



SANOFIE AVENTIS,
Opposer,

-versus-

GLENMARK PHARMACEUTICALS, LTD.,
Respondent- Applicant.

X-----X

IPC No. 14-2011-00089

Opposition to:

Appln. Serial No. 4-2010-500747

Date filed: 01 June 2010

TM: "STILOZ"

NOTICE OF DECISION

CESAR C. CRUZ & PARTNERS LAW OFFICES

Counsel for the Opposer
30th Floor, Ayala Life-FGU Center
6811 Ayala Avenue, Makati City

A.Q. ANCHETA AND PARTNERS

Counsel for Respondent-Applicant
Suite 1008-1009 Paragon Plaza
EDSA corner Reliance St.,
Mandaluyong City

GREETINGS:

Please be informed that Decision No. 2013 - 81 dated May 15, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 15, 2013.

For the Director:


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



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IPC No. 14-2011-00089

Opposition to Trademark

TM Appln. Serial No. 4-2010-500747

Date Filed: 01 June 2010

Trademark: "STILOZ"

Decision No. 2013-81

DECISION

Sanofi Aventis¹ ("Opposer") filed on 15 March 2011 an opposition to Trademark Application Serial No. 4-2010-500747. The contested application, filed by Glenmark Pharmaceuticals, Ltd.² ("Respondent-Applicant"), covers the mark "STILOZ" for use on "*pharmaceutical and medicinal preparations for the reduction of intermittent claudication*" under Class 05 of the International Classification of Goods³.

The Opposer avers that its mark "STILNOX" is an internationally well-known mark for its pharmaceutical products since 1988 and that it has filed its application for trademark registration as early as 01 June 2010. It maintains that the company has extensively been promoting and selling its pharmaceutical products bearing the said mark worldwide. It contests the Respondent-Applicant's application for registration of the mark STILOZ contending that the latter mark is an attempt to trade unfairly on the goodwill of STILNOX thereby resulting to diminution of value of the latter mark. The Opposer claims that the two marks resemble in spelling, pronunciation and appearance as to be likely to deceive or confusion as to constitute a violation of 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 the following as evidence:

1. copy of the Certificate of Renewal Registration No. 045305 for the trademark "STILNOX" issued by the Intellectual Property Office of the Philippines;
2. affidavit of Edith Gourtay, Trademark Lawyer of the Opposer;

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

² A foreign company duly incorporated on 18 November 1977 and existing in accordance with the laws of India with principal office address at 10-1 Mahalaxmi Chambers, 22, Bhulabhai Desai Road, Mumbai 400 026, India.

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.

3. affidavit of Malia Lei Tianco-Darantinao, the Supply Chain Director of Sanofi Aventis Philippines; and,
4. copies of sample sales invoices for pharmaceutical product STILNOX issued to Metro Drug Inc. and Mercury Drug Corporation.

For its part, the Respondent-Applicant alleges that the marks STILOZ and STILNOX are not confusingly similar. According to the Respondent-Applicant, aside from their distinctiveness - visually and aurally - the marks do not pertain to identical goods. The mark STILNOX is used on goods for the treatment of the central nervous system while STILOZ is exclusively used on goods for the reduction of symptoms of intermittent "*claudication*" - a disease that causes pain in the lower leg while walking. Furthermore, the Respondent-Applicant believes that the consumers will not be confused to buy one mistaking the other as the products will only be dispensed with assistance of a physician and because their labels show that the goods are manufactured by different companies. Likewise, the Respondent-Applicant debunks the Opposer's assertion that STILNOX is internationally well-known stating that no evidence was proffered to support this contention. It urges this Bureau to consider the decision of the National Office of Intellectual Property of Vietnam last 2007 where the Opposer's opposition to the registration of the same mark was denied. Finally, the Respondent-Applicant argues that the Bureau of Trademark has affirmed and confirmed the eligibility of STILOZ for registration.

The Respondent-Applicant's evidence consists of the following:

1. copy of the CIMS India's website page showing the indications of its STILOZ drug;
2. affidavit executed by Mr. Marshall J. Mendoza, Director and Legal and Company Secretary of the Respondent-Applicant;
3. certified true copy of the registration of STILOZ mark in India, dated 22 Aug. 2006;
4. certified true copy of the registration of STILOZ mark in Dominican Republic, dated 23 Mar. 2006;
5. Glenmark Pharmaceuticals, Ltd. Certified true copy of 2009-2010 Annual Report;
6. Memorandum and Articles of Association of Glenmark Pharmaceuticals, Ltd.;
7. certified true copy of the NKD/803 Domestic License from 29 Jan. 2003 to 31 Dec. 2007;
8. certified true copy of the renewal of NKD/803 Domestic License from 01 Jan. 2008 to 31 Dec. 2012;
9. certified true copy of export license from 22 Sept. 2003 to 31 Dec. 2012;
10. certified true copies of the domestic invoices for the sale of STILOZ in India from years 2003 to 2011;
11. certified true copies of the domestic invoices for the sale of STILOZ in Myanmar from years 2009 to 2011;

12. certified true copy of the domestic sales turn-over and international sales turn-over of STILOZ;
13. certified true copy of the annual sales, promotion expenses incurred on all products including STILOZ;
14. sample STILOZ packaging; and,
15. certified true copy of the visual aid of STILOZ.

The primordial issue in this case is whether the trademark application by Respondent-Applicant should be allowed.

This Bureau notices that the Opposer did not substantiate its allegation that STILNOX is an internationally well-known mark. The issue is a question of fact that must be determined by a competent authority and not merely by self-declarations and self-serving asseverations.

The Opposer though, hinges its opposition on Sec. 123.1 of the IP Code which 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.

In this regard, as culled from the records, the Opposer filed an application for the registration of the mark STILNOX as early as 09 January 1987. The application was allowed and the mark was registered on 23 June 1989. The latest renewal of the mark's registration was issued on 02 February 2010. Unquestionably, the Opposer's application preceded the Respondent-Applicant's.

A comparison of the Opposer's mark with the Respondent-Applicant's as depicted below:

STILNOX

STILOZ

shows that both contain the prefix "STIL". This similarity, however, is not sufficient to reach a conclusion that there is the likelihood of confusion, much less deception. The last syllable in the Respondent-Applicant's mark consisting of two (2) letters ("OZ") is visually and aurally different from the last syllable in the Opposer's composed of three (3) letters ("NOX").

That confusion or mistake, much less deception, is unlikely in this instant is bolstered by the fact that the goods covered by the STILNOX trademark registration are different from those indicated in the Respondent-Applicant's trademark application. The pharmaceutical products bearing the marks are not over-the-counter medicines or goods; these are dispensed through a physician's prescription. Because "NOX" after the

letter "L" in the Opposer's mark can easily be distinguished from the "OZ" after the letter "L" in the Respondent-Applicant's, it is very remote for a pharmacist to commit mistake in reading the prescription.

Furthermore, it is doubtful if the consumers in encountering the mark STILOZ will have in mind or be reminded of the mark STILNOX. The Opposer has not established that STILNOX is a well-known mark, nor its fame that could support a claim that the Respondent-Applicant's trademark application and use of the mark STILOZ manifest the latter's intent of riding in on the goodwill supposedly earned and enjoyed by the Opposer's mark.

It is emphasized that 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.⁴ This Bureau finds that the mark STILOZ meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-500747 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 May 2013.



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

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999.