor, Ortigas Building, Ortigas Avenue, Pasig, City, Philippines.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the 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 Purpose of the Registration of Marks concluded in 1957.

⁴ Exhibits "A" to "U".

⁵ in Paraguay, Australia, Cambodia, Chile, El Salvador, France, Hong Kong, International Registration, Israel, Jordan, Lebanon, Malasia, New Zealand, Panama and Republic of China;

In this regard, 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.⁶

Thus, Sec. 123.1(d) of the IP Code provides that a mark cannot 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 the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed the opposed trademark application on 23 August 2007, the Opposer has an existing trademark application for the mark COMBAXIM. The Opposer's application was allowed and a certificate of registration was issued on 15 October 2007.

But, are the competing marks nearly resemble each other that deception or confusion is likely to occur?

The only differences between the competing marks are the presence of the letter "B" in the Opposer's mark (COMBAXIM) and the last letters (COMBAXIM vs. COMAXIN). The differences notwithstanding, the competing marks still look and sound alike. By analogy, confusion cannot be avoided by merely dropping, adding or changing one of the letters of a registered mark.⁷

While the pharmaceutical products covered by the Opposer's mark ("vaccines") are not similar to the Respondent-Applicant's, these are closely related not only because they belong to Class 05 of the International Classification of Goods and Services, but because both products deal with bacterial diseases. The usage of these products may be different in the sense that one (Opposer's) is preventive, the other (Respondent-Applicant's) to treat or cure, this only highlight the need to prevent mistake or confusion. In *American Wire & Cable Co. v. Director of Patents et.al.*⁸, the Supreme Court held:

"The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. In short, to constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient for purposes of the law, that the similarity between the

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

⁷ Reference: *Continental Connector Corp. v. Continental Specialties Corp.*, 207 USPQ.

⁸ 31 SCRA 544 (G.R. L-26557, 18 Feb. 1970)


or mistake; it would be sufficient for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.”

Aptly, the ultimate ratio in cases of grave doubt is the rule that as between new comer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favour with the public, any doubt should be resolved against the newcomer in as much as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one.⁹

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2007-009204 be returned, together with a copy of this Decision, to the Bureau of Trademarks, for information and appropriate action.

SO ORDERED.

Taguig City, 07 March 2012.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs



⁹ *Del Monte Corporation et.al. v. Court of Appeals*, G. R. No. 78325. 25 Jan. 1990.