



SANOFI AVENTIS,
Opposer,

-versus-

YUNG SHIN (PHILS.), INC.,
Respondent-Applicant.

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} IPC No. 14-2010-00329
} Opposition to:
} Appln. Serial No. 4-2010-04028
} Filing Date: 16 April 2010
} TM: "SOVLAN"
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}
}

NOTICE OF DECISION

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c/o YUNG SHIN (Phils.), INC.
Respondent-Applicant
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101 Aguirre Street, Legaspi Village
Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 58 dated April 08, 2013 (copy enclosed)
was promulgated in the above entitled case.

Taguig City, April 08, 2013.

For the Director:


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



SANOFI AVENTIS,
Opposer,

IPC No. 14-2010-00329
Opposition to:

- versus -

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(Filing Date: 16 April 2010)
TM: "SOVLAN"

YUNG SHIN (PHILS.), INC.,
Respondent-Applicant,

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Decision No. 2013- 58

DECISION

SANOFI AVENTIS ("Opposer")¹ filed on 21 December 2010 an opposition to Trademark Application Serial No. 4-2010-04028. The application, filed by YUNG SHIN (PHILS.), INC. ("Respondent-Applicant")², covers the mark "SOVLAN" for use on "*pharmaceuticals/antibacterial*" under class 5 of the International Classification of goods³.

The Opposer alleges, among other things, that SOVLAN is confusingly similar to its registered mark "SOLIAN". According to the Opposer, the registration of SOVLAN in favor of the Respondent-Registrant violates 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 submitted⁴ as evidence copies of some foreign trademark registrations, list of places in the Philippines where SOLIAN products are being sold, and the affidavit of Beatrice Hammerer.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 21 February 2011. The Respondent-Applicant, however, did not file the Answer.

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

The essence of trademark registration is to give protection to the owners of trademarks. 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 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 a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 16 April 2010, the Opposer already has an existing trademark registration for SOLIAN under Reg. No. 4-1997-120433 issued on 14 December 2003. The Opposer's trademark registration indicates that the mark is for use on goods "*pharmaceutical products for the prevention and treatment of central nervous*

¹ A corporation organized and existing under the laws of France with principal address at 174 avenue De France, 75013 Paris, France.

² With address at 4th/F, Cacho-Gonzales Bldg., 101 Aguirre St., Legaspi Village, Makati City.

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.

⁴ Marked as Annexes "A" to "D".

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

system disorders" under class 5. Considering therefore that the Respondent-Applicant's trademark application covers "*pharmaceuticals*", this could include the goods specified in the Opposer's trademark registration.

But do the marks resemble each other that confusion, even deception, is likely to occur?

This Bureau agrees with the Opposer's assertion that the marks are confusingly similar because:

1. both marks are purely word marks;
2. both marks consist of two (2) syllables;
3. the Respondent-Applicant's applied mark appropriates five (5) out of six (6) letters of the Opposer's mark ("S", "O", "L", "A", and "N"); and
4. the Respondent-Applicant's applied mark adopts the same style of lettering.

To the eyes and ears, SOLVAN is almost undistinguishable from SOLIAN. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other⁶. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article⁷.

Succinctly, because the Respondent-Applicant will use or uses the mark on broadly-stated "*pharmaceuticals*", this could include goods or products that are similar and/or closely related goods to those covered by the Opposer's registered trademark. The changes in the spelling therefore did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. There is the likelihood that information, assessment, perception or impression about SOLVAN products delivered and conveyed through words and sounds and received by the ears may unfairly cast upon or attributed to the SOLIAN products and the Opposer, and *vice-versa*.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. 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 two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁸ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁹

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the

⁶ *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217.

⁷ *Emerald Garment Manufacturing Corp. v. Court of Appeals*, G.R. No. 100098, 29 Dec. 1995.

⁸ *American Wire and Cable Co. v. Director of Patents et al.*, (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.

⁹ *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant Opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2010-004028 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 08 April 2013.


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