



MERCK KgaA,
Opposer,

-versus-

BIOGEN IDEC MA INC.,
Respondent- Applicant.

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}
} IPC No. 14-2010-00141
} Opposition to:
} Appln. Serial No. 4-2009-009431
} Date filed: 18 September 2009
} TM: "AVONEX"
}

NOTICE OF DECISION

BUCOY POBLADOR & ASSOCIATES

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GREETINGS:

Please be informed that Decision No. 2013 - 222 dated November 19, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 19, 2013.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



MERCK KgaA,

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- Versus -

IPC No. 14-2010-00141

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BIOGEN IDEC MA INC.,

Respondent-Applicant.

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Decision No. 2013- 222

DECISION

Merck KgaA ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2009-009431. The application, filed by Biogen Idec Ma Inc. ("Respondent-Applicant")², covers the mark AVONEX for use on "*pharmaceutical preparations for use in the treatment of neurologic disorders*" under Class 5 of the International Classification of Goods or Services.³

The Opposer alleges, among other things, that the mark AVONEX so resembles its mark AFOREX and other marks with the prefix "AFOR": AFFORDABILITY, AFFORALL, AFORBES, AFORDEL, AFORDIN, AFOR, AFORGET, AFORGLIDE, AFORGLIM, AFORGLIMIDE, AFORLOD, AFORLOS, AFORMESAR, AFORMETAN, AFORNAP, AFORPEN, AFORPENTIN, AFORPID, AFORPIL, AFORQ, AFORSLIM, AFORSOL, AFORTAN, AFORVASC, and QUALITY AFORMEDS. According to the Opposer, its applications and the registrations of its marks preceded the Respondent-Applicant's trademark application. The Opposer thus, contends that the registration of the mark AVONEX in favor of the Respondent-Applicant will violate Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code").

To support its opposition, the Opposer submitted as evidence the following:

1. authenticated Affidavit executed jointly by its officers Dr. Arno Hartmann and Ulrich Fogel;
2. certified true copy of Cert. of Reg. No. 4-2008-012402 for the mark AFOREX;
3. print-outs of the webpages of the website "http://www.ipophil.gov.ph" showing Trademark Reg. Nos. 4-2006-003065, 4-2008-012407, 4-2008-012413, 4-2008-012410, 4-2008-012409, 4-2009-001087, 4-2008-009945, 4-2008-014295, 4-2008-012411, 4-2008-012406, 4-2008-012401, 4-2008-012403, 4-2008-012408, 4-2008-

¹ With business address at Frankfurter Strasse 250, 64293 Darmstadt, Germany.

² A foreign corporation with principal office address at 14 Cambridge Center, Cambridge, MA, U.S.A.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

012404, 4-2008-012412, 4-2009-004671, 4-2008-012405, and 4-2008-014296.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 02 August 2010. In spite of the extensions of the period to file Answer granted to the Respondent-Applicant, the said party failed to file an Answer.

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

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 resemble such mark as to be likely to deceive or cause confusion.

Records show that when the Respondent-Applicant filed its trademark application on 18 September 2009, the Opposer has an existing trademark registration for the mark AFOREX (Reg. No. 4-2008-012402) as well as various applications/registrations for marks with the prefix "AFOR". The goods or pharmaceutical products covered by the Opposer's Reg. No. 4-2008-012402 - "*pharmaceutical preparations for the prevention and treatment of cardiovascular diseases*" - are closely related to the goods indicated in the Respondent-Applicant's trademark application.

But, are the marks AVONEX and AFOREX resembling each other such that confusion is likely to occur?

AVONEX and AFOREX are similar insofar as the first, third, fifth and sixth letters ("A", "O", "E", and "X") are concerned. However, the letters between "A" and "O" (AVONEX versus AFOREX) and also between "O" and "E" (AVONEX versus AFOREX) conferred upon the Respondent-Applicant's mark visual and aural properties sufficient to distinguish it from the Opposer's, and thus, diffusing the likelihood of confusion, much less, deception. The intersecting diagonal lines forming an inverted triangle in the letter "V" are in stark contrast with the single pillar with branching two perpendicular lines in the letter "F". Also, the ears can easily tell that the sound created by the syllables "VONEX" - "*vo-neks*", is different from that of produced by the syllables "FOREX", that is, "*fo-reks*".

With respect to the Opposer's other applied or registered marks - AFFORDABILITY, AFFORALL, AFORBES, AFORDEL, AFORDIN, AFOR, AFORGET, AFORGLIDE, AFORGLIM, AFORGLIMIDE, AFORLOD, AFORLOS, AFORMESAR, AFORMETAN, AFORNAP, AFORPEN, AFORPENTIN, AFORPID, AFORPIL, AFORQ, AFORSLIM, AFORSOL, AFORTAN, AFORVASC, QUALITY AFORMEDS - these marks are obviously different, in sight and sound, to the mark AVONEX.

Succinctly, 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.⁵ This Bureau finds the Respondent-Applicant's mark consistent with this function.

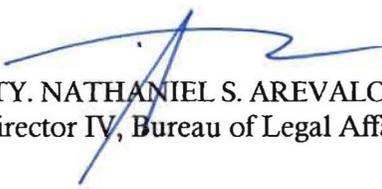
⁴ Marked as Annexes "A" to "K".

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

WHEREFORE, premises considered, the instant opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2009-009431 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 November 2013.



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